



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Reference: 2016 TMOB 156**  
**Date of Decision: 2016-09-23**  
**[UNREVISED ENGLISH**  
**CERTIFIED TRANSLATION]**

**IN THE MATTER OF AN OPPOSITION**

**Canadian Tire Corporation, Limited      Opponent**

**and**

**Gestion André Touchette Inc.      Applicant**

**1,561,116 for CANADA'S SINGLE      Application**  
**SOURCE FOR TIRE SOLUTIONS**  
**LEADER CANADIEN EN SOLUTIONS**  
**DU PNEU**

Introduction

[1] Gestion André Touchette Inc. (the Applicant) filed registration application No. 1,561,116 on January 24, 2012 for the CANADA'S SINGLE SOURCE FOR TIRE SOLUTIONS LEADER CANADIEN EN SOLUTIONS DU PNEU trade-mark (the Mark).

[2] The application is based on use of the Mark in Canada in association with services for warehousing, storage, sale and distribution of tires (the Services).

[3] The registration application was published on November 14, 2012 in the *Trade-Marks Journal* for the purposes of opposition.

[4] Canadian Tire Corporation, Limited (the Opponent), on April 12, 2013, filed a statement of opposition on the grounds of opposition based on sections 30(e) and (i), 12(1)(b) and (d), 16(3)(a) and 2 (distinctiveness) of the *Trade-marks Act*, RSC (1985), c T-13 (the Act). However, in its written argument, the Opponent withdrew the grounds of opposition based on confusion with registered marks and the previous use of these marks (sections 12(1)(d) and 16(3)(a)) and the ground of opposition based on section 30(i) of the Act.

[5] The Applicant filed a counter-statement denying each and every ground of opposition argued by the Opponent.

[6] The Opponent filed the affidavits sworn on October 24, 2013 by Andaleeb Dobson and Alexandra Scott.

[7] The Applicant filed two affidavits sworn on February 21, 2014 by Sandro Romeo and the affidavits sworn on February 24, 2014 by Frédéric Bouthillier and Roger Champoux.

[8] Messrs. Champoux and Bouthillier were cross-examined and the transcript of these cross-examinations is part of the record.

[9] Each party filed written arguments and they were represented at the hearing.

[10] For the reasons described below in greater detail, I refuse the registration application.

#### Evidentiary burden

[11] Under the procedure in the matter of opposition to the registration of a trade-mark, the legal onus is on the Applicant to show that the application for registration does not contravene the provisions of the Act. However, the Opponent must fulfill the initial burden of proving the facts on which it bases its claims. The fact that an initial evidentiary burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA, 29, 20 CPR (4th) 155

(FCA); and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41, CPR (4th) 223].

#### Preliminary comments

[12] I have studied all the evidence of record identified above. However, I will refer only to what I consider relevant for the purposes of my decision.

[13] The majority of the contents of the affidavit of Ms. Dobson, the Opponent's Vice-President, Tires and Auto Service Marketing, concern the Opponent's activities during the years 2007 to 2013. However, due to the withdrawal of the grounds of opposition based on confusion with registered marks and the previous use of these marks by the Opponent, these facts will have little importance in the context of the grounds of opposition based on section 12(1)(b) and 2 (non-distinctiveness of the Mark, because it would be clearly descriptive or deceptively misdescriptive of the nature or the quality of the Services).

[14] During the hearing, the Agent for the Applicant raised an objection to the admissibility of Exhibits C and D filed in the context of the cross-examination of Mr. Champoux, National Director, Sales and Marketing of Pneus Touchette Distribution Inc (Touchette Distribution), the Applicant's licensee. These exhibits were described as excerpts from Touchette Distribution's website, obtained from the Wayback Machine website. The Applicant argued at the hearing that these exhibits constitute hearsay evidence. Moreover, the Applicant argued that the Opponent used the cross-examination of Mr. Champoux to file this evidence, when it was available to the Opponent when the Applicant's evidence-in-chief was filed. A similar objection was filed during the hearing concerning Exhibits E, F, G and H filed during the same cross-examination. These are excerpts from third-party websites.

