



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

Citation: 2016 TMOB 42
Date of Decision: 2016-03-14

IN THE MATTER OF AN OPPOSITION

Strategic Storage Holdings, LLC **Opponent**

and

Storbec Mini Entrepôt Inc./Storbec Mini Storage Inc. **Applicant**

1,598,693 for MINI SMART **Application**
ENTREPÔTS & DESIGN

[1] Strategic Storage Holdings, LLC opposes registration of the trade-mark MINI SMART ENTREPÔTS & DESIGN shown below (the Mark), that is the subject of application No. 1,598,693 by Storbec Mini Entrepôt Inc./Storbec Mini Storage Inc.



[2] The application was filed based on use of the Mark in Canada since at least as early as October 1, 2012 in association with “the operation of a business offering storage facility services”.

[3] The Opponent has opposed the application for the Mark on the basis that: (i) the application does not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not entitled to registration of the Mark under section 16 of the Act; and (iv) the Mark is not distinctive under section 2 of the Act. The last three grounds of opposition revolve around the likelihood of confusion between the Mark and the following trade-marks of the Opponent, particulars of which are included in Schedule A to this decision:

- SMARTSTOP SELF STORAGE INVENTORY TRACKER (registration No. TMA856,668);
- SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! (registration No. TMA864,146);
- SMARTSTOP... THE SMARTER WAY TO STORE! (registration No. TMA864,147);
- SMARTSTOP, (registration No. TMA864,150); and
- THE SMARTER WAY TO STORE (application No. 1,584,532).

[4] For the reasons that follow, I refuse the application.

The Record

[5] The application for the Mark was filed on October 18, 2012.

[6] It was advertised for opposition purposes in the *Trade-marks Journal* dated July 10, 2013. On December 10, 2013, the Opponent filed a statement of opposition to oppose it under section 38 of the Act. The Applicant then filed and served its counter statement on February 17, 2014.

[7] In support of its opposition, the Opponent filed the affidavit of Ken Morrison, sworn June 12, 2014. Mr. Morrison was not cross-examined on his affidavit.

[8] In support of its application, the Applicant filed the affidavit of Ian Quint, sworn October 2, 2014, the affidavit of Caroline D'Amours, sworn August 19, 2014, and the affidavit of Sandro Romeo, also sworn August 19, 2014. None of the Applicant's affiant's were cross-examined on their affidavits.

[9] Both parties filed written arguments; however, only the Opponent was represented at the hearing.

Onus and Material Dates

[10] 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 be reasonably concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

[11] The material dates that apply to the grounds of opposition are as follows:

- Sections 38(2)(a)/30(b) – the date of filing of the application, namely, October 18, 2012 [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB); and *John Labatt Ltd, supra*];
- Sections 38(2)(a)/30(i) – the date of filing of the application, namely, October 18, 2012 [see *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- Sections 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(1)(a) and (b) – the date of first use, namely, October 1, 2012 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)]; and
- Sections 38(2)(d)/2 – the date of filing of the opposition, namely, December 10, 2013 [see *Metro-Goldwyn-Mayer, supra*].

Ground of Opposition Summarily Dismissed – Section 30(i)

[12] 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].

[13] In the present case, the Opponent submits that it has been using its SMART formative trade-marks in Canada such that the Applicant would have been aware of the use of the Opponent's trade-marks at least 2 years prior to adopting its confusingly similar trade-mark.

[14] However, even if the Applicant had been aware of the Opponent's trade-marks, the mere knowledge of the existence of the Opponent's trade-marks does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197].

[15] In the present case, the Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the section 30(i) ground is dismissed.

Section 30(b) Ground of Opposition

[16] The Opponent has pleaded that the application for the Mark does not comply with section 30(b) of the Act as the Applicant has used the Mark in Canada in association with the services listed therein prior to the date of first use claimed in the subject application of October 1, 2012.

[17] To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the initial evidentiary burden on the Opponent with respect to this ground is relatively light [see *Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, the Opponent may rely upon both its own evidence and that of the Applicant in order to meet its initial evidential burden [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230].

[18] In the present case, the Opponent is relying on the Applicant's own evidence to satisfy its initial evidentiary burden. In this regard, the Opponent submits that the Applicant has essentially

admitted in paragraph 8 of the Quint affidavit that the Applicant's services were offered to the public on a "soft launch" basis on September 9, 2012, approximately one month prior to the date of first use claimed in the application. As such, the Opponent submits, the application is invalid and the Applicant has not met the legal onus of establishing that it has complied with section 30 of the Act.

