

**IN THE MATTER OF AN OPPOSITION by  
Stop Centres Inc. to application No. 1,263,601  
for the trade-mark STOP DIETE filed by  
Nautilus Plus  
Inc.**

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**I The Pleadings**

[1] On July 5, 2005, Nautilus Plus Inc. (the “Applicant”) filed an application to register the trade-mark STOP DIETE (the “Mark”), based on proposed use in association with: nutrition program, namely nutritional recommendations for active people (the “Services”). The Applicant has disclaimed the right to the exclusive use of the term DIETE apart from the trade-mark. This application was published for opposition purposes in the *Trade-marks Journal* of March 1, 2006.

[2] On April 12, 2006, Stop Centres Inc. (the “Opponent”) filed a statement of opposition, which the Registrar forwarded to the Applicant on May 25, 2006. On June 12, 2006, the Applicant filed a counter statement essentially denying the grounds of opposition raised by the Opponent.

[3] The Opponent filed the affidavits of Stephen Wallack and Robert W. White. The Applicant filed the affidavit of Audrey Baltadjian and a true copy of application file 1,264,009. None of the affiants were cross-examined. Each party filed a written argument and was represented at an oral hearing.

**II The Grounds of Opposition**

[4] The grounds of opposition may be summarized as follows:

1. The application for registration does not comply with the requirements of section 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the “Act”), in that the Services are not described in ordinary commercial terms.
2. The application for registration does not comply with the requirements of section 30(i) of the Act in that the Applicant could not state that it was

satisfied that it was entitled to use the Mark since it knew that the Mark was not distinctive because of the Opponent's use of trade-names and trade-marks that are similar to the Mark, as appears from the facts alleged in the statement of opposition.

3. The Applicant is not the person entitled to registration of the Mark because, at the date of filing of the application for registration, the Mark was confusing with the Opponent's marks, including CENTRES STOP, STOP POIDS and STOP APPÉTIT, previously used in Canada by the Opponent.
4. The Applicant is not the person entitled to registration of the Mark because, at the date of filing of the application for registration, the Mark was confusing with the CENTRES STOP trade-mark for which an application filed on June 30, 2005, was pending at the time this application was filed.
5. The Applicant is not the person entitled to registration of the Mark because, at the date of filing of the application for registration, the Mark was confusing with the CENTRES STOP and STOP CENTRES trade-names previously used in Canada by the Opponent or other persons.
6. The Mark is not distinctive within the meaning of section 2 of the Act because it does not distinguish or is not adapted to distinguish the Applicant's services from the Opponent's wares and services, considering the previous use of the Opponent's aforementioned marks.

## **II General Principles**

[5] In proceedings to oppose the registration of a trade-mark, the opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts supporting those grounds. If the Opponent satisfies this requirement, the Applicant must then satisfy the Registrar, on the balance of probabilities, that the grounds of opposition should not prevent its trade-mark from being registered [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325, and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293].

## **III Relevant Dates**

[6] The ground of opposition based on non-compliance with the requirements of section 30 of the Act must be considered from the filing date of the application (July 5, 2005) [see *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293, and *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469]. The grounds of opposition based on the provisions of section 16(3) of the Act must also be examined from the filing date of the application [see section 16(3) of the

Act], while the distinctiveness of the Mark must be determined on the filing date of the statement of opposition (April 12, 2006) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. 2d 126, at page 130 (F.C.A.)].

#### **IV Ground of Opposition Based on Section 30(a) of the Act**

[7] The Opponent has not produced any evidence to support the first ground of opposition. Since the Opponent has failed to discharge its burden of proof, this ground of opposition is unsuccessful.

#### **V Ground of Opposition Based on Section 16(3)(a) of the Act**

[8] As for the third ground of opposition, the Opponent must establish use of its trade-marks prior to the filing date of the present application and that it had not abandoned use at the date of advertisement of the application [ref.: section 16(5) of the Act]. Did the Opponent therefore discharge its initial evidentiary burden? I must first examine the Opponent's evidence in that respect.

