



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

Citation: 2014 TMOB 272
Date of Decision: 2014-12-08

**IN THE MATTER OF AN OPPOSITION by
Itlas, S.p.A. to application No. 1,555,292 for
the trade-mark TAVOLE ITALIANE in the
name of eurolegno distribution inc.**

[1] Itlas, S.p.A. (the Opponent) opposes registration of the trade-mark TAVOLE ITALIANE (the Mark) that is the subject of application No. 1,555,292.

[2] The application was filed by eurolegno distribution inc. (the Applicant) on December 7, 2011 and is based upon use of the Mark in Canada since at least as early as December 31, 2010 in association with the following wares: “Engineered wood flooring/covering”.

[3] The opposition was brought by the Opponent under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[4] For the reasons explained below, the opposition is successful.

The Record

[5] The statement of opposition was filed by the Opponent on April 5, 2013. The grounds of opposition allege that the application does not conform to the requirements of section 30 of the Act for several reasons including that prior to and even after the filing of the opposed application, the Applicant was acting as a Canadian distributor of the wood floorings of the Opponent and, as such, the Applicant could not be satisfied that it was entitled to use the Mark in

Canada under subsection 30(i) of the Act; that the Applicant is not the person entitled to registration of the Mark under subsections 16(1)(a) and (c) of the Act since at the claimed date of first use of the Mark (which is denied), the Mark was confusing with the trade-mark and trade-name TAVOLE ITALIANE of the Opponent that had been previously used in Canada by the Opponent or its predecessors in title in association with wood floorings; and that the Mark is not distinctive under section 2 of the Act since the Mark does not actually distinguish, nor is it adapted to distinguish the applied-for wares of the Applicant from those of the Opponent.

[6] The statement of opposition was denied by the Applicant by counter statement.

[7] In support of its opposition, the Opponent filed an affidavit of its Export Manager, Gilberto Garbin, sworn October 31, 2013. The Applicant elected not to file evidence.

[8] Neither party filed written arguments. A hearing was requested but was ultimately cancelled by the parties. On November 17, 2014, in response to an Office letter dated November 12, 2014, the Applicant confirmed to the Registrar its interest in maintaining the present application and receiving a decision with respect to the opposition.

The parties' respective burden or onus

[9] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Analysis

The section 30(i) ground of opposition

[10] The section 30(i) ground of opposition, as pleaded by the Opponent, has three prongs.

[11] One of these prongs is that the statement of the Applicant contained in its application that it is satisfied as to its entitlement to the use of the Mark is false in view of the knowledge of the

Applicant of the rights of the Opponent and of the unlawfulness of said use in that:

1.3.3 prior to and even after the filing of the opposed application, the [A]pplicant was acting as a Canadian distributor of the wood floorings of the Opponent and as such, any user of the [Mark] alleged by the [A]pplicant was not a user by of for the [A]pplicant as owner, but rather as a distributor, agent or importer of wares bearing the [trade-mark TAVOLE ITALIANE] of the Opponent.

[12] The relevant date for considering the circumstances concerning pleadings based upon section 30(i) of the Act is the filing date of the Applicant's application [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB)].

[13] This brings me to review the evidence filed by the Opponent in support of this ground of opposition.

The Garbin affidavit

[14] The Garbin affidavit provides the following information regarding the Opponent and its use of its TAVOLE ITALIANE trade-mark in Canada :

- the Opponent is a wood flooring/covering company that also carries on business as Itlas Laborlegno [para 5];
- the type of floorings/coverings made by the Opponent in association with the trade-mark TAVOLE ITALIANE is illustrated in the copies of catalogues filed under Exhibit A-1. These catalogues are used in Canada for the promotion of the TAVOLE ITALIANE floorings of the Opponent [para 6]. Upon review of this exhibit, I note that the last page of one of these catalogues bears the following mention:

DISTRIBUTED BY
MORUZZI legno
514-863-9416
dino@moruzzi.com
www.moruzzi.com

- in 2007, the Opponent and Moruzzi Ltd (Moruzzi) (represented by Dino Ionescu) signed a distributorship agreement providing for the distribution of all of the Itlas Laborlegno products in the territory of Canada. The agreement provided, among others, that Moruzzi

shall refrain from selling any other wood flooring products that might be in competition with those of Itlas Labolergno for all the duration of the agreement between the parties [para 9; Exhibit A-3 – copy of the Distribution Agreement, clause 8];

