



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 64

**Date of Decision:** 2024-03-28

### **[UNREVISED ENGLISH CERTIFIED TRANSLATION]**

## **IN THE MATTER OF AN OPPOSITION**

**Opponents:** 6164722 Canada inc. and Vanlife Sagas Squadron inc.

**Applicant:** David Vachon

**Application** 1,910,982 for VANLIFE

### **INTRODUCTION**

[1] 6164722 Canada inc. and Vanlife Sagas Squadron inc. (the Opponents) oppose the registration of the trademark VANLIFE (the Mark) that is the subject of application No. 1,910,982 filed by David Vachon (the Applicant).

[2] The application is based on use of the Mark in Canada since November 27, 2016, in association with the following services (the Services):

[TRANSLATION]

(1) Sale of custom modified motor vehicles

(3) Rental of motorized recreational vehicles and custom modified recreational vehicles.

(2) Modification, conversion, and interior and exterior upfitting of motorized recreational vehicles for camping and other outdoor activities; custom design services for interior and exterior development, modification, and conversion of motorized recreational vehicles for camping and other outdoor activities

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

### **THE RECORD**

[4] The application for the Mark was filed on July 23, 2018, and advertised for opposition purposes in the *Trademarks Journal* on September 23, 2020.

[5] A statement of opposition was filed on March 23, 2021, pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Unless otherwise indicated, all references in this decision refer to the Act as amended on June 17, 2019.

[6] The Opponents base their opposition on the following grounds:

- the Mark is not registrable within the meaning of section 12(1)(b) of the Act because, whether depicted, written or sounded, the Mark is clearly descriptive of the Services [section 38(2)(b) of the Act];
- the Mark is not distinctive within the meaning of section 2 of the Act in that it is used by several other persons and therefore does not actually distinguish the Services in association with which it is used by the Applicant from the services of other persons, nor is it adapted to distinguish them thusly [section 38(2)(d) of the Act]; and
- at the filing date of the application, the Applicant was not using and did not propose to use the Mark in Canada in association with the Services [section 38(2) of the Act].

[7] The Applicant filed a counter statement denying each ground of opposition pleaded by the Opponents.

[8] In support of their opposition, the Opponents furnished a statutory declaration by Julien Roussin Côté dated September 7, 2022, accompanied by Exhibits O-1 to O-8 (the Roussin Côté Declaration); and a statutory declaration by Dominic Faucher dated September 7, 2022, together with Exhibits O-1 to O-8 (the Faucher Declaration).

[9] In support of his application, the Applicant furnished a statutory declaration in his own name dated January 7, 2022, together with Exhibits R-1 to R-17 (the Vachon Declaration); and a statutory declaration by Sabrina Lavoie dated January 7, 2022, together with Exhibits SL-1 to SL-23 (the Lavoie Declaration).

[10] No cross-examinations were conducted.

[11] Both parties submitted written representations and were represented at the hearing.

### **EVIDENTIAL BURDEN**

[12] It is initially up to the Opponents to establish that their opposition is well-founded. Their grounds of opposition must be properly pleaded, and the Opponents have an initial evidentiary burden to adduce sufficient evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial evidential burden has been met, it is incumbent upon the Applicant to establish, on a balance of probabilities, that none of these grounds for opposition preclude the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293, 1990 CanLII 11059 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29].

### **THE PARTIES' EVIDENCE**

[13] I provide below an overview of the evidence filed by the parties, which I will examine in more detail in my analysis of the grounds of opposition. In my review of the evidence, I will disregard any statement by a declarant amounts to an opinion on issues of fact and law that are for the Registrar to decide. I will also disregard any evidence submitted through written representations.

### ***The Opponents' evidence***

#### The Roussin Côté Declaration

[14] Mr. Roussin Côté is the President of Opponent 6164722 Canada Inc., carrying on business under the name Go-Van (Go-Van). Mr. Roussin Côté explains that since 2015, his company has been offering “vanlife”-related content via an online magazine and online promotional services for van rental companies. Mr. Roussin Côté states that he wrote a [TRANSLATION] “book on vanlife, entitled Vie de Van, published in 2019”.

[15] In his declaration, Mr. Roussin Côté provided printed copies of webpages defining the word *vanlife* as essentially meaning an alternative lifestyle that consists of living in a vehicle upfitted for this purpose. Mr. Roussin Côté also provided printed copies of webpages containing publications on this lifestyle, such as books, blogs, and magazine articles, as well as printouts of certain pages of the Applicant’s website.

