



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 186

Date of Decision: 2025-09-16

INTERLOCUTORY RULING

Opponent: Jetharam Nemaram Gehlot

Applicant: FM World Sp. z o.o.

Application: 2,139,643 for UTIQUE

INTRODUCTION

[1] Jetharam Nemaram Gehlot (the Opponent) has opposed registration of the trademark UTIQUE, which is the subject of application No. 2,139,643 in the name of FM World Sp. z o.o. (the Applicant).

[2] On July 14, 2025, the Applicant requested an interlocutory ruling to strike certain paragraphs of the statement of opposition. The Applicant also sought an extension of time to submit and serve its counter statement.

[3] By way of Office letter of July 15, 2025, the Registrar invited the Opponent to make its submissions in respect of the Applicant's request. No response to the Office letter has been received from the Opponent.

THE SCOPE OF INTERLOCUTORY RULINGS

[4] The sufficiency of a statement of opposition is governed by section 38 of the *Trademarks Act*, RSC 1985 c T-13 (the Act). Section 38(2) of the Act comprises an exhaustive list of the grounds upon which an opposition may be based. Section 38(3)(a) of the Act requires grounds of opposition to be set out in sufficient detail so as to enable an applicant to reply. An insufficient ground of opposition would therefore be one that either alleges an improper ground of opposition or does not contain sufficient material facts to allow an applicant to reply.

[5] 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)]. Further, it is not the purpose of an interlocutory ruling to determine whether a valid ground of opposition has a reasonable prospect of success, but rather whether it contains sufficient material facts.

RULING

[6] In summary, the Applicant requests to strike paragraph 4a. to paragraph 4c. of the statement of opposition because they do not set out grounds of opposition in sufficient detail to enable the Applicant to reply. The Applicant also requests to strike paragraphs 5 to 7 of the statement of opposition because “they are an improper attempt by the Applicant to prematurely tender evidence at the preliminary pleadings stage”.

[7] In assessing the contested paragraphs, it is of note that at paragraph 3 of the statement of opposition, the Opponent references its ownership of the trademark YUTIKA (application No. 2,066,700) and lists the Class 3 goods associated therewith.

Paragraph 4a. of the statement of opposition - Section 38(2)(a.1) ground

[8] The ground of opposition pleaded in paragraph 4a. reads as follows:

Pursuant to Section 38(2)(a.1), the Applicant's Mark is not registrable because it was filed in *bad faith*. The Applicant knew that their mark is confusingly similar to the Opponent's Mark which was previously used in Canada at least as early as 07-08-2020 by the Opponent in connection with similar or related Class 3 goods. The Opponent's mark 'YUTIKA' is being used worldwide since 2018. The Applicant was very well aware of the mark 'YUTIKA' and growing reputation thereof, therefore, in order to ride upon the goodwill and reputation of the mark 'YUTIKA' of the Opponent, the Applicant has filed the present application before the Canadian Intellectual Property Office.

[9] The Applicant submits that the ground of opposition is not set out in sufficient detail, in that there are no material facts to enable the Applicant to understand the basis of the allegation of bad faith. The Applicant submits that an allegation that an applicant was aware of an opponent's trademark does not by itself support a ground of opposition under section 38(2)(a.1) of the Act. I agree.

[10] Indeed, the ground as pleaded contains no material facts to support a conclusion of bad faith, other than the Applicant's prior knowledge of the Opponent's mark, which is insufficient [*Blossman Gas Inc v Alliance Autopropane Inc*, 2022 FC 1794 at paras 119-129; see also *Norsteel Building Systems Ltd v Toti Holdings Inc*, 2021 FC 927 at paras 64-75 suggesting that an applicant's knowledge of another party's trademark at the time of filing is alone not sufficient to demonstrate bad faith in the context of section 18(1)(e) of the Act, even if the trademarks are otherwise found to be confusing].

[11] Moreover, the allegations concerning the Applicant's intent to trade upon the goodwill and reputation of the Opponent's alleged trademark are speculative and conclusory, lacking the factual basis for any such conclusion.

The remainder of the statement of opposition likewise provides no factual basis that, if proven, would support the Opponent's allegations.