[15] I pointed out to the Agent for the Applicant that no objection to the filing of these exhibits had been formulated during the cross-examination of Mr. Champoux. In the circumstances, I dismiss the objections because they were not formulated at the time these exhibits were filed during the cross-examination. These documents are therefore part of the record. However, I will later discuss the eligibility of their contents, in view of the relevant dates associated with the grounds of opposition argued.

[16] Apart from the ground based on section 30(e), the other two grounds of opposition to be resolved are based on the argument that the Mark is clearly descriptive or deceptively misdescriptive of the nature or the quality of the Services. Consequently, the Mark would not be registrable and thus would be non-distinctive. It is self-evident that if the ground of opposition based on section 12(1)(b) is rejected, the same will apply to the ground based on the non-distinctiveness of the Mark.

Ground of opposition based on section 30(e) of the Act

[17] The Opponent argues that the registration application does not comply with the provisions of sections 38(2)(a) and 30(e) of the Act, in that the Applicant, as of the date of filing of its registration application, was already using the Mark in Canada in whole or in part.

[18] This ground of opposition must be analyzed as of the filing date of the registration application (January 24, 2012) [see *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB)]. The Opponent has the initial evidentiary burden. However, this burden is light [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)], and the Opponent can refer to the Applicant's evidence to discharge this light evidentiary burden [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[19] The Opponent refers to the contents of the cross-examination of Mr. Champoux (pages 10 to 13 of the cross-examination), some of the exhibits filed during this cross-examination and a previous registration application, filed by the Applicant for an identical mark based on use in Canada since November 1, 2009, which was subsequently abandoned. I will analyze each of these pieces of evidence to determine whether the Opponent has discharged its initial evidentiary burden.

[20] During the cross-examination of Mr. Champoux, the Opponent presented certain excerpts from the *tirelink.ca* website used by Touchette Distribution to promote services related to the TIRELINK mark. Mr. Champoux admitted that these services include the Services. Mr. Champoux admitted that the Mark appeared at the top of each page on this website.

[21] When confronted with the fact that Exhibit 1 to his affidavit contained the Mark and a copyright notice: ‘Droit d’auteur 2010 TireLink. Tous droits réservés’ (Copyright 2010 TireLink All rights reserved), he simply responded that this was an error.

[22] This is the context in which the Opponent presented Mr. Champoux with two excerpts dated July 11, 2010 and September 12, 2010 from the *tirelink.ca* website, obtained by means of the Wayback Machine website (Exhibits C and D in the cross-examination of Mr. Champoux). Mr. Champoux admitted that in 2010, Touchette Distribution used this website to promote the Services.

[23] However, Mr. Champoux also pointed out that he was responsible for the maintenance of this website. He mentioned that, insofar as he remembers, the information appearing in these excerpts traced by the Wayback Machine website is incorrect because only the unilingual English portion of the Mark was used at that time and not the bilingual version (the Mark).

[24] The Opponent, to support its claim that the Applicant used the Mark at the time of filing of the registration application, presented Mr. Champoux, during this cross-examination, with an excerpt from the Register of Trade-marks concerning registration application No. 1,476,696, filed by the Applicant on April 13, 2010. This concerned an application for registration of a mark identical to the Mark, in association with services identical to the Services. The application was based on use in Canada since November 1, 2009. It was declared abandoned on April 19, 2012.

[25] Examined on this registration application, which contradicts the contents of the present registration application concerning the use or non-use of the Mark in Canada, Mr. Champoux limited himself to saying this was an error.

[26] From this evidence, I conclude that the Opponent has discharged its initial burden of proving that the Applicant used the Mark in Canada in association with the Services at the time this registration application was filed, namely on January 24, 2012.

[27] Indeed, we can see the Mark in the excerpts from the *tirelink.ca* website, operated by the Applicant’s licensee, as of July 11, 2010 and September 12, 2010, obtained from the Wayback Machine website. We also find it in the excerpt from the *tirelink.ca* website attached to Mr. Champoux’s affidavit, which also contains a 2010 copyright notice. Finally, there is this

registration application filed by the Applicant on April 13, 2010 for registration of the Mark based on use in Canada since November 1, 2009.