[16] Furthermore, Mr. Roussin Côté states that the Applicant filed an application for registration of the Mark in the United States. In support, he provided a copy of the application in question and a copy of an official letter from the examiner of the United States Patent and Trademark Office (USPTO) in the file.

#### The Faucher Declaration

[17] Mr. Faucher is the President and Creative Director of the Opponent Vanlife Sagas Squadron Inc. (Vanlife Sagas), a company he describes as active in [TRANSLATION] “the creation of content related to vanlife”.

[18] Mr. Faucher’s declaration is essentially identical to that of Mr. Roussin Côté’s. The attachments are identical. Therefore, I will henceforth refer only to the Roussin Côté Declaration.

### ***Applicant's evidence***

#### The Vachon Declaration

[19] The Vachon Declaration provides a picture of the Applicant’s business project in the market niche of the conversion, rental, and sale of recreational vehicles.

[20] The Applicant first describes his background in van conversion. In particular, he explains that in 2001, he acquired and converted his first van into a recreational vehicle for his personal use, and that in 2012, he founded a cabinetmaking business, company 9263-1464 Québec inc., which operates as DVA Concept Design.

[21] Mr. Vachon also states that in September 2017, he affixed the Mark to a van that was converted into a recreational vehicle and that this van circulated in Quebec as a promotional tool for his company DVA Concept Design. According to Mr. Vachon, these promotional activities enabled him to build an order book and to [TRANSLATION] “officially launch VANLIFE in 2018”.

[22] In addition, Mr. Vachon has provided details on the operations of the companies he founded in 2019 as part of his business project, namely, “Compagnie de location de véhicules récréatifs VanLife” (Vanlife Montréal) offering recreational vehicle sales and rental services and “Compagnie de design et d’aménagement de véhicules récréatifs VanLife” (VanLife Conversion) offering recreational vehicle modification, conversion, and upfitting services. Mr. Vachon states that he is the majority shareholder and president of these two companies and attaches to his declaration excerpts from the Quebec Business Register in support. He also states that the promotion of Vanlife Montréal and VanLife Conversion goods and services is done jointly by the same employees and on the same platforms.

[23] Overall, I note that the Vachon Declaration focuses more on the promotional activities carried out or undertaken by the Applicant since 2017, providing little detail on the performance of the Services, let alone the performance of the Services in association with the Mark.

#### The Lavoie Declaration

[24] Ms. Lavoie is a counsel with Benoît & Côté inc., the firm representing the Applicant. She attached excerpts from the Register of Trademarks and excerpts from dictionaries to her declaration.

## **ANALYSIS**

[25] As a preliminary point, it should be noted that the Vachon Declaration refers to the business activities not only of the Applicant, but also of Vanlife Montréal and VanLife Conversion. The Opponents point out that the Applicant has not entered into evidence any licence or details of the means by which the Applicant exercised control such that use of the Mark by these entities would benefit the Applicant under section 50 of the Act.

[26] However, I find that the evidence is sufficient to infer the existence of the required control, particularly in light of the Applicant's role as majority shareholder and president of the companies in question, and Mr. Vachon's statements regarding their joint promotional activities [see *Lindy v Canada (Registrar of Trade-marks)* (1999), 241 NR 362 (FCA) on the principle that the required control may be inferred from the facts; for example, where the registered owner is an officer, director, or majority shareholder of the licensee]. I note that some statements by Mr. Vachon (e.g., [TRANSLATION] "I continue to use the VANLIFE mark in association with recreational vehicle sales and rental services through Vanlife Montréal", para 12 of the Vachon Declaration) support such an inference.

[27] I therefore accept that use of the Mark by Vanlife Montréal and VanLife Conversion may benefit the Applicant under section 50 of the Act; I will therefore make no distinction between these entities and the Applicant in my analysis.

[28] That said, even if I were wrong, and as will become evident from my analysis below, my conclusion on this matter has no bearing on the ultimate outcome of this proceeding.

### ***Section 38(2)(e) ground***

[29] At the hearing, the Opponents' agent submitted that the statement of opposition contains a typographical error as it should have alleged section 30(b) of the former Act, rather than section 38(2)(e) of the Act that was in force on the date on which the statement of opposition was filed.

[30] In this regard, the Opponents' position is essentially that this application did not comply with section 30(b) of the Act as it read at the time the application was filed in 2018. The Opponents submit that the Applicant's evidence does not support the date of first use claimed in the application and that no evidence has been submitted demonstrating use of the Mark by the Applicant [Opponents' written representations at paras 87–112].

