Federal Court  Cour fédérale

Date: 20100616

Docket: T-361-09
T-363-09

Citation: 2010 FC 645

Ottawa, Ontario, June 16, 2010

PRESENT: The Honourable Mr. Justice Martineau

BETWEEN:

1772887 ONTARIO LIMITED
a/o WHERE CANADA

Applicant

and

THE REGISTRAR OF TRADE-MARKS
and
MIKIT FRANCE, SOCIÉTÉ ANONYME

Respondents

REASONS FOR JUDGMENT AND JUDGMENT

[1] The applicant, Where Canada, appeals the decisions of the Registrar of Trade-Marks (the Registrar) rejecting pursuant to subsection 38(4) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended (the Act) its statements of opposition (the oppositions) to the trade-mark applications numbered 1,334,958 and 1,334,960 filed by Mikit France on February 12, 2007, for the registration of the trade-mark "MIKIT maisons prêtes à finir (& dessin)" and its English translation "MIKIT ready to finish houses (& design)" (the proposed marks).

[2] Subsections 38(2) and (3) set out the required content of a statement of opposition, and the grounds upon which one may be based:

38.	38.
…	…
(2) A statement of opposition may be based on any of the following grounds:	(2) Cette opposition peut être fondée sur l'un des motifs suivants :
(*a*) that the application does not conform to the requirements of section 30;	*a*) la demande ne satisfait pas aux exigences de l'article 30;
(*b*) that the trade-mark is not registrable;	*b*) la marque de commerce n'est pas enregistrable;
(*c*) that the applicant is not the person entitled to registration of the trade-mark; or	*c*) le requérant n'est pas la personne ayant droit à l'enregistrement;
(*d*) that the trade-mark is not distinctive.	*d*) la marque de commerce n'est pas distinctive.
(3) A statement of opposition shall set out	(3) La déclaration d'opposition indique :
(*a*) the grounds of opposition in sufficient detail to enable the applicant to reply thereto; and	*a*) les motifs de l'opposition, avec détails suffisants pour permettre au requérant d'y répondre;
(*b*) the address of the opponent's principal office or place of business in Canada, if any, and if the opponent has no office or place of business in Canada, the address of his principal office or place of business abroad and the name and address in Canada of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if it had been served on the opponent himself.	*b*) l'adresse du principal bureau ou siège d'affaires de l'opposant au Canada, le cas échéant, et, si l'opposant n'a ni bureau ni siège d'affaires au Canada, l'adresse de son principal bureau ou siège d'affaires à l'étranger et les nom et adresse, au Canada, d'une personne ou firme à qui tout document concernant l'opposition peut être signifié avec le même effet que s'il était signifié à l'opposant lui-même.
…	…

[3] On January 13 and 14, 2009, the Registrar rejected the oppositions pursuant to subsection 38(4) of the Act, which provides:

38.	38.
…	…
(4) If the Registrar considers that the opposition does not raise a substantial issue for decision, he shall reject it and shall give notice of his decision to the opponent.	(4) Si le registraire estime que l'opposition ne soulève pas une question sérieuse pour décision, il la rejette et donne avis de sa décision à l'opposant.
…	…

[4] While the applicant filed separate notices of application at this Court in relation to each of the proposed marks, the grounds of opposition, the Registrar's grounds for rejecting them and the applicant's grounds of appeal are all identical. Consequently, both appeals will be disposed of by these reasons.

[5] The applicant is the owner of the following registered trade-marks in Canada, bearing the registration numbers 368,571; 496,282; 408,695; 463,529; 520,864; 677,534; 674,494; 727,342 and 725,344: WHERE, WHERE MAGAZINES INTERNATIONAL, WHERE FAMILY, WHERE ON-LINE, WHERE THE FINDS ARE, WHERE LOCALS HIKE, WHERE TELEVISION and WHERE TELEVISION & DESIGN. These trade-marks are registered in association with a number of wares, including, but not limited to: communication software, computer software and hardware, printed publications, management and operational services for retail stores, restaurants and other entertainment services and informational and educational services including advertising services related to entertainment and tourist information.

