



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 194

Date of Decision: 2025-09-25

INTERLOCUTORY RULING

Opponent: Align Communications, Inc.

Applicant: A-Lign Compliance and Security, Inc.

Application: 1,980,818 for A-LIGN

INTRODUCTION

[1] Align Communications, Inc. (the Opponent) has opposed registration of the trademark ALIGN (the Mark), which is the subject of application No. 1,980,818 in the name of A-Lign Compliance and Security, Inc. (the Applicant).

[2] On July 8, 2025, the Applicant requested an interlocutory ruling to strike each ground of opposition from 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 9, 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.

[6] Section 38(6) confers upon the Registrar the ability to strike all or part of a statement of opposition.

RULING

[7] The Opponent pleads four grounds of opposition raised pursuant to sections 38(2)(a.1), 38(2)(c), 38(2)(d) and 38(2)(f) of the Act. Each ground of opposition is premised on allegations of confusion between the Mark and the same four trademarks of the Opponent, including “ALIGN and design”, that are alleged to have been used in Canada by the Opponent in association with various goods and/or services. None of the Opponent’s four trademarks are alleged to be registered or applied-for registration.

[8] I will first address the Applicant’s request that the Opponent’s alleged trademark ALIGN and design as well as certain of the Opponent’s alleged

goods and services be struck from the four grounds of opposition. I will afterwards address the Applicant's request to strike each ground of opposition in its entirety.

Opponent's trademark ALIGN and design and objected goods and services

Trademark ALIGN and design

[9] The Opponent did not provide any visual representation of its alleged trademark ALIGN and design. In addition, this is not a case where the Applicant could refer to a trademark registration or application for a visual representation of the alleged trademark. As a result, I agree with the Applicant that there is not sufficient detail to reply to any allegations based on this trademark.

[10] Accordingly, the reference to the trademark ALIGN and design, as reproduced below, is struck from each ground of opposition.

3) ALIGN and design, used in Canada in association with Installation, removal and reinstallation of telecommunications equipment and computer hardware; technical support services, namely, troubleshooting in the nature of the repair of computer hardware; and Computer services, namely, providing a web-based system and online portal for customers to remotely manage, administer, modify and control their end user computer devices, data and software applications; Computer technology support services, namely, help desk services; remote computer network technical monitoring and software maintenance services; remote computer software patch management services; technical support services, namely, troubleshooting of computer software problems

Objected goods and services

[11] The Applicant identifies in its request certain descriptions of goods and services that it submits are too vague to "know for what specific goods or services the Opponent is allegedly using its marks in Canada". The Applicant requests that these goods and/or services be struck from each ground of opposition.

[12] Since the reference to the trademark ALIGN and design has been struck, the objected services associated with this trademark are not at issue.

[13] Considering the pleadings in their entirety, the Applicant did not convince me that more details, such as the function of the objected goods, and the field, type or nature of the objected services, are required so as to enable the Applicant to reply.

[14] In my view, the Applicant is seeking a level of specificity that would be required in the context of examination of an application as the registration process grants exclusive right to an applicant. In the context of an opposition, the specificity of the description of goods/services is required so that an applicant can understand the opponent's claims and the case it has to meet.

[15] Here, I am satisfied that the objected goods and services are described in sufficient details for the Applicant to understand the case it has to meet and thus to reply to the allegations.

[16] Accordingly, I decline the Applicant's request to strike certain of the Opponent's goods and services from each of the grounds of opposition, as amended by this ruling.

Section 38(2)(a.1) ground – Bad faith

[17] The relevant part of the pleading reads as follows:

The application was filed in bad faith given that the Applicant knew of the Opponent's use of the mark in Canada, and worldwide, and could not have been satisfied that it was entitled to register its mark. The applied-for trademark is confusing with the Opponent's following trademarks used in Canada [...].

[18] I accept the Applicant's request to strike the ground of opposition.

[19] 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].

[20] Accordingly, the section 38(2)(a.1) ground of opposition is struck.

Sections 38(2)(c)/16(1)(a) ground of opposition – Non-entitlement to registration

[21] To determine whether an applicant is entitled to register a trademark pursuant to section 16(1)(a) of the Act, confusion is assessed as of the filing date of the application or the date of first use of the applied-for trademark in Canada, whichever is earlier.

