



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

Citation: 2015 TMOB 207
Date of Decision: 2015-11-24

IN THE MATTER OF OPPOSITIONS

**SALT Branding, LLC Limited Liability
Company California**

Opponent

and

Salt Creative Group, Inc.

Applicant

**1,537,788 for Salt Creative Group
1,537,793 for Salt Creative**

Applications

[1] SALT Branding, LLC Limited Liability Company California opposes registration of the trade-marks Salt Creative Group and Salt Creative (the Marks) that are the subject of application Nos. 1,537,788 and 1,537,793 respectively by Salt Creative Group, Inc.

[2] Filed on August 1, 2011, each application is based on use of the trade-mark in Canada since May 20, 2005 in association with “advertising, design and business consulting services, namely, marketing consultation; creation and management of brand names for others and logo development; naming and branding of products and services for others; development and implementation of marketing strategies for others; designing, developing and creating stationery,

package design, website design for others on a global computer network; general graphic design for sales materials for others” (the Services).

[3] In each case, the Opponent alleges 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 Applicant is not the person entitled to registration of the Mark under section 16 of the Act; and (iii) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I reject the opposition in each case.

The Record

[5] In each case, the Opponent filed a statement of opposition on June 28, 2013; the Applicant then filed and served its counter statement denying all of the grounds of opposition.

[6] In support of each of its oppositions, the Opponent filed a certified copy of the file history of the subject application, a certified copy of the Opponent’s United States registration for the trade-mark SALT under No. 2,671,901, a certified copy of the Applicant’s certificate of dissolution dated March 2, 2010, and the substantially identical affidavit of Angela C. Wilcox, a lawyer with a law firm in the United States that acts on behalf of the Opponent in trade-mark matters. In support of each of its applications, the Applicant filed the identical affidavit of Louise Sallese, Owner and President of the Applicant. Neither affiant was cross-examined.

[7] In each case, both parties filed a written argument. The parties also attended a hearing held for both opposition proceedings.

The Parties’ Respective Burden or Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities that its applications comply 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].

Non-Entitlement and Non-Distinctiveness Grounds

[9] In each case, the grounds of opposition raised under sections 16 and 2 of the Act are summarily dismissed for the Opponent's failure to meet its initial evidential burden.

[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 alleged trade-mark SALT had been used or made known in Canada prior to the date of first use claimed by the Applicant; it has not done so.

[11] In order to meet its initial burden in support of the non-entitlement ground of opposition based upon section 16(1)(c) of the Act, the Opponent was required to show that its alleged trade-name SALT BRANDING had been used in Canada prior to the date of first use claimed by the Applicant; it has not done so.

[12] In order to meet its initial burden in support of the non-distinctiveness ground of opposition based upon section 2 of the Act, the Opponent was required to show that its alleged trade-mark SALT or trade-name SALT BRANDING had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Marks [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC); *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)]; it has not done so.

Does the Application Conform to the Requirements of Section 30 of the Act?

[13] In each case, the Opponent alleges that the application does not conform to the requirements of section 30 of the Act, namely that:

- i. the application does not comply with section 30(a) of the Act since the Applicant did not include a statement in ordinary commercial terms of the specific goods or services in association with which the Mark "has been **actually** used in Canada";

- ii. the application does not comply with section 30(b) of the Act since the Applicant had not used the Mark in Canada in association with the Services, or otherwise had not continuously used the Mark, since the alleged date of first use; and
- iii. the application does not comply with section 30(i) of the Act since the Applicant could not have been satisfied that it was entitled to use the Mark in Canada with the Services:
 - a. in view of the Opponent's prior making known of its trade-mark SALT and prior making known and use of its trade-name SALT BRANDING with the same or the same type of services;
 - b. in view of the Opponent's "prior interests and/or rights" in the trade-mark SALT in Canada in association with the same or the same type of services, of which the Applicant had been aware prior to the filing of the subject application;
 - c. since the Applicant filed the application in bad faith having essentially copied the Opponent's statement of services in its corresponding US registrations for the trade-marks SALT and SALT BRANDING when filing its own Canadian application, as a result of which the Opponent alleges that the Applicant has not actually used the Mark with all or any of the Services as of the alleged date of first use "since the Applicant did not draft that statement of services based on [its] own actual alleged activities"; and
 - d. since the Applicant filed the application in bad faith for it had full knowledge of the Opponent's interest in the Mark in Canada and its objections to the Applicant's use of the Mark in Canada.

