



# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2025 TMOB 120

**Date of Decision:** 2025-06-02

## IN THE MATTER OF AN OPPOSITION

**Opponent:** Trademark Building Products Ltd.

**Applicant:** Window World International, LLC

**Application:** 1,855,788 for WINDOW WORLD

### OVERVIEW

[1] The application for the trademark WINDOW WORLD was filed on September 5, 2017 for the following Goods and Services on the basis of use in Canada and use and registration abroad.

Class 20 – (1) Window blinds, window shades

Class 35 – (1) Retail store services featuring replacement windows

Class 37 – (2) Installation of vinyl replacement and new construction windows

Class 37 – (3) Installation of replacement windows

[2] For the reasons that follow, the application is refused.

## **THE RECORD**

[3] The application was advertised for opposition in the *Trademarks Journal* of March 6, 2019. On March 19, 2019, the Opponent opposed the application by filing a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). This Act was amended on June 17, 2019. All references are to the Act as amended, 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 which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date].

[4] The Opponent raises a number of grounds of opposition including grounds based on sections 16(1)(a) and 16(2)(a) of the Act and non-distinctiveness primarily on the basis of confusion with the Opponent's trademark WINDOW WORLD. The Opponent also opposes the application on the basis that the Applicant did not use the Mark in Canada as of the dates claimed in the application contrary to section 30(b) of the Act.

[5] The Applicant filed a counter statement denying the grounds of opposition.

[6] The Opponent filed as its evidence the affidavits of Heather Bonnell, an articling student employed by its agent and the affidavit of Ian Franklin, a Director of the Opponent (at the time his affidavit was sworn) as well as certified copies of three trademark registration files. Mr. Franklin was cross-examined on his affidavit. The Applicant filed as its evidence two affidavits of Zach Luffman, Director of Franchising of Window World, Inc., a licensee of the trademark owner, as well as certified copies of four trademark registration files. Both parties filed written representations and attended a hearing.

## **OTHER PROCEEDINGS BETWEEN THE PARTIES**

[7] The parties are not strangers to each other with litigation concerning the WINDOW WORLD trademark at the Federal Court and a section 45 proceeding before the Registrar [*Trademark Building Products Ltd. v Window World International, LLC*, 2025 TMOB 63].

## **EVIDENCE OBJECTIONS**

### ***Objection to the Affidavits of Zach Luffman***

[8] The Applicant submitted as its evidence in this proceeding two affidavits of Zach Luffman which reference Federal Court File No. T-1325-21 in the header and primarily concern the Applicant's use of its trademark WINDOW WORLD. The Opponent submits that these affidavits should be declared inadmissible because they do not reference the current opposition, concern a different proceeding (with different material dates) and Mr. Luffman could not be subject to cross-examination. I disagree. Even though the header information does not correspond to this opposition, I would have had no trouble issuing a cross-examination order for Mr. Luffman had it been requested. I am unaware of any requirements in the Act or Regulations which require that an original affidavit be filed or that the header in an affidavit reference the opposed application [see also *Springwall Sleep Products Ltd v Ther-a-Pedic Associates, Inc* 1983 CanLII 5458 (TMOB) which discusses factors that the Registrar considers when accepting affidavits filed with respect to other proceedings]. Furthermore, for several years the Registrar has routinely accepted copies of affidavits without the filing of an original. As such, I find that the two affidavits of Mr. Luffman are admissible in this proceeding.

### ***Objection to the Affidavit of Ian Franklin***

[9] The Applicant objected to some of the evidence of Mr. Franklin on the basis of hearsay. Mr. Franklin became a Director of the Opponent on March 19, 2015 (para 1). Much of his evidence, however, related to the time period before he was a Director. On cross-examination, he indicated that he received advertisements pre-dating his involvement with the Opponent from the previous owner [see Qs 54-65]. However, he did not receive information on where, when or how these advertisements were distributed [Qs 65-70]. As such, while I have no difficulty finding that it was necessary for Mr. Franklin to file this evidence, I do not have enough information to assess its reliability. As such, I give it little weight.

## **ONUS AND LEGAL BURDEN**

[10] The legal onus is on the Applicant to show that the application complies with the provisions of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

## **REASONS FOR DECISION**

### *Section 30(b) Ground of Opposition*

[11] The application includes claims to use of the Mark in Canada since at least as early as July 31, 2015 on the Goods and since at least as early as October 29, 2012 on the Services.