[28] Consequently, the Applicant had the burden of proving, according to the balance of probabilities, that it had not used the Mark in Canada in association with the Services at the time this registration application was filed. To satisfy this burden, the Applicant simply refers to Mr. Champoux's testimony during his cross-examination, to the effect that the excerpts taken from the Wayback Machine website and the mention 'Droit d'auteur 2010' (Copyright 2010) in Exhibit 1 of his affidavit are errors. The allegation of use of the Mark in registration application No. 1,476,696 would also constitute an error, such that this registration application was abandoned. According to the Applicant, these allegations would be sufficient to discharge its evidentiary burden.

[29] I hold the contrary opinion. To satisfy the evidentiary burden that is now incumbent on the Applicant, there must be evidence that goes beyond the mere denial of the facts or the mention that an error is involved. All the Opponent's evidence on this point, as well as Exhibit 1 of Mr. Champoux's affidavit, supports the Opponent's position and raises serious doubts regarding the statement contained in this registration application to the effect that it is based on a proposed use in Canada.

[30] I must point out that Mr. Champoux is a mere representative of the Applicant's licensee. I do not see how he could affirm that the contents of registration application No. 1,476,696 filed by the Applicant was an error. I would add that, taken in isolation, the contents of this registration application would not have been sufficient to satisfy the Opponent's initial evidentiary burden. However, its contents are added to the other evidence, and it is this evidence as a whole that allows the Opponent to submit that the Mark was used in Canada by the Applicant as the filing date of this registration application.

[31] In the circumstances, the Applicant had to provide plausible explanations concerning the presence of the Mark in the excerpts from the *tirelink.ca* website. In the absence of an explanation, I conclude that the Applicant has not discharged its burden to prove that it had not used the Mark in Canada at the time of filing of this registration application [see *Marineland Inc v Marine Wonderland & Animal Park Ltd* [1974] 2 FC 558 at para. 41].

[32] The ground of opposition based on section 30(e) is therefore accepted.

Ground of opposition based on section 12(1)(b) of the Act

[33] The relevant date to rule on this ground of opposition is the filing date of the registration application (January 24, 2012) [see *Shell Canada Limited v. PT Sari Incofood Corporation* 2005 FC 1040, 41 CPR (4th) 250 (FCT)].

[34] It is good to recall the guiding principles that help us determine whether a mark is clearly descriptive or deceptively misdescriptive within the meaning of section 12(1)(b) of the Act. Thus, Mr. Justice Cattanach set out the following procedure to follow in *GWG Ltd v Registrar of Trade-marks* (1981), 55 CPR (2d) 1:

It has been repeatedly stated based on the authority of numerous decided cases: (1) that whether a trade mark is clearly descriptive is one of first impression; (2) that the word "clearly" in para. 12(1)(b) of the Act is not a tautological use but it signifies a degree and is not synonymous with "accurate" but means in the context of the paragraph "easy to understand, self-evident or plain", and (3) that it is not a proper approach to the determination of whether a trade mark is descriptive to carefully and critically analyse the words to ascertain if they have alternate implications or alternate implications when used in association with certain wares and to ascertain what those words in the context in which they are used would represent to the public at large who will see those words and will form an opinion as to what those words will connote: see *John Labatt Ltd. v. Carling Breweries Ltd.* (1974), 18 CPR (2d) 15 at p. 19.

[35] The jurisprudence also indicates that their common meaning must be applied to the appreciation of the facts [see *Neptune SA v Canada (Attorney General)* 2003 FCT 715, 29 CPR (4th) 497(FCT) and *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* 2011 FC 58, conf 2012 FCA 60]. Also, the descriptiveness of the Mark must be assessed by accounting for the services associated with it [see *Mitel Corporation v Registrar of Trade Marks* (1984), 79 CPR (2d) 202 at page 208 (FCTD)].

