



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

Citation: 2016 TMOB 63
Date of Decision: 2016-04-19

IN THE MATTER OF AN OPPOSITION

2435-8228 Québec Inc.

Opponent

and

Jetsetter, Inc.

Applicant

1,556,542 for JETSETTER

Application

I. Background

[1] On December 15, 2011, Gilt Travel, Inc. (a predecessor-in-title to the Applicant) filed an application to register the trade-mark JETSETTER (the Mark). The application is based upon use and registration of the Mark in the United States, as well as use of the Mark in Canada since at least as early as September 30, 2009. It covers services which are described as: “travel agency services namely arranging of tours and cruises; arranging travel tours; reservation and booking seats for travel; travel and tour ticket reservation services; travel, excursion and cruise arrangement”.

[2] The Opponent is the owner of the registered trade-mark JET-SETTER DESIGN (shown below), which is the subject of Canadian trade-mark registration No. TMA346,142. The Opponent’s registration covers “services relating to the operation of a retail store specializing in travel accessories and innovative personal gadgets for travel and lifestyle” and it is based upon use of the trade-mark in Canada since September 9, 1986.



[3] The Opponent is also the owner of a pending application for the trade-mark JET-SETTER, which was filed under application No. 1,615,914 on February 27, 2013 and which covers a variety of retail store and on-line retail store services relating to the sale of apparel, travel and lifestyle related goods. The application claims various dates of first use.

[4] In addition, the Opponent is the owner of the trade-name JET-SETTER, which it states to have been using in association with the operation of a retail store specializing in the sale of accessories and gadgets for travel and lifestyle since at least as early as September 1986.

[5] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* on January 30, 2013 and on June 17, 2013, the Opponent filed a statement of opposition against it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[6] The grounds of opposition are: (i) the application does not conform to the requirements of sections 30(b) and 30(i) of the Act; (ii) the Mark is not registrable under section 12(1)(d) of the Act, as it is confusing with the Opponent's registered trade-mark JET-SETTER DESIGN, which is the subject of registration No. TMA346,142 iii) the Applicant is not the person entitled to registration of the Mark under sections 16(1)(a), 16(1)(c), 16(2)(a) and 16(2)(c) of the Act in view of the Opponent's prior use of its JET-SETTER trade-marks and trade-name in Canada; and (iv) the Mark is not distinctive within the meaning of section 2 of the Act.

[7] A counter statement denying all of the allegations set out in the statement of opposition was filed by the Applicant on August 30, 2013.

[8] As evidence in support of its opposition, the Opponent filed the affidavit of Charles Breger, affirmed December 18, 2013 (the first Breger affidavit). Mr. Breger was not cross-examined. Notably, it was brought to my attention prior to the hearing that this evidence had

been lost. A replacement copy was subsequently served and filed and has been made of record. I wish to note that my decision is being rendered based upon the replacement copy.

[9] In support of its application, the Applicant filed the affidavit of David Krauter, sworn April 16, 2014 (the Krauter affidavit), the affidavit of Mary P. Noonan, sworn April 22, 2014 (the Noonan affidavit) and the affidavit of Amanda J. MacNaughton, sworn April 22, 2014 (the MacNaughton affidavit). The affiants were not cross-examined.

[10] As evidence in reply, the Opponent filed the affidavit of Charles Breger, affirmed May 14, 2014 (the second Breger affidavit). Mr. Breger was not cross-examined.

[11] Both parties filed written arguments and attended a hearing.

II. Onus

[12] 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

III. Analysis

Grounds of Opposition Summarily Dismissed

Non-conformity - Section 30(i)

[13] Where an applicant has provided the statement required by section 30(i), a ground of opposition based upon this section should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and the Opponent has not filed any evidence to demonstrate that this is an exceptional case. Accordingly, the ground of opposition based upon section 30(i) is dismissed.

Non-conformity – Section 30(b)

[14] The Opponent has pleaded that the application for the Mark does not conform to the requirements of section 30(b) of the Act because the Applicant “could not and cannot properly claim that use of the Trade-Mark in Canada commenced since at least as early as September 30, 2009 in association with the services described in the Applicant’s application”. The Opponent has not filed any evidence to support this ground of opposition and its written argument is silent on this issue. Accordingly, this ground of opposition is also dismissed.