[19] In his affidavit, Mr. Quint identifies himself as the Director of the Applicant. He then provides a brief history and description of the Applicant and its services, from its incorporation to the filing of the subject application, as well as details regarding the ordering and display of signage bearing the Mark, and advertising and promotion of the Mark through various means. He states that the Applicant's storage services have been offered under the Mark since at least as early as October 1, 2012; that is, the claimed date of first use in the application. The evidence is consistent with this statement.

[20] It is true that Mr. Quint states that as of the date of installation of signage bearing Mark at the Applicant's place of business, namely, September 9, 2012, the Applicant's services were offered to the public on a "soft launch" basis. Despite the absence of further explanation or details regarding the "soft launch" however, I find this statement insufficient to invalidate the application. The purported "soft launch" was less than one month prior to the claimed date of first use, which is consistent with the Applicant's "used since at least as early as" claim in this regard.

[21] I note that even in cases where the applied-for trade-mark was found to have been used prior to the claimed date of first use in the application, this did not render the section 30(b) ground of opposition successful [see for example *Health4All Products Limited v Nutraceutical Medicine Company Inc*, 2012 TMOB 194; *Overwaitea Food Group Limited v Sobeys Capital Incorporated*, 2013 TMOB 196]. In those cases, it was noted that the case law recognizes that an applicant may claim a date subsequent to the actual date of first use "out of an abundance of caution" and "in the interest of greater certainty" [see *Marineland v Marine Wonderland and Animal Park* (1974), 16 CPR (2d) 97 (FCTD)].

[22] Having regard to the foregoing, I dismiss the ground of opposition based on section 30(b) of the Act.

Section 12(1)(d) Ground of Opposition

[23] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with its SMARTSTOP registrations identified above at paragraph 3.

[24] I have exercised the Registrar's discretion to confirm that these registrations are in good standing as of today's date, which as previously indicated is the material date for assessing a section 12(1)(d) ground of opposition [per *Park Avenue Furniture Corp, supra*].

[25] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and any of these registered trade-marks of the Opponent.

[26] Unless indicated otherwise however, I will focus my analysis on the Opponent's registration No. TMA864,146 for the mark SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE!, as I consider this registration represents the Opponent's strongest case. If the Opponent is not successful with this mark, it would not achieve a more favourable result with the other marks.

The test for confusion

[27] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[28] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary

to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 (SCC) at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

Section 6)(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[29] The overall consideration of the section 6(5)(a) factor, involves a combination of inherent and acquired distinctiveness of the parties' marks.

[30] The Mark consists of the words SMART, MINI, and ENTREPÔTS in stylized form together with a graphic design element. The Applicant submits that its Mark is inherently distinctive by virtue of its unique graphic design. Further to this, the Applicant submits that as its Mark features the additional words MINI and ENTREPÔTS and a unique design, its Mark possesses greater inherent distinctiveness. However, the words MINI and ENTREPÔTS are descriptive of the applied-for services, and therefore do not contribute to the inherent distinctiveness of the Mark.

[31] With respect to the term SMART, the Applicant has made submissions that it deems applicable to its Mark as well as the Opponent's marks; in particular, that the word SMART is "suggestive of the smart choice a consumer would make" in choosing services associated with the parties' marks. I agree with the Applicant that the word SMART carries this connotation, particularly in the context of both parties' marks (ie – the inclusion of the animated box wearing a graduation cap and giving the "thumbs up" in the Applicant's Mark and the inclusion of the phrase "THE SMARTER WAY TO STORE!" in the Opponent's mark).

[32] This brings me to discuss the design element of the Applicant's Mark, which I agree with the Applicant gives the Mark a measure of inherent distinctiveness, albeit not significant. In this regard, I am mindful of the suggestive nature of the design itself, as discussed above.

[33] The Opponent's mark, on the other hand, is comprised mainly of ordinary dictionary words, which are either descriptive or suggestive in nature. The word SMART is part of a coined term SMARTSTOP, which provides some measure of inherent distinctiveness. However,

SMARTSTOP is made up of two ordinary easily discernable dictionary words, which could suggest that “stopping in” at the Opponent’s retail location or storage facilities is also a smart or intelligent decision.