### The Opponent Meets its Evidential Burden

[12] The Opponent alleges that the application does not comply with section 30(b) of the Act as the Mark was not being used as of these dates. The evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with this section of the Act is lighter because the facts supporting the use of the Mark are particularly within the knowledge of the Applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* 1986 CanLII 7617 (TMOB)].

[13] An opponent need only produce evidence to support its objections or adduce evidence from which it may reasonably be concluded that the facts alleged to support this ground of opposition exist [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at para 34]. There is no requirement that the evidence be clearly inconsistent with the claimed date of first use if an opponent has not relied on an affidavit filed by the applicant in the opposition proceeding [*Bacardi*, *supra* at para 33].

[14] Ms. Bonnell's evidence includes a printout of the Applicant's archived website for July 2, 2014 obtained from the internet archive WayBack Machine (Exhibit B). Evidence obtained from Wayback Machine has previously been found sufficient to meet an Opponent's light evidential burden with respect to section 30(b) [*Royal Canadian Golf Assn v O.R.C.G.A.* 2009 CanLII 90300 (TMOB)]. This website printout includes a list of locations of Window World stores which does not include any reference to Canada. As such, I find that the Opponent's evidence is sufficient to meet its evidential burden.

#### The Applicant Fails to Meet its Legal Onus

[15] Where an applicant seeks to register a trademark on the basis that it has been used by it prior to the filing of the application, such use must be continuous and in the normal course of trade [*Loblaws Inc v No Frills Auto and Truck Rental Ltd*, 2006 FC 537 at para 39]. In the *Bacardi* decision, *supra*, the Court stated the following regarding the test for continuous use at para. 60:

The test for continuous use being qualified by the "ordinary course of trade" provides crucial flexibility to the analysis. To expect that the continuous use of Dom Perignon Champagne at a high end liquor store and a pack of gum at a corner store would be identical in volume would belie important context and how the rate of sales in different industries can vary widely. Still, trademarks should not be registered over broad periods of time simply based on sporadic sales concentrated near the start of that period of time that fall below the ordinary course of trade. Otherwise, the use criterion, a cornerstone of trademark law, would be reduced to a technicality that any applicant could meet with isolated and manufactured sales that do not serve the principles underlying trade-mark law.

[16] The application includes claims to use of the Mark in Canada since at least as early as July 31, 2015 on window blinds, window shades and since at least as early as October 29, 2012 with retail store services featuring replacement windows and installation of vinyl replacement and new construction windows, and installation of replacement windows. Therefore, to meet its legal onus the Applicant must prove continuous use of its trademark in the normal course of trade with these goods and services from the dates claimed to the application's filing date of September 5, 2017.

[17] I find the Applicant's evidence insufficient to meet its legal onus to demonstrate compliance with section 30(b) of the Act, for the following reasons.

[18] With respect to the sale of window blinds and window shades, there is no evidence of the transfer of property of these items, as required by section 4(1) of the Act, to Canadians prior to the date claimed in the application. Rather, the only evidence of sales of products to Canadian customers is for windows (First Luffman affidavit, Exhibit B).

[19] With respect to the services, the relevant definition of use is set out in section 4(2) of the Act:

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[20] The display of a trademark on advertising is sufficient to meet the requirements of section 4(2) of the Act when the trademark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* 1976 CanLII 2656 (TMOB)]. In this case, while Mr. Luffman's evidence of advertising includes ads in magazines circulated in Canada prior to the material date (see, for example, First Luffman affidavit, paras 57-59, Exhibit D; Second Luffman affidavit paras 15-17, Exhibit D), I don't find that the Applicant was prepared to perform installation services in Canada from the date of first use claimed through the application filing date.

[21] First, I find that the description of the installation services in the application requires that installation services be offered in Canada. This is similar to the Federal Court's observation that a party claiming "operation of a hotel" would have to show operation of a hotel in Canada, whereas a party claiming hotel services could show use on reservation services which fall under hotel services [*Hilton Worldwide Holding LLP v Miller Thomson*, 2018 FC 895 at paras 83-84].