[9] The Applicant submits that I must restrict my analysis of this ground of opposition to the marks identified in the statement of opposition. Paragraph 2(a) of the statement of opposition clearly mentions that the Mark is confusing with the Opponent's marks, "including the following . . .". The Applicant did not consider it useful to file a request for clarifications in order to ensure that the Opponent was limiting this ground of opposition to the marks listed at paragraph 3 reproduced above and corresponding to paragraph 2(a) of the statement of opposition.

[10] In support of its arguments, the Applicant relied on the unreported May 14, 2007, decision of the Registrar in the matter of an opposition to the registration of trade-mark VITALIANO PANCALDI and design, application No. 821543. In that matter, the Opponent had not used the term "including" or any other similar term before listing the trade-marks it was planning to oppose. In this case, the combination of the use of the words "the trade marks [of] the

Opponent [. . .] including . . .” with the evidence filed on the Opponent’s marks does not take the Applicant by surprise. As pointed out by the Federal Court of Appeal, if clarifications are not requested at the interlocutory stage, the grounds of opposition that might be perceived as being ambiguous must be read in conjunction with the filed evidence [see *Novopharm Ltd v. AstraZeneca AB et al*, 21 C.P.R. (4th) 289].

[11] I will therefore take into account all the trade-marks referred to in Mr. Wallack’s affidavit and whose use during the relevant period has been established, as long as they are pertinent.

[12] Mr. Wallack is the president and founder of the Opponent, which was incorporated on April 4, 2000. He alleges that, since May 2000, the Opponent has been using a family of marks beginning with the word STOP in association with therapeutic services for obesity, appetite problems, stress, alcoholism, smoking and other health problems (the “Opponent’s services”). The Opponent is present in the Canadian marketplace, particularly in Quebec.

[13] For the purposes of this decision, I will make an exhaustive list of the trade-marks and trade-names appearing on the various exhibits filed:

<u>Document</u>	<u>Trade-mark or trade-name</u>	<u>Distribution date</u>
Pamphlet (SW-1)	STOP TOBACCO CENTRES 1 HOUR and design	May 2000
Pamphlet (SW-1)	Stop Tobacco Centres Inc.	May 2000
Pamphlet (SW-2)	STOP TOBACCO CENTRES 1 HOUR and design	2003
Pamphlet (SW-2)	STOP STRESS CENTRES 3 HOURS and design	2003
Pamphlet (SW-2)	STOP WEIGHT CENTRES 3 HOURS and design	2003
Pamphlet (SW-2)	The Stop-Tobacco Centres Inc.	2003
Pamphlet (SW-3)	Les Centres Stop	March 2005
Pamphlet (SW-3)	The Stop Centres	March 2005
Pamphlet (SW-3)	STOP-APPETITE	March 2005

Pamphlet (SW-3)	STOP-WEIGHT	March 2005
Pamphlet (SW-3)	STOP ALCOHOL	March 2005
Pamphlet (SW-3)	STOP TOBACCO	March 2005
Pamphlet (SW-3)	STOP STRESS	March 2005
Pamphlet (SW-3)	STOP ALCOOL	March 2005
Pamphlet (SW-3)	STOP-APPÉTIT	March 2005
Pamphlet (SW-3)	STOP-POIDS	March 2005
Advertisement <i>Télé-Horaire</i> (SW-4)	CENTRES STOP and design (√)	April and May 2004
Advertisement <i>Télé-Horaire</i> (SW-4)	Centres Stop Inc.	April and May 2004
Advertisement <i>Télé-Horaire</i> (SW-4)	STOP CENTRES and design(√)	April to June 2005
Advertisement <i>Journal de Montréal</i> (SW-5)	STOP CENTRES and design(√)	March 27, 2005
Advertisement <i>Journal de Montréal</i> (SW-5)	Les Centres Stop	March 27, 2005
Super Aubaines de Gatineau (SW-6)	STOP CENTRES and design (√)	April 2005
Super Aubaines de Gatineau (SW-6)	Les Centres Stop	April 2005
Le carnet de Denise (SW-7)	CENTRES STOP and design	2004 and 2005
Le carnet de Denise (SW-7)	STOP-STRESS	2004 and 2005
Le carnet de Denise (SW-7)	STOP-POIDS	2004 and 2005
Le carnet de Denise (SW-7)	STOP CENTRES and design (√)	2004 and 2005
<i>Journal de Montréal</i> (SW-11)	CENTRES D'ARRÊT STOP TABAC 1 HEURE and design	January 23, 2003
<i>Journal de Montréal</i> (SW-11)	CENTRES D'ARRÊT STOP POIDS 3 HEURES and design	January 23, 2003
<i>Journal de Montréal</i> (SW-11)	Les Centres D'arrêt Stop Tabac	January 23, 2003
<i>Journal de Montréal</i> (SW-11)	STOP TABAC	January 23, 2003
<i>Primeurs</i> (SW-12)	CENTRES D'ARRÊT STOP TABAC 1 HEURE and design	July 2003

