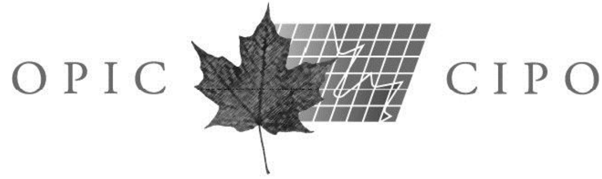


LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2014 TMOB 207
Date of Decision: 2014-09-26

IN THE MATTER OF AN OPPOSITION by U Box It Inc. to application No. 1,455,468 for the trade-mark U-BOX in the name of U-Haul International, Inc.

[1] U Box It Inc. (the Opponent) opposes registration of the trade-mark U-BOX (the Mark) that is the subject of application No. 1,455,468 by U-Haul International, Inc. (the Applicant).

[2] Filed on October 15, 2009, the application is based on use of the Mark in Canada since at least as early as October 3, 2009, as well as use and registration of the Mark in the United States, in association with “moving and storage services, namely, rental, moving, storage, delivery and pick up of portable storage units”.

[3] The Opponent alleges that: (i) the Mark is not registrable under section 12(1)(d) 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 sections 16(1)(a) of the Act; and (iii) the Mark is not distinctive under section 2 of the Act. The opposition turns on the likelihood of confusion between the Mark and the Opponent’s trade-mark U BOX IT.

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

The Record

[5] The Opponent filed its statement of opposition on August 31, 2010. The Applicant then filed and served its counter statement on October 14, 2011, denying all of the grounds of opposition alleged in the statement of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Anthony Mammone, Founder and Chief Executive Officer of the Opponent. In support of its application, the Applicant filed the affidavit of John "JT" Taylor, President of the Applicant. Only Mr. Mammone was cross-examined on his affidavit; the transcript of his cross-examination, along with exhibits and replies to undertakings, has been made of record.

[7] Only the Applicant filed a written argument. Both parties were represented at a hearing held jointly with hearings for opposition proceedings with respect to three other applications filed by the Applicant for the trade-marks U-BOX WE-HAUL, U-HAUL U-BOX and U-HAUL U-BOX WE-HAUL. Separate decisions will be issued for these other proceedings, which pertain to application Nos. 1,455,472, 1,455,473 and 1,455,478 respectively.

The Parties' Respective Burden or Onus

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Is the Mark Confusing with the Opponent's Registered Trade-mark?

[9] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act, on the ground that it is confusing with the Opponent's trade-mark U BOX IT under registration No. TMA708,544, registered for use in association with "garbage removal and waste management services".

[10] The material date for considering this issue, which arises from the section 12(1)(d) ground of opposition, is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[11] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing. The Registrar has the discretion to check the register in order to confirm the existence of the registration 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)].

[12] Having exercised the Registrar's discretion, I confirm that the Opponent's registration No. TMA708,544 is in good standing.

[13] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark. For the reasons that follow, I accept this ground of opposition and decide this issue in favour of the Opponent.

<u>The test for confusion</u>

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[15] 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 wares, 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 enumerated factors need not be attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[16] I will now turn to the assessment of the section 6(5) factors.

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

[17] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks. I assess the inherent distinctiveness of both parties' trade-marks to be equally weak. In this regard, I do not consider the terms "u-box" or "u box it" to be particularly unique or inventive considering that the registered and applied for services relate to boxes.

[18] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. In this regard, both parties provide some evidence of promotion and use of their trade-marks. I shall begin with a review of the Opponent's evidence.

