



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

Citation: 2010 TMOB 211
Date of Decision: 2010-12-03

**IN THE MATTER OF AN OPPOSITION by
JCM Professional Mini-Storage Management
Ltd. to application No. 1,283,150 for the trade-
mark CENTRAL CITY U-LOCK & Design in
the name of Central City U-Lock Ltd.**

[1] On December 14, 2005, Central City U-Lock Ltd. (the Applicant) filed an application to register the trade-mark CENTRAL CITY U-LOCK & Design (the Mark) based on use in Canada since August 01, 2005 in association with: the operation of a business providing leasing and rental of individual storage spaces in self-storage facilities and the sale of moving, packing and storage supplies (the Services).



[2] Following an examiner's report, the Applicant amended its application to disclaim the right to the exclusive use of LOCK apart from the trade-mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of 21 February, 2007 and on 21 March, 2007 JCM Professional Mini-Storage Management Ltd. (the Opponent), filed a statement of opposition against the application.

[4] The Applicant filed and served a counter statement in which it denies the Opponent's allegations.

[5] In support of its opposition the Opponent filed the affidavit of Robert Madsen. In support of its application the Applicant filed the affidavits of David Bradley, Lisa Saltzman and Dulce De Jesus Queiroga Campos.

[6] Only the Applicant filed a written argument and was represented at a hearing.

Statement of Opposition

[7] The grounds of opposition are based on s. 30(b), s. 30(i), s. 12(1)(b), s. 12(1)(d), s. 16(1)(a), s. 16(1)(b) and s. 2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

Onus and Material dates

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

[9] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a) / s. 30(b) and s. 30(i) of the Act - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b) / s. 12(1)(b) – the filing date of the application [see *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)];
- s. 38(2)(b) / s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c) / s. 16(1) - the date of first use claimed in the application [see s. 16(1)];

- s. 38(2)(d) / s. 2 of the Act - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Opponent's evidence in chief

Affidavit of Robert Madsen

[10] Robert Madsen identifies himself as Vice President of the Opponent. In his affidavit he refers to the Opponent by the acronym JCM. Mr. Madsen explains that “JCM has been in the business of leasing and operating self-storage facilities on behalf of facility owners in the Greater Vancouver area since at least February 1998. The facilities’ owners are licensees of JCM under JCM’s trademark shown below (...). The licensees in question are White Rock/Surrey U-Lock Mini Storage Ltd. and West Shore U-Lock Mini Storage Ltd.”.



[11] Mr. Madsen further explains that the Opponent has leased and operated self-service mini-storage facilities in the Greater Vancouver area since 2003 and that the mark has been used on referral cards, key fobs, business cards, information sheets, advertisements placed in publications and in telephone listings, samples of which are appended as Exhibits B to G.

[12] Exhibit A to Mr. Madsen’s affidavit is a certified copy of application under No. 1,242,654, for the above illustrated trade-mark, covering the leasing and operation of self-service mini-storage facilities. I would observe that application No. 1,242,654 was refused on November 5, 2009 [see *Central City U-Lock Ltd. v. JCM Professionals Mini-Storage Management Ltd.* (2009), 80 C.P.R. (4th) 467 (T.M.O.B.)].

Applicant's evidence in chief

Affidavit of David Bradley

[13] David Bradley identifies himself as a principal of the Applicant. He explains that in 2005 the Applicant decided to design a new trade-mark logo for its storage facilities and after research decided on the name CENTRAL CITY U-LOCK. The Applicant then contracted its graphic designer to create a unique and distinctive logo design. The Applicant's Services are provided in locations in the lower mainland of British Columbia including the communities of Vancouver, Surrey, and White Rock to name a few. The average cost per storage unit is approximately \$100.00 per month and the Applicant currently has approximately 800 customers. Exhibit B is sample advertising consisting of a flyer displaying the Mark, which Mr. Bradley states has been distributed by direct mail. Exhibit C is a printout from the Applicant's website featuring the Mark. There is however no indication as to when and how many of these flyers were distributed. As for the website, Mr. Bradley has not provided any evidence that anyone in Canada has viewed such site.

Affidavit of Lisa Saltzman

[14] Lisa Saltzman identifies herself as Director of the trade-mark searching department with *Onscope* a division of *Marque d'Or Inc.* Part of her employment responsibilities is to review and search the files and records of the Canadian Intellectual Property Office (CIPO) on the *ONSCOPE/Marque d'Or Inc.* database. At the request of the Applicant's trade-mark agent, she was asked to provide Canadian trade-mark, common law and domain name search results for the commonality of "ULOCK" and its phonetic equivalent in association with the general fields of storage or warehousing and locking or security devices. These results are appended as Exhibit "LS" to her affidavit.