[31] As the transitional provisions of the Act provide that an application advertised *after* the coming into force of the new Act is governed by the new Act [section 69.1 of the Act], there is no need to give further consideration to the "correction", without legal basis, argued by the Opponents. It is the ground of opposition as pleaded in the statement of opposition, *i.e.*, under section 38(2)(e) of the Act, that is applicable in this case.

[32] The material date for assessing this ground is the filing date of the application.

[33] I note first that the ground as pleaded is insufficient. While it is generally sufficient to simply argue that an applicant did not use the applied-for trademark at the filing date of the application to satisfy the first prong of section 38(2)(e) of the Act, the Opponents did not cite any relevant facts or reasons why the Applicant did not propose to use the Mark in Canada at the filing date of this application to satisfy the second prong. Furthermore, the evidence on the record does not provide any support or clarification in this regard.

[34] It should also be noted that the purpose of assessing a ground of opposition under section 38(2)(e) of the Act is to determine whether an applicant was using or was proposing to use the applied-for trademark in Canada at the date of filing of this application, not whether an applicant claimed the correct basis for registration in their application. Indeed, for applications advertised after June 17, 2019, an applicant is no longer required to include a separate claim (for example, of use since an earlier specific date), and nothing prevents an applicant from amending their application to delete such claims [see section 35 of the *Trademarks Regulations* and the Canadian Intellectual

Property Office Practice Notice entitled *Practice Notice on the Amendment and Deletion of Use, Proposed Use, and Use and Registration Abroad Claims*].

[35] As previously noted, and as will become clear from the analysis below regarding the section 38(2)(d) ground of opposition, the Applicant's evidence is sparse with respect to the use of the Mark. That being said, I do not consider it necessary to address the first prong of this ground of opposition. Indeed, even if I concluded that the Mark had not been used as of the filing date of the application under the first prong, the Opponents would not succeed under the second prong as they did not plead any material facts in support of it, nor is there any evidence on the record to that effect.

[36] Therefore, this ground of opposition is rejected.

***Section 38(2)(e) ground***

[37] The Opponents plead that the Mark is not registrable within the meaning of section 12(1)(b) of the Act as it clearly describes the character of the Services.

[38] The material date for assessing this ground of opposition is the filing date of the application.

[39] The issue as to whether a trademark is clearly descriptive must be considered from the point of view of the average consumer of the services associated with this mark. "Character" means a feature, trait or characteristic of the services, and "clearly" means "easy to understand, self-evident or plain" [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Can Ex Ct)]. The assessment of the descriptiveness of the Mark must take into account the services associated with it [*Ontario Teachers' Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60].

[40] The parties agree that the term *vanlife* essentially refers to a nomadic lifestyle, involving a vehicle converted or modified so it can be lived in.

[41] According to the Opponents, since the Applicant's Services [TRANSLATION] "are closely related" to the definition of the word VANLIFE, it is "inevitable" that a consumer would, on first glance, be able to clearly determine the character or characteristics of the



Services [Opponents' written representations at para 36]. At the hearing, the Opponents submitted that to live [TRANSLATION] "the van life" or "van living," it is "necessary to buy a van, rent a van, or convert a van," that is to say, the Services specified in the application.

[42] The Opponents also submit that an application for the Mark, in association with services similar to the Services, was rejected by the USPTO examiner as he determined that the Mark was descriptive.

[43] The Applicant challenges the admissibility and relevance of the evidence with respect to the application rejected by the USPTO examiner and denies that the Opponents have established a meaning of the term *vanlife* that was known to the [TRANSLATION] "general Canadian public" as of July 23, 2018, namely the material date to assess this ground.

[44] First of all, with respect to the USPTO examiner's decision, I note that foreign decisions are not binding on the Registrar and that although they may sometimes have a persuasive effect, I do not consider this to be the case here. Suffice it to mention that the evidence on the record does not establish that American law regarding the descriptiveness of a trademark coincides with the specific requirements of section 12(1)(b) of the Act, the American examiner's decision referring to the "merely descriptive" character rather than the "clearly descriptive" character to be assessed under section 12(1)(b) of the Act.

[45] Second, with respect to the meaning of the Mark, the Applicant rightly points out that most of the evidence concerning the meaning of the term *vanlife* postdates the material date. References dated prior to the material date are printouts of the websites WordSpy ([www.wordspy.com](http://www.wordspy.com)) and Urban Dictionary ([www.urbandictionary.com](http://www.urbandictionary.com)) that contain quotes including the term *vanlife* and definitions of that term [para 3 and Exhibit O-1 of the Roussin Côté Declaration]. Even if I were to accept that this evidence is sufficient to enable the Opponents to meet their burden, I find that the Applicant also discharged his burden of establishing that the Mark was not clearly descriptive within the meaning of section 12(1)(b) of the Act as of the filing date of the application.

