



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

**Citation: 2016 TMOB 181**  
**Date of Decision: 2016-11-30**

**IN THE MATTER OF AN OPPOSITION**

**Labrador II, Inc.**

**Opponent**

**and**

**Ren's Feed and Supplies Limited**

**Applicant**

**1,595,473 for RENS PETS DEPOT**

**Application**

[1] Labrador II, Inc. opposes registration of the trade-mark RENS PETS DEPOT (the Mark), that is the subject of application No. 1,595,473 by Ren's Feed and Supplies Limited.

[2] The application was filed based on use of the Mark in Canada since October 13, 2005 in association with a variety of services including retail pet store and associated services, a complete list of which is provided under Schedule A to this decision.

[3] The Opponent has opposed the application for the Mark on the basis that: (i) the application does not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not entitled to registration of the Mark under section 16 of the Act; and (iv) the Mark is not distinctive under section 2 of the Act.

[4] The last three grounds of opposition revolve around the likelihood of confusion between the Mark and the following trade-marks and trade-name of the Opponent:

- PET DEPOT (registration No. TMA744,221);
- PET DEPOT & Design (registration No. TMA762,328):



- PET DEPOT trade-name.

The Opponent's above-noted registrations are registered in association with "retail store services featuring pet supplies"; such services also being associated with the above-noted trade-name.

[5] For the reasons that follow, I have found that this application ought to be refused.

The Record, Onus and Material Dates

[6] The application for the Mark was filed on September 24, 2012 and it was advertised for opposition purposes in the *Trade-marks Journal* dated November 6, 2013. On November 29, 2013, the Opponent filed a statement of opposition to oppose it under section 38 of the Act. The Applicant then filed and served its counter statement on February 13, 2014.

[7] In support of its opposition, the Opponent filed the affidavit of Jane Buckingham, sworn on June 13, 2014, together with Exhibit A. Ms. Buckingham was not cross-examined on her affidavit.

[8] In support of its application, the Applicant filed the affidavit of Joe Lynn, sworn on October 9, 2014, together with Exhibits A through M. Mr. Lynn was also not cross-examined on his affidavit.

[9] Both parties filed written arguments and were represented at a hearing.

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could be reasonably concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

[11] With respect to the grounds of opposition, it is the following material dates that apply:

- Sections 38(2)(a)/30 - the filing date of the application, namely, September 24, 2012 [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 at 296 (FCTD) re: section 30(b); and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB) re: section 30(i)]; and
- Sections 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1981), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(1)(a) and (c) – the date of first use claimed in the application, namely, October 13, 2005 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)]; and
- Sections 38(2)(d)/2 – the date of filing of the statement of opposition, namely, November 29, 2013 [see *Metro-Goldwyn-Mayer supra*].

## Overview of the Parties' Evidence

### *The Opponent's Evidence*

#### *The Buckingham Affidavit*

[12] Ms. Buckingham is a trade-mark searcher employed by the agents for the Opponent.

[13] Ms. Buckingham conducted searches for the trade-mark registrations owned by the Opponent that are relied upon in its statement of opposition as follows:

- TMA744,221 for the trade-mark PET DEPOT; and
- TMA762,328 for the trade-mark PET DEPOT & Design.

[14] Ms. Buckingham attaches under Exhibit A to her affidavit, copies of the above-noted registrations. The printouts of the registrations confirm that both marks are registered in association with retail store services featuring pet supplies.

*The Applicant's Evidence*

*The Lynn Affidavit*

[15] Mr. Lynn is an officer of the Applicant.

[16] Mr. Lynn attests that the Applicant first began operating its business in Oakville, Ontario, in February of 1975, and he attaches as Exhibit A to his affidavit, various articles published in a local newspaper which profile the Applicant, including its founding. He states that it was on October 13, 2005, the Applicant began using the Mark in association with the applied-for services.

