



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

Reference: 2015 TMOB 104
Date of Decision: 2015-06-05

TRANSLATION

**IN THE MATTER OF AN OPPOSITION by
Ubermédia Inc. against application No. 1,504,269
for the trade-mark UBER in the name of Uber
Publicité Inc. operating under the name ‘Uber
Communications’**

Introduction

[1] Uber Publicité Inc., operating under the name ‘Uber Communications’ (the Applicant), filed registration application No. 1,504,269 on November 8, 2010 for the trade-mark UBER (the Mark).

[2] The application is based on use in Canada since January 1, 2004. This application has been amended on several occasions. The last amendment dates back to August 18, 2014 and involved modifying the statement of services, which since then reads as follows: marketing agency, advertising agency, Internet site design for others (the Services).

[3] I would like to point out that the amended application also includes an added reference to the Applicant’s predecessor-in-title, namely Benoît Bousquet.

[4] This application was advertised on October 10, 2012 in the *Trade-Marks Journal* for the purposes of opposition.

[5] On December 10, 2012, Ubermédia Inc. (the Opponent) filed its statement of opposition. This statement of opposition was amended on August 13, 2013 with the registrar's permission. The grounds of opposition raised in the amended statement of opposition are based on sections 30 *a*), 30 *b*) and 2 (distinctiveness) of the *Trade-marks Act*, RSC (1985), c T-13 (the Act). They are described in greater detail in Appendix A of this decision.

[6] The Applicant filed a counter-statement denying each and every ground of opposition. The counter-statement was also amended to respond to the amended statement of opposition.

[7] The Opponent filed the affidavits by Éric St-Martin and Grégory Vadnais-Alcide, dated August 13, 2013 and August 14, 2013, respectively, while the Applicant filed the affidavit by Benoît Bousquet dated March 6, 2014.

[8] The parties each filed a written argument and requested a hearing. However, after receiving the registrar's notice regarding the hearing date, the parties waived their right to be heard.

[9] For the reasons described below in greater detail, I find that the registration application should be refused.

Evidentiary burden

[10] Under the procedure in the matter of opposition to the registration of a trade-mark, the legal onus is on the Applicant to show that the application for registration does not contravene the provisions of the Act. This means that if a decisive conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidentiary burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd. v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

Preliminary comments

[11] Several procedural incidents occurred during the proceedings. I do not intend to describe all of them. I will discuss only the incidental proceedings that I consider important for understanding my decision.

Ground of opposition based on section 30a) of the Act

[12] The Opponent claims that the Services are not described in ordinary commercial terms. In its written argument, it specifically refers to the “Internet purchasing services namely services for the wares and services of others.” However, these services had been removed from the statement of services described in the original application when the Applicant filed its amended registration application on August 15, 2014.

[13] Hence, the ground of opposition based on section 30a) of the Act is now null and void.

Grounds of opposition raised under section 30b)

[14] Thus, following a replacement of agents, the Opponent filed, with the registrar’s permission, an amended statement of opposition dated August 13, 2013. It should be pointed out that the ground of opposition based on section 30 b) of the Act, as described in the amended statement of opposition, contains four parts:

- The Applicant did not exist on the date of first use alleged in the registration application and could therefore not claim to have used the Mark in Canada in connection with the Services since said date;
- The Applicant could not claim to have used the Mark in Canada in association with the Services since the date of first use alleged in the registration application because this date coincides with a statutory holiday in Canada;
- The Applicant did not use the Mark in Canada in association with the Services from the date of first use alleged in the registration application since the Applicant was providing the Services under marks and/or designations different from the Mark, namely UBER PUBLICITÉ and/or UBER COMMUNICATIONS;

- The Applicant has not used the Mark in Canada in connection with all the Services since January 1, 20014.

[15] The first part is now null and void. In fact, on August 18, 2014, the Applicant filed an amended registration application in which it alleged use of the Mark since January 1, 2004 in Canada by itself and its predecessor-in-title, Mr. Bousquet. The sole fact that the Applicant was not legally incorporated on the date of first use alleged in the application registration can no longer support this ground of opposition since the Applicant now refers to use of the Mark in Canada by its predecessor. Such an amendment to a registration application to remedy a shortcoming regarding the chain of title with respect to an applicant's predecessors dating back to the date of first use already alleged in a registration application was already granted by the registrar even near the hearing date [see *Empire Comfort Systems Inc v Onward Multi-Corp Inc* 2010 TMOB 30 and *Athletic Club Group Inc v Ottawa Athletic Club Inc*, 2012 TMOB 217 (CanLII)].