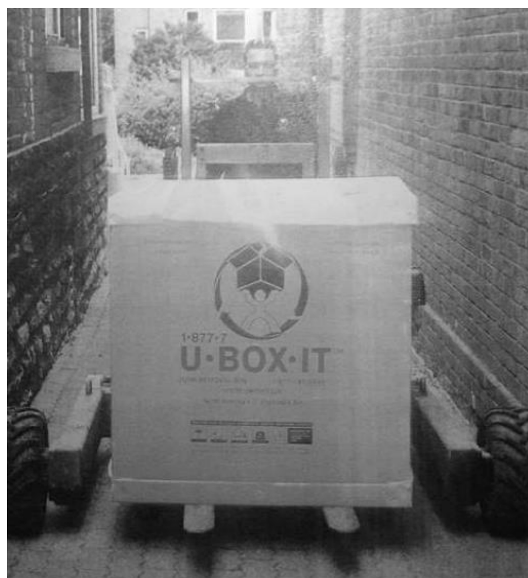
Acquired Distinctiveness – U BOX IT

[19] In his affidavit, Mr. Mammone states that the Opponent is a provider of "waste disposal and storage services to many companies and residents in the Greater Toronto Area (GTA)". According to Mr. Mammone, the Opponent has been using its trade-mark U BOX IT in association with "garbage removal, waste management and storage services, namely the delivery, storage and pick-up of containers" since at least as early as November 30, 2006.

[20] Mr. Mammone explains the Opponent's business as follows. The Opponent delivers containers to its customers upon request, who in turn load the containers with waste and junk that they wish to dispose or goods that they wish to store. Once a container is filled, the customer can request pick-up and removal by the Opponent, who will then load the container onto a truck using a forklift and dispose of it. Customers include individual residents and businesses located

across Ontario. These ready-to-assemble disposable containers can also be picked up by the customers through certain authorized retailers such as designated hardware stores.

[21] Attached as Exhibit 4 to the Mammone affidavit are photographs and diagrams depicting the manner in which the trade-mark U BOX IT appears in association with the Opponent's services. The Opponent's trade-mark can be seen prominently displayed on containers (reproduced below), on uniforms worn by employees, and on the sides of the Opponent's trucks and trailers.



[22] In terms of revenue, Mr. Mammone states that the Opponent's services are normally priced at $129, which includes "the container, delivery and the dumping fee". According to the affiant, the Opponent's approximate sales figures went from $129 in 2006 to over $57,000 in 2010, totalling nearly $140,000 from 2006 to the first half of 2011. Attached as Exhibit 6 to the Mammone affidavit are six sample invoices dated between 2006 and 2011, representative of services rendered by the Opponent in association with the trade-mark U BOX IT during that time period. I note that the invoices are issued by the Opponent to individuals and entities located in Ontario. The description "UBOX IT CONTAINERS" appears in the 2009, 2010 and 2011 sample invoices.

[23] In terms of promotion, Mr. Mammone explains that the Opponent has advertised its services in association with the trade-mark U BOX IT using various means, including:

- Brochures bearing the trade-mark U·BOX·IT with sample invoices documenting house distribution in the Toronto area in 2009 [Exhibits 7, 8 and 16];
- Newspaper ads bearing the trade-mark U·BOX·IT in various local and regional publications since February 2009 [Exhibit 9];
- Print ads bearing the trade-mark U·BOX·IT in real estate and home improvement publications between 2010 and 2011 [Exhibits 10a, 10b and 10c];
- Booths decorated with containers bearing the trade-mark U·BOX·IT at industry and consumer trade shows including the International Home and Garden Show of 2008 and 2009, National Home Show of 2008, the Green Living Show of 2008 and Metro Home Show of January 2008 [Exhibits 11a, 11b, 11c];
- Invoices and a sample copy of directory advertising on the website Canpages.ca under the classifications "Rubbish & Garbage Removal", "Garbage Containers" and "Rubbish Removal" in 2009 and on the website YellowPage-Ontario.com in 2010 [Exhibit 13 and Schedule C of Mr. Mammone's Replies to Advisement No. 3];
- Television ads [Exhibit 15] for U BOX IT services broadcast in Ontario since 2007; and
- Sponsorships at music events, including the Beachfest Event held in Toronto, where containers bearing the trade-mark U·BOX·IT were displayed in 2007 and 2008 [Exhibits 16a and 16b].