[17] He states that the Applicant has continued to carry on business using the Mark at its Oakville location and that over the years, the Applicant has successfully opened seven additional locations across Ontario as follows:

- Guelph Retail (September 2007);
- Guelph Warehouse (2008);
- Kitchener (November 2010);
- Waterdown (September 2013);
- Burlington (November 2013);
- Woodbridge (October 2013); and
- Waterloo (September 2014).

[18] In support of the aforementioned, he provides photographs of each storefront location with signage bearing the Mark (Exhibit B), various invoices dating from 2005 through 2011 which all appear to have been issued from the Applicant's Oakville, Ontario location (Exhibit C), and partially redacted annual sales figures reports from each store commencing from 2005 to the date of swearing of his affidavit (Exhibit D).

[19] Mr. Lynn then describes the various forms of advertising and promotion that the Applicant has conducted over the years, which include attendance and sponsorship of industry specific trade shows, sponsorship of sports teams and events, advertisements in local newspapers, retail flyer mail and email distribution, radio advertising, and product catalogue distribution. In support, he provides the following:

- Exhibit E – copies of various trade show and gala excerpts attended and sponsored by the Applicant over the years;
- Exhibit F – copies of various articles in relation to sponsorship over the years;
- Exhibit G – copies of newspaper advertisements;
- Exhibit H – copies of various flyers distributed over the years;
- Exhibit I – copies of various catalogue front/back covers over the years;
- Exhibit J – a report detailing the Applicant's marketing and advertising expenditures since 2005; and
- Exhibit K - various articles and blogs referencing the Applicant and the Mark.

[20] Mr. Lynn states that on September 30, 2010, the Applicant registered a Master Business Licence for the business name "Ren's Pets Depot", a copy of which he attaches as Exhibit L to his affidavit.

[21] Lastly, Mr. Lynn attaches as Exhibit M, copies of Federal Nuans Reports conducted in August 2012 and again in September 2014 using the search term "Pet Depot". He contends that the results demonstrate that the term "Pet Depot" forms part of the business name of numerous businesses across Canada, and highlights six such examples.

## Grounds of Opposition

### Section 30(b)

[22] The Opponent has plead that the Applicant did not use the Mark in Canada, in association with the applied-for services, since the date of first use claimed, namely, October 13, 2005.

[23] Section 30(b) of the Act requires that there be continuous use of the applied-for trademark in the normal course of trade from the date claimed to the filing date of the application [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[24] While the legal burden is upon an applicant to show that its application complies with section 30 of the Act, there is an initial evidential burden on an opponent to establish the facts relied upon by it in support of its section 30 ground [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 at 329 (TMOB); and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. With respect to section 30(b) of the Act in particular, an opponent's initial burden has been characterized as light due to an opponent's limited access to information regarding use relative to the applicant. While an opponent can meet its initial burden by reference to its own evidence, its burden can in some cases be met with reference to the applicant's evidence [*Molson Canada v Anheuser-Busch Inc* 2003 FC 1287; 2003 FC 1287 (CanLII), 29 CPR (4th) 315 (FC)]. However, it has been held that in order to do so, the opponent must show that the evidence is "clearly inconsistent" with the claims set forth in its application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), aff'd 11 CPR (4th) 489 (FCTD)].

[25] In a more recent decision, the Federal Court has described this "clearly inconsistent" burden as being slightly higher than the lesser burden imposed on an opponent who may rely on its own evidence under this ground [see *Corporativo de Marcas GJB, SA De CV v Bacardi & Company Ltd* 2014 FC 323 (CanLII)]. The Federal Court has indicated that an opponent may successfully rely upon an applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the applicant's application. On this issue, all of the pertinent evidence of record is to be assessed according to the normal criteria, that is, taking into consideration "its provenance (including its quality and reliability),

the absence of evidence that might reasonably be expected to exist, and whether it has been tested on cross-examination and if so, how it fared. Multiple diverse considerations inform the assessment of evidence” [*Marcas, supra*, at para 37].