[36] Alexandra Scott is a trade-mark agent employed by the firm of agents representing the Opponent. On October 16, 2013 she proceeded with several searches to obtain the definitions of the words: 'Canada', 'single', 'source', 'tire', and 'solution' in the following dictionaries: *The Canadian Oxford Dictionary*, *The New Shorter Oxford English Dictionary*, *The Random House*

*Dictionary of the English Language*. The same day, she searched in the dictionary *Le nouveau petit Robert de la langue française* to find the definition of the words: ‘leader’, ‘canadien’, ‘solution’ and ‘pneu’.

[37] On October 22, 2013 Ms. Scott also conducted searches on the website at *www.merriam-webster.com* for the words: ‘Canada’, ‘single’, ‘source’, ‘tire’, and ‘solution’.

[38] She similarly searched the Web on October 23, 2013, visiting the *www.larousse.com* website to find the definitions of the words: ‘leader’, ‘canadien’, ‘solution’ and ‘pneu’.

[39] She filed each of the relevant excerpts from these dictionaries concerning these words.

[40] In light of this evidence, it is clear that each of the words that form the Mark is a common word in the English or French language. However, the Mark taken as a whole must be considered.

[41] Without seeking to break down the Mark, the essential issue is to determine whether ‘tire solutions’ and ‘solutions du pneu’ are clearly descriptive of the nature and quality of the Services. The word ‘solution’ in English, according to the Opponent’s evidence, means: ‘the act or a means of solving a problem or difficulty’ or ‘an explanation, answer, or decision’. In French, the word ‘solution’ means [TRANSLATION] ‘answer to a problem, a question’ or ‘something that can resolve a difficulty, settle a complex situation’.

[42] The Opponent presented excerpts from websites on which the expression ‘tire solutions’ appears to prove this expression is used in the industry. It refers, more specifically, to Exhibits E, F and G of the cross-examination of Mr. Champoux. I rejected the Applicant’s objection based on the argument that the Opponent should have filed these exhibits as an integral part of its evidence-in-chief. However, the ground of opposition under section 12(1)(b) must be analyzed as of the date of filing of the registration application (January 24, 2012). Yet all these excerpts were printed on October 20 and 23, 2014, i.e. after the relevant date. I therefore cannot take their contents into account under this ground of opposition.

[43] During the cross-examination of Mr. Champoux, the Opponent tried to get him to admit that each of the Services could be considered a ‘solution du pneu’ or ‘tire solution’. Mr.



Champoux admitted that the tire warehousing and storage services were ‘solutions du pneu’ or ‘tire solutions’ but that this was not the case for tire sales (page 23).

[44] It is very possible that, for people working in the tire industry, like Mr. Champoux or Ms. Dobson, the use of the expression ‘tire solutions’ or ‘solutions du pneu’ can refer to services related to tires. The Mark thus could be considered highly suggestive or even descriptive of these services. However, this does not mean it is clearly descriptive of the nature or the quality of these services for the average consumer. I have no evidence that the average consumer, on the basis of a first impression, would associate these expressions with the nature or the quality of the Services.

[45] In the circumstances, I conclude that the Mark, taken as a whole, although highly suggestive of the nature of the Services, is not clearly descriptive of them. Since it is not clearly descriptive of the nature or the quality of the Services, it cannot be considered a deceptive misdescription of the Services.

[46] The parties argued on the question of whether or not the French portion of the Mark constituted a translation of the English portion. In view of my conclusion that the Mark, taken as a whole, was not clearly descriptive or deceptively misdescriptive of the nature or the quality of the Services, I do not have to rule on this question.

[47] Finally, the Opponent refers to Ms. Dobson’s allegation to the effect that other merchants offer tire solution services. However, Ms. Dobson does not explain what she means by ‘tire solutions’. Moreover, I agree with the Applicant that such an allegation, without other evidence, constitutes hearsay.

[48] I therefore reject this ground of opposition.

#### Ground of opposition based on non-distinctiveness of the Mark

[49] During the hearing, the Opponent indicated that this ground of opposition was based on the fact that the Mark, being clearly descriptive, could not serve to distinguish the Services from third-party services. However, I concluded that the Mark was not clearly descriptive of the Services.

[50] In the circumstances, I also reject this ground of opposition.

Disposal

[51] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, I refuse the registration application according to the provisions of section 38(8) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified true translation  
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**DATE OF HEARING:** 2016-08-30

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