

TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 117
Date of Decision: 2011-07-06

**IN THE MATTER OF AN OPPOSITION by
Nautilus Plus Inc. and 88766 Canada Inc. to
application No. 1,297,231 for the trade-mark
STOP TOBACCO in the name of Centres Stop
Inc.**

Proceedings

[1] On April 10, 2006, Centres Stop Inc. (the Applicant) filed an application bearing number No. 1,297,231 to register the trade-mark STOP TOBACCO (the Mark) in association with

(1) Naturopathic support products namely homeopathic drops, gel caps and pills for the cessation of smoking. (2) Educational publications, namely books, printed articles, pamphlets and workbooks and worksheets relating to smoking cessation (the Wares).

(1) Health services namely auricular therapy for smoking addictions. (2) Counselling, support and rehabilitation services for smoking addictions. (3) Educational services namely designing and providing educational programs, materials and information relating to smoking cessation and providing educational seminars by Internet with respect to smoking cessation (the Services).

[2] This application is made on the basis of use of the Mark in Canada since August 2004 in association with the Wares (1); since June 2000 in association with the Wares (2) and the Services (1) and (2); and since January 2005 in association with the Services (3).

[3] On April 4, 2007, the application was advertised for opposition purposes in the *Trade-marks Journal*. Nautilus Plus Inc. (Nautilus) and 88766 Canada Inc. (the Opponent) filed a joint

statement of opposition on June 4, 2007, which the Registrar forwarded to the Applicant on June 19, 2007. On October 19, 2007, the Applicant filed a counter statement denying all of the grounds of opposition described below. Nautilus and the Opponent amended their statement of opposition, and the Applicant amended its counter statement of opposition accordingly.

[4] As Rule 41 evidence, Nautilus and the Opponent filed certificates of authenticity concerning the registered trade-marks listed in their statement of opposition. As Rule 42 evidence, the Applicant filed Stephen Wallack's affidavit, dated December 8, 2008.

[5] Each of the parties filed written arguments. The Applicant and the Opponent were represented at a hearing. Three days before the hearing date, the Registrar was informed that Nautilus was withdrawing its opposition. Therefore, only the Opponent's opposition remains to be decided.

Grounds of opposition

[6] The various grounds of opposition raised by the Opponent in its amended statement of opposition dated July 18, 2008, may be summarized as follows:

- (1) On the filing date of the application, the Applicant was not using the Mark on the various dates of first use alleged in the registration application or each date of first use claimed is incorrect, contrary to s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (Act);
- (2) The trade-mark of which use is alleged is not the Mark, but another, different trade-mark;
- (3) The alleged use of the Mark in association with the Wares and Services is intermittent, in whole or in part;
- (4) Given the Applicant's knowledge of the rights of third parties or opponents and the illegality of any use, the Applicant falsely stated being satisfied that it was entitled to use the Mark in Canada (s. 30(i) of the Act);
- (5) The application does not contain a statement in ordinary commercial terms of the Wares or Services (s. 30(a) of the Act);
- (6) The Mark is not registrable under s. 12(1)(d) of the Act, as it is confusing with the following registered trade-marks:

CARE-FREE SNORE STOPPER, registration No. TMA656,081, for an oral device, namely an apparatus designed and fitted for individuals to eliminate snoring;

HEMOR-STOP, registration No. TMA256,558, for suppositories to treat hemorrhoids;
BLOOD STOP, registration No. TMA666,933, for dressings, bandages and bands for medical use;
SNORE STOP, registration No. TMA492,013, for homeopathic preparations to prevent snoring;
STOP'N GROW and design, registration No. TMA162,143 for “nail biting deterrent preparations”;
TABASTOP, registration No. TMA383,956, for tablets to stop smoking.

- (7) The Mark is not, and cannot be, distinctive of the Wares and Services because it does not distinguish the Applicant's Wares and Services from the wares and services of others, considering the presence on the market and in the register of STOP-type trade-marks for wares and services of the same nature as those stated in this application for registration;
- (8) The Mark is not, and cannot be, distinctive of the Wares and Services because the Applicant allowed third parties to use the Mark outside the scope of the legislative provisions governing licensed use, contrary to s. 50 of the Act;
- (9) The Mark is not, and cannot be, distinctive of the Wares and Services because, as a result of its transfer, there subsisted rights in two or more persons to the use of the Mark, and those rights were exercised concurrently by those persons, contrary to s. 48(2) of the Act.