[26] If an opponent succeeds in discharging its initial evidential burden, the applicant must then, in response, substantiate its claim of use during the material time. However, while an opponent is entitled to rely on the applicant’s evidence to meet its evidential burden, the applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidential burden [see *Kingsley v Ironclad Games Corporation*, 2016 TMOB 19 (CanLII), at para 63].

[27] In the present case, the Opponent relies on the Applicant’s own evidence, in particular, the Master Business License in Exhibit L, and one of the NUANS reports in Exhibit M to the Lynn affidavit. In this regard, the Opponent submits that both documents indicate that the Applicant, Ren’s Feed and Supplies Limited, was incorporated on May 1, 2009. The Opponent notes that this date is after the date of first use claimed, and no predecessor-in-title was named in the application. As such, the Opponent submits, this raises the issue as to whether the Applicant was able to claim entitlement based on use themselves, or whether use was by a predecessor-in-title.

[28] In addition to the aforementioned, the Opponent submits that, in any event, there is no reference whatsoever to any of the services other than the retail and mail order services (the additional services). As but one example, the Opponent submits, the article profiling the Applicant in the Exhibit I catalogue, points to the Applicant as being a supplier of products, but not a supplier of the sorts of additional services, such as pet boarding, etc. based in the application.

[29] Lastly, the Opponent submits that there is a distinction between the Mark that is applied for and the trade-mark that is in use, namely, the inclusion of REN’S rather than RENS. The Opponent submits that the impact of the apostrophe is important because it changes the connotation of the mark, and provides the example of ROBS versus ROB’S as an analogy.

[30] In reply, the Applicant submits that Exhibit A to the Lynn affidavit, which includes copies of articles from publications dating from 1994 to 2004, refers to the name of the corporation as being Ren's Feed and Supplies Ltd. The Applicant submits that the Opponent is not an expert as to what the Master Business License is about, and that the evidence is not at all inconsistent as to the date of first use. I agree with the Applicant that the evidence does not appear, as a whole, to be inconsistent in this regard, as the evidence reflects that the Applicant is and has been a family-owned and operated business for over 30 years. In this regard, for example, I note that the back cover page of the Applicant's catalogue dated November 16, 2007 at Exhibit I includes a write up regarding the founding and history of the Applicant, indicating that in 1975, an individual named Ren Job started "Ren's Feed and Supplies Ltd." Further to this, I note that an article published in the Oakville Beaver newspaper, dated February 11, 2004, included in Exhibit A, includes the following: "So, Ren moved his family to Oakville, bought a local feed business operating on Trafalgar Road and literally put his name to it --- Ren's Feed & Supplies Ltd. 'That was 29 years ago and the business has just evolved,' said Collin."

[31] Furthermore, with respect to the additional services questioned under this ground by the Opponent, I agree with the Applicant's submission that the Applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by the Opponent in meeting its evidential burden. In any event, there is nothing in the evidence that casts doubt as to the Applicant's claimed date of first use with respect to these services.

[32] Lastly, with respect to the Opponent's submission that the trade-mark used is not the Mark as applied for, I find this situation is not analogous to "ROB'S", as "rob(s)" is an ordinary dictionary word in the English language that has an alternate meaning other than that of a first or given name. In applying the principles concerning deviation of trade-marks, as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I consider the inclusion of the apostrophe in the trade-mark as used to be a minor deviation from the Mark. In my view, the dominant feature remains the words, and as such, the identity of the Mark is preserved and the use of the possessive form of REN'S in the Mark would not, in my opinion, mislead an unaware purchaser.



[33] Having regard to the foregoing, the ground of opposition based on section 30(b) of the Act is dismissed.

#### Section 30(i)

[34] The Opponent has plead that the Applicant could not have been satisfied that it was entitled to use the Mark in association with the applied for services because of the prior rights owned by the Opponent by reason of its registered PET DEPOT and PET DEPOT & Design trade-marks, and because the Applicant must have known that the Mark was not distinctive of it.

