



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

Citation: 2015 TMOB 42
Date of Decision: 2015-03-17

**IN THE MATTER OF AN OPPOSITION
by Basix International, Inc. to application
No. 1,500,954 for the trade-mark PRIMA
DECORA in the name of Luna Decora
Inc.**

[1] On October 25, 2010, Luna Decora Inc. (the Applicant) filed an application to register the trade-mark PRIMA DECORA (the Mark). The application is based on the Applicant's use of the Mark in Canada since November 1, 2008 in association with the following goods and services:

Goods: Kitchen Counter Tops, Bathtubs, Counter top Vanities and Sinks, Kitchen Sinks, Shower tray, Shower wall, Commercial Counter Tops.

Services: We import and do resale of Kitchen Counter Tops, Bathtubs, Counter top Vanities and Sinks, Kitchen Sinks, Shower tray, Shower wall, Commercial Counter Tops.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 2, 2012.

[3] Basix International, Inc. (the Opponent) filed a statement of opposition on August 22, 2012. The Opponent has pleaded grounds of opposition pursuant to sections 30, 16, and 2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[4] The Applicant filed and served a counter statement. The Applicant's evidence consists of the two affidavits of Ali Vakili. While the Opponent requested and was granted leave to file the affidavit of Alexander Alvarez, this affidavit is no longer part of the record due to Mr. Alvarez's

failure to attend cross-examination. Only the Applicant filed a written argument. No hearing was held.

Onus

[5] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Material Dates

[6] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30 – the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- sections 38(2)(c)/16(1)(a) – the date of first use claimed in the application; and
- sections 38(2)(d)/2– the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Analysis of the Grounds of Opposition

Section 30(a) Ground of Opposition

[7] The Opponent alleges that the Goods and Services are not in ordinary commercial terms since the wording “we import and do resale of...” does not describe Services performed for the benefit of third parties and suggests that the Goods are not those of the Applicant but rather those of third party manufacturers, including the Opponent. First, I do not find that the statement of services leads to the inference that the importation and resale services described cannot be for the benefit of third parties. Second, in the absence of cross-examination of Mr. Vakili or submissions from the Opponent, I see no reason not to infer that the Services are performed for the benefit of third parties. Finally, there is no evidence that supports the allegation that the

Goods are those of third party manufacturers, including the Opponent, such that the application does not comply with section 30(a). Accordingly, this ground of opposition is rejected.

Section 30(b) Ground of Opposition

[8] The Opponent alleges that the Applicant has not used the Mark in Canada in association with the Goods and Services as of the date of first use alleged in the application since the Applicant became a distributor of the Opponent's PRIMA DECORA products in spring 2011 and the Applicant did not use the Mark in Canada prior to that date. There is no evidence to support such an allegation, as such this ground of opposition is rejected.

Section 30(i) Ground of Opposition

[9] Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no evidence that the Applicant acted in bad faith. This ground of opposition is therefore rejected.

Section 16(1)(a) Ground of Opposition

[10] In order to meet its initial burden in support of the non-entitlement ground of opposition based upon section 16(1)(a) of the Act, the Opponent was required to show that its trade-mark PRIMA DECORA had been used or made known in Canada prior to November 1, 2008. It has not done so. This ground of opposition is therefore rejected.

Section 2 Ground of Opposition

[11] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that as of August 22, 2012 its trade-mark PRIMA DECORA, was known to some extent at least and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. It has not done so. This ground of opposition is therefore rejected.

Disposition

[12] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office