<i>Primeurs</i> (SW-12)	CENTRES D'ARRÊT STOP POIDS 3 HEURES and design	July 2003
<i>Primeurs</i> (SW-12)	Les Centres D'arrêt Stop Tabac	July 2003
Le carnet de Denise (SW-14)	CENTRES D'ARRÊT STOP TABAC 1 HEURE and design	Late 2003
Le carnet de Denise (SW-14)	CENTRES D'ARRÊT STOP POIDS 3 HEURES and design	Late 2003
Le carnet de Denise (SW-14)	Les Centres D'arrêt Stop-Tabac	Late 2003
<i>Le Point</i> (SW-15 et 16)	CENTRES D'ARRÊT STOP POIDS 3 HEURES and design	July 2003
<i>Le Point</i> (SW-15 et 16)	CENTRES D'ARRÊT STOP STRESS 3 HEURES and design	July and August 2003
<i>Le Point</i> (SW-15 et 16)	CENTRES D'ARRÊT STOP TABAC 1 HEURE and design	July and August 2003
<i>Feature</i> (SW-17)	STOP TOBACCO CENTRES 1 HOUR and design	September 2003
<i>Feature</i> (SW-17)	STOP WEIGHT CENTRES 3 HOURS and design	September 2003
<i>Feature</i> (SW-17)	STOP STRESS CENTRES 3 HOURS and design	September 2003
<i>Feature</i> (SW-17)	The Stop-Tobacco Centres	September 2003
<i>Télé-Horaire</i> (SW-19)	CENTRES D'ARRÊT STOP TABAC 1 HEURE and design	June and Dec. 2003
<i>Télé-Horaire</i> (SW-19)	Les Centres D'arrêt Stop-Tabac	June and Dec. 2003
<i>Télé-Horaire</i> (SW-19)	Les Centres Stop Inc.	February 2005
<i>Télé-Horaire</i> (SW-19)	CENTRES STOP TABAC and design	February 2005
Photo of exterior window (SW-23)	STOP CENTRES and design (√)	May 2005 to Jan. 2007
Brochure (SW-24)	CENTRES STOP and design	2004
Brochure (SW-24)	CENTRES STOP TABAC and design	2004
Brochure (SW-24)	CENTRES STOP POIDS and design	2004
Brochure (SW-24)	CENTRES STOP STRESS and design	2004
Brochure (SW-24)	Centres Stop Inc.	2004
Advertisement COOP PPM (SW-25)	CENTRES D'ARRÊT STOP POIDS 3 HEURES and design	2003 and 2004

Advertisement COOP PPM (SW-25)	CENTRES D'ARRÊT STOP TABAC 1 HEURE and design	2003 and 2004
Advertisement COOP PPM (SW-25)	CENTRES D'ARRÊT STOP STRESS 3 HEURES and design	2003 and 2004
Advertisement COOP PPM (SW-25)	CENTRES D'ARRÊT STOP TABAC	2003 and 2004

[14] I show below the various design marks referred to above that seem most relevant for understanding the scope of the Applicant's arguments about the use of the Opponent's word marks:



[15] I note that the evidence about the circulation of exhibits SW-7, SW-12 and SW-14 is hearsay. I will therefore disregard the evidence about the distribution of these exhibits provided by third parties and filed under SW-8 and SW-13. Affidavits of representatives of the organizations attesting to the veracity of the distribution figures of these exhibits should have been filed. As to Mr. Wallack's comments about the circulation of the magazines identified above, they are also hearsay in the absence of evidence about Mr. Wallack's expertise in this area. I will consider the affidavit of Robert White, Vice-President of the Audit Bureau of Circulation, an independent body that publishes and audits circulation figures for publications in Canada. In his affidavit, Mr. White provides us with the circulation figures for the editions of the *Journal de Montréal* (exhibits SW-4, SW-5, SW-11 and SW-19) in which the *Télé-Horaire* guide displaying the trade-marks and trade-names identified in paragraph 13 was inserted.