[35] However, where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence in the present case.

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

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

#### Confusion Grounds

##### Section 12(1)(d) Ground of Opposition

[38] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with its PET DEPOT and PET DEPOT & Design registrations.

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

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

*The test for confusion*

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

[42] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 (SCC) at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

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

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

[44] The Mark consists of the words RENS, PETS, and DEPOT, while the Opponent's marks also incorporate the words PET and DEPOT in combination.

[45] The word PET(S), singular or plural, is self-explanatory in my view, as it clearly signals to the consumer that the parties' services pertain to cats, dogs, and other such domesticated

animal companions. In addition, the following definitions of the word DEPOT, as located in the Canadian Oxford Dictionary, 2<sup>nd</sup> edition appear applicable [see *Tradall SA v Devil's Martini* (2011), 2011 TMOB 65 (CanLII), 92 CPR (4th) 408 (TMOB) at para 29 re: judicial notice of dictionary definitions]:

DEPOT: *noun* a storehouse. A place for the storage of large quantities of equipment, food, or goods. A store for supplies.

[46] Accordingly, the combination of the words PET(S) and DEPOT are suggestive of a store or storehouse of a large number of items or supplies for pets. As such, I do not consider the combination of the words PET(S) and DEPOT to be inherently strong when used in association with the parties' respective services.

[47] Furthermore, I do not find that the design element in the Opponent's PET DEPOT & Design mark adds much distinctiveness to the Opponent's mark in the context of its services.

[48] The Applicant's Mark however, as previously noted, also includes the word RENS. The Opponent submits that the word RENS, is non-distinctive as it is a first name. I agree that the word RENS has first or given name significance; this is supported by the Applicant's evidence which indicates that the Applicant was founded by Mr. Ren Job (per newspaper articles in Exhibit A).

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

[50] The Opponent submits that use of a trade-mark indicated in a registration is sufficient proof for the purpose of section 6(5) of the Act, and that declarations of use in this regard for the Opponent's registrations for the trade-marks PET DEPOT and PET DEPOT & Design were filed on June 25, 2009 and November 2007, respectively. However, the Registrar will assume only *de minimus* use of a trade-mark based on such evidence alone [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. As the mere existence of the registrations can establish no more than *de minimus* use, it cannot give rise to an inference of significant and continuous use. Thus, I am unable to conclude that the Opponent's PET DEPOT and PET DEPOT & Design marks have any degree of acquired distinctiveness.

[51] The Applicant's evidence, on the other hand, shows that the Mark has been used in association with "retail pet store services, on-line retail store and mail order catalog sales featuring pet products" since 2005. The Opponent submits that the Applicant has led insufficient evidence to substantiate use of the Mark. In this regard, in addition to the its submissions under the section 30(b) ground above, the Opponent submits that since the sales figures provided by the Applicant have been redacted, this evidence is problematic in determining the extent to which the Mark has become known. I have already dealt with the submissions under section 30(b) and while it is true that specific sales figures have been redacted, the evidence demonstrates, at the very least, that the Applicant's business has steadily grown over the years culminating as of the date of Mr. Lynn's affidavit, in an expansion to seven such stores providing services under the Mark. In addition, substantial advertising figures have been provided, as well as circulation figures for advertising flyer inserts featuring the Mark over the years. Thus, I am prepared to infer that the Applicant experienced some degree of reputation and acquired distinctiveness of its Mark in the geographic market (i.e. South-Western Ontario) in which the Applicant operates.

[52] Having regard to the aforementioned, while I conclude that the Mark possesses only a marginally greater degree of inherent distinctiveness by virtue of the inclusion of the word RENS, it has a greater degree of acquired distinctiveness through continuous use through an expanding business since 2005. Hence, I find that the overall consideration of the section 6(5)(a) factor favours the Applicant.

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

[53] The application claims use of the Mark since at least as early as October 13, 2005. This date is supported in the Lynn affidavit through photographs of storefront signage bearing the Mark and invoices bearing the Mark, the earliest of which predates October 13, 2005.