Affidavit of Dulce De Jesus Queiroga Campos

[15] Dulce De Jesus Queiroga Campos, identifies herself as a trade-mark assistant for the trade-mark agents of the Applicant. As part of her responsibilities she conducts corporate, trade-mark and Internet searches. In July 2008, she was instructed to conduct an Internet search for the directory listings to ascertain the occurrences of the term U-

LOC, U-LOK, U-LOCK and their phonetic equivalents in Canada. Appended as Exhibit A is a printout of her condensed findings which yielded 449 occurrences for businesses in the self-storage industry. Exhibit B is a printout taken from all of the U-LOC, U-LOK and U-LOCK websites she visited from the search referenced at Exhibit A.

Ground of opposition based on s. 30(b)

[16] The Opponent has pleaded that the Applicant has not used its Mark in Canada in association with the Services since August 1, 2005 and accordingly the application does not comply with the requirements of s. 30(b) of the Act.

[17] In order for this ground to be considered at all, the Opponent must meet its initial evidentiary burden. This initial burden is lighter respecting the issue of non-conformance with s. 30(b) of the Act, because the facts regarding an applicant's first use of its mark are particularly within the knowledge of the applicant [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd* (1986), 10 C.P.R (3d) 84 (T.M.O.B.)].

[18] Mr. Madsen, at paragraph 5 of his affidavit, explains that he has worked in the self-storage industry for approximately 20 years and is familiar with the storage industry in Canada and British Columbia in particular. He states that by virtue of his experience in the industry, he would have known if the Applicant has used its Mark since August 1, 2005, and states that he did not see any such use of the Mark at that time and he believes there was none.

[19] Furthermore, Mr. Madsen, at paragraphs 6 to 9 of his affidavit, recounts third party conversations with respect to use of the Mark. The Applicant however takes the position that these statements constitute inadmissible hearsay and should be deemed inadmissible.

[20] With respect to paragraphs 6 to 9, I would observe that the Opponent has not provided any explanation regarding the necessity or reliability of these statements which contain hearsay.

[21] I am of the view that statements by third parties are inherently unreliable. In this respect, I refer to *The Law of Evidence in Canada*, 2nd ed. Sopinka, Lederman, Bryant, (Toronto: Butterworths, 1999) at page 175: “(...) There is no guaranty of the veracity of the declarant and the trustworthiness of the declarant's statement. The declarant is not under oath and not subject to cross-examination and, therefore, the declarant's perception, memory and credibility cannot be tested. Thus, this evidence is unreliable and is rejected as hearsay.”

[22] In view of the above, I find that the reporting of these third party statements by Mr. Madsen, the truth of which cannot be tested through cross-examination, are inherently unreliable and shall not be considered.

[23] Regarding paragraph 5, I find Mr. Madsen's unsubstantiated statement that he was not aware of the Applicant's Mark being in use, is insufficient and falls short from meeting the Opponent's burden respecting the issue of non-conformance with s. 30(b) of the Act.

[24] Accordingly, this ground is dismissed.

Ground of opposition based on s. 30(i)

[25] Pursuant to s. 30(i), the Opponent has pleaded the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services described in the application.

[26] This ground, as pleaded, does not raise a proper ground of opposition. Even had this ground been properly pleaded, where an Applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the Applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the present case and accordingly this ground is dismissed.

Ground of opposition based on s 12(1)(b)

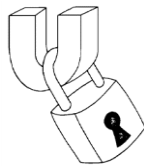
[27] The Opponent alleges that the Mark is not registrable in that it is clearly descriptive of deceptively misdescriptive of the character or quality of the Services in association with which it is used because the Mark evokes a U-Lock facility in the central part of a city.

[28] Although there is a legal onus upon the Applicant to show that its Mark is registrable, the Opponent must first adduce sufficient evidence to support its claim that the mark is clearly descriptive or deceptively misdescriptive [see *John Labatt Ltd. v. Molson Cos.* (1990), 30 C.P.R. (3d) 293(F.C.T.D.) *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[29] As the Opponent failed to adduce any evidence in this regard this ground is dismissed.

Ground of opposition based on s. 12(1)(d)

[30] The Opponent alleges that the Mark is not registrable since it is confusing with registered trade-mark No. TMA245,975 (the “Cited mark”, as shown below) covering storage services, namely, the provision of self-serve storage facilities.