[16] I have no information about the circulation figures for the pamphlets filed as exhibits SW-1, SW-2 and SW-3. However, Mr. Wallack can confirm that they were distributed, but unfortunately, he did not provide circulation figures or, at the very least, the number of

pamphlets printed. As to exhibit SW-6, I cannot accept the figures provided by Mr. Wallack, but I accept his claim that this advertisement was circulated in Quebec. I also accept the uncontradicted testimony of Mr. Wallack that there was some circulation of the *Primeurs*, *Le Point* and *Feature* magazines (exhibits SW-12, 15, 16 and 17 *inter alia*) in Quebec, but I have no information about the extent of their circulation at any relevant time.

[17] Mr. Wallack concludes his affidavit by stating that over 17,000 people were treated in the different STOP CENTRES between 2000 and July 5, 2005. As a result, STOP CENTRES' gross revenues increased from \$40 000 to over \$2 million over this period. However, I have no breakdown of these figures by type of treatment provided (smoking, stress or weight).

[18] I must therefore determine whether there is enough evidence to conclude that the Opponent has discharged its burden of proof, namely, proving the previous use in Canada of a trade-mark in Canada and if previous use is proven, which of the trade-marks listed above were used. Lastly, I must determine whether its trade-mark(s) was (were) abandoned at the date of advertisement of the application (March 1, 2006) [section 16(5) of the Act].

[19] The Applicant submits that the Opponent has not met its initial evidentiary burden and that, consequently, the third ground of opposition should be dismissed. This argument is based on three premises:

- a) Only the word trade-marks identified in the third ground of opposition should be considered;
- b) The use of the design marks reproduced above does not constitute use of the word marks listed under the third ground of opposition; and
- c) There is no evidence that the Opponent used its trade-marks continuously until the date of advertisement of this application (section 16(5) of the Act).

[20] I have already disposed of the first argument in favour of the Opponent. I must therefore now consider the Applicant's second contention. It goes without saying that the graphical representation of a word mark can constitute use of the word mark.



[21] There is no reason to consider the following marks at this stage:

STOP TOBACCO CENTRES 1 HOUR and design;  
STOP STRESS CENTRES 3 HOURS and design;  
CENTRES STOP and design (√);  
STOP CENTRES and design(√);  
CENTRES D'ARRÊT STOP TABAC 1 HEURE and design;  
CENTRES STOP TABAC and design;  
CENTRES D'ARRÊT STOP STRESS 3 HEURES and design.

[22] In fact, I consider that the Opponent has a better chance of succeeding if it compares the STOP POIDS, STOP WEIGHT, STOP-APPETITE and STOP-APPÉTIT marks with the Mark.

[23] The only matter left to decide is whether, for the purposes of the Applicant's second contention, use of the marks

STOP WEIGHT CENTRES 3 HOURS and design;  
CENTRES D'ARRÊT STOP POIDS 3 HEURES and design; and  
CENTRES STOP POIDS and design

can be considered use of the word marks STOP WEIGHT and STOP POIDS. I am guided by the following excerpt from *Registrar of Trade Marks v. Compagnie Internationale pour l'Informatique CII Honeywell Bull, Société Anonyme et al.* (1985), 4 C.P.R. (3d) 523, where the Honourable Justice Pratte wrote as follows:

. . . The real and only question is whether, by identifying its goods as it did, CII made use of its trade mark "Bull". That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used. The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

Viewing the problem in that light and applying that test, we cannot escape the conclusion that, in using the composite mark "CII Honeywell Bull", CII did not use its mark "Bull". (Emphasis added)

[24] In *Nightingale Interlock Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535, the Registrar wrote as follows:

The jurisprudence relating to the question of what deviations in a trade mark are permissible is complicated and often contradictory but in my opinion it is best viewed as establishing two basic principles:

7 Use of a mark in combination with additional material constitutes use of the mark per se as a trade mark if the public, as a matter of first impression, would perceive the mark per se as being used as a trade mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing (see e.g., *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp. et al.* (1971), 1 C.P.R. (2d) 155 at p. 163, [1971] F.C. 106), or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name: see e.g., *Carling O'Keefe Ltd. v. Molson Cos. Ltd.* (1982), 70 C.P.R. (2d) 279 at pp. 280-1, applying *Bulova Accutron Trade Mark*, [1969] R.P.C. 102 at pp. 109-10.