[54] However, as previously indicated in the analysis under section 6(5)(a) above, the mere existence of the Opponent's registrations can establish no more than *de minimus* use and cannot give rise to an inference of significant and continuous use of its PET DEPOT and PET DEPOT & Design marks.

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

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

[56] The Opponent submits that the core service offered under both parties’ marks is “retail pet store services/retail store services featuring pet supplies”, and thus, the nature of the trade of both parties is identical.

[57] As I agree that the services of the parties are similar and overlapping, I find the overall consideration of these third and fourth factors favours the Opponent.

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

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

[59] The Opponent submits that the Applicant has appropriated the identical combination of the words PET(S) and DEPOT combined with a non-distinctive word element, i.e. RENS PETS DEPOT. The Opponent submits that the most striking portion of both parties’ marks is the combination of the words PET(S) and DEPOT; the dominant element of the Applicant’s Mark, when considered by the average consumer as a matter of first impression, being the phrase PETS DEPOT. With respect to ideas suggested, the Opponent further submits that the first portion of the Mark, RENS, is not distinctive, in that it is merely a first or given name, as opposed to a coined or invented word. As such, the Opponent submits, the addition of the name RENS to the

Mark does not assist in distinguishing it from the Opponent's PET DEPOT and PET DEPOT & Design marks as it would not prevent the average consumer from mistakenly assuming that the source of the services associated with the Mark is one and the same as the source of the services associated with the Opponent's marks. In other words, the average consumer would think it is a "PET DEPOT" pet store, licensed and operated by someone named Ren.

[60] The Applicant submits that the only commonality between the Mark and the trade-marks of the Opponent is the combination of the descriptive words PET and DEPOT; however, contrary to the Opponent's position, the Applicant submits that its Mark is dominated by the formative RENS. In this regard, the Applicant submits that jurisprudence has well established that: the prefix of a trade-mark is normally the most important element of a trade-mark in determinations of confusion; when a trade-mark element is common in the trade, average consumers will tend to focus upon differences, and; when a trade-mark element is descriptive, the degree of distinctiveness attributable thereto is limited.

[61] However, I am of the view that the differences in the parties' trade-marks are not significant enough to outweigh their similarities in appearance, sound and ideas suggested, as a matter of first impression and imperfect recollection. In this regard, although the first component of a mark is often considered the most important for the purpose of distinction, I agree with the Opponent that the significance of the first component is decreased in the present case, given that RENS is a first name. Furthermore, I agree with the Opponent's submission that the average consumer would think that the idea conveyed by RENS PETS DEPOT is that it is a "PET DEPOT" pet store, licensed and operated by someone named Ren. Lastly, the addition of the "s" to the word PET in the Mark is not sufficient to create any significant difference between the parties' marks [see *Hot Stuff Foods, LLC v Maple Leaf foods Inc*, 2012 TMOB 30 (CanLII)].

[62] The section 6(5)(e) factor therefore favours the Opponent.

## *Additional Surrounding Circumstances*

### *State of the Marketplace*

[63] The Applicant submits that there is widespread use of the formative PET DEPOT as a trade-name by others throughout Canada. The Applicant's evidence in this regard consists of the NUANS search reports attached under Exhibit M to the Lynn affidavit. As previously indicated, Mr. Lynn highlights five such examples which include the following: REGINAS PET DEPOT; 333 PET DEPOT INC; PET DEPOT CANADA, ULC; STACYS PET DEPOT; and SUES PET DEPOT. I note that additional instances include AMBERS PET DEPOT; and LINDAS PET DEPOT.

[64] The Opponent submits, and I agree, that the Applicant has provided no evidence on the ownership of the above-noted names or if any of these business names are in use in the Canadian marketplace. Further to this, the Opponent submits that the fact that one or more of these entities may be listed as having an "active" status is irrelevant as there is no way of knowing if this information accurately reflects the state of the marketplace. In summary, the Opponent submits that without actual evidence of use, no conclusion can be drawn from the mere existence of these names.

