

IN THE MATTER OF AN OPPOSITION by ClicNet Télécommunications Inc. to
Application No. 1,039,569 for the trade-mark CLIC in the name of CLIC Import
Export Inc.

On December 14, 1999, CLIC Import Export Inc. (the “Applicant”) filed an application to register the trade-mark CLIC (the “Mark”). The application is based on use of the Mark in Canada in association with (1) beans, peas, lentils, rice, corn, flour, oil namely olive oil and vegetable oil, dried beans and canned beans, carrots, mushrooms, tomatoes, artichokes, canned rice, since at least as early as 1985; (2) wheat, pasta, spices, condiments namely herbs, mustards, salts and vinegars, ghee, olives, sauces for meat, pasta and vegetables, vinegar, fruit juices, table syrup, jams, dates, dried fruits, nuts, almonds, pistachios, cheese, pickles, water, tahini, canned vegetables, canned fruits, canned fish, since at least as early as January 1999.

The application was advertised in the *Trade-marks Journal* of July 4, 2001. ClicNet Télécommunications Inc. (the “Opponent”) filed a statement of opposition on December 4, 2001.

The first ground of opposition is that the application does not comply with Section 30(b) of the *Trade-marks Act* (“the Act”) because the Applicant did not use the Mark in Canada in association with the wares identified in the application and did not use the Mark since the claimed dates of first use. The second ground of opposition is that the application does not comply with Section 30(i) of the Act because, as it appears from the statement of opposition, the Applicant falsely made the statement that it was entitled to use the Mark in association with the wares identified in the application. The third ground of opposition is that the Mark is not distinctive of the Applicant’s wares since as a result of a transfer of the Mark, more than one person had rights into the Mark and exercised these rights contrary to the provisions of Section 48(2) of the Act.

The Applicant filed on April 18, 2002 a counter statement denying essentially all grounds of opposition.

The Opponent’s evidence consists of a solemn declaration of Louis-Marius Gendreau, President of the Opponent. The only purposes of his declaration is to introduce into evidence (Exhibit LMG-1) copy of an affidavit of April 12, 2002 of Assad Abdelnour (“the Abdelnour affidavit”), President of the Applicant, filed as evidence in an opposition proceedings to Application No. 1,031,291 for the Opponent’s own trade-mark CLIC. According to Mr. Gendreau, the Abdelnour affidavit recounts facts supporting the Opponent’s grounds of opposition. Mr. Gendreau has not been cross-examined.

The Applicant did not file any evidence. Both parties filed a written argument. No oral hearing was conducted.

The material date for considering the circumstances with respect to the grounds of opposition based upon non-compliance with Section 30 is 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.)]. While the legal burden is on the Applicant to show that its application complies with Section 30, there is an initial evidential burden on the Opponent to establish the facts relied upon by it in support of its Section 30 grounds. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the trade-mark [see *Joseph E. Seagram & Sons Limited v. Seagram Real Estate Ltd.* (1984) 3 C.P.R. (3d) 325 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R. (3d) 293 (F.C.T.D.)].

The material date for considering the issue of distinctiveness of the Mark is generally accepted to be the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) (F.C.T.D.)]. While there is a legal onus is on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of its ground of non-distinctiveness.

The first ground of opposition based upon non compliance with Section 30(b) appears to be pleaded as a two-prong ground of opposition, namely that the Applicant did not use the Mark in association with the wares listed in the application and did not use the Mark in association with the specific wares listed in the application since the claimed dates of first use. To the extent that the relevant facts are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to the ground of opposition based upon non compliance with Section 30(b) is lower [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)].