[24] Mr. Mammone further states that the Opponent's approximate advertising expenditures for the services associated with the trade-mark U BOX IT vary between approximately $221,000 in 2005 and $70,000 in 2011, totalling more than $815,000 for the period between October 2005 and June 2011. In other words, the Opponent's advertising expenditures for its U BOX IT services were nearly six times as much as its sales figures for approximately the same period. While the Applicant characterizes these numbers as "highly suspect" in its written submissions, I note that the Applicant elected not to question the affiant in this regard during cross-examination despite its detailed examination of nearly all the sample advertisements attached as exhibits, as well as the Opponent's sales figures.

[25] Finally, Mr. Mammone states that the Opponent was the recipient of the International Design Excellence Bronze Medal Award in 2008 for its disposable container design bearing the trade-mark U BOX IT. The award was featured in Bloomberg BusinessWeek magazine in July 2008, available online as well as in print [Exhibit 17 to the Mammone affidavit].

[26] At the oral hearing, the Applicant submitted that the magazine circulation numbers, the television viewership numbers, as well as the number of times the radio commercials were broadcast, are inadmissible hearsay evidence. In particular, the Applicant argued that

Mr. Mammone admitted during cross-examination that he had no personal knowledge of the information nor did he review any business records in this regard. Rather, the information was provided by the publications, the television and radio stations, to an employee of the Opponent at the time of the placement of the ads. The information was in turn provided to Mr. Mammone for the purpose of this affidavit by the employee.

[27] Setting aside any potential hearsay issues, the affiant has nevertheless provided substantial evidence of promotion of the trade-mark U BOX IT in association with garbage removal and waste management services. This includes printouts of the Opponent's website, copies of brochures distributed to households in Ontario, photos and diagrams of its containers, uniforms, trucks and trailers, photos of its booth at the various trade shows and events, copies of its ads in newspapers, magazines and on television, as well as its annual advertising figures between 2005 and 2011.

[28] I therefore find that the Opponent's trade-mark U BOX IT has become known to at least some extent in Canada in association with garbage removal and waste management services.

Acquired Distinctiveness – U-BOX

[29] In his affidavit, Mr. Taylor states that the Applicant and its subsidiary corporations (the U-Haul Companies) have been providing the rental of trucks, trailers, towing equipment, and storage rooms to households and small businesses throughout the United States and Canada since 1945. Mr. Taylor further states that the U-Haul Companies are the undisputed leader in the truck-and-trailer rental industry, and that they are one of the industry's largest operators of self-storage facilities throughout the United States and Canada. Mr. Taylor also adds that the U-Haul Companies have never been involved in, have no plans to be involved in, and do not expect to be involved in the trash disposal business.

[30] According to Mr. Taylor, there are more than 16,000 U-Haul dealers and centers providing moving rental and storage services across the United States and Canada, with over 100,000 trucks and 100,000 trailers and towing equipment bearing various trade-marks, including "U-BOX", "U-BOX WE-HAUL", "U-HAUL U-BOX" and "U-HAUL U-BOX WE-HAUL" (the U-BOX Marks).

[31] In terms of use, Mr. Taylor states that the Applicant has licensed the U-BOX Marks to various U-Haul Companies, including U-Haul Co. (Canada) LTD. and U-Haul International dealers located in Canada. The affiant further states that the Applicant exercises direct or indirect control over the character or quality of all wares and services sold under the U-BOX Marks by various means, including the use of standardized operating procedures, the review of advertising and promotional materials displayed at U-Haul locations, as well as the approval of all general advertising and marketing materials. In these circumstances, I am prepared to accept that any use of the U-BOX Marks by the U-Haul Companies would enure to the benefit of the Applicant pursuant to section 50 of the Act.