Burden of proof when opposing the registration of a trade-mark

[7] In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence relating to the grounds of opposition raised to show clearly that there are facts supporting those grounds. If the opponent meets this requirement, the applicant must satisfy the registrar, on a balance of probabilities, that the grounds of opposition should not prevent registration of the mark [see *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.) and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.)].

Grounds of opposition summarily decided

[8] The Opponent failed to submit any evidence proving the allegations made in the grounds of opposition 3, 5, 8 and 9, described above. In the circumstances, I dismiss them because the Opponent has failed to meet its initial burden of proof.

[9] Regarding the fourth ground of opposition, s. 30(i) of the Act does not require the Applicant to state being satisfied that it is entitled to register the Mark. This statement appears in the application for registration. Section 30(i) of the Act could be argued, among other cases, where it is alleged that the Applicant's statement was made in bad faith [see *Sapodilla Co. Ltd. v. Bristol Myers Co.* (1974) 15 C.P.R. (2d) 152 (T.M.O.B.)]. This has neither been alleged nor proven. The fourth ground of opposition is therefore also dismissed.

[10] Regarding the seventh ground of opposition, there is no evidence of use of the trade-marks appearing in the Register referenced by the Opponent in the sixth ground of opposition and on which the Opponent is relying. The Opponent must demonstrate that one of the marks referenced in support of the allegation that the Mark cannot be distinctive was sufficiently known at the date the statement of opposition was filed [see *Bojangles' International, LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)]. The filing of the registration certificate for each of the marks referenced is not sufficient to meet this initial burden of proof [see *Classical Remedia Ltd. v. 1404568 Ontario Ltd.* (2010), 81 C.P.R. (4th) 317 (T.M.O.B.)]. For these reasons, the seventh ground of opposition is also dismissed.

Registrability of the Mark under s. 12(1)(d) of the Act

[11] In its sixth ground of opposition, the Opponent alleges that the Mark is confusing with the registered trade-marks listed above. The Opponent has met its initial burden of proof by filing a certificate of authenticity for each of those marks. However, I did exercise my discretion to check the register [see *Quaker Oats Co. of Can. v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)], and all are in good standing except for registration TMA256,558, which has since been expunged. That registration therefore cannot be taken into account in support of this ground of opposition.

[12] The Applicant must therefore show that there is no risk of confusion between the Mark and any of the marks referenced by the Opponent. The applicable test in this case is described at s. 6(2) of the Act. Thus, the use of the Mark will cause 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 and services associated with those trade-marks are manufactured, sold, hired or performed by the same person, whether or not the wares or services are of the same general class. A

non-exhaustive list of relevant circumstances is set out at s. 6(5) of the Act. In the recent decision *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27, the Supreme Court of Canada interpreted s. 6(2) and clarified the scope of the various criteria listed at s. 6(5) of the Act. This analysis shows that the most important factor is still the degree of resemblance between the marks at issue.

[13] With the exception of the trade-mark TABASTOP, which I will discuss more fully below, not only are the marks referenced by the Opponent different phonetically, visually and in terms of the ideas they suggest, but the wares and services covered by those registrations are different from the Wares and Services.

[14] I must point out that in the [TRANSLATION] “ARGUMENTS” section of its written submissions, the Opponent refers only to the first and second grounds of opposition. The Opponent presents no argument that can support the sixth ground of opposition. This was also the case at the hearing. The Applicant, for its part, merely points out in its written arguments that the registration for the mark TABASTOP was subject to s. 45 proceedings under the Act and that, therefore, the Registrar should ignore it. No case law has been cited to support such a position. When I checked the state of the register, I noticed that this registered trade-mark was still listed in the register. Since the relevant date is the date of my decision, I must take this reference into account.

[15] At the hearing, the Applicant argued that the Opponent had no interest to oppose this application for registration. On this point, I agree with the statements by the agent for the Opponent. The opposition process is, to a certain degree, in the “public interest”. At s. 38 of the Act, Parliament uses the expression “any person . . .” to identify the persons who may file a statement of opposition. However, some grounds of opposition are limited to persons who can claim certain rights. As an example, I refer to s. 17 of the Act. No such restriction is present in the language of s. 12(1)(d) of the Act.

[16] I do not intend to perform an exhaustive analysis of the criteria listed at s. 6(5) of the Act to dispose of this ground, given the parties’ lack of interest in debating this point. However, there is a public interest in maintaining the purity of the register [see *T.G. Bright & Co. v. Andres*

Wines Ltd. (1985), 4 C.P.R. (3d) 79 (T.M.O.B.)). For this reason, I will nonetheless consider the merits of this ground of opposition.