[14] The material date for considering the circumstances with respect to the grounds of opposition based upon non-compliance with section 30 is the filing date of the application, namely August 1, 2011 in each case [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

Section 30(a) Ground

[15] With respect to the section 30(a) ground, the Opponent submitted at the hearing that in each case, the statement of services in the subject application does not reflect the services actually provided by the Applicant with the trade-mark. Such pleading is more appropriately raised under section 30(b) of the Act. Consequently, I dismiss the non-compliance ground under section 30(a) of the Act for having been improperly pleaded.

Section 30(b) Ground

[16] In each case, the Opponent alleges that (i) the Applicant had not used the trade-mark in Canada in association with the applied for services since the claimed date of first use, (ii) or otherwise had not continuously used the trade-mark since the claimed date of first use.

[17] The issue under section 30(b) is whether the Applicant had continuously used the Marks in the normal course of trade from the alleged date of first use to the material date [see *Immuno AG v Immuno Concepts, Inc* (1996) 69 CPR (3d) 374 (TMOB); *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262 and *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323].

[18] In each case, there is an initial evidential burden on the Opponent to adduce sufficient evidence to support its allegation of the application's non-conformity to section 30(b) of the Act, bearing in mind that the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1996), 10 CPR (3d) 84 (TMOB) at 89 and *Corporativo de Marcas*, supra]. The Opponent's initial burden can be met by reference not only to its own evidence but also that of the Applicant's [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. If the Opponent succeeds in discharging its initial evidential burden, the Applicant must then, in response, substantiate its claim of use during the material time.

[19] In each case, with respect to the first prong of the section 30(b) ground, the Opponent submits that the trade-mark was not used as applied for and that the services provided are not

those set out in the application. In support, the Opponent relies on Ms. Sallese's affidavit filed by the Applicant; I shall begin with a summary of the most salient points of her affidavit.

[20] In her affidavit, Ms. Sallese states that from June 21, 1999 to May 2005, her and her husband operated a marketing, advertising and design business under the name "Salt", a play on the word "sale" from their last name which means "salt" in the Italian language. Sample invoices dated between 2001 and 2004 bearing the terms SALT ADVERTISING & DESIGN along with a geometric design are attached as Exhibit C. Descriptions of services found in the invoices include the creation and development of a magazine (including market research and consultation, brand image development, and logo concepts); concept and design of an annual report and web layout; the creative art direction and design of a travel brochure; materials for wedding shows; and the creative art direction of a photo shoot. Excerpts from magazines and calendars between 2001 and 2004 acknowledging Salt's design contribution are attached as Exhibit D.

[21] According to Ms. Sallese, her and her husband decided to incorporate as the Applicant on May 20, 2005; a copy of the Certificate of Incorporation is attached as Exhibit F. The domain names <saltcreativegroup.com>, <saltcreative.ca>, and <saltcreativegroup.ca> were registered between 2005 and 2011 [Exhibits G, H and J]. I note that the Registrar has previously found that the mere registration of a domain name does not constitute use of a trade-mark nor that of a trade-name [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc* 2011 TMOB 15 (CanLII); *4358376 CanSada Inc v 770879 Ontario Ltd* 2012 TMOB 213 (CanLII); *Lofaro v Esurance Inc* 2010 TMOB 216 (CanLII)].