Remaining Grounds of Opposition

Section 12(1)(d)

[15] The Opponent has pleaded that the Mark is not registrable because it is confusing with its registered trade-mark JET-SETTER DESIGN, which is the subject of registration No. TMA346,142 (reproduced below).



[16] The material date to assess the section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]. I have exercised my discretion and checked the register to confirm that the Opponent’s registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial burden with respect to this ground.

[17] As the Opponent’s evidential burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trade-mark.

[18] 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 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.

[19] 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 enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

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

[20] The words JETSETTER and JET-SETTER in the parties' marks are phonetic derivatives of the word JET SET, which is used to refer to individuals who are frequent travelers or enjoy a "jet set" lifestyle [*Canadian Oxford Dictionary*, (2 ed.)]. Both of the parties' trade-marks are therefore highly suggestive within the context of their associated services. Consequently, neither possesses a particularly high degree of inherent distinctiveness. The Opponent's trade-mark is arguably more inherently distinctive due to the fact that it also contains a design component. However, in view of the fact that the design component predominately consists of a winged horse, which may be perceived to reinforce the idea of flight and travel, I do not consider the Opponent's trade-mark to be significantly more inherently distinctive than the Mark.

[21] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use and in this case, both parties have submitted evidence relating to the promotion and use of their marks.

[22] According to the first Breger affidavit, the Opponent opened its first retail store specializing in the sale of travel accessories and gadgets in Montreal in September 1986 and it has operated its business continuously since that time [para 2]. Mr. Breger does not indicate whether the Montreal location is the sole store or whether there are additional locations.

[23] Mr. Breger states that the Opponent has displayed the trade-name JET-SETTER, its trade-mark JET-SETTER and its registered trade-mark JET-SETTER DESIGN on its business cards, stationery letterhead and plastic bags since September 1986 and continuously to date [para 9]. Copies of such business cards used in 1997, circa 2000 and since 2000, as well as the stationery letterhead and plastic bags used since as early as 1995 and continuously to date are attached as Exhibit O-5. Contrary to what Mr. Breger has stated, only the domain name *www.jet-setter.ca* and the registered trade-mark JET-SETTER DESIGN appear on these materials.

[24] In paragraph 10, Mr. Breger states that to promote its business, the Opponent has distributed promotional flyers to its customers and to consumers generally. Attached as Exhibit O-6 are copies of these flyers, which were distributed in 2000 and 2001. The flyers display the trade-mark and trade-name JET-SETTER, as well as the Opponent's registered trade-mark JET-SETTER DESIGN. Mr. Breger has not indicated whether similar flyers were distributed during any other years. In addition, no information has been provided regarding where or how many such flyers have been distributed.

[25] Mr. Breger states that the Opponent also distributes promotional discount coupons to its customers in order to promote its business. Copies of such coupons for the years 2004-2006 and 2008-2012 are attached as Exhibit O-7. The trade-mark and trade-name JET-SETTER and the Opponent's registered trade-mark JET-SETTER DESIGN appear on the coupons, along with its domain name *www.jet-setter.ca*. Mr. Breger has not provided any information with respect to how many discount coupons were distributed or redeemed during those years, nor has he indicated the geographic region(s) in which they were distributed.

[26] According to Mr. Breger, the Opponent also advertises its business in newspapers and has done so periodically since 1986. Attached as Exhibit O-8 to his affidavit are representative advertisements published in various newspapers in 1986, 1995 and 1996. No circulation information has been provided for these publications and Mr. Breger has not provided any

further details with respect to the extent to which the Opponent has advertised in other newspapers during any other years.

[27] In paragraph 13, Mr. Breger states that the Opponent has also promoted its business on its website continuously since 2005. Copies of various pages from the website are attached as Exhibit O-9. No information is provided with respect to how many Canadians have accessed the website.

[28] Based upon the information and materials provided by Mr. Breger, I find it reasonable to conclude that the Opponent's registered JET-SETTER DESIGN trade-mark has likely become known to at least some extent in Canada. However, due to the lack of detail in Mr. Breger's affidavit regarding the extent of the Opponent's business operations (for example, how many customers it serves on average on an annual basis, etc) and advertising (for example, how widely and in what volume it distributes its promotional discount coupons or other advertising materials) and in the absence of any advertising figures or sales figures, I am unable to conclude that the Opponent's registered trade-mark (or its unregistered JET-SETTER trade-mark and trade-name, for that matter) has become known to any significant extent.