[46] In particular, although the Mark may refer to the lifestyle to which the Applicant's clients aspire, it does not describe the intrinsic character of the Services, that is the sale, rental or conversion of motorized recreational vehicles. The meaning of the Mark is not self-evident or plain such that one can conclude that it is clearly descriptive within the meaning of the Act. Rather, a mental exercise is required to start from the idea suggested by the Mark—that is, that consumers can [TRANSLATION] “live the vanlife” if they use the Applicant's Services—and to end up at the identification of those Services [see *GWG Ltd v Registrar of Trade-marks* (1981), 55 CPR (2d) 1 at pp 6 and 7 (FCTD) for a discussion regarding the assessment of descriptiveness when assigning meaning requires an exercise in “mental gymnastics”].

[47] I therefore find that the first impression created by the Mark does not clearly describe the character of the Services. While the Mark is evocative, section 12(1)(b) of the Act does not preclude its registration.

[48] Therefore, this ground of opposition is also rejected.

### ***Section 38(2)(d) ground***

#### The ground pleaded by the Opponents

[49] The Opponents plead that the Mark is not distinctive within the meaning of section 2 of the Act, as it is [TRANSLATION] “used by several other persons and therefore does not truly distinguish the Services in association with which it is used by the Applicant from those of others, nor is it adapted to distinguish them thusly.”

[50] The material date for assessing this ground of opposition is the filing date of the statement of opposition, that is, March 23, 2021.

[51] Upon reading the parties' written representations, and following the oral arguments, I find that the Applicant appears to interpret this third ground as a mere repetition of the ground alleging the descriptiveness of the Mark under section 38(2)(b), as well as an allegation of prior use of VANLIFE as a trademark by third parties [see the Applicant's written submissions at paras 94–108]. Such an interpretation overlooks some important nuances.

[52] Firstly, as discussed by the Federal Court in *Canadian Council of Professional Engineers v APA – The Engineered Wood Assn*, a ground based on non-distinctiveness under section 38(2)(d) of the Act is not merely repetitive of a ground under section 38(2)(b), and the fact that a trademark is not clearly descriptive does not necessarily mean that the mark is distinctive [(2000), 7 CPR (4th) 239 (FCTD) at 253].

[53] Thus, while this ground of opposition alleges that *vanlife* is a term used to describe a lifestyle related to the Services, the question is not whether this term is clearly descriptive. Rather, the question to ask is whether, in light of prior use of this word by third parties, the Mark could be used to identify the Applicant as the single source of the Services or, in other words, whether it could be used to distinguish the Applicant's Services from those of others as of the material date of March 23, 2021.

[54] Secondly, with respect to the allegation of prior use of the term *vanlife*, it is important to note that the Opponents do not allege such use as a trademark. Rather, the ground is based on the adoption of this term as a common or generic word.

[55] To satisfy their initial burden, the Opponents must therefore file sufficient evidence to enable me to reasonably conclude that the alleged facts exist, namely, that the term *vanlife* was used by third parties to an extent that would be sufficient to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58; for the analysis of a ground of opposition similarly based on an allegation of prior use of a term as a common word, see *Ebel Quarries Inc v Owen Sound Ledgerock Limited*, 2014 TMOB 11].

[56] The documentary evidence attached to the Roussin Côté Declaration is voluminous. However, it is far from clear that the evidence as a whole reflects the understanding of the term *vanlife* in Canada as of the material date of March 23, 2021. As noted by the Applicant, several documents are not dated or dated after the material date, and/or do not clearly establish a connection to Canada; for example, this is the case for several printed webpages [Exhibits O-1, O-2, and O-3], the list of results obtained from a Google search for videos related to the keywords [TRANSLATION]

“Vanlife documentary” [Exhibit O-4], and the printout of an excerpt from the Instagram page for the hashtag *#vanlife* [Exhibit O-6].

[57] However, I find that the Opponents’ evidence is sufficient to establish that *vanlife* was a term commonly used in Canada as of the material date, particularly in the context of renting recreational vehicles, thereby casting doubt on the distinctiveness of the Mark at the time of filing the statement of opposition.