[22] Ms. Sallese states that the Applicant has been an active corporation since its incorporation. Copies of selected invoices of work performed for various clients between June 5, 2005 and March 20, 2014 are attached as Exhibit O; excerpts of various publications acknowledging credit to the Applicant's design work between 2005 and 2008 are attached as Exhibit P. I note that the following trade-mark (shown below) appears on invoices dated between 2006 and 2014 while no trade-mark appears on the 2005 invoices. Descriptions of services found in the selected invoices include sourcing, searching and manipulation of images and photos; design, layout and printing of missionary cards; creative concept of a book; art direction for photoshoots; proof of a book; printing of shirts; design, layout and printing of postcards;

modifications to layouts for publications; cover redesign; art direction and design of images in a publication; layout of images; production of design proofs; concept and studio work for publication; concepts for an ad; brand strategy; corporate icon logo word mark; print ad for gallery opening; development of a logo with application to business cards, letterheads and envelopes; design, layout and digital production of materials for events including brochure, invitation, name tags, inserts, web banner, web announcement, art direction and studio development of stationary and digital billboards, etc.



The same design appears on excerpts of two printed publications attached as Exhibit P while the words “Designed by: SALT Creative Group” appear at the back of a book cover and the words “DESIGNED BY SALTCREATIVEGROUP.COM” can be seen in another excerpt.

[23] Attached as Exhibit T are copies of the Applicant’s business cards, pamphlets and brochures, said to have been circulated at various meetings and events attended; attached as Exhibit U are copies of the Applicant’s Christmas cards and e-cards. According to Ms. Sallese, the Applicant’s Christmas cards and e-cards were sent to approximately 90 existing and potential clients each year between 2005 and 2013; the target demographic being small to medium businesses in Toronto and the Greater Toronto Area. I note that the same design appears on the Applicant’s sample business cards and brochures, along with references to advertising, design, branding, marketing, newsletter, magazines, brochures, stationary, packaging, corporate communication, direct mail, posters, calendars, annual reports, etc. The same design also appears on some of the sample Christmas cards and e-cards attached while others contain a similar design where the design element appears on the left side of the words “SALT CREATIVE”.

[24] In its written submissions and at the oral hearing, the Opponent submits that the use of the design identified above is not use of the Marks, but of a new and different composite mark consisting of “the word SALT, followed by the flame design, and then the words CREATIVE

GROUP”. The Opponent further submits that the design is clearly part of the trade-mark as it does not appear as a separate element.

[25] In response, the Applicant simply submits that the evidence shows use of the Marks.

[26] Generally, the use of a word mark can be supported by the use of a composite mark featuring the word mark and other elements [see *Nightingale Interloc Ltd v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)]. Further, as stated in *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB) at 395 in the context of a word mark that is registered:

As clearly pointed out by the registrant, the trade-mark as registered is a word mark. No particular design or font size was registered. Consequently, in the case of a word mark, use of the trade-mark word or words in any stylized form and in any colour can be considered as use of the registered mark.

[27] Thus, since the Marks in question are word marks, the display of the words SALT CREATIVE and SALT CREATIVE GROUP in any stylized form can be considered as use of the Marks.

[28] With regards to the addition of the design and written material, in applying the principles set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canda Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I find that essential feature of the Marks, namely the words SALT CREATIVE in each case, has been maintained and that the addition of the design to be a minor deviation in such a way that in each case, the applied for trade-mark has not lost its identity and remain recognizable. This is the case in view of the relative sizing of the words SALT and CREATIVE in comparison with the design element, the use of the same font for both words, and the fact that the average consumer would perceive the words SALT CREATIVE together despite the addition of the design. Moreover, I consider the additional written material, “INC.” in the case of application No. 1,537,788 and “GROUP INC.” in the case of application No. 1,537,793, to be a minor deviation in each case given its descriptive nature, its size, as well as its separate positioning.

[29] In the end, I find that the trade-mark as used in the above-mentioned invoices and printed publications constitute display of the Marks.