[29] By contrast, the Krauter affidavit establishes that the Mark has become known to a reasonable extent in Canada. I will highlight some of the contents of the Krauter affidavit below:

- The Applicant operates a members-only travel service that enables travelers to purchase at a discounted rate, vacations, cruises, adventures and accommodations from "travel partners" which have been pre-screened and hand-selected by the Applicant [para 4].
- Launched in September 2009 the Applicant's website allows members to book travel packages online [para 5]. The Opponent's website and travel agency and reservation services can also be accessed through various apps which are compatible with mobile devices [para 6]. Attached as Exhibit 1 is a copy of a September 2009 press release announcing the launch of the Applicant and its website. Attached as Exhibit 7 are archived copies of representative pages from the Applicant's website showing the Mark.

- At the present time, the Applicant has millions of members worldwide, including over 300,000 Canadian members located across the country [para 10].
- Since September 30, 2009, revenue generated from Canadian bookings related to the Applicant's services in association with the Mark has exceeded \$8 million [para 24].
- Over the years, tens of thousands of dollars have been spent by the Applicant on various advertising, marketing and promotional efforts relating to the Mark and the Applicant's services in Canada [paras 26 and 27]. Some of these expenses relate to online and digital advertising and marketing such as Canada-specific search engine marketing advertisements (SEM's). Attached as Exhibit 8 is a printout from Google.ca showing such an SEM advertisement at the top of the list of search results.
- The Applicant's services are also frequently advertised, promoted, featured or mentioned in association with the Mark in web-based publications which are circulated or made available to Canadians [para 28]. Representative print-outs or pages from some of these publications are attached as Exhibit 9. Some of them include: *Vancouver Sun*; *Calgary Herald*; *The Globe and Mail*; *The Vancouver Province*; *Toronto Star*; and *Edmonton Journal*.
- Examples of other online and print-based advertising and promotional materials featuring the Mark and distributed by the Applicant in recent years are attached as Exhibits 10-12. They include press releases, blog posts and an on-line magazine. The Applicant also prominently displays the Mark on its website, on its Facebook website on Twitter and on Pinterest [para 30; Exhibits 13 to 15]. The number of Canadian visits to the Applicant's website increased from 360,000 in 2011 to 1,600,000 in 2013 and the Applicant has received over 250,000 "likes" from Facebook users worldwide.

[30] Based on the foregoing, I am able to conclude that the Mark has become known in Canada to a reasonable extent.

Section 6(5)(b) – the length of time each has been in use

[31] The Opponent has been using its trade-mark since September 9, 1986 and the Applicant first commenced use of the Mark in September 2009. While this factor does favour the Opponent, in view of the lack of evidence pertaining to the extent of the Opponent’s use, I do not find that it does so significantly.

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

[32] When considering sections 6(5)(c) and (d) of the Act, it is the statement of services in the application for the Mark and the statement of services in the Opponent’s registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*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. 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); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[33] The statement of services in the Opponent’s registration covers “services relating to the operation of a retail store specializing in travel accessories and innovative personal gadgets for travel and lifestyle”. By contrast, the application for the Mark covers “travel agency services namely arranging of tours and cruises; arranging travel tours; reservation and booking seats for travel; travel and tour ticket reservation services; travel, excursion and cruise arrangement”.

[34] At the hearing, the Opponent focused a fair bit of attention on the fact that both of the parties’ services target travelers and that they target them at the same point in time (i.e. prior to the start of travel). While that may well be the case, that is the only relationship between the parties’ services. Otherwise, they differ entirely, as the Opponent is operating a retail store which sells goods and the Applicant essentially offers travel agency services. Thus, despite the fact that both parties’ services would primarily be of interest to individuals who travel, the nature of the

parties' businesses is entirely different, as are their channels of trade. Unlike in the *Transat* decision relied upon by the Opponent at the hearing, where there was evidence of a connection between the applicant's goods (luggage, travelling bags, etc) and the opponent's travel agency services due to the fact that the opponent's franchisees gave away travel bags as promotional items, there is no evidence of any such connection in the present case [*Transat A.T. Inc v Luggage America, Inc*, 2010 TMOB 15 (CanLII)].