[25] The words “CENTRES”, “D’ARRÊT” and “3 HEURES” appearing on the design marks illustrated above are purely descriptive. Moreover, the words in the colour version of the design marks are written in different colours: STOP POIDS in white; CENTRES D’ARRÊT in blue; and 3 HEURES in green. Lastly, the design portion is in red. In my opinion, the average consumer would not believe that the services offered in association with the Opponent’s design marks would come from a source other than the services offered in association with the STOP POIDS and STOP WEIGHT marks. The dominant part of these design marks is “STOP POIDS” and “STOP WEIGHT”. I therefore consider that any evidence of use of these design marks can constitute use of the word marks STOP POIDS and STOP WEIGHT. Consequently, for the purposes of this decision, I will no longer distinguish between the design and word versions of these marks. Moreover, whether or not there is a hyphen between the words STOP and POIDS is irrelevant. I will therefore use STOP POIDS and STOP WEIGHT regardless of the form used by the Opponent.

[26] Lastly, the Applicant claims that the STOP POIDS, STOP-APPÉTIT, STOP APPETITE and STOP WEIGHT have not been used continuously. The evidence described above demonstrates use of the STOP POIDS mark in various pamphlets and advertisements as of January 23, 2003 (ref.: exhibit SW-11). The evidence of first use for the STOP WEIGHT mark dates back to September 2003 (ref.: exhibit SW-17). For these marks, therefore, the Applicant has shown use prior to the filing date of the application (July 5, 2005). For their part, the STOP

APPÉTIT and STOP APPETITE marks are found on a single brochure (exhibit SW-3), which was apparently distributed in March 2005.

[27] Section 16(5) of the Act speaks of the abandonment of a trade-mark and not of its continuous use on the date of advertisement of the application for registration (April 12, 2006). The question of the abandonment of a trade-mark is a question of fact that must be assessed in light of the evidence on file. Moreover, the absence of use of a trade-mark must be combined with the intention to abandon use of that trade-mark, which can be inferred from a long period of non-use of the mark in question [see *Dastous v. Mathews-Wells Co. Ltd.*, [1950] S.C.R. 261]. The Applicant referred me to the Registrar's decision in VITALIANO PANCALDI, *op. cit.* In that decision, there was a lack of evidence for use of the opponent's mark for over two and a half years. In this case, there is documentary evidence of use at least until March 2005. Moreover, Mr. Wallack stated in his affidavit that exhibit SW-7 was distributed in 2005, adding the following at paragraph 18:

18. Stop Centres has continuously marketed its health services under the STOP POIDS Trade-marks in a variety of magazines, newspapers, brochures, pamphlets, booklets and books from March 2003 to July 5, 2005, and onwards. (Emphasis added)

[28] At paragraph 16 of his affidavit, he stated that the Opponent has been providing counselling, support and rehabilitation services for weight loss and weight and appetite control in association with the STOP POIDS mark since 2003.

[29] In light of the voluminous documentary evidence and the allegations contained in Mr. Wallack's affidavit, I cannot conclude that the Opponent abandoned use of its STOP POIDS and STOP WEIGHT trade-marks on April 12, 2006. However, the evidence is not sufficient for me to draw the same conclusion for the STOP APPÉTIT and STOP APPETITE trade-marks.

[30] What remains to be determined is whether there is a likelihood of confusion between the Mark and the Opponent's trade-marks STOP POIDS and STOP WEIGHT. The likelihood of confusion between two trade-marks must be analyzed on the basis of the specific

circumstances in each case. Section 6(5) of the Act contains a non-exhaustive list of these circumstances. The Honourable Justice Binnie, writing on behalf of the Supreme Court of Canada, analyzed these circumstances in *Mattel Inc. c. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321. I will review the circumstances that are relevant to this file in light of this analysis.