[32] Mr. Taylor states that the Applicant began using the U-BOX Marks in association with moving and storage services in the form of rental, moving, storage, delivery and pick-up of portable storage units in Canada since at least as early as October 3, 2009. In this regard, Mr. Taylor states that between October 2009 and 2012, the U-Haul Companies had thousands of rentals of moving and storage pods bearing the U-BOX Marks across Canada, with sales growing almost 100% each year. Specifically, the annual sales figures for the applied for services performed in association with the U-BOX Marks went from $6,570 in the last 3 months of 2009 (representing 18 rentals), to $838,359 (representing 2,983 rentals) in 2012, totalling more than $1.5 million of sales (representing 4,153 rentals) in Canada.

[33] In terms of advertising, Mr. Taylor states that the moving and storage pods themselves bear the U-BOX Marks and serve as billboards for the Opponent’s applied for services. A photo of the pod bearing the U-BOX Marks (reproduced below) is attached as Exhibit B to the Taylor affidavit.

[34] According to Mr. Taylor, there are over 1,300 pods across Canada bearing the U-BOX Marks, found in people's driveways and at over 96 U-Haul locations throughout all 10 provinces. Photos of pods bearing the U-BOX Marks, similar to the one shown above, said to be posted by various U-Haul locations in Canada on the website *uhaul.com* are attached as Exhibit C to the Taylor affidavit. Mr. Taylor also provides as Exhibit D a list of more than 60 cities across Canada where the pods and the applied for services are said to be provided.

[35] In addition to the use of the U-BOX Marks on the pods, Mr. Taylor states that the applied for services have also been advertised in association with the U-BOX Marks in Canada via the *uhaul.com* website since at least 2009. Attached as Exhibits E and F to the Taylor affidavit are printouts from the website as it appeared from 2009 to 2013; the earlier versions were obtained via the Wayback Machine. According to Mr. Taylor, the *uhaul.com* homepage received between 1.2 million and 1.9 million visits from Canada annually between 2009 and 2012, while the specific pages devoted to the U-BOX Marks received between 22,000 and 82,000 visits from Canada annually between 2010 and 2012. Photos of the pod bearing the U-BOX Marks, as well as references to "U-HAUL", "U-BOX" and "U-BOX We-Haul" moving and storage services, can be seen on the printouts.

[36] According to the printouts, an empty pod can be delivered by the Applicant to the customer upon request or it can be picked-up by the customer at a U-Haul location using a special designed trailer. Once the pod is filled, the customer can either drop it off or call for pick-up, following which the Applicant will store it in a warehouse or deliver it to the requested location.

[37] Finally, attached as Exhibit G to the Taylor affidavit are sample ads that have appeared in the Yellow Pages in Canada in 2010 and 2011. The trade-marks "U-HAUL", "U-BOX", "U-BOX, WE-HAUL" and "U-BOX, WE-HAUL, ANYWHERE" can be seen in the ads, under the classification of "store", "storage" and "storage - self storage". Printed marketing materials for moving and storage services associated with the U-BOX Marks, said to have been distributed in Canada, are also attached as Exhibit H.

[38] In the end, while the Opponent's sales and advertising figures associated with the trade-mark U BOX IT in Ontario are not insignificant, the volume of transactions, the sales figures, as well as the availability and the performance of the Applicant's services in association with the U-BOX Marks across Canada, appear to be considerably more extensive.

[39] Accordingly, the overall consideration of the section 6(5)(a) factor favours the Applicant.

Section 6(5)(b) – the length of time the trade-marks have been in use

[40] As per my review of the Mammone affidavit, the Opponent has shown use of the trade-mark U BOX IT in association with garbage removal and waste management services since 2006. In comparison, the earliest evidence of use of the Mark in association with moving and storage services provided by the Applicant in the Taylor affidavit is October 2009.