[16] However, it remains to be determined whether the Mark has been used in this manner by the Applicant and/or its predecessor-in-title in Canada in connection with each of the Services since the date of first use alleged in the amended registration application.

Affidavit by Mr. Bousquet dated February 15, 2013

[17] Appended to the original counter statement filed on February 15, 2013 is an affidavit by Benoît Bousquet, the Applicant's president, who was sworn on the same date. In fact, this affidavit was filed prematurely. However, in his affidavit of March 6, 2014 filed as the Applicant's evidence under section 42 of the *Trade-marks Regulations*, C.R.C., c.1559, Mr. Bousquet "reiterates each and every allegation contained in my affidavit of February 15, 2013" [TRANSLATION]. Given this statement, I consider that its content is part of the record. Hence, my later references to Mr. Bousquet's affidavit of March 6, 2014 must be understood as including the statements contained in his affidavit of February 15, 2013.

Reference to ÜBER and UBER

[18] I would like to point out that I have been careful to make a distinction between ÜBER and UBER throughout this decision when I refer to the exhibits filed and the allegations in the parties' affidavits.

Judgment of the Quebec Superior Court

[19] Lastly, in its written argument, the Opponent refers to long excerpts from a judgment by the Quebec Superior Court in *Über Publicité inc v Übermédia inc* 2014 QCCS 1422 (CanLII). I remind the parties that a judgment is not evidence of proof of fact before this court of law, but it can be cited in order to refer to conclusions of law, provided they are relevant.

[20] Since the evidence of record appears to be different than what was presented before the Court and the issues in dispute were not the same as those that I must rule on, I consider this judgment not to be very relevant in this case.

Analysis of the grounds of opposition

Ground of opposition based on section 30 b) of the Act

[21] I will first rule on the argument to the effect that the date of first use is incorrect since it falls on a statutory holiday. I am prepared to take judicial notice that January 1 is a statutory holiday in Canada. I am aware that the registrar has already rendered decisions to this effect [see *Thomas Research Associates Ltd v Daisyfresh Creations Inc/ Créations Daisyfresh Inc* (1983), 81 CPR (2d) 27 (TMOB)].

[22] However, an applicant can always claim a date of first use later than the actual date of first use as a precautionary measure. The date of first use of January 1, 2004 would therefore not be fatal for the Applicant if the evidence of record reveals that Mr. Bousquet, as the Applicant's predecessor-in-title, used the Mark before January 1, 2004. Therefore, is there evidence on file establishing use of the Mark prior to the date of first use alleged in the registration application?

[23] In his affidavit of March 6, 2014, Mr. Bousquet describes the following facts that occurred before the date of first use alleged in the registration application:

4. In late November 2003, I went to see some lawyers to enquire about my duty of loyalty to my former employer, as appears from the invoice for professional fees from Legault, Joly, Thiffault s.e.n.c. appended to this affidavit as Exhibit BB-1;

5. On December 5, 2003, I went to see a notary for the incorporation of the Applicant, as appears from the excerpt of the 2003 agenda, the invoice for professional fees from Bousquet & Bousquet, and the invoice from Marque d'Or appended as a package in support of this affidavit as Exhibit BB-2;

6. In December 2003, I offered my services under the trademark 'UBER COMMUNICATIONS,' as appears from the quotes dated December 8 and 16, 2003 appended as a package in support of this affidavit as Exhibit BB-3;

7. The Applicant and its services have been known commercially since December 2003 under the trademark 'UBER';

[24] Whether Mr. Bousquet had seen a lawyer to obtain a legal opinion on his duty of loyalty toward his former employer and retained the services of a notary for the incorporation of a company does not constitute evidence of use of the Mark in association with the Services under the meaning of section 4(2) of the Act.

[25] However, what about the quotations filed as Exhibit BB-3 in support of his affidavit? I would like to point out, and in fact Mr. Bousquet acknowledges it himself in his affidavit, that the mark that appears on these quotes is ÜBER COMMUNICATIONS. These documents clearly show that the Applicant's predecessor was providing Services in December 2003 in connection with the mark ÜBER COMMUNICATIONS.

[26] However, the Opponent is also arguing that the Applicant did not use the Mark but rather the marks UBER COMMUNICATIONS and UBER PUBLICITÉ. According to the Opponent, the Applicant only began using the Mark in 2012. Hence, despite the reference to the predecessor-in-title, according to the Opponent, the date of first use of the Mark is still incorrect.

[27] If I conclude that use of the mark ÜBER COMMUNICATIONS constitutes use of the Mark, the Applicant will have shown that there had been use of the Mark prior to January 1,

2004 in connection with the Services under the meaning of section 4(2) of the Act. As a result, the Applicant could state in its registration application that the Mark had been used prior to January 1, 2004.

