



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2024 TMOB 126

**Date of Decision:** 2024-07-08

## **INTERLOCUTORY RULING**

**Opponent:** DMD Products, LLC

**Applicant:** Donna Lehtonen

**Application:** 2057257 for G'LOVE HANDLES

## **INTRODUCTION**

[1] Reference is made to the applicant's letter of May 22, 2024 requesting an interlocutory ruling and an extension of time to file a counter statement. In particular, the applicant requests that the grounds of opposition set out in paragraphs 4(2), (3) and (4) of the opponent's statement of opposition dated March 20, 2024 be struck.

[2] Reference is also made to the opponent's letter of June 14, 2024 contesting the applicant's request for an interlocutory ruling, and the applicant's response dated June 17, 2024.

[3] The sufficiency of a statement of opposition is governed by section 38 of the *Trademarks Act* (the Act). 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 a statement of opposition to be set out

in sufficient detail to enable the applicant to reply [see *Schneider Electric Industries SAS v Spectrum Brands, Inc*, 2021 FC 518 at para 26]. The Registrar's power to strike all or part of a statement of opposition is set out in section 38(6) of the Act, as follows:

(6) At the applicant's request, the Registrar may ... strike all or part of the statement of opposition if the statement or part of it

(a) is not based on any of the grounds set out in subsection (2); or

(b) does not set out a ground of opposition in sufficient detail to enable the applicant to reply to it.

[4] A proper pleading alleges the material facts but not the evidence which the opponent intends to submit to establish those facts [*Pepsico Inc v Registrar of Trade-marks* (1976), 22 CPR (2d) 62 (FCTD)].

#### **INTERLOCUTORY RULING**

##### ***Paragraph 4(2) of the statement of opposition***

[5] In this paragraph of the statement of opposition, the opponent alleges that the applicant is not the party entitled to registration of the trademark under sections 16(1)(a) and 16(1)(c) of the Act, because of an alleged likelihood of confusion with the opponent's trademark and trade name, respectively. I note that in paragraph 3 of the statement of opposition, the opponent identifies the trademark on which it relies as well as the related goods and services. In paragraph 4(2)(b) of the statement of opposition the opponent identifies its trade name.

[6] The applicant contends that paragraph 4(2) of the statement of opposition does not "identify any statutory grounds of opposition nor basis required to be pleaded in the statement of opposition." I respectfully disagree with the applicant's position on this point. In my view, the existing language of paragraph 4(2), including the references in that paragraph to

sections 16(1)(a) and 16(1)(c) of the Act, make it apparent that the opponent is relying on section 38(2)(c) of the Act, in conjunction with sections 16(1)(a) and 16(1)(c) of the Act. Moreover, when paragraph 4(2) is read in conjunction with the preceding paragraph 3 which describes the trademark on which the opponent relies, the basis for the opponent's non-entitlement ground of opposition is sufficiently particularized to permit the applicant to reply. Consequently, I consider paragraph 4(2) of the statement of opposition to be sufficiently pleaded and I refuse the applicant's request to strike this paragraph.

***Paragraph 4(3) of the statement of opposition***

[7] In paragraph 4(3) of the statement of opposition, the opponent alleges that the trademark is not distinctive within the meaning of section 2 of the Act because it is confusing with the opponent's trademark and trade name. The applicant's contention with this paragraph is the same as with paragraph 4(2), namely, that paragraph 4(3) does not "identify any statutory grounds of opposition nor basis required to be pleaded in the statement of opposition." I again reject the applicant's position regarding this paragraph. The existing language of paragraph 4(3), including the reference to section 2 of the Act, makes apparent that the opponent is relying on an allegation of non-distinctiveness under section 38(2)(d) of the Act in conjunction with section 2 of the Act. Similarly, when paragraph 4(3) is read in conjunction with paragraph 3 of the statement of opposition which describes the opponent's trademark, and paragraph 4(2)(b) which describes the opponent's trade name, the non-distinctiveness ground of opposition is sufficiently particularized to permit the applicant to reply. Consequently, I consider paragraph 4(3) of the statement of opposition to be sufficiently pleaded and refuse the applicant's request to strike this paragraph.

***Paragraph 4(4) of the statement of opposition***

[8] Paragraph 4(4) of the statement of opposition makes multiple allegations, including that the application does not comply with sections 38(2)(e), 38(2)(f), 38(2)(a), 38(2)(a.1), and section 30 of the Act. For the reasons set out below, each of these grounds of opposition are insufficiently pleaded, and thus paragraph 4(4) in its entirety will be struck.