[58] In particular, I note the presence of the term *vanlife* in many Canadian publications, including the following articles provided in Exhibits O-2 and O-3 of the Roussin Côté Declaration:

- “Why van life is the best way to travel,” dated June 14, 2019, and “Millennial Women Tell Us Why They Joined the #VanLife Trend...,” dated January 19, 2020, published on the Just Go Vans website (*justgovans.ca*);
- « La Norvège : Le paradis du Vanlife? » [Norway: Vanlife paradise?] dated February 5, 2020, and published on the Opponent’s website Vanlife Sagas (*vanlifesagas.com*);
- « Voici 6 endroits où louer un véhicule pour vivre la *vanlife* au Québec cet été » [Here are six places to rent a car to live the *vanlife* in Quebec this summer], dated May 27, 2020, and published on the Journal de Montréal website (*journaldemontreal.com*);
- « Vanlife au Québec : 8 conseils de pro pour réussir ses vacances » [Vanlife in Quebec: eight tips from pros for a successful vacation], dated June 8, 2020, and published on Elle Québec’s website (*vanlifesagas.com*); and
- « Une saison de folie pour la *vanlife* au Québec » [A crazy season for *vanlife* in Quebec], dated November 12, 2020, and published on the Espaces website (*espaces.ca*).

[59] The Roussin Côté Declaration also provides a list of books about “vanlife,” or its phonetic equivalent “van life,” as identified by a search of Renaud-Bray’s (*renaud-bray.com*) and Indigo (*chapters.indigo.ca*) websites [Exhibit O-5]. Several of the identified titles have release dates prior to the material date, including:

- *Van Life: Your Home on the Road*, released on October 10, 2017;
- *The Vanlife Companion*, released on November 20, 2018;
- *The Rolling Home Presents the Culture of Vanlife*, released on March 27, 2019;
- *Vanlife Diaries: Finding Freedom on the Open Road*, released on April 9, 2019;
- *Van Life: Skill Up for Life on the Road*, released on April 23, 2019; and
- *Vanlife en Famille: Osez la Liberté!* [Vanlife as a Family: Dare to be Free!], released on September 24, 2020.

[60] In addition, I note the term *vanlife* on websites offering recreational vehicle rental and upfitting services [Roussin Côté Declaration, Exhibit O-3], including:

- a printout of the Québec Campervans website (*quebeccampervans.com*) offering the rental of upfitted vans that refers to [TRANSLATION] “custom-built vanlife” and presents a copyright notice dated 2020; and
- a printout of the Curious Campervans website (*curiouscampervans.com*) offering caravan upfitting in British Columbia (“*Handcrafted Campervan Conversions in BC, Canada*”). A section of the webpage invites readers to watch a video of a 2020 *vanlife* trip and asks readers to contribute ideas for a future trip in 2021 (“*Check out the video below for our 2020 vanlife trip through the Kootenays and Rocky Mountains. Where should we go in 2021?!?*”).

[61] The Opponents having met their initial burden, it is up to the Applicant to demonstrate that his Mark did distinguish his Services from those of others or was adapted to distinguish them as of the material date [see *Muffin Houses Inc v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB) for the same principle with respect to goods].

#### Distinctiveness of a trademark

[62] There are two types of distinctiveness. First, inherent distinctiveness, when the mark is made up of a single or invented name that can only refer to one thing. Second, acquired distinctiveness, when consumers associate a mark with a particular source following the continued use of that mark. Acquired distinctiveness thus corresponds to

the extent to which a mark has become known as a result of its use. To establish that a mark has acquired distinctiveness, it must be shown that consumers are aware of the mark as an indicator of a single source [*Tommy Hilfiger Licensing Inc v Produits de Qualité IMD Inc*, 2005 FC 10 at paras 53–58].

[63] There is no doubt that “the very essence of a trade-mark is to be distinctive” [*Drolet v Stiftung Gralsbotschaft*, 2009 FC 17 at para 168]. Indeed, it is the distinctiveness of a mark that allows consumers to know what they are buying and from whom [*Kirkbi AG v Ritvik Holdings Inc / Gestions Ritvik Inc*, 2005 SCC 65 at para 39; see also *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 75].

[64] The question of whether a mark is distinctive is therefore a question of fact determined by reference to the message it conveys to the ordinary consumer of the goods or services in question [see *Richtree Market Restaurants Inc v Mövenpick Holding AG*, 2016 FC 1046 at para 33].

[65] For the reasons that follow, I consider the Applicant’s evidence insufficient to establish on a balance of probabilities that the Mark conveyed a clear message at the relevant date identifying the Applicant as the single source of the Services.

The Applicant has not demonstrated the inherent distinctiveness of his Mark

[66] The Applicant submitted that the term *vanlife* possesses inherent distinctiveness. In this regard, at the hearing the Applicant repeated arguments submitted in relation to the ground of opposition based on the descriptiveness of the term *vanlife*, that is, that the Opponents did not introduce into evidence any dictionary definition or [TRANSLATION] “official” source establishing a definition for the term *vanlife*, and that at most this term is known only by “very limited” number of persons to refer to an alternative lifestyle.