[30] As for the allegation that the services provided are not those set out in the applications, I fail to see any inconsistency between the services described in Ms. Sallese's affidavit, including those set out in the sample advertisements and invoices, and the statement of services in the subject applications. In the absence of any evidence suggesting that the Applicant has not used the Marks in Canada as of the alleged date of first use, the Applicant is under no obligation to positively evidence such use. Consequently, I dismiss the first prong of the section 30(b) ground of opposition for the Opponent's failure to meet its initial burden in each case.

[31] With respect to the second prong of the section 30(b) ground, the Opponent submits in each case that the Applicant was dissolved on March 2, 2010, thus the Applicant had not continuously used the Mark since the claimed date of first use. In support, the Opponent filed a certified copy of the certificate of dissolution of the Applicant dated March 2, 2010. I am therefore satisfied that the Opponent has met its initial evidential burden.

[32] In her affidavit, Ms. Sallese states that even though the Applicant has remained in operation since its incorporation in 2005, it was dissolved by Industry Canada on March 2, 2010 for failure to pay a fee to maintain the corporation's active status. Ms. Sallese explains that her and her husband only became aware of the dissolution upon receipt of a letter from Canada Revenue Agency on August 8, 2011 regarding the filing of corporate income tax return [Exhibit K]. Ms. Sallese states that she proceeded to request a certificate of revival on August 17, 2011 and that the certificate was issued the same day [Exhibit L]. Ms. Salles further states that the Applicant continued to perform its services during that time. Redacted Statements of Income of the Applicant for the years ending January 31, 2011 and January 31, 2012, as well as redacted General Ledgers for that period of time, are attached as Exhibit Q.

[33] In its written argument, the Opponent submits that any alleged use of the Marks during that year and a half did not accrue to the Applicant since it did not exist as a legal entity, thus it cannot be said that the Applicant has continuously use the Marks since the claimed date of first use.

[34] In its written argument, the Applicant notes that Form 15 which pertains to the articles of revival of the corporation pursuant to section 209 of the *Canada Business Corporations Act*, also attached as Exhibit L to the Sallese affidavit, indicates that “a revived corporation is restored as if it had not been dissolved” and that “the public record will show the articles of the revived corporation exactly as they were at the time the corporation was dissolved”. The Applicant also submits that in any case, the evidence clearly establishes the continuous use of the Marks by the Applicant during the material time.

[35] Section 209 of the *Canada Business Corporations Act*, RCS 1985, c C-44 provides the following:

(1) When a body corporate is dissolved under this Part or under section 268 of this Act, section 261 of chapter 33 of the Statutes of Canada, 1974-75-76, or subsection 297(6) of the Canada Not-for-profit Corporations Act, any interested person may apply to the Director to have the body corporate revived as a corporation under this Act.

(2) Articles of revival in the form that the Director fixes shall be sent to the Director.

(3) On receipt of articles of revival, the Director shall issue a certificate of revival in accordance with section 262, if

(a) the body corporate has fulfilled all conditions precedent that the Director considers reasonable; and

(b) there is no valid reason for refusing to issue the certificate.

(3.1) A body corporate is revived as a corporation under this Act on the date shown on the certificate of revival.

(4) Subject to any reasonable terms that may be imposed by the Director, to the rights acquired by any person after its dissolution and to any changes to the internal affairs of the corporation after its dissolution, the revived corporation is, in the same manner and to the same extent as if it had not been dissolved,

(a) restored to its previous position in law, including the restoration of any rights and privileges whether arising before its dissolution or after its dissolution and before its revival; and

(b) liable for the obligations that it would have had if it had not been dissolved whether they arise before its dissolution or after its dissolution and before its revival.

(5) Any legal action respecting the affairs of a revived corporation taken between the time of its dissolution and its revival is valid and effective.