[34] On balance, having regard to the foregoing, I find that the Applicant’s Mark possesses marginally more inherent distinctiveness due to the addition of the design element.

[35] Nonetheless, the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use.

[36] Following the “soft launch” of the Applicant’s services in September, 2012, the evidence demonstrates that the Applicant has continued to grow its business and promote and offer its services in association with the Mark. In this regard, Mr. Quint has provided sales figures and advertising expenditures for the years ending August 31, 2013 and August 31, 2014, with sales revenues for the 2014 year end totalling \$431,263. He also provides numerous examples or specimens of advertisements (para 9 and Exhibit E of the Quint affidavit). One such example includes an advertisement for the Applicant’s services featuring the Mark that appeared in various Montreal area publications in 2013, together with circulation figures ranging from 50,000 to 150,000. As such, I accept that the Applicant’s Mark has become known in the Canada to some extent, particularly as the evidence shows, in the Montreal suburbs of Brossard and Greenfield Park.

[37] On the other hand, the Opponent submits that its evidence (the Morrison affidavit) provides clear information concerning the length of time and extent of use of its various SMARTSTOP trade-marks in Canada. The Opponent submits that the issue of acquired distinctiveness is clearly in its favour.

[38] Similar to the Applicant’s evidence contained in the Quint affidavit, the Opponent’s evidence in the Morrison affidavit includes sales revenues and advertising figures, as well as examples or specimens of use of its trade-marks. I agree with the Opponent that the evidence shows that it has used its various SMARTSTOP trade-marks in Canada (including TMA864,146) for a longer period of time and more extensively. In particular, the sales revenues provided by Mr. Morrison refer to sales for the years 2010 to 2014, wherein annual sales peaked at

approximately \$2.5 million in 2013, with total sales for these years being in excess of \$6.5 million. This is in contrast to the annual revenues attested to by Mr. Quint for the Applicant's 2013 and 2014 year ends totalling almost \$600,000. I also note that Mr. Morrison attests that advertising expenditures in Canada since 2010 are in excess of \$355,000; this is in contrast once again to the \$45,879 publicity costs for the Applicant's 2013 and 2014 year ends attested to by Mr. Quint.

[39] In the end, I conclude that the Mark possesses a greater degree of inherent distinctiveness but that the Opponent's mark has become known to a greater extent in Canada. Hence, I find that the overall consideration of the section 6(5)(a) factor does not significantly favour either party.

Section 6(5)(b) – the length of time of use

[40] As per my review of the Morrison affidavit, the Opponent has shown use of the trademark SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! in association with storage related services since November, 2010. In comparison, the earliest evidence of use of the Mark in association with the services provided by the Applicant in the Quint affidavit is in the fall of 2012.

[41] Accordingly, the section 6(5)(b) factor favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the services and business or trade

[42] It is the Applicant's statement of services as defined in its application versus the Opponent's registered services that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. These statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. While evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)], the rights conferred by registration will be restricted by the statement of services as it reads in the application or registration.

[43] In its written argument, the Applicant acknowledges the overlap of the parties' services and the nature of their trade, as it submits that both the Applicant's Mark and the Opponent's

marks are for storage services and there is a similarity in the nature of the trade for both parties' marks.

[44] Accordingly, I find this factor favours the Opponent.

Section 6(5)(e) – degree of resemblance in appearance, when sounded, or in idea suggested

[45] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totalities; it is not the correct approach to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks. The Supreme Court of Canada in *Masterpiece, supra* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[46] Both parties' marks include the word SMART, which in my view is the most striking element of both parties' marks given the relative size or positioning of this element (ie – first portion of the mark) within each respective mark.

[47] The Applicant submits that when considering the parties' marks in their entirety, the mere fact that both parties' marks contain the word SMART is insufficient to conclude that the parties' marks share any significant degree of similarity in appearance, sound or ideas suggested. In this regard, the Applicant appears to take the position that the word SMART itself is so non-distinctive that the unique element in its Mark is the design portion and the addition of the words MINI and ENTREPÔTS; differences, in the Applicant's view, that are sufficient overall to differentiate between the parties' marks in appearance, sound, and ideas suggested.

[48] The Opponent submits, and I agree though, that the Applicant has not brought forth any alternatives as to the ideas suggested by its Mark that would differ from that of the Opponent. Indeed, as previously indicated, the Applicant acknowledges similarity between the parties' marks in the idea suggested by the common element SMART, being "suggestive of the smart choice a consumer would make" in choosing services associated with the marks.