[22] The Applicant submits that because the Opponent did not indicate since when it has used its alleged trademarks, the ground of opposition raised is not set out in sufficient detail so as to enable the Applicant to reply. I disagree.

[23] I am satisfied that this ground has been pleaded in sufficient detail to enable the Applicant to reply. The Opponent has alleged that its trademarks have been previously used in Canada and has indicated the associated goods and services. Further, I find it implicit in the ground of opposition that the Opponent is alleging that the previous use of its trademarks occurred prior to the yet to be determined material date. In other words, the date of first use of the trademarks at issue will be a question of evidence.

[24] Accordingly, I decline to strike the section 38(2)(c) ground of opposition, as amended by this ruling.

Section 38(2)(d) ground of opposition – Non-distinctiveness

[25] Here also, the Applicant submits that because the Opponent did not indicate since when it has used its alleged trademarks, the ground of opposition is not set out in sufficient detail so as to enable the Applicant to reply. I disagree.

[26] The ground of opposition is based upon allegations of confusion between the Mark and the Opponent's trademarks. The pleading identifies the Opponent's allegedly used trademarks and the associated goods and services. Thus, I am satisfied that this ground has been pleaded in sufficient detail to enable the Applicant to reply.

[27] Accordingly, I decline to strike the section 38(2)(d) ground of opposition, as amended by this ruling.

Section 38(2)(f) ground of opposition – Non-entitlement to use

[28] Section 38(2)(f) of the Act addresses an applicant's lawful entitlement to use the applied for trademark.

[29] The ground of opposition reads, in part, as follows:

The applicant is not entitled to use the trademark in Canada for the following reasons:

The Applicant is not entitled to use the mark A-LIGN in Canada as such use depreciates the value of the goodwill in the Opponent's trademarks set out below, which are used in Canada, and offends section 22 of the Trademarks Act:

[...]

Additionally, such use by the Applicant offends section 7(b) of the Trademarks Act in that any use by the Applicant would or does direct public attention to its goods in such a way as to cause or be likely to cause

confusion in Canada. [...]. Thus, the average consumer who sees the Applicant's mark is likely to assume that it is related to the Opponent's mark and that the Applicant is affiliated and associated with the Opponent.

[30] For the reasons set out below, I accept to strike the reference to section 22 of the Act from the pleading, but I decline to strike the reference to section 7(b) of the Act.

Use contrary to section 22 of the Act

[31] Section 22 of the Act specifically references the use of “a trademark registered by another person”. Since the Opponent did not plead any registered trademarks, the reference to section 22 of the Act in the pleading is necessarily invalid.

[32] Accordingly, the ground of opposition is hereby amended to strike the reference to section 22 of the Act from the pleading, as shown in strikethrough below:

[...] The Applicant is not entitled to use the mark A-LIGN in Canada as such use depreciates the value of the goodwill in the Opponent's trademarks set out below, which are used in Canada, ~~and offends section 22 of the Trademarks Act~~: [...].

Use contrary to section 7(b) of the Act

[33] Pleadings acceptable under this ground should comprise material facts, which, if proven, would establish the three elements described by the *Federal Court in Diageo Canada Inc v Heaven Hill Distilleries Inc*, 2017 FC 571, namely goodwill, public deception due to misrepresentation and actual or potential damage.

[34] I find the ground based on sections 38(2)(f) and 7(b) of the Act, as amended by this ruling, is sufficiently particularized. Indeed, the Opponent has alleged goodwill associated with its trademarks and confusion which, if established, would fulfill the requisite misrepresentation element of the test

[*Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2016 FCA 69 at para 21]. Finally, given these alleged facts, I consider that an allegation of actual or potential damage to the Opponent is implied.

[35] Accordingly, I decline to strike the portion of the ground of opposition, as amended by this ruling, relating to section 7(b) of the Act.

APPLICANT'S DEADLINE TO FILE ITS COUNTER STATEMENT

[36] 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: Moffat & Co.

For the Applicant: Deeth Williams Wall LLP