[36] In *Litemor Distributors (Ottawa) Ltd v WC Somers Electric Ltd*, 2004 CanLII 39026 (ON SC), 73 OR (3d) 228, the Ontario Superior Court of Justice states the following in relation to section 209(4) of the *Canada Business Act* and an equivalent provision in the *Ontario Business Corporation Act*, “upon revival, any acts undertaken in the name of the corporation by its principals during the period of dissolution would be ‘cured’ so that such acts are deemed to have been taken by the corporation itself even though it was dissolved at the time” [par 27]. Similarly, while discussing section 209(4) of the *Canada Business Act* and its equivalent in the *New Brunswick Business Corporation Act*, the Tax Court of Canada notes in *Leger v The Queen* 2007 TCC 322 (CanLII) that “the revival of a corporation is retroactive to the date of its dissolution and that, for all intents and purposes, it is deemed to have never been dissolved” [par 26].

[37] The Sallese affidavit must be considered in its entirety. In addition to providing a certificate of revival, the Applicant has provided evidence that it continued to perform the Services in association with the Marks during the temporary period of dissolution. Section 290(4) of the *Canada Business Corporations Act* provides that the Applicant, once revived, is restored to its previous position in law, including the restoration of any rights and privileges, “in the same manner and to the same extent as if it had not been dissolved”, I am therefore satisfied that there was continuous use of the Marks since the claimed date of first use.

[38] In view of the foregoing, I reject the second prong of the section 30(b) ground of opposition in each case.

Section 30(i) Ground

[39] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. I shall address each of the allegations raised by the Opponent in its statement of opposition under section 30(i) of the Act.

[40] The mere fact that the Opponent has alleged prior use or making known of its trade-mark and of its trade-name in association with the same or the same type of services as those of the Applicant in Canada is not by itself sufficient to put into question section 30(i) of the Act. Likewise, the mere fact that the Applicant might have been aware of the Opponent's alleged "prior interests and/or rights" in its trade-mark in Canada, or of its "prior objections" to the use of the Marks in Canada, is not by itself sufficient to suggest bad faith and to put into question section 30(i) of the Act [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[41] The Opponent further alleges that in each case, the application does not comply with section 30(i) of the Act in view of the fact that the Applicant has not actually used the trade-mark with all or any of the services listed in its application since the alleged date of first use. In this regard the Opponent pleads that the Applicant essentially copied the Opponent's statement of services found in its foreign registrations. Such pleading is more appropriately raised under section 30(b) of the Act. I dismiss the issue for having been improperly pleaded as it does not put into question section 30(i) of the Act.

[42] At the hearing, the Opponent further alleges that in each case, the application does not comply with section 30(i) of the Act in view of the fact that the Applicant did not file an application for its own trade-mark, but that of the Opponent, for the Applicant essentially copied the Opponent's statement of services found in its foreign registrations. As such, the Opponent submits that there is a material misstatement in each application. In response, the Applicant

submits that this particular allegation was not pleaded in the statements of opposition and that there is no evidence to suggest a misstatement was made. Suffice it to say that the Opponent failed to substantiate its claim to the Marks in Canada when it elected not to file any evidence of use or making known of its trade-mark or trade-name in Canada. Thus, I dismiss this section 30(i) issue.

[43] The remaining issue raised in the section 30(i) ground revolves around an allegation of bad faith on the basis that the Applicant essentially copied the statement of services found in the Opponent's US registrations. Attached as Exhibit A to the Wilcox affidavit is a copy of a cease and desist letter dated July 29, 2011 accompanied by copies of the Opponent's US registrations for the service marks SALT and SALT BRANDING under Reg. No. 2,671,901 and 2,596,052 respectively, sent by the Opponent's US trade-mark representative to the Applicant, as well as the file wrapper of the subject applications. I note that in each case, the subject application, as it was first filed with the Canadian Intellectual Property Office on August 1, 2011, contained a statement of services that is nearly identical to that of the Opponent's US registrations. As such, the Opponent submits that the subject applications were not filed in good faith, and the Applicant "was likely trying to ensure that their applications would have the greatest chances of blocking any applications subsequently filed by the Opponent".