[49] The Opponent submits that upon first impression, a consumer having imperfect recollection seeking to purchase the storage services of the Applicant and the storage services of

the Opponent could easily assume there is a connection between the parties. The Opponent submits that the inclusion of the word MINI in the Applicant's Mark is so small in the overall Mark that it is difficult to discern within the mark itself. The Opponent further submits that the existence of the logo chosen by the Applicant merely reinforces an association between the parties, as the logo consists of a box (for storing goods), and a graduation cap which suggests SMART or a SMART CHOICE.

[50] The Opponent submits that it is not necessary that every part of a trade-mark be copied; it is sufficient if enough is copied to have a tendency to confuse the public as to the source of origin of the goods [citing *C Turnbull Co v Dominion Woollens & Worsteds Ltd*, 1932 CarswellNat 26, (1932) ExCR 218 at 234 (ExCt); and *Corby Distilleries v Wellington County Brewery Ltd* (1993), 52 CPR (2d) 429 (TMOB) aff'd (1995) 59 CPR (3d) 356 (FC)]. The Opponent further submits that although some differences may be accepted to distinguish between marks comprising ordinary dictionary words, in the present case, the Applicant's logo and the minimal size of the word MINI is not sufficient.

[51] I agree with the Opponent that when the trade-marks are assessed in their entirety, they share a fair degree of similarity. Despite the inclusion of the words MINI and ENTREPÔTS in the Mark, as previously indicated, these words are descriptive of the applied-for services and do not serve as distinguishing elements. Furthermore, I agree with the Opponent that the design element simply reinforces the ideas suggested by the word elements of the Mark.

[52] Having regard to the above, I am of the view that the differences in the parties' trade-marks are not significant enough to outweigh their similarities in appearance, sound and ideas suggested, as a matter of first impression and imperfect recollection. The section 6(5)(e) factor therefore favours the Opponent.

Additional Surrounding Circumstances

The State of the Register and Marketplace

[53] Evidence concerning the state of the Register is relevant only to the extent that inferences may be drawn concerning the state of the marketplace [see *Ports International Ltd v Dunlopo*

Ltd (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FC)]. Furthermore, inferences concerning the state of the market may be drawn from this evidence only if a large number of relevant registrations are located [see *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)]. As stated by my colleague Natalie de Paulsen in *Sobeys West Inc v Schwan's IP, LLC, 2015 TMOB 197*, relevant trade-marks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the marks at issue and (iii) are those that include the component at issue in a material way.

[54] The Applicant submitted state of the register evidence with respect to the use of the word SMART via the Romeo affidavit. In this regard, Mr. Romeo, a Trade-Mark Research Analyst employed by Thomson CompuMark conducted a search of the Trade-marks Register to retrieve all occurrences of the term “SMART” for storage services. The Applicant contends that over 30 relevant registrations were located as a result of this search.

[55] The Opponent submits that a review of Mr. Romeo’s search results does not support a conclusion that the word SMART has been commonly adopted by other third parties for storage services. To begin with, the Opponent submits, the results refer to any and all references to SMART *regardless of the nature of the goods and services* and thus, are unpersuasive as they include reference to completely unrelated goods and services to those of the parties herein. The Opponent further submits that these results fail to provide sufficient co-existence of parties where the word SMART and/or the word STORE or STORAGE are registered in the same trade-mark in a manner which would allow the Registrar to conclude that SMART STORE/STORAGE is commonly adopted and used by others such that the Applicant should also be permitted to use its trade-mark in Canada.

[56] Upon review of Mr. Romeo’s search results, I am of the view that, at best, the following third party registrations might be considered to be relevant: CUBESMART (TMA861,196), EARTHSMART (TMA817,164), SMARTBOX (TMA785,136), SMARTYARD (TMA739,384), SMART COURIER (TMA608,339), STORESMART SELF-STORAGE (TMA707,867), and IDEA SMART LIVING DESIGN (TMA720,560). Even of these registrations, the first component of several of the marks is sufficiently different in appearance,

when sounded, and in ideas suggested from those at issue [see *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 at 370 (FCTD) re: the relevance of the first portion of a mark for the purposes of distinction].