[22] Mr. Luffman's evidence is that the Applicant grants a license to Window World, Inc, who in turn sublicences the use of the Mark to franchisees (First Luffman affidavit, paras 3-13). The evidence provided by Mr. Luffman about the terms of the license including the Applicant's monitoring of Window World, Inc. and the provision of a standard operating procedures manual to franchisees, approval of vendors and the ability to inspect franchisees, is sufficient for me to find that the use by franchisees would enure to the benefit of the Applicant.

[23] Mr. Luffman's evidence is that its Old Vermont Franchisee who sold and arranged installation of WINDOW WORLD windows in Canada had its franchise terminated October 18, 2016 (First Luffman affidavit, paras 56, 95). After this, there is no evidence that any installation services were performed in Canada, nor that any of the Applicant's franchisees were ready to perform the installation services in Canada. At para 101 of Mr. Luffman's First affidavit, he explains:

During my tenure as Director of Franchising, I have spoken with an existing franchisee regarding relocating or opening up another franchise in Canada. From my company's business records, my company received three other inquiries within the last two years about expanding or relocating to Canada from existing franchisees, namely an inquiry about relocating or expanding, into Vancouver, an inquiry about relocating or expanding to Toronto, and an inquiry about relocating or expanding into Quebec. **From my company's business records, the Detroit Franchisee inquired within the last two years about cross-border sales into Canada, and the New Vermont Franchisee also inquired about cross-border sales into Canada, specifically about resuming the Old Vermont Franchisee's Services into Quebec. ...**

[24] As such, I do not find that the Applicant has met its legal onus with proving continuous use of the Mark in association with the installation of vinyl replacement and new construction windows and installation of replacement windows in the normal course of trade between the date claimed in the application and the filing date pursuant to section 30(b) of the Act.

[25] With respect to the retail store services featuring replacement windows, the Applicant relies on the ancillary services offered on its website. These services include a visualizer which appears to have been introduced on March 14, 2010 and was in use on the Old Vermont's Franchisee's website until its dissolution on October 18, 2016 (First Luffman affidavit, para 79). The visualizer remained in use on the [www.windowworld.com](http://www.windowworld.com) and other franchisees' website after the date of dissolution.

[26] I accept that the Old Vermont Franchisee offered retail store services in the normal course of trade until its date of dissolution based on the appearance of the trademark on its website and in magazine advertising combined with the evidence of interactivity with Canadian consumers through the corresponding sales evidence (see, for example, Exhibit B, pages 104, 113, 114).

[27] Between the date of dissolution of the Old Vermont Franchisee and the filing date of the application, I do not find that the appearance of the visualizer on the www.windowworld.com or franchisee's websites was in the normal course of trade as required in *No Frills Auto and Truck Rental, supra*. Rather, the normal course of trade appears to be that the visualizer is used to generate cost estimates and quotes by the franchisees (First Luffman affidavit, paras 73-76). and there is no evidence that this was done for Canadian consumers during this time. At page 238 of the First Luffman Affidavit, a franchisee's website explains:

### **Design Center**

For many of our customers, the hardest part of the home improvement process is visualizing what the final product will look like. With Window World's unique Design Software, envisioning new products on your home becomes as easy as a few clicks of a mouse. Simple to use and navigate, the Design Centre brings your future project to life. The convenient "Print" option provides a hard copy of your selections for inspirations during your in-home consultation.

### **Visualizer**

See how Window World products can improve the look of your home. Simply upload a picture of your home, start adding products, save your project, and then contact us!

At para 27 of his affidavit, Mr. Luffman explains that franchisees offer the following professional advice, services and assistance as part of the Services including:

The provision of written cost estimates and quotes, adjustments and amendments thereto, and conception renderings and layout diagrams prepared by experience retail and design professionals, including the provision of proprietary Window Visualizer Design Center software available in Canada through my company's www.windowworld.com website and through franchisee websites...

[28] As there is no evidence that any quotes were provided to Canadians through means such as the telephone number, email, through the forms featured on the website(s), in-house consultations at this time or at any WINDOW WORLD retail stores, I do not find that the Applicant meets its legal onus of showing continuous use of the Mark with the Services in the normal course of trade from the date claimed in the application to the filing date.