[28] Remember that it is the Opponent who has the initial evidentiary burden and the ground of opposition must be analyzed on the filing date of the application, which in this case is November 8, 2010 [see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 369 (TOMB)]. However, this burden is light [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TOMB)], and the Opponent can refer to the Applicant's evidence to meet its light evidentiary burden [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (CFPI)].

[29] This brings me to review the evidence of record on this point.

Opponent's evidence

Affidavit by Mr. Vadnais-Alcide

[30] Mr. Vadnais-Alcide was a law student who would do research from time to time for the Opponent's agent. He was asked to check the use of the names UBER and/or UBER COMMUNICATIONS and/or any other name and/or trade-mark that contained the word 'uber' used to refer to the Applicant between 2005 and 2013. To this end, he alleges having viewed the archives of two websites that are well known for producing newsletters on developments in the advertising industry, namely: *Infopresse* and *Marketing Qc*.

[31] Mr. Vadnais-Alcide did not explain why he did not view the archives of these websites for January 2004, which is the date of first use of the Mark alleged in this registration application. However, this anomaly has no effect on my decision.

[32] Having read the contents of Exhibits GVA-1 to GVA-4, inclusively, appended to Mr. Vadnais-Alcide's affidavit, namely the excerpts of the archives of *Marketing Qc* and *Infopresse* from August 2005 to April 2013, I noticed that:

- Virtually all of the articles (31 in all) published prior to November 2011 (with the exception of two) refer to Über Communication;
- Virtually all of the articles published after November 2011 (except for one) refer to Über.

[33] Moreover, one of the articles filed by Mr. Vadnais-Alcide dated November 6, 2012 states that ‘Über has just launched its new brand image, along with a new logo, an updated website, and an abbreviated name (the agency has dropped the word ‘communications’ that came after Über)’ [TRANSLATION].

[34] I would like to point out that these articles report on the Applicant’s activities and do not in themselves constitute evidence of use of any mark whatsoever under the meaning of section 4(2) of the Act. However, these articles do show that the Applicant was known under the company name Über Communications until 2012.

[35] Mr. Vadnais-Alcide also visited the online service *Internet Archive - Wayback Machine* and filed pages of the Applicant’s website dated October 3, 2010, which is the only result obtained before the relevant date. In the upper right-hand corner one can see the words ‘Über communications’ written with an upper-case Ü, and ‘Über’ appears in a larger font size than the word ‘communications’ just below ‘Über’.

[36] Mr. Vadnais-Alcide filed excerpts from certain online dictionaries for the word ‘Über.’ ‘Über’ is a German word meaning ‘over’ or ‘above.’ I see that the word’s spelling includes an umlaut over the U. However, the Mark does not have an umlaut.

Affidavit by Mr. St-Martin

[37] Mr. St-Martin is the Opponent’s president. He explained that he searched for the Applicant’s company through the Registraire des entreprises du Québec’s website. He noted that the Applicant was incorporated on January 5, 2004, which is after the date of first use alleged by the Applicant in its registration application.

[38] With this evidence, the Opponent is attempting to prove that it was impossible for the Applicant to have used the Mark as of January 1, 2004. However, as previously indicated, this

anomaly was corrected by the reference in the amended registration application on the use of the Mark by a predecessor-in-title.

[39] This search also revealed that the Applicant has been operating under another name, Über Communications, since March 30, 2004. There is no mention of the use of the Mark or the company name 'Über' in this register since the Applicant's date of incorporation.

[40] Mr. St-Martin added that on November 5, 2012, he learned, via an article published in *Le Grenier aux nouvelles*, a publication specialized in advertising news, quoting a representative of the Applicant, that the latter had decided to stop using the word 'Communications' and to simply refer to itself as 'Über.' He produced a copy of this article as Exhibit ESM-10 to his affidavit. Although this article was published after the relevant date, its contents pertain to facts that occurred during the relevant period.

Applicant's Evidence

Affidavit by Mr. Bousquet

[41] It is interesting to note that Mr. Bousquet, the Applicant's predecessor-in-title and representative, acknowledged that the Applicant used the word 'Über' together with the words 'Publicité' and 'Communication' (sic). In fact, the quotes that Mr. Bousquet prepared in December 2003 bore the name 'Über Communications.'

[42] Mr. Bousquet filed, as Exhibit BB-4 in support of his affidavit of March 6, 2014, excerpts from advertising material developed by the Applicant. However, the excerpts bearing a date are all later than 2011. Two excerpts do not have any date but the stylized form of the word 'Über' corresponds to the new corporate image adopted by the Applicant in October 2010 and described above in more detail in paragraph 35.