[67] Even in the absence of a dictionary definition, I find it entirely reasonable to conclude from the evidence that the term *vanlife* was understood by the Canadian public to mean a nomadic lifestyle, including by a community of enthusiasts of this lifestyle including individuals and companies offering rental and/or upfitting of recreational vehicles adapted for “van living”.

[68] Given the previous use of *vanlife* as a generic term in Canadian publications as evidenced in the Roussin Côté Declaration, I am of the view that this word was neither original, nor unique or inventive as of the material date of March 23, 2021. Therefore, I find that the Mark did not have inherent distinctiveness on that date.

The Applicant has not demonstrated the acquired distinctiveness of his Mark

[69] The Applicant submitted that the Mark also acquired distinctiveness through its use. In this regard, the Applicant submits that the evidence shows use of the Mark, including because the presentation of VANLIFE MTL and the “Logo”, described below, constitute examples of use of the Mark *per se*.

[70] The Applicant relies, among other things, on the following evidence in the Vachon Declaration [see the Applicant’s written representations at paras 109–113]:

- a copy of an Analytics report showing the number of visits to the Applicant’s website *www.vanlifemtl.com* between February 7, 2018 and April 21, 2021, including more than 200,000 visitors who chose either the language “fr-ca” or “en-ca” [para 16, Exhibit R-9];
- a copy of a report on visitor statistics and the type of visitor interaction with the *www.vanlifemtl.com* website showing more than 200,000 new users of this site in 2020 and a projection of more than 300,000 new users in 2021 [para 17, Exhibit R-10]; and
- printed pages of postings from the Applicant’s Instagram account, which had more than 25,000 subscribers at the time of its printing in 2022 [para 18, Exhibit R-11]. The Instagram account handle is VanLifeMtl. The profile picture of the account is the following image (the Logo):



[71] Among the photographs posted on the Instagram account, I note some of them showing vans with the Logo, the *www.vanlifemtl.com* website address, or both. The Instagram publications presented in Exhibit R-11 are undated. However, I note a screenshot in Exhibit R-2 showing a post dated September 30, 2017, on the Applicant's Instagram account, which includes a photograph of an individual wearing a shirt on which is displayed VANLIFEMTL in front of a van marked *vanlifemtl.com*.

[72] At paragraph 114 of his written submissions, the Applicant also highlights the [TRANSLATION] "substantial" promotional efforts evidenced in the Vachon Declaration, namely:

- participating in trade shows and promotional events between 2017 and 2019 [paras 7–10];
- maintaining a recreational vehicle reservation website at *www.vanlifemtl.com* [para 23];
- maintaining Instagram and FaceBook social media accounts with the handle VanLife Mtl and displaying the Logo as a profile picture [paras 18, 19, and 22];
- acquiring of 34 domain names with the term *vanlife*, listed in a table with each of their creation dates [para 14, Exhibit R-8]; and
- videos released on YouTube [para 21, Exhibit R-12].

[73] With respect to these videos, Mr. Vachon states that [TRANSLATION] "Vanlife Montréal ...promotes its products and services through videos on the Youtube® platform, always in association with the VANLIFE trademark." In support, he attaches Exhibit R-12, namely a list of videos available on this platform, including their titles,



release dates, and viewing statistics. I note tens of thousands of views between September 2019 and September 2020. Several titles refer to VanLife MTL (e.g., [TRANSLATION] “Rental of VanLifeMTL campervans,” “VanLife MTL launches its 2019 season,” and “Live the adventure with VanLife MTL!”). Although the term VANLIFE *per se* is also present in some titles (e.g., [TRANSLATION] “VanLife” and “VanLife Cover Autumn,”) the content of the videos was not entered into evidence, and I cannot assess how, if at all, the Mark was displayed in these videos.

[74] With respect to the performance of services, the evidence is essentially limited to some relatively vague statements by Mr. Vachon, such as those referring to VanLife Montréal’s “clientele,” as well as a document that Mr. Vachon describes as [TRANSLATION] “internal statistics [showing] the number of VANLIFE van rentals for each month since 2018” [para 28, Exhibit R-15]. This one-page document is a table with a number of transactions and monthly sales between May 2018 and April 2021. The total for these three years, excluding April 2021, is 866 transactions totaling approximately \$1,200,000. Mr. Vachon states that the [TRANSLATION] “sale price of vans upfitted by Vanlife Conversion is between \$125,000 and \$200,000” but does not provide sales figures for vans sold or converted. No statement is made with respect to the display of the Mark on vans rented, sold or converted by the Applicant.