[29] In addition, to meet the section 30(b) requirement, the Applicant's retail services between the date of dissolution and the application date would have to show the requisite interactivity with Canadian consumers as described in *Lapointe Rosenstein LLP v West Seal Inc*, 2012 TMOB 114 at paragraphs 27 and 28:

[27] In [*TSA Stores, Inc. v Registrar of Trade-Marks*, 2011 FC 273, as with *Saks & Co. v Registrar of Trade Marks* (1989), 24 CPR (3d) 49], it was contemplated that the combination of certain factors could be sufficient to support a registration for retail store services, even in the absence of brick-and-mortar stores in Canada. Such factors must demonstrate a certain level of interactivity with potential Canadian customers in order for there to be a benefit to Canadians sufficient to support such a registration. Certainly, it would appear that this level of interactivity is satisfied where a registrant operates a retail website and ships goods purchased via the website to Canada. Listing prices in Canadian dollars or showing other indicators that the website is directed to Canadian customers may also satisfy the requirements of sections 4 and 45 in the absence of evidence of shipping to Canada. On the other hand, as noted above, merely offering refunds appears to be insufficient [*Boutique Limitée Inc v Limco Investments, Inc* (1998), 1998 CanLII 8416 (FCA)]. Finally, on the particular facts in [*TSA Stores*], offering several ancillary services on a website equivalent to what one might find in a brick-and-mortar store was found to be sufficient.

[28] In other words, there appears to be a threshold of ancillary or incidental services that, when combined, can support a registration for retail store services. What appears to be necessary is some degree of interactivity with the customer, and to the hypothetical Canadian customer in particular. Although the Requesting Party encouraged the Registrar to outright ignore the reasoning in [*TSA Stores*], it can be considered consistent with the other jurisprudence in that the Court found, through the provision of ancillary services, a sufficient degree of interactivity with the Canadians who accessed the website to support the registrations for "retail store services".

[Citations to TMOB decisions omitted]

[30] The Applicant's evidence fails to do so. First, there is no evidence from which I can conclude between the Old Vermont Franchisee's dissolution and the filing of the application that Canadians did anything more than "passively view content on a foreign website". The internet statistics provided at Exhibit G to the First Luffman affidavit are not specific for the time period between the Vermont Franchisee's dissolution and the filing of the application. There is no evidence that at this critical point between the dissolution of the Old Vermont Franchisee and the filing of the application as to whether any Canadians availed themselves of the visualizer or other educational or informational content on the WINDOW WORLD websites. Given the number of time periods covered

in the web statistics at Exhibits G-H of the First Luffman affidavit, I consider that the Applicant could have addressed the time period falling between the dissolution of the Old Vermont Franchisee and the filing of the application, if it wished to do so. Finally, there is no evidence that any Canadians availed themselves of warranty services on previously sold windows (First Luffman affidavit, para 84).

[31] There is no evidence such as that in *Dollar General Corporation v 2900319 Canada Inc.*, 2018 FC 778 or *TSA Stores* that allows me to find that Canadians benefitted from use of the Applicant's website by using it as a substitute for visiting a brick-and-mortar store between dissolution of the Old Vermont Franchisee and the application filing date. In *Hilton*, Justice Pentney found that "it is essential that some aspect of the services must be offered directly to Canadians or performed in Canada" (at para 56) and that it must be demonstrated that people in Canada obtained "some tangible, meaningful, benefit" from the use of the Mark in association with the service (at para 90). There is no evidence that people in Canada obtained some tangible, meaningful, benefit from the Applicant's website after the dissolution of the Old Vermont Franchisee.

[32] I acknowledge that previous TMOB decisions have maintained the Applicant's registrations on the basis of similar evidence filed in section 45 proceedings. There is, however, different burdens between a section 45 case (a prima facie burden) and an opposition case (a balance of probabilities) [*Fraser Sea Food Corp v Fasken Martineau Dumoulin LLP*, 2011 FC 893 at paras 14-15]. Further, in this case the relevant period discussed in Mr. Luffman's evidence is September 20, 2016 to September 20, 2019 which is different than the time period between the date of use claimed in the application (October 29, 2012) and the application filing date (September 15, 2017). Finally, there is no requirement that use in association with services be in the normal course of trade for the purposes of section 45 of the Act [*Montréal Production Inc. and H-D U.S.A., LLC*, 2022 TMOB 234 at para 18].