[12] Accordingly, paragraph 4a. of the statement of opposition is struck.

Paragraph 4b. of the statement of opposition – Section 38(2)(c) ground

[13] In paragraph 4b., the Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act because at the filing date of the application, the Mark was confusing with the Opponent's trademark YUTIKA.

[14] The Applicant requests to strike the term "deceptively similar" in the following portion of the pleading:

[...] Applicant's mark 'UTIQUE' is visually, phonetically and deceptively similar to the mark 'YUTIKA' as such there is a likelihood of causing confusion in the minds of the consumers [...].

[15] In support of its request, the Applicant submits the following:

It appears that the Opponent is relying on confusion based on section 6 of the *Trademarks Act*. However, deception does not fall within the parameters of section 6 of the *Trademarks Act*. That is, deception literally does not appear in any of the statutory provisions contained within section 6. With that said, thus, there is no statutory basis for the concept of deception under the confusion analysis. As such, the impugned "made-up" expression (with no basis in the *Trademarks Act*) must be struck.

[16] In my view, the Applicant's submissions go to the merit of the pleading rather than to its sufficiency. Furthermore, it is clear from its own submissions that the Applicant understands the case it has to meet.

[17] Accordingly, the Applicant's request to strike the term "deceptively similar" in paragraph 4b. is denied.

Paragraph 4c. of the statement of opposition – Section 38(2)(d) ground

[18] The ground of opposition pleaded in paragraph 4c. reads as follows:

The Applicant's Mark is not distinctive pursuant to Section (2) which provides that a mark is considered distinctive, if "in relation to a trademark, describes a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adopted [*sic*] so to distinguish them"

Clearly, the use or registration of the Applicant's Mark which is confusingly and/or deceptively similar to the Opponent's Mark as such the same is not capable of distinguishing the goods of the Applicant in Class 3 from the similar or related goods offered or sold by the Opponent under the mark 'YUTIKA' which will lead to confusion in the minds of the consumers at large.

[19] The Applicant requests to strike the first paragraph of the pleading reproduced above because it "merely repeats the language of the statute and provides no material facts". With respect to the second paragraph, the Applicant submits that "...in Class 3 from the similar or related goods..." is "vague, ambiguous, indefinite and subjective" and "fails to identify with required certainty the goods at issue".

[20] I acknowledge that the first paragraph of the pleading merely repeats the definition of the term "distinctive" at section 2 of the Act. However, when the pleading is *read in its entirety*, this is not a case where an opponent merely repeats the wording of the Act without any material facts to support the allegation.

[21] Indeed, when read in the context the statement of opposition as a whole, it is apparent that the allegation "Class 3 from the similar or related goods" in the second paragraph concerns the goods of Class 3 in the Applicant's application and the Opponent's goods identified at paragraph 3 of the statement of opposition.

[22] Accordingly, I do not consider paragraph 4c. to be insufficient or otherwise improper within the meaning of section 38 of the Act, and the Applicant's request to strike this paragraph is denied.

Paragraphs 5 to 7 of the statement of opposition

[23] These paragraphs do not set out grounds of opposition. They contain allegations introduced under the following headings:

- Paragraph 5: History of the Applicant
- Paragraph 6: International Registrations of YUTIKA
- Paragraph 7: Advertising of the Mark YUTIKA

[24] I find it unnecessary to discuss at length the Applicant's submissions in support of its request to strike paragraphs 5 to 7. When read fairly, I find these paragraphs provide context for the grounds of opposition set out at paragraph 4 of the statement of opposition. Even if I am wrong in so finding, refusing to strike paragraphs 5 to 7 is of no consequence. It is well established that allegations contained in a statement of opposition are neither evidence nor treated as evidence by the Registrar when a decision is rendered pursuant to section 38(12) of the Act.

[25] Accordingly, the Applicant's requests to strike paragraphs 5 to 7 is denied.

APPLICANT'S DEADLINE TO FILE ITS COUNTER STATEMENT

[26] Pursuant to its request, the Applicant is hereby granted one month from the date of this Interlocutory Ruling to submit and serve its counter statement.

Céline Tremblay
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Agents of Record

For the Opponent: ANITA MAR

For the Applicant: OLLIP P.C.