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

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

[42] When considering sections 6(5)(c) and (d) of the Act, it is the statements of services as defined in the application for the Mark and in the Opponent's registration No. TMA708,544 that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. Those 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. In this regard, evidence of the actual trades of the parties is useful [see *McDonald's*

Corp v Coffee Hut Stores Ltd (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[43] Based on a review of the parties' statements of services, I see no similarity or overlap between the Opponent's garbage removal and waste management services and the Applicant's moving and storage services. One provides means for clients to get rid of unwanted materials while the other provides means for clients to keep their possessions for future use. As noted by the Applicant, the Opponent's directory advertisements are classified as "rubbish and garbage removal" and "garbage containers" [Exhibit 13 of the Mammone affidavit] while those of the Applicant are classified as "storage" [Exhibit G of the Taylor affidavit].

[44] However, based on the evidence put forth by both parties, there are similarities between the manners in which the parties' services are offered. In providing garbage removal services, the Opponent offers to drop-off a flat, ready-to-assemble, disposable container at a location chosen by the customer. Once filled, the Opponent picks up the container upon request, and disposes of the unwanted materials with the container at a waste processing facility, such as a landfill. In comparison, in providing storage and moving services, the Applicant offers to drop-off a pre-built wooden container at a location chosen by the customer. Once filled, the Applicant picks up the container upon request, puts it in a storage facility or ships it to another location for the customer. While the Opponent offers its services under an all-inclusive flat rate for delivery, pick-up and removal, the Applicant offers its services in the form of a rental agreement.

[45] At the oral hearing, the Opponent argued that the parties' services are closely related in that someone who is moving might also require garbage disposal services. There is no evidence to suggest that an average consumer of moving and storage services would necessary look for companies that offer specialised garbage disposal and waste management services, or vice versa. However, it is conceivable that consumers looking to move and/or to store their possessions might also be involved in clean-up or renovation projects that would require large volume garbage disposal services. Thus, both parties' services could be seen as complementary to an overlapping segment of their respective target markets.

[46] In view of the connection that exists between the parties' services and the fact that the Opponent's registration and the application for the Mark do not contain any restrictions, there is potential for overlap in the parties' channels of trade. However, such overlap appears to be unlikely as the evidence shows that the Applicant's services are only made available by contacting U-HAUL by phone, via the U-HAUL website or at the U-HAUL service locations.

[47] Accordingly, the section 6(5)(c) factor slightly favours the Opponent while the section 6(5)(d) factor does not particularly favour either party.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[48] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks.

[49] There is a high degree of resemblance visually and phonetically between the Opponent's trade-mark U BOX IT and the Applicant's trade-mark U-BOX given that the Mark is essentially an abridged version of the Opponent's trade-mark.

[50] There are also strong similarities in the ideas suggested as both trade-marks convey the idea of putting items into a container by "you", the customer, albeit for completely different reasons when viewed in association with the registered and applied for services. In this regard, according to *The Canadian Oxford Dictionary*, the letter "U" is defined, in part, as an informal reference to the pronoun "you".

[51] In the end, there is a high degree of resemblance in appearance, sound and in ideas suggested when the trade-marks are assessed in their entirety. The section 6(5)(e) factor therefore favours the Opponent.

Conclusion

[52] In the recent decision *Masterpiece*, the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion.

Specifically, the Court noted that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion analysis; the other factors become significant only once the marks are found to be identical or very similar.

[53] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having regard to all the surrounding circumstances including the high degree of resemblance between the parties' trade-marks, the longer period of time for which the Opponent's trade-mark has been in use, as well as the similarities in the execution of and the complementary nature of the parties' services, I am of the view that the average Canadian consumer, when faced with moving and storage services offered and performed under the trade-mark U-BOX, would likely think that they originate from the same source as the garbage removal and waste management services offered and performed under trade-mark U BOX IT, or vice versa. While I acknowledge that the Applicant's Mark has acquired distinctiveness to a larger extent than that of the Opponent's from 2009 to 2012, I am of the view that it is insufficient to shift the balance of probabilities in favour of the Applicant in the present case.

[54] Consequently, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its trade-mark U-BOX and the Opponent's trade-mark U BOX IT when used in association with their respective services.

[55] The ground of opposition based on section 12(1)(d) of the Act is therefore successful.