[43] I must therefore determine whether use of the mark Über Communications, appearing on the quotes produced as Exhibit BB-3, constitutes use of the Mark. If the answer is yes, the ground of opposition under section 30 *b*), seen from this perspective, must be rejected.

Conclusion on use of the Mark since the alleged date of first use

[44] I have concluded that use of the mark Über Communications by the Applicant dating back to December 2003 constitutes use of the Mark. The word ‘Über’ is predominant, while the word ‘Communications’ is understood as being a descriptive suffix of the Services. Regarding the use of an umlaut over the letter ‘U,’ this is a very minor addition. Hence, the Mark has not been modified such that it has lost its identity. The Mark remains recognizable [see *Canada (Registrar of Trade-marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), CPR (3d) 523 (FCA)].

[45] For all these reasons, I reject the ground of opposition based on section 30(i) of the Act.

Ground of opposition based on non-distinctiveness of the Mark

[46] As indicated in the appendix, the ground of opposition being argued in the amended statement of opposition is worded as follows:

The applicant’s Mark is not distinctive.

[47] It goes without saying that if I had to rule on this ground of opposition without there being any evidence in the record, I would reject it under section 38(3) of the Act since it is not detailed enough. Moreover, this is what the Applicant is asking me to do.

[48] However, the Federal Court of Appeal, in *Novopharm v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA), tells us that once the evidence is included in the record, the ground of opposition must be read jointly with said evidence.

[49] It is generally accepted that the Relevant Date for analyzing this ground of opposition is the filing date of the statement of opposition, namely December 10, 2012) [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[50] In the *Bojangles’ International, LLC v Bojangles Café Ltd* decision, 2006 FC 657, the federal court conducted an exhaustive analysis of the *Motel 6 Inc v No 6 Motel Limited*,

[1982]1 CF638 and *E & J Gallo Winery v Andres Wines Ltd* [1976] 2 FC 3 decisions in order to determine the ‘standard of evidence that must be met in order to prove that a trade-mark was sufficiently known to negate the distinctiveness of another trade-mark.’ [*Bojangles’ op.cit.* paragraph 24].

[51] I will therefore summarize the evidence filed by the Opponent to determine if it has met its initial evidentiary burden.

Evidence of use of the Opponent’s company name

[52] Mr. St-Martin is not only the Opponent’s president but also the president of the firm Uberinnov Inc. (Uberinnov), incorporated on December 14, 2006. Mr. St-Martin explained that the Opponent is a services firm that is specialized in audiovisual production, more specifically the production of high-definition videos using state-of-the-art technology. The Opponent produces audiovisual content, mainly corporate videos and secondarily training videos, promotional videos, event videos, explanatory videos associated with products, web banners and TV commercials, in addition to providing website design services and consulting in the audiovisual field.

[53] Mr. St-Martin is alleging that the company name and the trade-mark UBERMÉDIA as well as the mark ÜBERMEDIA and design, as reproduced below, were transferred from Uberinnov to the Opponent on January 7, 2008, the date of its incorporation, and has produced a transfer deed to this effect:



I note in this graphical representation that the emphasis is placed on the word “ÜBER” as a result of being framed and because of the font size used for the letter “U.”

[54] Mr. St-Martin affirms that the company name “UBERMÉDIA” was used by Uberinnov from January 2007 to January 7, 2008.

[55] To support the alleged use of the company name and/or trade-mark ÜBERMEDIA and of the trade-mark ÜBERMEDIA and design by the Opponent, Mr. St-Martin filed a contract proposal dated June 11, 2007, business cards, and invoices bearing the mark ÜBERMEDIA and design produced by the Opponent starting in January 2007 [see Exhibit ESM-3]. He also produced excerpts of the Opponent’s website advertising these services in connection with the ÜBERMEDIA trade-mark. Other invoices produced between April 2008 and October 2012 by the Opponent for the services described above [see Exhibit ESM-5] and bearing the trade-mark ÜBERMEDIA and design are also appended to his affidavit.

[56] I would like to point out that I consider use of the mark ÜBERMEDIA and design as use of the mark ÜBERMEDIA [see *CII Honeywell Bull, supra*].

[57] Mr. St-Martin claims that the Opponent now has annual sales of \$200,000.00 to \$250,000.00. The Opponent had the following clients on the relevant date, based on the invoices filed as Exhibit ESM-5: Concession A25, Groupe Robert Inc., Table de concertation agroalimentaire des Laurentides and Les Toitures Hogue. Mr. St-Martin lists other clients in his affidavit, but I have no evidence that these companies were the Opponent’s clients on the relevant date.