[44] In response, the Applicant submits that "copying of statements of services is *de facto* encouraged by the Canadian Intellectual Property Office which maintains a list of service descriptions that are approved for filing". Moreover, the Applicant points to the Sallesse affidavit for evidence of a business operated by Ms. Sallesse, the Owner and President of the Applicant, with her husband in Canada from 1999 to 2005 under the name SALT in the field of marketing, advertising and design, prior to incorporating as the Applicant in 2005 and applying for the registration of the Marks [paragraphs 2 to 10 of the Sallesse affidavit]. Thus, the Applicant submits that the evidence clearly establishes that it not only believed itself to be entitled to use the Marks but was in fact entitled to use them.

[45] While the Canadian Intellectual Property Office maintains a list of pre-approved goods and services in its *Goods and Services Manual*, it does not comment on practices that involve the copying of statements of goods and services from third party applications or registrations, in

Canada or abroad. I note that the statement of services in question does not appear to be taken from the pre-approved list found in the *Goods and Services Manual*. Instead, the subject applications appear to have been heavily inspired by the statement of services found in the Opponent's US registrations for the trade-marks SALT and SALT BRANDING.

[46] Even so, I am of the view that the mere copying of a statement of services does not by itself put into question the veracity of the Applicant's statement made under section 30(i) of the Act for each of its applications, especially when I take into consideration the fact that the owner of the Applicant had been operating a similar business using a name that bears significant similarities with the Marks years before the Opponent's cease and desist letter.

[47] In *Taverniti SARL v DGGM Bitton Holdings Inc* (1986), 8 CPR (3d) 400 (TMOB) at 404-405, Member Troicuk states the following with respect to a section 30(i) ground:

The opponent's third ground of opposition is that the applicant's application does not comply with section 30(i) in that the applicant could not have been satisfied that it was entitled to use the trade mark in Canada ... The opponent submitted that it could be inferred from the evidence that ... the applicant had knowledge of the opponent's trade marks and ... could not have been satisfied that it was the person entitled to registration. In support of this submission, the opponent relied upon the decision of the Exchequer Court in *Williamson Candy Co. v. W. J. Crothers Co.*, [1924] Ex. C.R. 183 (Can. Ex. Ct.), and, in particular, Maclean J.'s following statement at p. 191:

I think knowledge of foreign registration and user, of a mark applied to the same class of goods, as in this case, and particularly where the foreign user is in a contiguous country using the same language, and between which travel is so easy, and advertising matter so freely circulates, should in most cases be a bar to registration knowingly, of that mark here.

The Williamson case was, however, decided under the *Trade Mark and Design Act*, R.S.C. 1906, c. 71, s. 13 of which required an applicant to declare that the trade mark for which he sought registration was not in use to his knowledge by any other person than himself at the time of his adoption thereof. No such provision exists under the present

Trade-Marks Act. In the present case, the opponent has not established prior use, prior making known, prior filing of an application or that its trade marks were known sufficiently in Canada to negate the distinctiveness of the applicant's trade mark and there is therefore no basis for concluding that the applicant could not have been satisfied that it was entitled to use its trade mark in Canada in association with the wares covered in its application. As a result, I also reject the opponent's third ground of opposition.

[48] In view of the foregoing, I am unable to conclude that the applications were submitted in bad faith simply based on the fact that the Applicant appears to have used the wording of statements of services found in the Opponent's registrations, when filing its own applications for the Marks. This is especially true considering the history of the corporation and the services that the Applicant has performed over the years in association with the Mark and variations thereof, as explained by Ms. Sallese in her affidavit.

[49] Consequently, I reject the section 30(i) ground of opposition in each case.

Disposition

[50] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act in each case.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: September 30, 2015

Appearances

Richard Whissell

For the Opponent

Steven H. Leach

For the Applicant

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For the Applicant