<u>Was the Applicant the person entitled to registration of the Mark?</u>

[56] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act, on the ground that it is confusing with the Opponent's trade-mark U BOX IT, which had been previously used in Canada in association with (i) garbage removal and waste management services since November 30, 2006, and (ii) "wares comprising containers, including storage containers" since at least as early as February 5, 2007.

[57] As a preliminary matter, I note that the in its statement of opposition, the Opponent alleges use of its trade-mark with "wares comprising containers, including storage containers", rather than with "storage services" *per se*. However, a review of the Mammone affidavit, along with the cross-examination transcript as well as the Opponent's submissions on this point during the oral hearing, makes it clear that these wares are provided as part of its alleged storage services. Moreover, upon review of the Applicant's written and oral submissions, it is also clear that the Applicant understood the section 16(1)(a) ground to include allegations of confusion with the use of the Opponent's trade-mark U BOX IT in association with storage services provided by the latter. Thus, it would appear that the Applicant is well aware of the case it has to meet. In these circumstances, I will address the non-entitlement ground in view of the Opponent's pleadings considered in conjunction with the evidence filed [see *AstraZeneca AB v Novopharm Ltd* (2001), 15 CPR (4th) 327 (FCA) for authority to consider a ground of opposition in view of the evidence filed].

[58] For the reasons that follow, I accept the non-entitlement ground of opposition and decide this issue in favour of the Opponent.

[59] The Opponent has the initial burden of proving that the alleged trade-mark was used in Canada prior to the material date, namely October 3, 2009, and had not been abandoned at the date of advertisement of the application for the Mark, namely July 7, 2010 [section 16(5) of the Act].

Garbage removal and waste management services

[60] With respect to the first prong of the non-entitlement ground, as per my review of the Mammone affidavit under section 12(1)(d) analysis, I am satisfied that the trade-mark U BOX IT has been used in association with garbage removal and waste management services in Canada prior to October 3, 2009, and that it had not been abandoned as of July 7, 2010.

Storage services

[61] With respect to the second prong of the non-entitlement ground, I shall review the Mammone affidavit regarding use of the trade-mark U BOX IT in association with storage services.

[62] As discussed above under the section 12(1)(d) analysis, Mr. Mammone states that the Opponent is a provider of "waste disposal and storage services to many companies and residents in the Greater Toronto Area (GTA)" and that the Opponent first used its trade-mark U BOX IT in association with "garbage removal, waste management and storage services, namely the delivery, storage and pick-up of containers" since at least as early as November 30, 2006.

[63] Furthermore, as per my earlier review, there is ample documentary evidence showing use of the Opponent's trade-mark in association with garbage removal and waste management services prior to the material date. However, the same cannot be said of allegations of use of the trade-mark in association with storage services prior to the material date.

[64] As noted by the Applicant in its written submissions, the Opponent has not offered any evidence that it has ever stored any of its single-use disposable containers for any of its customers. On the contrary, there is clear evidence that the Opponent's disposable containers are always picked up and taken to waste processing facilities for disposal. In this regard, the affiant confirmed that all containers are picked up from the Opponent's customers at some point as the containers can only stay on site for up to 6 months [Q155 and Mr. Mammone's Replies to Advisement No. 6].

[65] Similarly, there is no evidence that the Opponent has ever conducted any transactions in relation to its disposable containers separate from its garbage removal and waste management services. Instead, there is clear evidence that the Opponent's services were always offered at a fixed priced of $129.00, which covers the delivery, pick-up and disposal of the container. This is consistent with the general sales figures offered by Mr. Mammone where no breakdown of the sales figures pertaining to the Opponent's alleged storage services was provided.