[33] Accordingly, I find that this ground of opposition succeeds.

### ***Entitlement Grounds of Opposition***

[34] The Opponent pleads that the Applicant is not entitled to register the Mark since it is confusing with the trademarks WINDOW WORLD and WINDOW WORLD design or its trade name used by the Opponent or its predecessor in title since 2002 in association with the same services as in the application.

[35] The material date for this ground of opposition is the filing date of the application. For the use and registration claim, this is the date set out in section 16(2) of the Act. In light of the success of the section 30(b) ground of opposition, the material date for this ground of opposition for the use based claim also shifts to September 5, 2017, the date of filing the application for the Mark.

[36] In order to meet its initial burden with respect to its sections 16(1)(a) and 16(2)(a) grounds of opposition, the Opponent must show that it had used its trademark WINDOW WORLD as of September 5, 2017.

[37] The Opponent's evidence summarized below is sufficient to meet its evidential burden with respect to use of the trademark WINDOW WORLD prior to the filing date for the sections 16(1)(a) and 16(2)(a) grounds of opposition. Having found that the Opponent meets its evidential burden with respect to use of its trademark WINDOW WORLD, I decline to consider whether it meets its evidential burden with respect to the trade name Window World.

- (a) Mr. Franklin identifies the website [www.windowworld.ca](http://www.windowworld.ca) as being part of the asset purchase from the Opponent's predecessor-in-title in 2015 and confirms in response to when it was operational as being "there when I bought it" although he does not know when it was up and running before this time (Qs 96-98, Exhibit 1 to the cross-examination). Ms. Bonnell's evidence includes an archived version of this website in 2014. The archived versions of the website prominently feature the trademark WINDOW WORLD in 2014 (Exhibit E).

(b) The Opponent's evidence includes a picture of a showroom in New Brunswick including the trademark WINDOW WORLD prominently in an advertisement. Mr. Franklin identifies the WINDOW WORLD store as being part of a large multi-tenant building (at Qs 105-106). Mr. Franklin also explained that he would talk to customers at the store (although he did not have involvement in sales) (Q 114).

[38] At the hearing, the Applicant submitted that the Opponent could not meet its evidential burden relying on evidence of use of the trademark WINDOW WORLD in face of the Applicant's ownership of trademark registration No. TMA947,806 for the trademark WINDOW WORLD covering identical services. The Registrar has previously found that an Opponent cannot rely on its unlawful use where the Registrar is able to come to a clear conclusion on the unlawfulness. The Registrar, however, in the course of opposition proceedings under section 38 of the Act, does not have the jurisdiction to conduct a full hearing to determine the lawfulness of the use of the trademark. In this case, as both parties claim prior rights to the trademark WINDOW WORLD, I cannot come to a clear conclusion that the Opponent's use of its trademark is unlawful [see *Sunbeam Products, Inc v Mister Coffee Services Inc* (2001), 16 CPR (4th) 53 (FC)]. Likewise, the Opponent's allegations that the Applicant's predecessor-in-title engaged in breach of business ethics and acceptable business behavior (Second Luffman affidavit, paras 33-34) does not change my findings on whether the Opponent meets its evidential burden.

### ***Test for confusion***

[39] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. Therefore, section 6(2) of the Act does not deal with confusion between trademarks themselves, but with the likelihood that the goods or services from one source will be perceived as being from another source.

[40] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54].

[41] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees an applicant's mark, at a time when they have no more than an imperfect recollection of an opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

#### Inherent distinctiveness of the trademarks

[42] The Mark and the Opponent's trademark WINDOW WORLD have a similar degree of inherent distinctiveness as they are identical.

#### Extent to which they have become known and length of time in use

[43] These factors appear to favour the Applicant as it has provided evidence of advertising in, for example, the Good Housekeeping magazine (including evidence of circulation in Canada) prominently featuring the WINDOW WORLD trademark, that the trademark appears on windows that it sells (First Luffman affidavit, para 34), and invoices showing sales prior to the material date in Canada from the Old Vermont Franchisee (First Luffman affidavit, exhibit B). I consider the Opponent's evidence of sales numbers without correlating these sales to use of the trademark (whether on windows or in association with the performance or advertising of the services including visits to the showroom or the website) to be insufficient for me to find that this factor favours it.