[31] The Applicant has noted that the owner of this registration is not a party to this proceeding. Nevertheless, it has been held that an opponent is free to rely upon third party registration in challenging the registrability of an applicant’s mark in relation to a s. 12(1)(d) ground of opposition [see *U.S.V. Pharmaceuticals of Canada Ltd. v. Sherman and Ulster Ltd.* (1974), 15 C.P.R. (2d) 79 (T.M.O.B.)].

[32] I have exercised my discretion to verify the register and confirm that registration No. TMA245,975 is extant as of today’s date, thus the Opponent has met its initial burden. Accordingly, the legal onus is upon the Applicant to establish on a balance of

probabilities that there is no reasonable likelihood of confusion between the Mark and the Cited mark.

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

[34] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 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 the trade-marks have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)].

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

[35] The first factor under s. 6(5) of the Act is the strength of the marks which is broken down into 2 considerations; their inherent distinctiveness and their acquired distinctiveness.

[36] In terms of inherent distinctiveness, I note that in *Central City U-Lock Ltd., supra*, the term U-LOCK for self-service storage facilities was found to be clearly descriptive. Likewise, I find the U-LOCK portion of the Mark to be clearly descriptive of the Applicant's Services, however, when viewed in its entirety the Mark possesses some measure of inherent distinctiveness owing to its more dominant portion CENTRAL CITY combined with its design elements.

[37] The Cited mark which is the design of a padlock on a hook, which hook resembles the letter U, conveys the idea that these are self-storage facilities that “you lock”. Given its highly suggestive nature it is not an inherently strong mark.

[38] The acquired distinctiveness of the marks at issue is measured by the extent to which the marks have become known. Based on the Applicant’s evidence I find that the Mark has become known to a limited extent in Canada.

[39] The Cited mark has been registered for over thirty years, however without evidence of actual use, the date of first use in the registration can only establish *di minimis* use of the trade-mark in Canada and cannot give rise to an inference of significant and continuing use of the trade-mark in association with the services.

s. 6(5)(b) - the length of time each trade-mark has been in use

[40] The Applicant has used its Mark since August 2005. The Cited mark is based on use since May 1978.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[41] The services are identical as would be the trade-channels.

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

[42] The marks at issue resemble each other only insofar as the design component in each mark consists of a padlock.

Surrounding circumstances

State of the register

[43] The Applicant is also seeking to rely on third party trade-marks, domain names and corporate names to evidence widespread use and adoption of the term U-LOCK and any phonetic equivalent by other traders in the self-storage industry.

[44] 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 [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welsh Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[45] From the search results appended at Exhibit “LS” of the Saltzman affidavit I am of the view that there are four relevant registered trade-marks, all of which also include a padlock design. Moreover, there are 26 registered names, 34 commercial names and 26 domain names all of which include the term ULOCK or its phonetic equivalent.

[46] Additionally, the Campos affidavit reveals the results of the directory listings (Canada411) to ascertain the occurrences of the term U-LOC, U-LOCK and any phonetic equivalent in association with storage services. Although her search yielded 449 occurrences (Exhibit A) I consider that 24 are relevant as they include the term U-LOCK or an equivalent in their corporate name and are in the category of self-storage services. Exhibit B of the Campos affidavit contains 34 relevant printouts from websites that Ms. Campos visited from her search results referenced in Exhibit A.

[47] Based on the foregoing, I am of the view that the average consumer would have some familiarity with third party use of the term U-LOCK with respect to self-storage facilities.

Conclusion re confusion

[48] When applying the test for confusion, it is the totality of the circumstances that will dictate how each consideration must be treated. I have considered that it is a matter of first impression and imperfect recollection. I have also had regard to all the surrounding circumstances including those enumerated in s. 6(5) of the Act.

[49] In most instances, it is the first portion of a mark that is the most important for purposes of distinction. In this case the Mark's first and most dominant portion is significantly different than that of the Cited mark.

[50] Based on the foregoing, I conclude that the Applicant has satisfied its onus to show that on a balance of probabilities there is no reasonable likelihood of confusion between the Mark in association with the applied-for Services and the Cited mark. This is primarily because of the lack of evidence of use of the Cited mark and the differences existing between the parties' marks which outweigh the other factors in the present circumstances.

Ground of opposition based on s. 16 (1)(a)

[51] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark since at the date of first use alleged in the Applicant's application, the Mark was confusing with the Opponent's trade-mark U-LOCK & Design (shown below) covering the leasing and operation of self-service mini-storage facilities.



[52] In order to meet its initial burden, the Opponent must evidence use of its trade-mark in Canada prior to August 1, 2005.