Section 6(5)(e) – the degree of resemblance between the trade-marks

[35] There is a high degree of resemblance between the parties' trade-marks, as they are identical in sound, similar in appearance in that they both contain JET SETTER (without a space in the case of the Mark and hyphenated in the case of the Opponent's trade-mark) and they suggest the same idea (i.e. travel). While the Opponent's trade-mark also features a prominent design component that is not present in the Mark, resulting in an additional difference, overall, I still consider there to be a high degree of resemblance between the parties' marks.

Surrounding Circumstances

State of the Register/State of the Marketplace

[36] The Applicant has filed state of the register and state of the marketplace evidence by way of the Noonan and MacNaughton affidavits. It has been held that state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Ms. Noonan's search identified only 5 trade-marks (including those of the parties) with JET SET or a similar term as a component [para 3; Exhibit 1]. This is not a sufficient number to enable me to conclude that such terms have been commonly adopted or used in the marketplace.

[37] While Ms. MacNaughton visited a number of websites and managed to locate references to 3 of the 5 trade-marks that were located in Ms. Noonan's search, as well as references to a few

others incorporating the term JET SET or a similar term [para 2; Exhibits 1 to 6], I do not find her evidence to be of much assistance to the Applicant either. In this regard, I note that Ms. MacNaughton located only a small number of references, not all of the websites she visited appear to be Canadian and not all of them reference goods which are related to the services of the parties. Moreover, the mere existence of the marks on these websites does not enable me to draw any meaningful conclusions regarding the extent to which they have become known in Canada.

[38] In view of the foregoing, I do not consider the state of the register and state of the marketplace evidence to be a significant surrounding circumstance in this case.

Absence of Actual Confusion

[39] As an additional surrounding circumstance, the Applicant relies on the fact that the parties have co-existed in the marketplace without any resulting confusion. In support of this assertion, the Applicant relies on statements made in the Krauter affidavit [paras 33-35].

[40] An absence of evidence of actual confusion over a period of time may entitle the Registrar to draw a negative inference about the likelihood of confusion [see *Mattel* 348 N.R. 340, *supra* at p 347]. Nevertheless, the Opponent is under no obligation to submit evidence of instances of actual confusion. Moreover, the absence of such evidence does not necessarily raise any presumptions unfavourable to the Opponent as the burden is on the Applicant to demonstrate the absence of likelihood of confusion. In the present case, there has been approximately a six year period of co-existence. However, the evidence suggests that the Opponent's business is geographically limited to one store in Montreal and while the Applicant has established more reputation in respect of its Mark, it is unclear from the evidence how much of that reputation it has acquired in the province of Quebec or in Montreal in particular. In view of this, I am not prepared to consider the absence of evidence of any instances of actual confusion to be a significant surrounding circumstance in this case.

Applicant's Alleged Admission of Likelihood of Confusion

[41] In response to Mr. Krauter's affidavit and his assertions regarding the lack of any instances of actual confusion, the Opponent filed a second affidavit from Mr. Breger. Attached

as Exhibit O-10 to the second Breger affidavit is a copy of an email received by the Opponent on or about April 14, 2014 from its domain name registrar. The email is allegedly from an entity by the name of CitizenHawk, Inc., an alleged authorized agent of the Applicant. The email contains allegations to the effect that by registering “a confusingly similar domain name”, the Opponent is infringing TripAdvisor’s rights because it creates a likelihood of confusion among the public, who will believe that the Applicant’s goods or services are affiliated with or endorsed by TripAdvisor, when in fact, they are not. According to the email, the Applicant’s predecessor-in-title is a subsidiary of TripAdvisor LLC. I note that the email in question appears to make reference to U.S. trademark registrations and not rights in Canada. In addition, this evidence clearly constitutes hearsay. For these reasons, I am not prepared to give this evidence any weight.

Conclusion on the Likelihood of Confusion

[42] I acknowledge that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties’ trade-marks. If the marks do not resemble one another, it is unlikely that even a strong finding on the remaining factors set out in section 6(5) of the Act would lead to a likelihood of confusion [*Masterpiece, supra* at para 49].

[43] I also acknowledge that there is a high degree of resemblance between the parties’ trade-marks in this case. However, despite the degree of resemblance between the parties’ trade-marks, I am of the view that the Applicant has succeeded in establishing, on a balance of probabilities, that confusion between the parties’ trade-marks is unlikely.