[57] With respect to the remainder of the trade-marks included in Mr. Romeo's search results of the Register, those marks appear to be in relation to goods and/or services that are sufficiently different from the storage services of the parties. While the word SMART does appear from Mr. Romeo's search results to be used commonly in the field of cargo, transportation and freight-related services, I consider these services to be sufficiently different from the overlapping storage services of the parties. Given the small number of relevant registrations as outlined above, I am not prepared to draw any inferences concerning the state of the marketplace from the state of the register evidence filed.

[58] To buttress the state of the Register evidence, Mr. Romeo also provides the results of a search he conducted for the term "SMART" used as a domain name (including printouts of associated homepages), and Ms. D'Amours provides the results of a search she conducted of Canadian business name registers, including the telephone directory *Canada411.ca*, to retrieve the term SMART used as a trade name or a company name in combination with storage services.

[59] In its written representations, the Applicant draws particular attention to 40 domain name references from Mr. Romeo's search results, which it deems are relevant references, owned by entities other than the Applicant or the Opponent, and which it submits appear to be associated with storage services.

[60] The Opponent submits that aside from the list of domain names, the Applicant has not provided any other information, such as any information concerning business activities associated with those domain names. In addition, the Opponent submits, the existence of a domain name does not mean that any business activities have been undertaken in Canada in association with such domain names, and the use of a word or trade-mark within a domain name is not considered use of a trade-mark under section 4 of the Act.

[61] I have reviewed Mr. Romeo's domain name search results, including those highlighted by the Applicant and note that only one such result references a webpage that includes the word

SMART for overlapping storage services in Canada. The remaining domain name references however, refer to entities that are located outside of Canada to which there is no indication that the services advertised are being offered to Canadians in Canada and/or the services being offered are not overlapping services or there is no information concerning the associated goods/services or the area of business.

[62] With respect to Ms. D'Amours Canadian business name register and telephone directory searches, the Applicant highlights 20 such search results that it deems relevant in providing an indication as to the state of the marketplace concerning the use of the word SMART. It should be noted however, that business/corporate name registrations are not evidence that such names have been used [see *Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc* (1995), 62 CPR (3d) 108 (TMOB); and *Opus Building Corp v Opus Corp* (1995), 60 CPR (3d) 100 at 106 (FCTD)]. Furthermore, of the *Canada411.ca* search results, there is no clear evidence, in many instances, of the specific nature of the goods, services, or trade of these businesses; thus, for many of these search results, I am unable to determine the relevance of such third party usages. While it appears that there may be a few of instances of use of the word SMART in association with businesses potentially engaged in overlapping services in disparate geographic locations, there simply appears to be too few instances to enable me to conclude that consumers are accustomed to distinguishing between such marks and/or names.

[63] Based on the foregoing, I am not satisfied that the Applicant has provided state of the register or marketplace evidence sufficient to be considered as a relevant surrounding circumstance in determining the likelihood of confusion between the parties' marks.

Family of Marks

[64] The Opponent submits that in terms of considering the degree of similarity in cases where you have a family of marks, the entire family of marks should be considered in terms of their characteristics in order to assess the degree of resemblance [citing *Canadian Olympic Association v Healthcare Employees Union of Alberta* (1992), 46 CPR (3d) 12 (FCTD)].

[65] In the present case, the term SMARTSTOP is the most striking component of each of the Opponent's four registered marks, with three of the four marks also referring to self-storage or

storage of goods, two of which include wording that further reinforces the idea of making a smart or intelligent choice in selecting the Opponent's storage services [i.e. THE SMARTER WAY TO STORE!].

[66] However, in order to rely on a family of marks, the party must evidence use of those marks in the marketplace [see *McDonald's Corp v Yogi Yogurt* (1982), 66 CPR (3d) 101 (FCTD)]. Furthermore, a party seeking to establish a family of marks must establish that it is using *more than one or two trade-marks* within the alleged family (a certified copy of the registration does not establish use) [see *Techniquip Ltd v Canadian Olympic Assn* (1998), 80 CPR (3d) 225 (FCTD) aff'd (1998) 3 CPR (4th) 298 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)].

[67] The Applicant submits that the Opponent does not show any evidence of use of any marks using the term SMART, other than limited evidence of use of its SMARTSTOP mark.

