



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 91

Date of Decision: 2024-05-09

INTERLOCUTORY RULING

Opponent: Parkside Professional Products Ltd.

Applicant: Lidl Stiftung & Co. Kg

Application: 1948044 for PARKSIDE

INTRODUCTION

[1] Parkside Professional Products Ltd. (the Opponent) has opposed registration of the trademark PARKSIDE (the Mark), which is the subject of application No. 1948044, applied for by Lidl Stiftung & Co. Kg (the Applicant).

[2] By way of letter dated March 27, 2024, the Applicant requested an interlocutory ruling striking paragraphs 6(a), 6(b), 6(c), 6(d), 6(e), 6(f) and 6(g) of the Opponent's statement of opposition dated March 21, 2024.

[3] The Opponent responded by way of letter dated May 3, 2024, in which the Opponent also requested leave to file an amended statement of opposition.

LEAVE TO AMEND THE STATEMENT OF OPPOSITION

[4] I am satisfied that it is in the interests of justice to grant leave to the Opponent pursuant to section 48 of the *Trademarks Regulations* to file the amended statement of opposition dated May 3, 2024, given that the amendments are in response to a request for an interlocutory ruling and the opposition is at a very early stage.

[5] Therefore, the interlocutory ruling below is in respect of the amended statement of opposition dated May 3, 2024.

INTERLOCUTORY RULING

[6] The sufficiency of a statement of opposition is governed by section 38 of the Trademarks Act, RSC 1985 c T-13. Section 38(2) of the Act details an exhaustive list of the grounds upon which an opposition may be based, and section 38(3)(a) of the Act requires that a statement of opposition be set out in sufficient detail to enable the applicant to reply. An insufficient ground of opposition would be one that either alleges an improper ground of opposition or does not contain sufficient material facts to enable the applicant to reply. A proper pleading alleges the material facts but not the evidence which the party intends to adduce to establish those facts [see *Pepsico Inc and Pepsi-Cola Canada Ltd v Registrar of Trade-marks* (1975), 22 CPR (2d) 62 (FCTD)]. Pursuant to section 38(6) of the Act, the Registrar may strike all or part of a statement of opposition if it is not based on a ground in section 38(2) or does not set out a ground in sufficient detail to enable the applicant to reply to it.

[7] For the reasons set out below, paragraph 6(a), the word “including” in paragraph 6(e), paragraph 6(f) and paragraph 6(g) of the amended statement of opposition are struck. The Applicant’s request to strike the remaining paragraphs is refused as I am satisfied that the remaining

grounds each constitute valid grounds of opposition and have been pleaded with sufficient detail to enable the Applicant to reply.

Paragraph 6(a) Ground of Opposition

[8] The Applicant submits that this ground should be struck because the Opponent did not indicate which of the applied for goods lacks the required degree of specificity. While the Opponent did identify numerous goods at issue in a schedule to the statement of opposition and defined them as the Applicant's goods, the schedule provided to the statement of opposition as amended appears to be nothing more than a list of all of the applied for goods without any indication whatsoever regarding why any of these goods do not comply with section 30(a) of the Act. In my view, this is not sufficient for an applicant to know the case it has to meet. And as noted by the Applicant, this is especially true when there is a long list of goods, as there is in the present case.

[9] Accordingly this ground of opposition is struck.

Paragraph 6(e) Ground of Opposition

[10] I agree with the Applicant that by stating that the Applicant's trademark is not distinctive of and is not adapted to distinguish the Applicant's goods "from the goods and services of others, including the Opponent", without indicating who those others are, this ground is not pleaded with sufficient detail to enable the Applicant to reply. With a section 2 ground of opposition, an Opponent may not plead non-exhaustive language in order to rely on unidentified third parties and unidentified third party trademarks, as this does not permit the Applicant to know the case it has to meet.

[11] Therefore, the word "including" in paragraph 6(e) is struck and replaced with the word "namely".

[12] The distinctiveness ground of opposition in paragraph 6(e) is therefore limited to the trademark not distinguishing the Applicant's goods from the goods and services associated with the Opponent's trademarks mentioned in the statement of opposition.

Paragraph 6(f) Ground of Opposition

[13] I agree with the Applicant that by simply mirroring the language of section 38(2)(e), this ground has been insufficiently pleaded. It is not sufficient to merely plead that an applicant did not propose to use such trademark. Instead, an opponent must allege specific facts with respect to how or why the applicant did not, or could not, propose to use the trademark in Canada [see, for example, *Engineers Canada/Ingénieurs Canada v Kokuyo Co Ltd*, 2023 TMOB 89; *Pax Labs, Inc v Shenzhen Topgreen Technology Co, Ltd*, 2023 TMOB 17].

[14] Accordingly, this ground of opposition is struck.

Paragraph 6(g) Ground of Opposition

[15] In this case, the section 38(2)(f) ground is pleaded as follows:

Pursuant to s. 38(2)(f), at the filing date of the Application, the Applicant was not entitled to use the Applicant's trademark in Canada with the Applicant's Goods:

- (i) The Applicant was well aware or is deemed to have been aware of the Opponent's Marks which had been previously used and made known in Canada in association with the goods and services as set out in the chart in paragraph 3 above;
- (ii) The Applicant was not entitled to use the Applicant's trademark in Canada in association with the Applicant's Goods in view of the allegations set out above; and

(iii) The Applicant was not entitled to use the Applicant's trademark in Canada with the Applicant's Goods since to do so would be contrary to the passing off provisions set out in s. 7 and would depreciate the goodwill in the Opponent's Marks in section 22.

[16] In assessing whether or not any part of a ground of opposition as pleaded ought to be struck, the test to be applied is whether "assuming the truth of all of the allegations of fact in the statement of opposition, the opponent has an arguable case" [*1772887 Ontario Ltd v Canada (Registrar of Trade-marks)*, 2010 FC 645; *Manufacturers Life Insurance Company v British American Tobacco (Brands) Limited*, 2017 FC 436/2010 FC 645].

[17] In this case, and considering the statement of opposition as amended as a whole, I do not find that the Opponent has provided sufficient facts about its trademarks that would support a finding that use by the applicant of its trademark would be contrary to the passing off provisions in section 7 or would depreciate the goodwill in the Opponent's marks pursuant to section 22 of the Act. Further, since it appears that the section 38(2)(f) allegation is based on a mere awareness of the Opponent's applied for trademarks, and there is no other allegation of bad faith or circumstances that would prevent the applicant from using the applied-for trademark, I do not find that this ground as pleaded would result in an arguable case under section 38(2)(f) of the Act. It is accordingly struck.

[18] This interlocutory ruling has no effect on any outstanding deadlines.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Agents of Record

For the Opponent: Dickinson Wright LLP

For the Applicant: Robic IP Agency LP