[17] Although the Mark seems both phonetically and visually different from the mark TABASTOP, the Mark consists of the phonetic equivalent of the words TABAC and STOP. Thus, the trade-mark STOP TOBACCO constitutes the same word STOP and the English word TOBACCO, which is the English translation of the French word TABAC [see the *Larousse French-English Dictionary*]. Thus, the idea suggested by the marks is the same: to stop smoking. It must be borne in mind that we must consider the average bilingual consumer [see *Smithkline Beecham Corporation v. Pierre Fabre Médicament* (2001), 11 C.P.R. (4th) 1]. There is also a similarity of wares as regards “drops, gel caps and pills for the cessation of smoking”. In addition, there is a connection between educational publications relating to smoking cessation and tablets for the cessation of smoking. This connection also exists with the other Services.

[18] I conclude, on a balance of probabilities, that the average consumer with an imperfect recollection of the mark TABASTOP might confuse it with the Mark when the Mark is used in association with the Wares and Services.

[19] I therefore allow the sixth ground of opposition.

Use of the Mark

[20] At the hearing, the agent for the Opponent stated that she would limit to the Wares the scope of the first two grounds of opposition. Therefore, I must first decide whether the various marks used by the Applicant constitute use of the Mark. If so, I will then have to determine whether this constitutes use of the Mark in association with the Wares (wares (1) and (2)).

[21] For the purposes of this decision, it is sufficient to state that Mr. Wallack is the Applicant’s president and founder. The Applicant was incorporated on April 4, 2000. Mr. Wallack states that, in May 2000, the Applicant began using a family of marks all beginning with the word STOP in association with treatments offered to individuals for problems related to weight, appetite, stress, and alcohol and tobacco addictions.

[22] The Opponent alleges that the trade-mark used by the Applicant is not the Mark. To clearly understand the Opponent's argument on this point, it is worth reproducing an illustration



of the trade-mark as it is shown on some of the exhibits filed by the Applicant:

(STOP TOBACCO and design)

[23] In my decision in *Stop Centres Inc. v. Nautilus Plus Inc.* (2009), 81 C.P.R. (4th) 200, I addressed a similar issue in a slightly different context: in fact, in that case, the Applicant was opposing the Opponent's registration of the mark STOP DIÈTE on the basis of the previous use of its mark STOP POIDS. However, the evidence filed by the Applicant in that case showed the use of a design similar to the one illustrated above, except that the words STOP TOBACCO were replaced by STOP POIDS. After having referred to the decisions in *Registrar of Trade-Marks v. Compagnie Internationale L'Informatique CII Honeywell Bull, Société Anonyme et al.* (1985), 4 C.P.R. (3d) 523 and *Nightingale Interlock Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535, I then found as follows:

The words "CENTRES", "D'ARRÊT" and "3 HEURES" appearing on the design marks illustrated above are purely descriptive. Moreover, the words in the colour version of the design marks are written in different colours: STOP POIDS in white; CENTRES D'ARRÊT in blue; and 3 HEURES in green. Lastly, the design portion is in red. In my opinion, the average consumer would not believe that the services offered in association with the Opponent's design marks would come from a source other than the services offered in association with the STOP POIDS and STOP WEIGHT marks. The dominant part of these design marks is "STOP POIDS" and "STOP WEIGHT". I therefore consider that any evidence of use of these design marks can constitute use of the word marks STOP POIDS and STOP WEIGHT.

[24] The Opponent asks me to distinguish this case from the STOP DIÈTE decision. The Opponent argues that in the STOP DIÈTE case, that finding was made in relation to use of a trade-mark referenced by an opponent, whereas in this case, it is a matter of determining whether the Applicant, who has the ultimate burden, has proven the use of the Mark in association with

the Wares. With respect for the contrary view, I do not see how the fact that the Applicant has the burden of proving the use of the Mark on the dates of first use claimed in its application for registration would lead to a different finding. The central issue is the same: is it open to me to find that use of the trade-mark STOP TOBACCO and design is equivalent to use of the Mark? I make the same finding as I did in the STOP DIÈTE case: the use of the trade-mark STOP TOBACCO and design does constitute use of the Mark.

[25] Consequently, I cannot agree with the Opponent's arguments in support of its second ground of opposition.