Prior to dealing with the grounds of opposition, I need to address the issue of the relevancy of the Abdelnour affidavit filed as Exhibit LMG-1. I acknowledge that the Registrar has accepted certified copies or photocopies of affidavits filed in other opposition proceedings where the circumstances justify such a course of action [see *Beachcombers Restaurant Ltd. v. Vita-Park Citrus Products Co.* (1976), 26 C.P.R. (2d) 282 (T.M.O.B.)]. I am not satisfied however that such an approach is justified with respect to the Abdelnour affidavit. In this regard, I note that (a) whether or not the parties to the proceedings are the same; (b) whether or not the trade-mark applied for is the same in both proceedings; (c) the availability of the affiant for cross-examination; and (d) whether or not all, or most, of the issues in both proceedings are

the same, are amongst the circumstances that have to be considered [see *Springwall Sleep Products Ltd. v. Ther-A-Pedic Associates, Inc.* (1984), 79 C.P.R. (2d) 227 (T.M.O.B.)]. Although the Abdelnour affidavit relates to an opposition involving the same parties, it is the Opponent's trade-mark and not the Mark that is the subject of said opposition. In addition, the Opponent cannot make the affiant available for cross-examination. Finally, the Opponent has failed to file submissions on whether or not all the issues, or most of them, are the same in both proceedings. Accordingly, I am not satisfied that the circumstances justify to make the Abdelnour affidavit an affidavit in this proceeding. Mr. Gendreau's declaration is at best evidence that the Abdelnour affidavit was filed in the Applicant's opposition to the Opponent's own trade-mark application [see *Scarabelli v. Jack Spratt Mfg. Inc.* (1985), 6 C.P.R. (3d) 573 (T.M.O.B.); *Innovations Pour L'Élégance Masculine v. Promo-Wear Ltd.* (1985), 2 C.P.R. (3d) 480 (T.M.O.B.)].

In the event that I am wrong in not according any weight to the Abdelnour affidavit, I would still find that it does not lend support to each aspect of the first ground of opposition for the reasons discussed hereafter. I should note that the following comments on the Abdelnour affidavit are made in the context of the present opposition and not in the context of the opposition to Application No. 1,031,291.

While I acknowledge the Opponent's argument that allegations relating to advertisement do not constitute evidence of use within the meaning of the Act, I find that some of the exhibits to the Abdelnour affidavit illustrate product packaging displaying the Mark. The Opponent also argues that the Abdelnour affidavit (a) does not identify the specific food products distributed by the Applicant since 1985 (paragraph 8); (b) does not provide specific information with respect to the dates of first use of the Mark for the Applicant's wares nor does it specifically identify the wares for which the Mark is being used (paragraph 12); and (c) Exhibit K illustrates use of the Mark in association with some food products but not in association with all the wares listed in Application No. 1,039,569. Bearing in mind the fact that the Abdelnour affidavit has been filed in opposition proceedings where the burden of proof resting upon the Applicant as opponent differs from the burden of proof resting upon the Applicant in these proceedings, I believe it would not be proper to hold the lack of reference to specific food products against the Applicant. In addition, and more importantly, there are no clear statements in the Abdelnour affidavit from which it could be concluded that the Mark has been used since a date subsequent to the dates of first use alleged in the application or was not in use at the filing date of the application. Accordingly, I am of the opinion that it would be unfair, in the present opposition, to rely on the Abdelnour affidavit to shift the burden to the Applicant. I should also note that I have disregarded the extracts of the records of l'Inspecteur général des institutions financières au Québec attached to the Opponent's written argument as these have not been properly filed as evidence in the present opposition.

In view of the above, I am not satisfied that the Opponent has meet its evidential burden under Section 30(b). Thus the first ground of opposition is unsuccessful.

With respect to the ground of opposition based upon non-compliance with Section 30(i), the Opponent has essentially alleged that the Applicant falsely made the statement that it was entitled to use the Mark in view of the opposition. The mere fact that the application is being opposed does not support a ground of non-compliance with Section 30(i) of the Act. Thus, I find that the second ground of opposition is unsuccessful. Should I be wrong in my interpretation of the pleading, I would still dismiss the second ground of opposition on the basis that the Opponent did not discharge its evidentiary burden.

Since the Opponent did not submit any evidence supporting its ground of opposition based upon non-distinctiveness, the third ground of opposition is also unsuccessful.

Accordingly, and with the authority delegated to me under Section 63(3) of the Act, I reject the Opponent's opposition pursuant to Section 38(8) of the Act

DATED AT MONTREAL, QUEBEC, THIS 3rd DAY OF FEBRUARY 2005.

Céline Tremblay
Member,
Trade-marks Opposition Board