[66] Moreover, exhibits showing use and promotion of the trade-mark prior to the material date in the Mammone affidavit center around the Opponent's garbage disposal services, including:

- Slogans such as "Junk… made easy" or "Junk removal" appear prominently in the Opponent's print ads, in its brochures, and on its trailers [Exhibits 4, 7, 9];
- The words "Junk Removal Bin" can be seen right underneath the trade-mark on the disposable containers [Exhibit 4];
- Quotes from the Opponent's brochure include "U-Box-It is a disposable, single use junk removal bin you purchase to load up your garbage and call to arrange pickup for disposal", "Use it for: builders waste, renovation waste, garden waste, unwanted clutter from garage, attic or basement", "Great for: renovations, spring cleaning, yard waste, moving & more…", "1-877-7-U-BOX-IT will not be responsible for any secondary use of this container" and "$129 + taxes includes delivery / pick-up / disposal" [Exhibit 7];
- TV commercial said to have been shown in 2007 and 2008 referring to the Opponent's services as "the world's first disposable junk removal bin", "the easy, affordable way to clean up junk", and "one low fixed price includes delivery, pick-up and delivery", showing a person putting a full garbage bag into the container. Another video shows filled containers sliding off the back of the Opponent's truck and dumped into a landfill, exposing the content of the containers, with the words "the new age of waste management" appearing at the end of the commercial [Exhibit15];
- Excerpts from an article dated July 17, 2008 from Bloomberg BusinessWeek Magazine [Exhibit 17] profiling the Opponent's International Design Excellence Bronze Medal Award for the design of a disposable bin entitled "U-Box-it. They Collect and Recycle it", with the heading "Keeping The Focus On Trash", and the following paragraph:

  > But already, [Mr. Mammone]'s seen the product evolved to being a more reusable product for large-scale shipping and storage as well as residential moves. "We've had a lot of requests from people who want to know if we handle moves," Mammone says. For the time being, however, the company is focusing on trash. "We've been in the waste management business for more than 35 years" he concludes. "That's where we've staying for now."

- Excerpt from the Opponent's press release [Exhibit 18] reporting the award stating "U-BOX-IT, a revolutionary new concept in junk removal, was designed specifically for the 'Do-It-Yourself' home renovation and clean up. Both lightweight and compact, the U-BOX-IT container was developed to eliminate the large bulky metal containers which take up space".

[67] This is not to say that Mr. Mammone's affidavit does not support any evidence of use of the trade-mark U BOX IT in association with storage services, but any evidence of use with these services would be after the material date. In this regard, the following exhibits corroborate Mr. Mammone's assertions with respect to the advertising of the Opponent's trade-mark with storage services post October 3, 2009:

- Printouts of the Opponent's website located at *www.uboxit.com* with the heading "Junk & Storage Made Easy!", along with distinct webpages on "Disposal" and "Storage" related services. Even though the printouts are undated, the notation "©2011 U-BOX-IT" appears at the bottom each page, along with an excerpt of a press release dated June 26, 2011 [Exhibit 1]; and
- Copy of an advertisement that ran in Holmes Magazine in June/July 2011 with the following message "Great for: renovations, spring cleaning, yard waste, moving, storage and more..." [Exhibit 10b].

[68] During the cross-examination, Mr. Mammone pointed to the use of the words "and more" in the Opponent's ads and on the disposable containers as evidence that the U BOX IT container is also designed for storage services [Q61 of the Mammone cross-examination]. Mr. Mammone further states that nothing prevents a customer from using the disposable container for storage rather than a garbage bin [Q94 of the Mammone cross-examination].

[69] I disagree. Firstly, I am not prepared to infer that the Opponent offered storage services on the basis of the cryptic reference to "and more" or the use of an ellipsis "…" in its advertising materials or on its disposable containers, nor did the Opponent offer any evidence suggesting that the average consumer of its services perceived these references to mean storage services. Secondly, I note that Mr. Mammone failed to provide any information in support of his bald statement regarding the use of the Opponent's disposable container as a storage container by its customers. In any case, whether a consumer finds alternate use for the Opponent's container provided in the context of its garbage removal and waste management services is irrelevant in the present proceeding. Thirdly, ads pertaining to the act of placing junk into the Opponent's container in view of removal and disposal do not support assertions of use of the trade-mark with storage services, but rather with garbage removal and waste management services.