[44] In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 2005 FC 1550 (CanLII), 46 CPR (4th) 112 at para 31 (FCTD), de Montigny J. stated the following:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used
...

[45] In the present case, we are also dealing with inherently weak trade-marks. It is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through

extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD)]. However, while the evidence in this case may establish that the Opponent has used its trade-mark for a lengthy period of time, it does not, by any means, establish that such use has been extensive. I am not prepared to infer that the Opponent has acquired any significant reputation in its trade-mark based solely upon the length of time it has been stated to be in use.

[46] Having considered all of the surrounding circumstances, despite the high degree of resemblance between the parties' trade-marks, the Opponent's lengthy period of use, and the fact that the services associated with the parties' marks both happen to relate to travel generally, I find that the differences in the precise nature of the parties' services, businesses and trade, coupled with the differences in the marks are sufficient to avoid any reasonable likelihood of confusion, particularly because the parties' trade-marks are inherently weak and only the Applicant has managed to establish any significant reputation in its mark.

[47] In view of the foregoing, I therefore find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the parties' trade-marks is unlikely.

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

Sections 16(1)(a), 16(1)(c), 16 (2)(a) and 16(2)(c)

[49] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under sections 16(1)(a), 16(1)(c), 16(2)(a) and 16(2)(c) of the Act in view of the Opponent's prior use of its trade-marks JET-SETTER and JET-SETTER DESIGN and its trade-name JET-SETTER.

[50] In order to meet its evidential burden under its section 16(1)(a) and 16(1)(c) grounds of opposition, the Opponent must show that it had used either of its trade-marks (16(1)(a)) or its trade-name (16(1)(c)) in Canada prior to Applicant's claimed date of first use and that it had not abandoned them as of the date of advertisement of the application for the Mark [section 16(5) of the Act]. With respect to the section 16(2)(a) and 16(2)(c) grounds of opposition, the Opponent must show that it had used either of its trade-marks (16(2)(a)) or trade-name (16(2)(c)) in Canada

prior to the filing date of the application for the Mark and that it had not abandoned them as of the date of advertisement of the application for the Mark [section 16(5) of the Act].

[51] To the extent that the Opponent has met its burden in respect of any of these grounds of opposition and is able to rely on its use of JET-SETTER as a trade-mark and/or trade-name, its case is arguably stronger under these grounds of opposition than it was under its section 12(1)(d) ground of opposition. This is primarily because there is an even higher degree of resemblance between the Mark and JET-SETTER (they are almost identical). However, even if I were to take this into account, along with the impact on the evidence of the earlier material dates associated with these grounds (i.e. less or no reputation in the Mark), it would not significantly impact the outcome of my confusion analysis under section 12(1)(d) above.

[52] Accordingly, for reasons similar to those set out in my analysis under section 12(1)(d) above, these grounds of opposition are also unsuccessful.

Section 2

[53] The Opponent has pleaded that the Mark is not distinctive in that it does not distinguish and is not adapted to distinguish the services in association with which it is used from those of others, including those of the Opponent.

[54] In order to meet its burden in respect of this ground of opposition, the Opponent's evidence must show that one or more of its trade-marks or trade-name had become known sufficiently as of the commencement of the opposition to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 (CanLII) at paras 33-34]. When an opponent's reputation is restricted to a specific area of Canada, the opponent's evidential burden may be satisfied if its trade-mark is well known in a specific area [*Bojangles, supra*; *CEG License Inc v Joey Tomato's (Canada) Inc.* (2011), 97 CPR (4th) 436 (TMOB) aff'd (2012), 110 CPR (4th) 398 (TMOB)].

[55] As previously discussed, the extent to which the Opponent has acquired reputation in Canada is unclear in this case and based upon the evidence before me, I am unable to conclude that the Opponent's trade-marks or trade-name have become well known in the specific area in

which the Opponent operates (Montreal). The Opponent has therefore failed to meet its initial evidential burden in respect of this ground of opposition.

[56] Accordingly, this ground of opposition is also unsuccessful.

IV. Disposition

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

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-12-01

Appearances

Mark Hanna

For the Opponent

Kevin Sartorio

For the Applicant

Agents of Record

Hanna Glasz & Sher

For the Opponent

Gowling Lafleur Henderson LLP

For the Applicant