[75] Considering the evidence as a whole, I accept that the evidence demonstrates the advertisement and performance of at least some of the Services by the Applicant. However, as will be seen from the analysis below, it is unclear that the evidence shows the use of *the Mark* in association with the Services within the meaning of section 4(2) of the Act, let alone the use of the Mark to a sufficient extent to establish that consumers recognized the Mark as an indicator of a single source.

#### *Use of the Mark per se*

[76] Although the Applicant alleges the abundant and continuous use of “the Mark,” it appears very rarely in the evidence relating to the Applicant’s Services. The Opponents rightly point out that the Applicant’s evidence instead shows the generic usage of the word *vanlife* as designating an experience or lifestyle. For example, I note the following

passages, all contained in articles posted on the Applicant's website prior to the material date [Exhibit O-8 of the Roussin Côté Declaration]:

[TRANSLATION]

- “Although the vanlife movement is becoming increasingly well known...”
- “... if you are toying with the idea of vanlife...,”
- “I experienced VanLife with friends...,”
- “Vanlife is not camping *per se*,” and
- “... the community spirit surrounding the Vanlife movement.”

[77] At the hearing, the Applicant could identify only one example of use of the Mark *per se* in the evidence as a whole. This is the inscription of the word VANLIFE on the interior upfitting of vans appearing in photographs posted on the Applicant's website, including certain webpages that provide details on the recreational vehicle rental service [Exhibit R-14A of the Vachon Declaration].

[78] I find that the display of the Mark, both inside recreational vehicles and in photographs of such vehicles published on the Applicant's website, is insufficient evidence to establish that the Mark *per se* had acquired any distinctiveness in association with the Services at the material date. Without further factual details regarding the display of the Mark on the vehicles, the number of vehicles rented, sold or modified by the Applicant that were apparently so marked, over what time period, the date of publication of the photographs in question on the website, or other relevant information, the evidence does not enable me to determine the extent to which the Mark may have become known as a result of its use within the meaning of section 4(2) of the Act.

[79] With respect to Mr. Vachon's assertion that he [TRANSLATION] “affixed the VANLIFE mark to a van converted into a recreational vehicle” in September 2017 [Vachon Declaration at para 6], I note that the photographs he provides in support of this assertion [Exhibit R-2] do not show the Mark *per se*, be it on the interior upfitting of the van or on the van's exterior. Instead, the van displays the hashtag #vanlifemtl and a reference to the website [www.vanlifemtl.com](http://www.vanlifemtl.com).

[80] Before proceeding, it is worth recalling here that mere registration of a domain name does not alone constitute use of a trademark [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone), Inc*, 2011 TMOB 15]. Accordingly, the existence of the domain names listed in Exhibit R-8 of the Vachon Declaration, with nothing more, does not establish use of the Mark nor any acquired distinctiveness.

#### *Use of VANLIFE MTL*

[81] The parties seem to agree that the Applicant uses VANLIFE MTL as a trade name. In this regard, I note the following examples of use of VANLIFE MTL to designate the Applicant (and incidentally his vehicles), all contained in articles posted on the Applicant's website prior to the material date [Exhibit O-8 of the Roussin Côté Declaration]:

#### [TRANSLATION]

- “VanLife MTL offers you a completely different experience”,
- “... VanLife MTL believes it is important to upfit 4 season vans...”,
- signed by “DOMINICK MÉNARD, VANLIFE MTL AMBASSADOR AND FOUNDER OF BONVELO”,
- “TheVanLife MTL team is working very hard...”,
- “A VanLife MTL is like a cottage on wheels...”,
- “Leave for a few days either by renting a VanLife MTL van...”, and
- “I have made it my mission to convince you that a winter adventure in VanLife MTL is possible!”

[82] At the hearing, the Applicant submitted that the term MTL is simply an addition to [TRANSLATION] “clarify” his Mark and “better identify” his business. According to the Applicant, the use of VANLIFE MTL is therefore equivalent to the use of the Mark. In other words, the Applicant wishes to avail himself of the use of the VANLIFE MTL mark (and trade name) to demonstrate that the Mark had acquired distinctiveness.

[83] First of all, I note that the use of a trade name and the use of a trademark are not mutually exclusive, particularly in association with services [*Consumers Distributing*

*Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB); *I Quint Group Inc. v Quintcap Inc.*, 2021 TMOB 281 at para 72].