Nature of the services or business; and nature of the trade

[44] The overlap is significant. The parties' services appear to essentially be the same – providing replacement or new windows for homeowners.

Degree of resemblance between the trademarks

[45] The Mark and the Opponent's trademark WINDOW WORLD are identical.

Applicant's registrations for WINDOW WORLD

[46] It is well established that an applicant's ownership of one or more trademarks does not give it the automatic right to obtain a further registration [*Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* 1984 CanLII 5900 (TMOB), 385229 *Ontario Limited v ServiceMaster Company*, 2012 TMOB 59 at para 47]. Further, there are no circumstances in this case that would support a finding that the existence of the Applicant's prior registrations for WINDOW WORLD, such as evidence of concurrent use without confusion or longstanding use, is a relevant surrounding circumstance [*Caesarstone Sdot-Yam Ltd v Ceramiche Caesar S.P.A* 2016 FC 895 at paras 50-56].

**CONCLUSION ON LIKELIHOOD OF CONFUSION**

[47] Having considered all of the surrounding circumstances, I find that the Applicant has not satisfied its legal burden to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark WINDOW WORLD. The section 16(1)(a) and 16(2)(a) grounds of opposition therefore succeed.

***Section 30(i) Ground of Opposition***

[48] The material date for this ground of opposition is the filing date of the application [*Georgia-Pacific Corp. v Scott Paper Ltd.* 1984 CanLII 5911 (TMOB)].

[49] The Opponent alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada when the Mark was filed as the Applicant "was well aware of Opponent's existing trademarks rights in Canada to the WINDOW WORLD trademark for essentially identical goods and services". The Opponent has filed as part

of its evidence a cease and desist letter sent to the Applicant prior to the application filing date. If I was to accept this cease and desist letter in combination with the Opponent's evidence of use as sufficient to meet the Opponent's evidential burden with respect to this ground of opposition, I find that the Applicant's ownership of trademark registrations for WINDOW WORLD (TMA947,806) and WINDOW WORLD & Design (TMA947,807) is sufficient to meet the Applicant's legal onus of proving that it was satisfied of its entitlement to use the trademark.

### ***Distinctiveness Ground of Opposition***

[50] The Opponent pleads that the Mark is not distinctive of the Applicant due to the use and making known of the Opponent's WINDOW WORLD trademark and tradename.

[51] While there is a legal onus on an applicant to show that its trademark is adapted to distinguish or actually distinguishes its goods and services from those of others throughout Canada [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* 1985 CanLII 6385, 4 CPR (3d) 272 (TMOB)], there is first an initial evidential burden on an opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[52] The Opponent will have met its evidential burden if it shows that as of March 19, 2019, the date of filing its statement of opposition, its WINDOW WORLD trademark or its WINDOW WORLD trade name is known in Canada to some extent and its reputation is substantial, significant or sufficient or, in the alternative, that it is well known in a part of Canada [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 at paras 21, 33-34].

[53] The Opponent fails to meet its evidential burden as its sales do not support that its trademark WINDOW WORLD was known in Canada to some extent and had a sufficient reputation or was well known in the area of Canada it operates. The evidence includes the sales numbers, advertising expenditures, a picture of a showroom, advertisements in Mr. Franklin's affidavit and printouts of the Opponent's website attached to Ms. Bonnell's affidavit. Setting aside the hearsay issue discussed for the advertisements, on cross-examination the affiant was not able to provide any information as to distribution of the advertisements, nor confirm dates of advertisements (Franklin cross-examination, Qs 66-

70), nor is there any evidence as to consumers' exposure to the Opponent's WINDOW WORLD trademark on signage or advertising. As such, this ground of opposition is rejected.

**DISPOSITION**

[54] In view of all of the foregoing, 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.

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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



# Appearances and Agents of Record

**HEARING DATE: 2025-02-05**

## **APPEARANCES**

**For the Opponent:** Jennifer E. McKay

**For the Applicant:** Peter J. Pribil

## **AGENTS OF RECORD**

**For the Opponent:** DENTONS CANADA LLP

**For the Applicant:** FINLAYSON & SINGLEHURST