[6] On December 17, 2008, the applicant filed oppositions with regard to the proposed marks claiming that they should be rejected because (1) they are confusing with the applicant's family of trade-marks (as per subsections 12(1)(d) and 16(3)(a) & (c) of the Act), (2) Mikit France could not have been satisfied of its entitlement to use the proposed marks as required by paragraph 30(i) of the Act given that it was aware, or ought to have been, of the existence and notoriety of the applicant's family of trade-marks, (3) the wares listed as "plans" on the applications for the proposed marks are too broad and not expressed in an ordinary commercial term as required by subsection 30(a) of the Act, and (4) the proposed marks are not distinctive.

[7] According to the Registrar, the applicant did not raise proper grounds of opposition because (1) Mikit France's awareness of the applicant and its trade-marks and trade-names did not, on its own, prevent it from truthfully stating it is entitled to use the proposed mark in association with the wares and services described in the application, as Mikit France was required to do pursuant to paragraph 30(i) of the Act, and (2) the applicant's contention that the word "plans" was not an ordinary commercial term as required by paragraph 30(a) was not supported since this was a translation from French, the language of the proposed marks' applications, and therefore did not necessarily carry the same meaning as the word employed in the application and further, the allegation was not supported by any facts and was not set out in enough detail as required by paragraph 38(3)(a). Finally, the Registrar found that any allegations relating to confusion between the applicant's family of trade-marks and the proposed marks were unsupported given the "almost complete absence of any degree of resemblance between the [proposed] mark[s] and the [applicant's] marks and names".

[8] While the applicant raises a number of issues in their memorandum, the only issue to be determined in these appeals is whether the Registrar acted unreasonably in rejecting the applicant's opposition "because it did not raise a substantial issue for decision". This is basically a mixed question of fact and law.

[9] In determining whether there is a substantial issue for decision, the jurisprudence is clear that the Registrar is not to assess whether the opponent has a likelihood or probability of success, rather, the Registrar it to ask whether "assuming the truth of all the allegations of fact in the statement of opposition, the opponent had an arguable case". No evidence must be considered in determining the issue; the Registrar must limit his consideration to the application itself and the allegations contained in the opposition. See *Koffler Stores Ltd. v. Canada (Registrar of Trade Marks)*, [1976] 2 F.C. 685, at paragraph 3; *Canadian Tampax Corp. v. Canada (Registrar of Trade Marks)* (1975), 24 C.P.R. (2d) 178, [1975] F.C.J. No. 1110 at paragraph 20 (F.C.T.D.) (QL) citing *Pepsico Inc. v. Canada (Registrar of Trade Marks)*, [1976] 1 F.C. 202 at paragraph 12 (F.C.T.D.).

[10] Neither the Registrar nor Mikit France have filed a memorandum of fact and law with regard to the present appeals. However, at the hearing, counsel for the Registrar stated that it would be appreciated if the Court would clarify the "arguable case" notion referred to in the case law. Counsel also indicated that this was not a proper case where the Registrar would exercise its discretion to afford the applicant the opportunity to amend the oppositions.

[11] In my opinion, given the expertise of the Registrar, deference should generally be shown in respect of a finding made by the Registrar pursuant to subsection 38(4) of the Act, unless it can be shown that the Registrar clearly misunderstood or misapplied the applicable legal test. Accordingly,

the question is whether it was reasonable for the Registrar to conclude that the applicant's oppositions failed to raise a substantial issue for decision.

[12] At the hearing, learned counsel for the applicant submitted to the Court that the decisions made by the Registrar were premature and that he actually made findings on the merit, without the benefit of any evidence. In other words, the Registrar did not limit himself to considering the allegations made in the oppositions. Consequently, the applicant warned that the Court should not make the same error by denying these appeals. Simply put, the applicant requests the chance to prove the allegations made in the oppositions. I do not agree with the applicant. The present appeals must fail for a number of reasons.

[13] First, it is clear after reviewing the oppositions and the Registrar's reasons that the Registrar did not misunderstand or misapply the test found in subsection 38 (4) of the Act. The Registrar did not assess the applicant's chances of success, nor the sufficiency of its evidence, and even if he did so, which is not the case in the Court's opinion, the oppositions still fail to raise a substantial issue for decision.