[68] As previously indicated, the Opponent's evidence in the Morrison affidavit includes sales revenues and advertising figures, as well as examples or specimens of use of its trade-marks. In particular, the specimens of use include what I consider to be use of the registered marks SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! (registration No. TMA864,146) and SMARTSTOP (registration No. TMA864,150). However, I do not see any specimens reflecting use of the marks SMARTSTOP SELF STORAGE INVENTORY TRACKER (registration No. TMA856,668) or SMARTSTOP... THE SMARTER WAY TO STORE! (registration No. TMA864,147). I note further that Mr. Morrison has not broken down any of the Opponent's sales revenues and advertising figures by trade-mark, but instead provides aggregate figures for all trade-marks. Thus, as it is difficult to assess the extent to which a "family" of marks would be recognized by the consumer, I do not consider that the Opponent has established the use of a "family of marks".

Conclusion in the likelihood of confusion

[69] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Furthermore, having regard to all the surrounding circumstances set out above, including the clear overlap in the nature of the parties' services and channels of trade, as

well as the similarity of the parties' marks in appearance, sound, and ideas suggested, I am not satisfied that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! (registration No. TMA864,146).

[70] Accordingly, the section 12(1)(d) ground of opposition is successful.

Sections 16(1)(a) and (b) grounds

[71] In order to meet its initial burden under section 16(1)(a) of the Act, the Opponent must show that one or more of the its trade-marks alleged in support of this ground of opposition were used or made known prior to the Applicant's claimed date of first use (October 1, 2012) and were not abandoned at the date of advertisement of the application for the Mark (July 10, 2013) [section 16(5) of the Act].

[72] As previously indicated, I am satisfied that the Opponent has provided evidence of use of its mark SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! in association with storage related services since November, 2010, and that such mark was not abandoned at the date of advertisement of the application for the Mark. Thus, I am satisfied that the Opponent has met its initial burden under this ground of opposition.

[73] Since the difference in the relevant date has no impact on my previous assessment of the factors set out in subsection 6(5) of the Act, I conclude that the Applicant has not discharged its ultimate onus of establishing, according to the balance of probabilities, that there was no likelihood of confusion between the Mark and the Opponent's mark SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! as of October 1, 2012.

[74] Therefore, the ground of opposition based on section 16(1)(a) of the Act is successful.

[75] With respect to the ground of opposition based on section 16(1)(b) of the Act, the Opponent has an initial burden of establishing that one or more of its applications set out in the statement of opposition was filed prior to the date of first use alleged in the subject application

(October 1, 2012), and that they were not abandoned at the date of advertisement (July 10, 2013) [section 16(4) of the Act].

[76] The Registrar has the discretion to check the Register in order to confirm the existence of the applications relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that all of the Opponent's applications relied upon under this ground (with the exception of TMA864,150) were filed prior to the date of first use claimed in the Applicant's application and were pending as of its advertisement.

[77] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the date of first use in the Applicant's application, namely, October 1, 2012, there was not a reasonable likelihood of confusion between its Mark and the Opponent's previously filed trade-mark SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! (TMA864,146).

[78] Once again, the difference in the relevant date has no impact on my previous assessment of the factors set out in subsection 6(5) of the Act; therefore, I conclude that the Applicant has not discharged its ultimate onus of establishing, according to the balance of probabilities, that there was no likelihood of confusion between the Mark and the Opponent's mark SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! as of October 1, 2012.

[79] Therefore, the ground of opposition based on section 16(1)(b) of the Act is also successful.

Non-distinctiveness grounds of opposition

[80] The Opponent's non-distinctiveness ground is two pronged. First, the Opponent pleads that the Applicant's Mark is not distinctive of the Applicant nor has it been adapted to distinguish the Applicant's services from the services of the Opponent. Second, the Opponent pleads that the Applicant's Mark is not distinctive of the Applicant nor has it been adapted to distinguish the Applicant's services from those of others who have used its trade-mark in Canada as unauthorized licensees.

[81] There is an initial evidential burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground. Once the burden has been met, there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods and services from those of others [See *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 298; *Muffin Houses Incorporated v The Muffin House Bakery Ltd*, (1985) 4 CPR (3d) 272 (TMOB); *Imperial Tobacco Canada Limited v Philip Morris Products SA*, 2013 TMOB 175 (TMOB) para 24, aff'd 2014 FC 1237 para 15-16 and 68; *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2013 FC 608 para 55].