[31] The Mark has a very low degree of inherent distinctiveness. The combination of the words STOP and DIETE is highly suggestive of the Services. The same can be said of the Opponent's STOP POIDS and STOP WEIGHT trade-marks. In fact, the Mark suggests the cessation of eating habits by following a diet, while the STOP POIDS and STOP WEIGHT suggest the cessation of weight gain.

[32] The inherent distinctiveness of a trade-mark may be enhanced by significant use. However, despite the evidence for the use of the Opponent's trade-marks, except for the circulation of the *Journal de Montréal* daily newspaper, there is no admissible evidence on the extent of the distribution of the various advertisements in which the Opponent's marks appeared. The only evidence of an advertisement in the *Journal de Montréal* for the STOP POIDS mark is exhibit SW-11, which is limited to the January 23, 2003, edition. In the circumstances, I conclude that, insofar as the STOP POIDS mark has become more known than the Mark, this is not significant.

[33] The evidence of use of the Opponent's trade-marks described above dates back to January 23, 2003 (exhibit SW-11), even though there is no evidence of use of the Mark.

[34] The Services are of the same character as those offered in association with the STOP POIDS and STOP WEIGHT marks. I refer to exhibit SW-3, according to which the treatment offered under these marks includes [TRANSLATION] "two meetings for nutritional advice, coaching and recommendations on food combinations and personalized menus".

[35] Since there is no evidence on the nature of the Applicant's trade and bearing in mind that the Services are of the same nature as those of the Opponent, it can be inferred that the nature of the parties' trades is the same.

[36] As has been stated on numerous occasions, the degree of resemblance is the most important factor when determining the likelihood of confusion between two trade-marks [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, aff'd. 60 C.P.R. (2d) 70]. Moreover, the first portion of a trade-mark is often considered more important [*Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359]. This principle must be tempered, however, when the first portion is descriptive or not distinctive and, in addition, freely used as a portion of trade-marks.

[37] The Applicant has argued that the meaning of the marks at issue is different. The combination of the words STOP and POIDS suggests the cessation of weight gain. The average consumer associates this process with the cessation of a “bad” state of affairs. To use its expression, the process involves stopping the bad. According to the Applicant, the Mark does not suggest anything bad. I cannot agree with the Applicant. The word “STOP” means to cause something to cease. When juxtaposed with the word “WEIGHT” or the French equivalent “POIDS”, the idea suggested is that of ceasing to gain weight. I concede that the combination of the words “STOP” and “DIETE” may seem strange at face value, but the idea of a diet is to lose or maintain weight. I conclude that, overall, the marks suggest a similar idea and that they also resemble each other visually and phonetically because of the word “STOP”.

[38] The parties have raised two additional circumstances they deem relevant, namely, the state of the register and the existence of a family of trade-marks.

[39] Audrey Baltadjian was an intern for the Applicant’s agent’s firm at the time of execution of her affidavit. On August 8, 2007, she searched a database of Canadian trade-marks. The Opponent objects to the admissibility of this evidence based on the best evidence rule. The Opponent relies on the Registrar’s decision in *PepsiCo, Inc v. 100777 Canada Inc.* (2006), 51 C.P.R. (4th) 205. Yet in that case the affiant did not provide any information on the database consulted or the origin of the photocopies filed. In the case of the documents filed by Ms. Baltadjian, Ms. Baltadjian identified the database she consulted as the Canadian Intellectual Property Office’s Trade-marks Database. I therefore accept this evidence.

[40] This search was nonetheless limited to locating 55 trade-marks which she lists at paragraph 6 of her affidavit without, however, indicating how she obtained this list and what parameters she used to generate it. There is no analysis of the search in the affidavit or the Applicant's written arguments. At the hearing, the Applicant referred to 21 of the trade-marks cited. (ref.: pages 1, 3, 5, 10, 14, 18, 22, 24, 29, 35, 38, 41, 45, 48, 56, 63, 65, 70, 72, 74 and 78 in exhibit AB-4). Five of these marks were not registered at the time this application was filed (ref.: pages 1, 5, 48, 56 and 63). None of the remaining items on the list cover trade-marks registered in association with services of the same nature as the Services or the services offered by the Opponent. Moreover, except for one trade-mark, the registrations cited cover very specific wares which are often related to the medical field, such as bandages (STOP BLOOD) and preparations and substances for the treatment of haemorrhoids (INCOSTOP).