[14] Second, the Registrar was correct to note that the simple fact that Mikit France was aware, or ought to have been, of the applicant's trade-marks and trade names, did not render the statement that they were entitled to use their proposed marks in association to the listed wares and services untruthful. Given that there were no other facts submitted in support of this allegation, it is not unreasonable for the Registrar to have found that it was not a proper ground of opposition.

[15] Third, as concerns the allegation that the use of the word “plans” is not an ordinary commercial term, there are a number of problems. First, this could not have been the term employed by Mikit France in its applications for registration of their proposed marks, since these were completed in French. Therefore, whether this is even the appropriate translation is not clear. Further, the applicant did not explain why this was not in compliance with the requirements of the Act simply by stating that it was overly broad. Again, given that the allegation lacked details which would enable Mikit France to respond to it, it was not unreasonable for the Registrar to conclude that this was also not a proper ground of opposition.

[16] Fourth, having reviewed the certified copy of the trade-mark file, it was not unreasonable for the Registrar to conclude that the applicant failed to raise an arguable case with regard to its allegation of confusion. As noted by the Registrar, there is no resemblance between the proposed marks and the applicant’s family of trade-marks and trade names. Given that the criteria used to determine whether confusion exists includes consideration of, *inter alia*, the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known, the nature of the wares, services or business, the nature of the trade and the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them, it is not unreasonable for the Registrar to have concluded that based on the complete lack of resemblance, there was no arguable case for confusion. Further, while not mentioned by the Registrar, it is of note that in addition to bearing no similarities in physical appearance, the proposed marks are in no way associated to any wares or services that overlap with the applicant’s family of trade-marks and trade names. As is fairly evident from the proposed marks themselves, the wares and services listed in conjunction with the proposed marks are related to the construction of houses. Moreover, while the applicant generally alleged in its statements of opposition that the proposed marks are not

distinctive, it included no allegations of fact to support this, which is in complete contravention of the specific requirements enumerated in subsection 38(3)(a) of the Act.

[17] In conclusion, the Court finds that the Registrar's conclusions are reasonable. That being said, even if one accepts the proposition made at the hearing by applicant's counsel that the Court must have a "fresh look" on the matter and come to its own conclusions, this judge is equally of the view that the oppositions do not raise a substantial issue for decision. Indeed, in the Court's opinion, the oppositions were so clearly futile that they did not have the slightest chance at succeeding. Consequently, they did not disclose an arguable case, to restate the test established by the jurisprudence.

[18] Before concluding, the applicant mentioned in its written memorandum and at the hearing that in the alternative the Registrar should have granted it leave to amend its statements of opposition. This proposition must also be rejected. Granting leave to amend is purely a matter of discretion. No such legal obligation exists under subsection 38(4) of the Act. The applicant and its counsel are well aware of the Act, and the Act is clear as to the minimum requirements of a statement of opposition. The jurisprudence is also clear that while the Registrar may invite the party that filed the opposition to complete and/or explain it, he is not always required to (*Koffler Stores Ltd.*, above, at paragraph 12). Considering the particular circumstances of the case, I fail to see any misuse of the Registrar's discretion in not inviting the applicant to amend their statements of opposition before exercising its power under subsection 38 (4) of the Act.

[19] For all these reasons, the appeals are dismissed. Since there were no memorandum of fact and law from either of the named the respondents, there will be no costs.

JUDGMENT

THIS COURT ADUDGES AND ORDERS that the appeals of the applicant in files T-361-09 and T-363-09 be dismissed, without costs.

"Luc Martineau"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-361-09 T-363-09
STYLE OF CAUSE:	**1772887 ONTARIO LIMITED a/o WHERE CANADA and THE REGISTRAR OF TRADE-MARKS and MIKIT FRANCE, SOCIÉTÉ ANONYME**
PLACE OF HEARING:	Toronto, Ontario
DATE OF HEARING:	June 7, 2010
REASONS FOR JUDGMENT:	MARTINEAU J.
DATED:	June 16, 2010

APPEARANCES:

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