- in 2010, the Applicant took over the 2007 Distribution Agreement A-3 [para 10; Exhibit A-4 – copy of Memorandum of Agreement];
- in 2010, the Opponent sold to Moruzzi and the Applicant, 1,543.57 square meters of its TAVOLE ITALIANE floorings, for a total amount of 86,439.92 €, in 2011, to the Applicant and Itlas International LTS., 2,318.17 square meters for 135,781.62 € and, in 2012, to Itlas International LTS, 31.23 square meters for 1,836.32€ [paras 7, 8 and 18; Exhibit A-2 – table showing a breakdown of these sales; and Exhibit A-12 – copies of invoices issued by the Opponent to the Applicant, Moruzzi or Itlas International Ltd. (Itlas International) for, among others, the TAVOLE ITALIANE floorings of the Opponent for the same years];
- Dino Ionescu is president, secretary and treasurer of both the Applicant and Itlas International [paras 12 and 13; Exhibits A-6 and 7 – copy of extracts of the *Registre des entreprises du Québec* with respect to the Applicant and Itlas International]. Upon review of these exhibits I note that the Applicant does business under different names, including Moruzzi Legno Distribution. Itlas International also does business under another name, namely Distributions International Itlas. I further note that Itlas International is located at the very same address provided for the Applicant in the copies of invoices filed under Exhibit A-12;
- in November 2011, the Opponent became aware that the Applicant was not respecting its exclusivity of representation and the Distribution Agreement was not renewed [para 14; Exhibit A-8 – copy of a 2011-11-21 letter of the Opponent to the Applicant];
- the Opponent (through “Paolo Favaro: in charge of the marketing of TAVOLE ITALIANE”) and the Applicant (through Dino Ionescu) have had various email exchanges between the fall 2009 and the winter 2010 with respect to the conception of the catalogues A-1 [para 15; Exhibit A-9]; and

- further documentation concerning these catalogues is attached, namely: Exhibit A-10 consisting of copies of invoices received on March 31, 2010 and in the fall 2011 by the Opponent from two Italian suppliers concerning the designing and printing of the catalogues; and Exhibit A-11 consisting of invoices issued by the Opponent to the Applicant on December 14, 2011 and to Itlas International on January 26, 2012 with respect to, among others, the ordering of copies of catalogues.

[15] I find that the foregoing satisfies the Opponent's initial evidentiary burden.

[16] As reminded by Member Jean Carrière in *International Clothiers Inc v R'Bibo* (2005) CanLII 78152 (TMOB) at page 5: "A distributor is precluded from registering the trade-mark of the manufacturer of the goods it distributes. [See *Lin Trading Co Ltd v CBM Kabushiki Kaisha Ltd* (1987), 14 CPR (3d) 32]."

[17] As per my review of the Garbin affidavit, the Applicant took over the 2007 Distribution Agreement A-3. The letter A-8 expressly reproaches to the Applicant to be "in violation of clause 8 of the Distribution Agreement signed by Moruzzi [...] and later assigned to [the Applicant]." The catalogue A-1 identifying the Applicant as distributor of the TAVOLE ITALIANE floorings of the Opponent; the email exchanges A-9 between the Applicant and the Opponent with respect to the conception of the TAVOLE ITALIANE catalogues A-1; as well as the invoices A-12 issued by the Opponent to the Applicant for, among others, the TAVOLE ITALIANE floorings of the Opponent between December 20, 2010 and December 14, 2011 all support the Opponent's pleading that, as of the filing date of the application, the Applicant was acting as a Canadian distributor of the TAVOLE ITALIANE floorings of the Opponent, and as such, could not be satisfied of its entitlement to the use of the Mark.

[18] As indicated above, the Applicant elected not to file any evidence or written argument. As was the case in *International Clothiers, supra*, there is no evidence in the record that the Applicant could rely on to meet the ultimate burden of proof upon it with respect to this ground. Under the circumstances, I have no alternative but to maintain the ground of opposition pleaded under section 1.3.3 of the statement of opposition.

Remaining grounds of opposition

[19] In view of my finding above, and bearing in mind that the Applicant only showed minimal interest in the present proceeding, it is not necessary to consider the remaining grounds of opposition.

Disposition

[20] In view of the foregoing and 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.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office