

TRADUCTION/TRANSLATION



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

Citation: 2011 TMOB 114
Date of Decision: 2011-07-25

**IN THE MATTER OF AN OPPOSITION by
Nautilus Plus Inc. and 88766 Canada Inc. to
application No. 1,297,237 for the trade-mark
STOP DÉPRIME HIVERNALE in the name
of Centres Stop Inc.**

Proceedings

[1] On April 10, 2006, Centres Stop Inc. (the Applicant) filed an application bearing number No. 1,297,237 to register the trade-mark STOP DÉPRIME HIVERNALE (the Mark) in association with

(1) Naturopathic support products namely homeopathic drops, gel caps and pills related to reducing stress, insomnia and depression related to climate conditions. (2) Educational publications, namely books, printed articles, pamphlets and workbooks and worksheets related to reducing stress, insomnia and depression related to climate conditions. (The Wares)

(1) Health services namely auricular therapy related to reducing stress, insomnia and depression related to climate conditions. (2) Counselling, support and rehabilitation services related to reducing stress, insomnia and depression related to climate conditions. (3) Educational services namely designing and providing educational programs, materials and information related to reducing stress, insomnia and depression related to climate conditions and providing educational seminars by Internet related to reducing stress, insomnia and depression related to climate conditions. (The Services)

[2] This application is made on the basis of use of the Mark in Canada since October 2005 in association with the Wares and Services.

[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] 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. 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.

[14] The marks referenced by the Opponent are not only phonetically and visually different, but are also different in terms of the ideas they suggest, despite the presence of the word STOP. The inherent distinctiveness of this word is very weak. As well, the certificates of registration for the marks referenced by the Opponent are for wares that differ from the Wares and Services, except for the wares for the mark TABASTOP. Yet, in this last case, the very lack of resemblance with the Mark is sufficient to find that there is no likelihood of confusion.

[15] Even if the other factors listed at s. 6(5) of the Act weighed in the Opponent’s favour, their weight would not be enough to counter the effect of the lack of any degree of resemblance between the Mark and the registered trade-marks referenced by the Opponent.

[16] I therefore find that there can be no confusion between the Mark and the registered trade-marks referenced by the Opponent in support of this ground of opposition. In the circumstances, the sixth ground of opposition is also dismissed.

Use of the Mark

[17] 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)).

[18] 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.

[19] I should note that there is an anomaly in the numbering of the exhibits appended to Mr. Wallack's affidavit. Mr. Wallack's affidavit makes no reference to Exhibit SW-8, even though this exhibit is appended to it. Therefore, the numbering of the subsequent exhibits is off. I will use the tab number for each exhibit rather than the number Mr. Wallack used in his affidavit.

[20] The Opponent alleges that the trade-mark used by the Applicant is not the Mark. Yet, the Mark appears on the publication filed as Exhibit SW-1, despite the fact that there is a hyphen between the words STOP and DÉPRIME. In addition, there is a second variation of the Mark shown, among others, in Exhibits SW-2, SW-6 and SW-7, in which the letter O in STOP is replaced by a snowflake. I consider the use of these versions to be use of the Mark [see *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].

[21] However, it should be noted that the use of the mark STOP-DÉPRESSION HIVERNALE shown in Exhibits SW-3, SW-4 and SW-5, among others, does not constitute use of the Mark.

[22] Therefore, I cannot accept the Opponent's submissions in support of its second ground of opposition, and I dismiss that ground.

[23] All that 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 date claimed in the application for registration.

Is the Mark used in association with the Wares?

[24] 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 evidence filed by the Applicant does 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].

[25] Mr. Wallack states in his affidavit that Exhibits SW-1 and SW-2 are promotional brochures. This does not constitute evidence of use of the Mark in association with the Wares within the meaning of s. 4(1) of the Act.

[26] I have already found that the Mark was not shown in Exhibits SW-3 to SW-5 inclusively. Therefore, these documents cannot support use of the Mark in association with the Wares.

[27] Exhibit SW-6 is a gift certificate for the Services. Exhibit SW-7 is a photograph of the cover of a hand dryer found in various bars and restaurants in Quebec, on which an advertisement is affixed. Here as well, the advertisement is for the Services. Exhibits SW-11 and SW-12 are photographs of an outdoor sign and a motor vehicle bearing the trade-mark STOP CENTRES, not the Mark. The contents of Exhibit SW-9 make no reference to the Mark. None of these exhibits filed by Mr. Wallack shows the Wares (1), except for Exhibit SW-10, which I will discuss in greater detail below. None of these exhibits can constitute evidence of use of the Mark in association with the Wares within the meaning of s. 4(1) of the Act.

[28] 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 use of the Mark in association with the Wares (2).

[29] 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-10, which is a photocopy of a container for homeopathic drops. However, the mark on the container is STOP CENTRES, not the Mark.

[30] The Applicant alleges that paragraph 18 of Mr. Wallack's affidavit proves that advertising brochures showing the Mark were distributed with homeopathic products such that there is an association between the Mark and its homeopathic products. I can dispose of this argument by reproducing the paragraph in question:

18. Since at least as early as October 2005, Stop Centres provides to its clients a wide range of naturopathic support products for weight loss, weight management, smoking cessation, appetite control, stress reduction and winter blues in connection with promotional brochures or material bearing the STOP DÉPRIME HIVERNALE trade-mark. Exhibit SW-11 [*sic*] to my affidavit is a picture of one such bottle of homeopathic drops.

[31] The product shown in photograph SW-10 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-1, 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 18 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.

[32] Therefore, none of the evidence filed by the Applicant 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-10, but it does not show the Mark. This leads me to conclude that there is substantial doubt regarding the Applicant's allegation that it used the Mark in association with the Wares on the date claimed.

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

Abuse of process

[34] 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.

[35] The mechanism adopted by Parliament to prevent abuse of process through frivolous and meritless opposition proceedings is set out at s. 38(4) of the Act. Under this subsection, when the Registrar receives a statement of opposition, the Registrar must read it to determine whether there is at least one ground of opposition that, on its face, appears to raise a substantial issue. In serving the statement of opposition on the Applicant, the Registrar deemed that, on its face, the statement of opposition was not frivolous. Moreover, this decision shows that one of the grounds of opposition was allowed in part.

Decision

[36] By exercising the powers delegated to me pursuant to s. 63(3) of the Act and in accordance with the principles set out in *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH*, 10 C.P.R. (3d) 482, I allow the application for registration only with regard to the Services, that is,

Health services namely auricular therapy related to reducing stress, insomnia and depression related to climate conditions;

Counselling, support and rehabilitation services related to reducing stress, insomnia and depression related to climate conditions;

Educational services namely designing and providing educational programs, materials and information related to reducing stress, insomnia and depression related to climate conditions and providing educational seminars by Internet related to reducing stress, insomnia and depression related to climate conditions.

and I refuse the application for registration of the Mark with regard to the Wares, that is,

Naturopathic support products namely homeopathic drops, gel caps and pills related to reducing stress, insomnia and depression related to climate conditions;

Educational publications, namely books, printed articles, pamphlets and workbooks and worksheets related to reducing stress, insomnia and depression related to climate conditions.

by operation of s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
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Certified true translation
Sarah Burns