[65] The Opponent submits that the same general rule applies in respect of third party marks on the Register, in that state of the register evidence is only relevant insofar as valid inferences about the marketplace, itself, can be drawn from the state of the register evidence. The Opponent then correctly notes that while the Applicant has filed NUANS reports, it has not filed any evidence of third party PET DEPOT marks on the Register itself.

[66] The Applicant submits that the NUANS search results are relevant and admissible to prove that the business names are in use. In this regard, the Applicant relies on the decision in *Image Intellectual Property Law Professional Corp v Pinnacle Foods Group LLC* (2013), 114 CPR (4th) 272 (TMOB), which the Applicant submits allows the Registrar to exercise common sense for a reasonable conclusion in assuming that at least one of the names is in use. This decision, however, is entirely distinguishable as it dealt with a ground of opposition based upon

section 12(1)(a) of the Act, wherein 9,492 directory listings were evidenced with respect to the surname at issue.

[67] In any event, even if I were to conclude that at least one of the above-noted business names was in use, this would be insufficient to demonstrate that such use is widespread and/or common and that consumers would thus be accustomed to distinguishing between such trade-names and/or marks.

*Examiner Deemed Application to be a “Doubtful Case”*

[68] The Opponent submits that a further relevant surrounding circumstance to be considered is that the Registrar, by reason of the Opponent’s registered PET DEPOT marks, was in doubt whether the Mark is registrable, thus notifying the Opponent of the advertisement of the application, pursuant to section 37(3) of the Act. The Opponent submits that this supports the Opponent’s position that at the very least, there exists doubt of the registrability of the application, such that the Opposition Board should refuse the application.

[69] However, a decision by an Examiner of the Canadian Intellectual Property Office has no precedential value for the Board because both the onus and evidence before an Examiner differs from that before the Board [see *Thomas J Lipton Inc v Boyd Coffee Co* (1991), 40 CPR (3d) 272 (TMOB) at 277 and *Procter & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 (TMOB) at 386]. Thus, I must come to a decision based solely on the evidence of record in this opposition proceeding.

[70] Based on the foregoing, this does not form a relevant surrounding circumstance.

Conclusion

[71] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[72] In *Masterpiece Inc v Alavida Lifestyles* (2011), 92 CPR (4th) 361, the Supreme Court of Canada highlighted the importance of the section 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found the parties’ marks share a high degree of



similarity in appearance, when sounded, and in ideas suggested, as the Mark incorporates the whole of the Opponent's PET DEPOT trade-mark.

[73] Further to this, I have concluded that the parties' services are the same or overlapping, as are the channels of trade.

[74] While I acknowledge that the parties' marks are not inherently strong, absent sufficient state of the marketplace evidence that PET DEPOT, in combination, is common in the trade, I cannot conclude that consumers are accustomed to distinguishing between such marks.

[75] Having regard to the above, I find that the balance of probabilities is evenly balanced between a finding of confusion between the marks in issue and a finding of no confusion. As the onus is on the Applicant to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's PET DEPOT marks, I must decide against the Applicant.

[76] Having regard to the foregoing, I allow the ground of opposition based on section 12(1)(d) of the Act.

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

[77] With respect to the ground of opposition based on section 16(1)(a) of the Act, the Opponent has an initial burden of establishing that one or more of its trade-marks alleged in support of this ground of opposition were used or made known prior to the Applicant's claimed date of first use (October 13, 2005) and were not abandoned at the date of advertisement of the application for the Mark (November 6, 2013) [section 16(5) of the Act].

[78] Similarly with respect to the ground of opposition based on section 16(1)(c), the Opponent must show that its trade-name PET DEPOT had been used in Canada prior to the claimed date of first use of the Mark. The Opponent must also demonstrate that it had not abandoned its trade-name at the date of advertisement of the Mark.