[84] That said, I am not satisfied that the Mark *per se* may have acquired distinctiveness through the use of VANLIFE MTL. To reach such a conclusion, the Applicant had to demonstrate that, upon seeing VANLIFE MTL, the consumer's first impression would have been that the Mark *per se* was used. To resolve such a case, one must consider whether the Mark stood out from the additional element MTL, or whether the additional element would have been perceived as purely descriptive or as a separate trademark or trade name [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) at 538].

[85] According to the Federal Court of Appeal, the practical test to be applied in such a case is to compare the mark in question with the actual mark in use and to determine “whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.” [*Canada (Registrar of Trade Marks) v Cll Honeywell Bull*, [1985] 1 FC 406 (FCA) at 409, 1985 CanLII 5537]. In my view, this is not the case here.

[86] I come to this conclusion by first considering the evocative nature of the word *vanlife* and the common usage of that word at the material date as a generic term designating a lifestyle. In this regard, it is important to recall that trademarks composed of descriptive or suggestive words have a low degree of inherent distinctiveness [see *Prince Edward Island Mutual Insurance Co v Insurance Co of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD); *Kellogg Inc v Weetabix of Canada Ltd*, 2002 FCT 724].

[87] I also take into account that the additional element MTL is not a word but a combination of letters that would likely be seen in this context as an abbreviation referring to the city of Montreal. Furthermore, I note that combinations of letters, initials, and acronyms are generally weak marks lacking inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) at pp 162–164]. Therefore, the additional element MTL—whether seen by consumers as a reference to

the city of Montreal suggesting the origin of the Services or simply as a combination of letters—has low inherent distinctiveness.

[88] Thus, neither the VANLIFE nor MTL elements possess a significant degree of inherent distinctiveness. In my view, the distinctiveness of VANLIFE MTL is more a result of the *combination* of these two elements. Therefore, I find that a consumer is likely to perceive VANLIFE MTL as a unitary phrase or an indissociable whole rather than a combination of two marks, or a combination of the Mark and a mere “clarification” term. In light of the Opponents’ evidence demonstrating the prior usage of *vanlife* by third parties, I find that the addition of the element MTL is far from superfluous or unimportant: this addition transforms or qualifies the term VANLIFE so as to distinguish the Applicant’s Services from those of others.

#### *Logo use*

[89] At the hearing, the Applicant submitted that the Logo is only a minor variation of the Mark and that the presentation of the Logo in association with the Services amounts to use of the Mark. The Applicant also submitted that the VANLIFE element dominates the Logo when both sounded and viewed.

[90] I am not persuaded by the Applicant’s submissions. First, when viewed, given the suggestive nature of the VANLIFE and MTL word elements discussed above, I find that the striking effect of the Logo results from its graphical component, including the marked contrast between the black triangular road indented by the rectangular van. I also note that the triangular shape of the road gives a perspective and movement effect that draws the eye to these design elements.

[91] When sounded, the graphic component of the Logo would not likely be pronounced. Although the MTL term is in a smaller font size than the VANLIFE term, I am not convinced that the MTL term would be ignored by consumers. For the reasons stated above, and particularly the importance of the addition of the MTL term, I find that consumers would be more likely to pronounce the Logo as the combination of the words VANLIFE and MTL, as in “vanlife M-T-L” or “vanlife Montreal.”

[92] In short, I am not satisfied that the use of the Logo amounts to the use of the Mark and that it may have enabled the Applicant to acquire a reputation in association with the term VANLIFE in itself, such that consumers recognize the Mark *per se* as identifying the Applicant as the single source of the Services.

#### Conclusion on distinctiveness

[93] As I noted above, the Applicant has the ultimate burden of demonstrating on a balance of probabilities that none of the grounds of opposition prevent the registration of the Mark. The fact that the ultimate burden falls on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, the issue must be decided against the Applicant.

[94] Based on my above analysis, I am not satisfied that the Applicant has met the burden of demonstrating that the Mark distinguished his Services from those of others as of the material date. Accordingly, the ground of opposition under sections 38(2)(d) and 2 of the Act is successful.

#### **DECISION:**

[95] 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.

Eve Heafey  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

Certified translation  
Daniel Lépine, Lisa Hannaford-Wong, Beau Brock

# Appearances and Agents of Record

**HEARING DATE:** 2023-11-30

## **APPEARANCES**

**For the Opponents:** Frédéric Letendre

**For the Applicant:** Hilal El Ayoubi

## **AGENTS OF RECORD**

**For Opponents:** Yulex, Attorneys and Strategists, S.E.N.C.R.L.

**For the Applicant:** Hilal El Ayoubi