[70] As part of Mr. Mammone's cross-examination, the Opponent filed a photo of its truck said to be taken on December 19, 2007 showing the word "storage" on one of the five containers depicted on the graphics set out on the side of the truck [Schedule D of Mr. Mammone's Replies to Advisement No. 5]. I note that this reference to storage is made in the context of an overall ad for "Junk Removal", with the remaining containers identified as "Office Junk", "Reno Junk", "Yard Waste" and "Seasonal Clean Up". Further, Mr. Mammone explains that the containers allow the customers to store items until removal time [Q178 of the Mammone cross-

examination]. I am therefore not prepared to accept this photo as evidence of use of the trade-mark in association with storage services, but rather with garbage removal and waste management services.

[71] In the end, the evidence overwhelmingly points to the promotion and use of the trade-mark U BOX IT exclusively in association with garbage removal and waste management services by the Opponent prior to the material date. When the Opponent's evidence is viewed in its entirety together with the complete record of Mr. Mammone's cross-examination, I am unable to find support for the affiant's statements of use of the trade-mark U BOX IT in association with storage services prior to October 3, 2009.

[72] As the Opponent has satisfied its initial burden with respect to the use of the trade-mark U BOX IT used in association with garbage removal and waste management services, the Applicant must therefore establish, on a balance of probabilities, that as of the date of first use of the Applicant's services, namely, October 3, 2009, there was not a reasonable likelihood of confusion between the Mark and the Opponent's trade-mark U BOX IT used in association with garbage removal and waste management services.

<u>The test for confusion</u>

[73] Assessing each of the section 6(5) factors as of October 3, 2009 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case; the main difference being the absence of acquired distinctiveness of the Applicant's Mark as of the relevant material date.

[74] As in the case of the non-registrability ground, I conclude that the Applicant has not discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its trade-mark U-BOX and the Opponent's trade-mark U BOX IT used in association with garbage disposal and waste management services.

[75] The ground of opposition based on section 16(1)(a) of the Act is therefore successful.

Was the Mark distinctive of the Applicant's services?

[76] The Opponent has pleaded that the Mark does not actually distinguish the Applicant's services from those of the wares and services of the Opponent, in view of the provisions of section 2 of the Act.

[77] The material date to assess the ground of opposition is the filing date of the statement of opposition, namely August 31, 2010 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. For the reasons that follow, I accept the ground of opposition and decide this issue in favour of the Opponent.

[78] As per my previous review of the Mammone affidavit, I am satisfied that the Opponent has met its evidential burden to show that its trade-mark U BOX IT had a sufficient reputation in Canada in association with garbage removal and waste management services so as to negate the distinctiveness of the Mark as of August 31, 2010 [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 (CanLII), 2006 FC 657 (CanLII), (2006), 48 CPR (4th) 427 (FC)].

[79] However, for reasons similar to those expressed under the previous ground of opposition, I conclude that the Opponent has not discharged its burden to show that the trade-mark U BOX IT had become sufficiently known in Canada in association with storage services, as of August 31, 2010, so as to negate the distinctiveness of the Mark. In this regard, given that the bulk of Mr. Mammone's advertising and sales figures deal with garbage removal and waste management services, with no breakdown for storage services, I am unable to determine the extent to which the Opponent's trade-mark would had become known in association with storage services in Canada, as of August 31, 2010.

[80] Accordingly, 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 trade-mark U BOX IT in association with garbage removal and waste management services as of August 31, 2010.

[81] I conclude that assessing each of the section 6(5) factors as of August 31, 2010 does not impact my analysis of the surrounding circumstances of this case under the non-entitlement ground of opposition. Accordingly, I am not satisfied that the Applicant has discharged its legal onus of establishing that there was no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark U BOX IT in association with garbage removal and waste management services as of August 31, 2010.

[82] The non-distinctiveness ground of opposition is therefore successful.

Disposition

[83] 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.

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