Paragraph 4(4)(a) - Section 38(2)(e) ground of opposition

[9] With this ground of opposition under section 38(2)(e) of the Act, the opponent alleges that the applicant was not using and did not propose to use the trademark in Canada. However, the opponent has not pleaded any material facts to support that allegation, either in this paragraph or elsewhere in the statement of opposition. Instead, the opponent merely repeats the language of the statute, which is not sufficient for a section 38(2)(e) ground of opposition. The jurisprudence under Section 30(e) of the Act as it read prior to June 19, 2019 (the Old Act) is instructive here. Under that provision of the Old Act, it was not sufficient for an opponent to merely replicate the language of the provision; an opponent had to provide sufficient detail as to why an applicant did not have the requisite intention to use a trademark [see *Avon Canada Inc v Lifestyles Canada Ltd*, 2001 CarswellNat 4120].

[10] In view of the above, the section 38(2)(e) ground of opposition is hereby struck.

Paragraph 4(4)(b) - Section 38(2)(f) ground of opposition

[11] With this ground of opposition, the opponent alleges that the applicant was not entitled to use its trademark in Canada. Again, with this allegation, the opponent has simply repeated the language of section 38(2)(f) of the Act without providing any material facts to support the allegation. This does not provide the applicant with sufficient detail to enable it to reply. Even reading

this paragraph in conjunction with the rest of the statement of opposition, at best for the opponent the allegation could be read as an allegation that the applicant was not entitled to use the trademark due to confusion with the opponent's trademark and/or trade name, and that would be an improper ground as in essence it simply duplicates the other confusion grounds already alleged in the statement of opposition, such as those in paragraphs 4(2) and 4(3). Consequently, the section 38(2)(f) ground of opposition is hereby struck.

Paragraph 4(4)(c) - Section 38(2)(a) ground of opposition

[12] With this ground of opposition, the opponent alleges that the application does not conform to the requirements of section 30(2) of the Act. The opponent has not identified which provision(s) of section 30(2) is allegedly contravened, nor pleaded any material facts that would make that apparent. Consequently, this paragraph is not pleaded in sufficient detail to enable the applicant to reply.

[13] I note that section 30(2)(a) of the Act requires an application to include a description of the goods and services in ordinary commercial terms; however, to the extent that is the provision on which the opponent intended to rely, the opponent did not plead that, nor has the opponent identified which goods or aspects of the descriptions are not in ordinary commercial terms or why.

[14] In view of the above, the section 38(2)(a) ground of opposition is hereby struck.

Remainder of paragraph 4(4)

[15] In the remainder of paragraph 4(4), the opponent alleges that the application was not entitled to file the application under section 30 of the Act and/or such filing was not made in good faith and thus contravened section

38(2)(a.1) of the Act, because the applicant had not used and did not have a bona fide intention to use the trademark, and “did not take any reasonable steps to inquire whether it was entitled to use” the trademark.

[16] I agree with the applicant that the allegations in this remaining portion of paragraph 4(4) of the statement of opposition are insufficient and should be struck. The allegations regarding an absence of use or intention to use simply replicates the allegation under section 38(2)(e) of the Act, discussed above, which was insufficiently pleaded under that section and is similarly insufficiently pleaded here. The allegations regarding an absence of steps to inquire whether the applicant was entitled to use, appears to be duplicative of its non-entitlement allegations in paragraph 4(2) based on alleged confusion, and do not constitute a separate ground of opposition under section 38(2)(a.1). While section 38(2)(a.1) is a reasonably new provision (having come into force in June 2019) and thus may be given a generous interpretation at the pleadings stage, in my view, there are no material facts pleaded in this paragraph or elsewhere in the statement of opposition that would support an allegation of bad faith on the part of the applicant.

[17] Consequently, the remainder of paragraph 4(4) of the statement of opposition is struck.

#### **SUMMARY OF DISPOSITION**

[18] Paragraph 4(4) of the statement of opposition is hereby struck in its entirety. The remainder of the applicant’s request to strike is denied.

[19] Please note that the Registrar does not strike statements of opposition (or portions thereof) with or without leave to amend. Leave to amend a statement of opposition is governed by section V of the Practice Notice entitled *Practice in trademark opposition proceedings*.

**COUNTER STATEMENT DEADLINE**

[20] The applicant will have one (1) month from the date of this letter within which to file and serve its counter statement.

Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## Agents of Record

**For the Opponent:** MCMILLAN LLP

**For the Applicant:** OLLIP P.C.