[53] In this respect, Mr. Madsen states that the Opponent began use of its mark in 2003. While he provides samples of such use on referral cards, key fobs, business cards, advertisements placed in publications and in telephone listings [see Exhibits B to G], there is no indication as to when and how many of these items or advertisements were distributed.

[54] Moreover, Mr. Madsen states that use has been through its licensees.

[55] In order for use of a mark by an entity to be deemed that of the Opponent which claims ownership of the mark, the use must comply with s. 50(1) or (2) of the Act.

[56] In the present case there is no evidence that public notice of the nature discussed in s. 50(2) has been given, particularly in light of the following examples, which do not identify any of the named licensees referred to at paragraph 2 of Mr. Madsen's affidavit:

- Exhibit E purports to be a customer information sheet and refers to two different entities, one identified as White Rock / Surrey U-Lock Mini Storage, the other, as White Rock / Surrey U-Lock (a partnership of Limited Liability Companies).
- Exhibit G, is an alleged telephone listing and refers to White Rock /Surrey U-Lock Storage Ltd.

[57] Furthermore the evidence does not satisfy me that s. 50(1) applies in that Mr. Madsen fails to provide any evidence of such licensed use. He does not provide a copy of a licence agreement nor does he provide the terms of any licence agreement whether written or verbal. In addition, there is no indication in his affidavit regarding the control over the character and quality of the services nor is there any statement made Mr. Madsen that any control exists over the character and quality of the services with the trade-mark relied upon.

[58] It follows that use of the above noted mark, if any, does not accrue to the benefit of the Opponent pursuant to s. 50 of the Act.

[59] In view of the above, the Opponent has not met the burden cast upon it and accordingly this ground is also dismissed.

Ground of opposition based on s. 16 (1)(b)

[60] The Opponent has pleaded that the Applicant is not the person entitled to registration since at the date of first use alleged in the Applicant's application, the Mark was confusing with the Opponent's trade-mark which application for registration had been previously filed.

[61] Although the Opponent has failed to identify the prior application number in the pleaded ground, it nonetheless filed as its evidence a certified copy of application

No. 1,242,654 for the trade-mark U-Lock & Design [see illustration at paragraph 10 above] covering the leasing and operation of self-service mini-storage facilities.

[62] Application No. 1,242,654 was filed prior to the Applicant's application and was still pending at the date of advertisement of the Applicant's application.

[63] Accordingly, the Opponent has met its burden respecting this ground, thus the legal onus is upon the Applicant to establish on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark.

[64] It is recalled that the test for confusion is one of first impression and imperfect recollection and in applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act.

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

[65] As earlier stated, I find the Mark as a whole possesses some measure of inherent distinctiveness owing to its more dominant portion CENTRAL CITY combined with its design elements, whereas the Opponent's mark is in my view descriptive in association with the services covered by it.

[66] The acquired distinctiveness of the marks is measured by the extent to which the marks have become known. Based on the Applicant's evidence I find that the Mark has become known to a limited extent in Canada.

[67] For the reasons discussed under s. 16(1)(a) I find the Opponent has not established use of its mark in Canada.

s. 6(5)(b) - the length of time each trade-mark has been in use

[68] Only the Applicant has established use of its Mark.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[69] The services are identical as would be the trade-channels.

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

[70] The marks at issue resemble each other insofar as they share the U-LOCK component.

Surrounding circumstances

State of the register

[71] I have disregarded the evidence contained in the Campos affidavit sworn July 22, 2008 because it is well past the material date with respect to this ground. As for the evidence contained in the Saltzman affidavit, only two relevant trade-marks were registered prior to the material date. I find that such results are of limited assistance to the Applicant's case. In any event, I do not consider that additional circumstances are necessary to find in favour of the Applicant

Conclusion re confusion

[72] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its burden to show that there is no reasonable likelihood of confusion between the marks at issue. The descriptive term U-LOCK (phonetic equivalent of you lock) is simply not one that can be given a broad scope of protection given its ordinary meaning particularly in association with self-storage facilities. Where a trader uses as its trade-mark an ordinary word it cannot expect to hold a wide ambit of protection. In such cases relatively small differences between the marks will suffice to distinguish them.

[73] Furthermore, in most instances it is the first portion of a mark that is the most important for purposes of distinction. In this case the Mark's first portion is the most dominant and is significantly different than that of the Opponent's mark.

[74] In view of the above, I dismiss this ground of opposition.

Distinctiveness ground of opposition

[75] In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition the Opponent's mark had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

[76] For the reasons previously discussed under the ground of opposition based on s. 16(1)(a), I am of the view that the Opponent has not met its initial burden and accordingly this ground is dismissed.

Disposition

[77] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Lynne Pelletier
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