[82] This means that with respect to the first prong above, in order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, December 10, 2013, one or more of the Opponent's marks had become known sufficiently to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, (2004), 34 CPR (4th) 317 (FC); and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[83] As per my as per my analysis under the section 12(1)(d) ground of opposition, I accept that the Opponent's SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! trade-mark had become known to a sufficient extent in Canada as of the material date.

[84] Since I am satisfied that the Opponent's evidence establishes that its SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! trade-mark had become sufficiently known as of December 10, 2013 to negate the distinctiveness of the Mark, the issue becomes whether the Applicant has satisfied its legal onus to show that the Mark was not reasonably likely to cause confusion with the Opponent's SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE! trade-mark.

[85] The difference in material dates is not significant, and as a result, my findings under the ground of opposition based on section 12(1)(d) are equally applicable here. Accordingly, the ground of opposition based on this prong of non-distinctiveness ground is successful.

[86] However, with respect to the Opponent's second prong under this ground of opposition as noted above, there is no evidence of use of the Applicant's Mark by unauthorized licensees.

Thus, the Opponent fails to meet its evidential burden and this prong of the non-distinctiveness ground of opposition is rejected.

Disposition

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

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

Hearing Date: 2015-09-17

Appearances

Luanne Morrow For the Opponent

No one appearing For the Applicant

Agents of Record

Borden Ladner Gervais For the Opponent

Sari E. Moscovitz For the Applicant

SCHEDULE “A”

<u>Trade-mark</u>	<u>Reg. or App. No.</u>	<u>Registered services</u>
SMARTSTOP SELF STORAGE INVENTORY TRACKER	TMA856,668	providing on-line and mobile software tools for managing inventory of goods of others for storage in self-storage facilities
SMARTSTOP SELF STORAGE... THE SMARTER WAY TO STORE!, and SMARTSTOP... THE SMARTER WAY TO STORE!	TMA864,146 TMA864,147	Providing retail store services featuring storage supplies, namely boxes, shipping blankets and pads, and insulation materials; storage of vehicles, namely, storage of cars, recreational vehicles, boats, and aircraft of others; storage of files and documents of others; physical storage of electronically-stored household and business records; providing self-storage facilities for others; providing rental storage spaces for others; warehousing services for goods of others; providing portable metal structures for storage of goods of others; rental of storage containers; providing containers for storage of goods of others; marina services for berthing, mooring, and storage of boats; providing pickup, delivery and storage of goods of others by truck.
SMARTSTOP	TMA864,150	Providing retail store services featuring storage supplies, namely boxes, shipping blankets and pads, and insulation materials; storage of vehicles, namely, storage of cars, recreational vehicles, boats, and aircraft of others; storage of files and documents of others; physical storage of electronically-stored household and business records; providing self-storage facilities for others; providing rental storage spaces for others; warehousing services for goods of others; providing portable metal structures for storage of goods of others; rental of storage containers; providing containers for storage of goods of others; marina services for berthing, mooring, and storage of boats; providing pickup, delivery and storage of goods of others by truck. Providing retail store services featuring storage supplies, namely boxes, shipping blankets and

		<p>pads, and insulation materials; storage of vehicles, namely, storage of cars, recreational vehicles, boats, and aircraft of others; storage of files and documents of others; physical storage of electronically-stored household and business records; providing self-storage facilities for others; providing rental storage spaces for others; warehousing services for goods of others; providing containers for storage of goods of others; providing pickup, delivery and storage of goods of others by truck.</p>
<p>THE SMARTER WAY TO STORE</p>	<p>1,584,532</p>	<p>Providing retail store services featuring storage supplies including boxes, packaging tape and dispensers, padlocks and cylinder locks; storage of vehicles, namely, storage of cars, recreational vehicles, boats, and aircraft of others; storage of files and documents of others; physical storage of electronically-stored household and business records; providing self-storage facilities for others; providing rental storage spaces for others; warehousing services for goods of others; providing containers for storage of goods of others; and providing pickup, delivery and storage of goods of others by truck.</p> <p>Storage of vehicles, namely, storage of cars, recreational vehicles, boats, and aircraft of others; storage of files and documents of others; physical storage of electronically-stored household and business records; providing self-storage facilities for others; providing rental storage spaces for others; warehousing services for goods of others; providing containers for storage of goods of others; and providing pickup, delivery and storage of goods of others by truck.</p>