[26] In the event I am in error, I would like to emphasize that, in any event, the record contains evidence of use of the Mark. Thus, Exhibits SW-2 and SW-7 show use of the mark STOP-TOBACCO CENTRES. The mark STOP-TOBACCO appears in Exhibits SW-4, SW-5, SW-10, SW-11 and SW-12. I consider the use of each of these marks to be use of the Mark [see *CII Honeywell Bull and Nightingale, op.cit.*].

[27] What remains to be determined is whether the Mark was used in association with the Wares within the meaning of s. 4(1) of the Act at the dates claimed in the application for registration.

Is the Mark used in association with the Wares?

[28] It is acknowledged in the case law that an opponent may refer to the applicant's evidence to prove allegations relating to s. 30(b) of the Act [see *Labatt Brewing Co. v. Molson Breweries, Partnership* (1996), 68 C.P.R. (3d) 216 (T.M.O.B.)]. However, this evidence must raise substantial doubts. The Opponent contends that the exhibits listed above do not show use of the Mark in association with wares within the meaning of s. 4(1) of the Act because there is no association between the Mark and a product. The best way of showing this association would be to put the Mark on the product itself or on its packaging [see *Farside Clothing et al. v. Caricline Ventures Ltd.*, 2002 FCA 446].

[29] Mr. Wallack states in his affidavit that Exhibits SW-2, SW-4 and SW-5 are promotional brochures. However, they do not constitute use of the Mark in association with the Wares (1).

None of the exhibits filed by Mr. Wallack show the Wares (1), except for Exhibit SW-14, which I will discuss further below.

[30] As for the educational publications (Wares (2)), the promotional brochures filed by Mr. Wallack are distributed to promote the Applicant's Services in association with the Mark. I agree with the Opponent that these documents do not prove the use of the Mark in association with the Wares (2).

[31] Exhibit SW-7 is an advertisement placed in a magazine to promote the Services in association with the Mark. Exhibits SW-10 and SW-11, as described by Mr. Wallack, are brochures describing the various programs the Applicant offers. As for the copies of letters filed as Exhibit SW-12, although their contents refer to the Mark, they do not mention the Wares at all.

[32] There is no doubt that the Applicant uses the Mark in association with the Services. However, there is no evidence in the record showing use of the Mark in association with the Wares. There is Exhibit SW-14, which is a photocopy of a container for homeopathic drops. However, the mark on the container is STOP CENTRES. This does not constitute use of the Mark.

[33] The Applicant alleges that paragraph 19 of Mr. Wallack's affidavit proves that advertising brochures showing the Mark were distributed with homeopathic products such that there was an association between the Mark and its homeopathic products. I can dispose of this argument by reproducing the paragraph in question:

19. Since at least as early as August 2004, Stop Centres provides to its clients a wide range of naturopathic support products for weight loss, weight management, smoking cessation, appetite control, and stress reduction in connection with promotional brochures or material bearing the STOP TOBACCO trade-mark. Exhibit SW-14 to my affidavit is a picture of one such bottle of homeopathic drops.

[34] This product, shown in photograph SW-14, does not bear the Mark. Although it is distributed with brochures bearing the Mark, those brochures promote the Services, not the Wares, in association with the Mark. For example, in Exhibit SW-10, I found a passage referring to natural products, but there is no illustration of those products and, more importantly, no

mention that those products bear the Mark. At the very most, the allegation in paragraph 19 of Mr. Wallack's affidavit concerning an association between the Mark and the Wares (1) is ambiguous, given that the exhibit he filed in support of this allegation shows the use of another trade-mark.

[35] Therefore, although the evidence filed by the Applicant is abundant, none of it shows the use of the Mark in association with the Wares. The only evidence showing the use of a trade-mark in association with wares is Exhibit SW-14, but it does not show the Mark. This leads me to conclude that there is a substantial doubt regarding the Applicant's allegation that it used the Mark in association with the Wares on the dates claimed.

[36] I therefore allow the first ground of opposition with regard to the Wares alone.

Abuse of process

[37] At the hearing, the Applicant alleged that the opposition proceedings in this file were without merit and abusive. Consequently, it asked the Registrar to find that they were an abuse of right under the *Civil Code* and therefore asked me to dismiss the opposition.

[38] However, as shown by this decision, the statement of opposition cannot be considered frivolous or abusive because two of the grounds of opposition have been allowed: one in part and the other completely.

Decision

[39] By exercising the powers delegated to me pursuant to s. 63(3) of the Act and through the combined effect of the grounds of opposition allowed in whole or in part, I refuse the application for registration pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Sarah Burns