[41] The only registrations that seem relevant are the following:

NUTRISTOP: [TRANSLATION] food substitutes for weight-loss programs;

SNORE STOP: homeopathic formulations for the relief of the symptoms of snoring;

TABASTOP: [TRANSLATION] tablets to stop smoking.

[42] This number is clearly insufficient to allow me to infer the state of the Canadian marketplace and hence conclude that the average Canadian would be able to distinguish the different marks which have the word "STOP" as a portion when they are used in association with services of the same nature as the Services. I also note that the word "STOP" appears at the end of each of these trade-marks and not as a prefix or first portion of a trade-mark, as is the case in this file.

[43] As for the existence of a family of trade-marks whose common denominator is the word "STOP", I must take into account the evidence of use of the CENTRES STOP, STOP CENTRES, STOP TABAC and STOP STRESS marks. The Applicant argues that to agree with the Opponent would be nothing less than granting it a monopoly over the word "STOP". In

response to this argument, suffice it to say that the Opponent holds rights on the trade-marks it uses in association with the type of services it offers.

[44] In its written arguments, the Applicant states that the Opponent, for the examination of its application No. 1,264,009 for the trade-mark CENTRES STOP, claimed that there would be no confusion between this trade-mark and the registered marks containing the word STOP. I have no reason to comment on this position, since I did not include the trade-mark CENTRES STOP in the list of trade-marks I considered relevant for the purpose of my analysis of the likelihood of confusion between the Mark and the Opponent's marks.

[45] I conclude that the Applicant has not discharged its burden of proving, on a balance of probabilities, that the Mark would not be confusing with the Opponent's STOP POIDS and STOP WEIGHT marks. In fact, the Mark possesses little inherent distinctiveness; the Services are of the same nature as the services offered by the Opponent in association with its trade-marks; the Mark resembles the Opponent's said marks; and the Opponent has shown use of a family of trade-marks starting with the word "STOP" in association with services of the same nature as the Services. I therefore allow the third ground of opposition.

#### **VI Ground Based on the Non-Distinctiveness of the Mark**

[46] The wording of this ground of opposition leads me conclude that it is limited to trade-marks clearly identified in the statement of opposition, namely CENTRES STOP, STOP POIDS and STOP APPÉTIT. The ground of opposition does not contain the word "including", which would open the door to the possibility of arguing, as was the case under the preceding ground of opposition, use of other trade-marks as long as such evidence of use is on file.

[47] The Opponent has the burden of proving that its trade-marks have become known sufficiently in Canada as of the relevant date (April 12, 2006) in order to deny the distinctiveness of the Mark. The evidence described above, with regard to STOP POIDS, suggests that this trade-mark had indeed become sufficiently known in Canada. The difference between the relevant dates for this ground of opposition and the ground under section 16(3)(a)

of the Act does not affect my analysis of the likelihood of confusion between STOP POIDS and the Mark.

[48] The Applicant did not submit any arguments specifically relating to this ground of opposition. It argued that there was no confusion between the Opponent's marks and the Mark. I have already concluded that there is a likelihood of confusion between the trade-mark STOP POIDS and the Mark. In the circumstances, I must allow the last ground of opposition and find that the Mark is not distinctive and is not adapted to distinguishing the Services from the services offered by the Opponent in association with the Opponent's trade-mark STOP POIDS.

### **VII Remaining Grounds of Opposition**

[49] As I have found in favour of the Opponent on two separate grounds of opposition, there is no need for me to rule on the second, fourth and fifth grounds of opposition.

### **VIII Conclusion**

[50] Having been delegated authority by the Registrar of Trade-Marks by virtue of s. 63(3) of the Act, I refuse the application for registration of the Mark, pursuant to section 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 30 DAY OF NOVEMBER 2009.

Jean Carrière  
Member, Trade-marks Opposition Board

Certified true translation  
Johanna Kratz