[79] At the oral hearing, the Opponent, although not withdrawing these grounds, acknowledged that they had not filed any evidence that would meet their burden under these grounds of opposition.

[80] Furthermore, any reference to use in the Opponent's registrations or application is not sufficient to satisfy the Opponent's evidentiary burden under section 16(1)(a) of the Act [see *Roxxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

[81] Therefore, the grounds of opposition based on section 16(1)(a) and (c) of the Act are dismissed due to the Opponent's failure to meet their evidentiary burden.

#### Non-distinctiveness Ground of Opposition

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

[83] This means that in order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, November 29, 2013, that one or both of the Opponent's marks and/or trade-name had become known sufficiently to negate the distinctiveness of the Mark, and that the reputation of one or both of its PET DEPOT trade-marks and/or trade-name in Canada was substantial, significant or sufficient [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427; *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, (2004), 34 CPR (4th) 317 (FC); and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. In doing so, it is not necessary that the Opponent show that its PET DEPOT marks and/or trade-name have become well known in Canada in the technical sense of Section 5 of the Act. Indeed, the Opponent may rely on evidence of knowledge or reputation of its mark and/or trade-name spread by means of word of mouth and evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles as opposed to advertising [see *Motel 6*, at 58-59].

[84] The Opponent has pleaded that the Mark is not distinctive of the Applicant in that neither distinguishes nor is it adapted to distinguish the services set forth in the application for the Mark from the services of the Opponent in association with its PET DEPOT and PET DEPOT & Design trade-marks.

[85] The Opponent submits that should confusion be found under the section 12(1)(d) ground of opposition, that it follows that the Mark cannot be held to be distinctive of the Applicant.

[86] However, the Opponent's burden, as described above, must nevertheless be satisfied. In the present case, as the Opponent has not filed any evidence of use of its PET DEPOT and PET DEPOT & Design marks or trade-name. Furthermore, similar to the grounds of opposition based upon section 16 of the Act, any reference to use in the Opponent's PET DEPOT and PET DEPOT & Design registrations, is not sufficient to satisfy the Opponent's evidentiary burden under this ground [see *Rahbar-Dehghan v Parkside Optical Inc*, 2013 TMOB 77 (CanLII)]. Thus, despite a finding of confusion under section 12(1)(d), the Opponent has failed to satisfy its burden under this ground.

[87] Accordingly, the non-distinctiveness ground of opposition is dismissed.

#### Disposition

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

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

**Schedule “A”**

<u>Application No.</u>	<u>Trade-mark</u>	<u>Services</u>
1,595,473	RENS PETS DEPOT	Retail pet store services, on-line retail store and mail order catalog sales featuring pet products and services, namely pet food, pet grooming, pet care, pet hygiene accessories, pet shampoo and conditioner, deodorizers for pets, pet odor removers and pet stain removers, pet safety seats for use in vehicles and pet car seats, disposable housebreaking pads for pets and plastic bags for disposing of pet waste, disposable pet diapers, pet clothing, leashes for pets, collars for pets, harnesses and carriers, animal training devices, beds for household pets, pet crates, pet ramps and playhouses for pets, pet brushes, first-aid kits for pets, pet nutritional supplements and vitamins, dog chews, pet cages, pet feeding and water dishes and scoops for disposing of pet waste, pet blankets, pet toys, pet food and pet treats, deodorizers for household pet litter boxes, pet boarding, pet day care, pet adoption, and pet obedience and training; providing facilities for the adoption of animals; educational and training services on the topics of pet care, pet food, pet grooming and breeding, pet hygiene, pet boarding, pet adoption, and pet obedience; pet grooming services; pet day care services; pet boarding services, kennel services; animal exercising services.

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

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Hearing Date: 2016-07-21

Appearances

Robert MacDonald

For the Opponent

Steven Leach

For the Applicant

Agents of Record

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For the Opponent

Ridout & Maybee LLP

For the Applicant