[58] In light of this evidence, I find that use of the Opponent’s mark ÜBERMEDIA in Quebec for over four years was sufficient at the relevant date to negate the distinctiveness of the Mark. I believe that at December 10, 2012, the Mark was incapable of distinguishing the Services from the Opponent’s services provided in Quebec since January 2007 in connection with the mark ÜBERMEDIA. To justify this conclusion, I will review all the relevant circumstances, including those listed in section 6(5) of the Act, namely, the inherent distinctiveness of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the type of goods, services or enterprises; the type of business; the degree of similarity between the trade-marks in their presentation or sound, or in the ideas they suggest.

[59] In its *Masterpiece* ruling cited above, the Supreme Court of Canada interpreted section 6(2) of the Act and enlightened us as to the scope of the various criteria listed in section 6(5) of the Act.

[60] I note that none of the parties has examined these criteria, except for comments on the Opponent's evidence regarding the state of the register and state of the marketplace.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[61] Mr. St-Martin filed an excerpt from the *Larousse* German-French dictionary taken from the online version of the dictionary. Hence, as previously mentioned, the German word 'über' means 'au-dessus de' in French (above or over).

[62] By filing certain excerpts from *Wikipedia* and from articles from various websites, which are appended to Mr. Vadnais-Alcide's affidavit, the Opponent is attempting to argue that the word 'über' has become part of the English language as a synonym of 'super.' However, the evidence filed in this matter is not sufficient to reach such a conclusion. In addition, the texts that have been produced refer to the United States of America rather than Canada.

[63] Since the Mark is a word in a foreign language and there is no evidence that the average French-speaking, English-speaking or bilingual Canadian knows the meaning of the word, I believe that the Mark has an inherent distinctiveness. With respect to the mark ÜBERMEDIA, it has less inherent distinctiveness than the Mark as a result of the presence of the term 'media,' which suggests the type of services provided by the Opponent.

[64] The distinctiveness of a mark can be enhanced by its use and the extent to which it has become known in Canada due to its use and promotion.

[65] I have already described above in my decision a part of the evidence of use of the parties' marks. In fact, I concluded that the evidence of use of the mark ÜBER COMMUNICATIONS constitutes proof of use of the Mark.

[66] However, this evidence of use of the marks ÜBER COMMUNICATIONS and the Mark is very slight. In fact, there are only five advertising excerpts to show use of the Mark in association with the Services. Mr. Bousquet claims that the Applicant had revenues of \$200,000.00 when its company was formed and \$4,000,000.00 currently. However, Mr. Bousquet does not indicate the Applicant's sales figures in connection with the Mark on the relevant date.

[67] I previously described the Opponent's evidence of use of the mark ÜBERMEDIA, which is slightly more substantial as a result of having filed a package of invoices as Exhibits ESM-3 and ESM-5. I believe that this mark was at least as well known as the Mark on the relevant date.

[68] Under the circumstances, I do not consider that the weight attributed to this factor will be decisive in the analysis of the various factors described in section 6(5) of the Act.

The period during which the trade-marks have been in use

[69] The Opponent has been using the mark ÜBERMEDIA since at least 2007, while the Applicant has been using the Mark since December 2003.

[70] This factor favours the Applicant.

Nature of the services or business; the nature of the trade

[71] There is definitely some overlapping between the Services and the services provided by the Opponent in connection with its mark ÜBERMEDIA described above. The nature of the trade of each is similar.

[72] This factor therefore favours the Opponent.

The degree of resemblance between the trade-marks

[73] The Mark is the primary component of the mark ÜBERMEDIA and its dominant part. I am fully aware that the ÜBER component of the mark ÜBERMEDIA has an umlaut. However, I do not believe that the absence of this punctuation mark and of the word 'media' in the Mark,

at the very least suggestive of the type of services provided by the Opponent, constitute substantial differences that would serve in distinguishing the Mark from the mark ÜBERMEDIA.

[74] For the average consumer who has no knowledge of German, there is a certain visual as well as phonetic resemblance between the Mark and the mark ÜBERMEDIA as a result of the word 'Über' being the primary component of the Opponent's mark.

[75] Hence, this factor favours the Opponent.

State of the register and of the market

[76] The Opponent has filed evidence from the register to demonstrate use of the prefix 'uber' or 'über' as a component in several registered trade-marks. I am referring to the contents of paragraph 11 and Exhibit GVA-8 filed in support of Mr. Vadnais-Alcide's affidavit. Although the research done by Mr. Vadnais-Alcide dates back to August 13, 2013, which is later than the relevant date, the citations filed pertain to marks that were in the register on this date.

[77] Mr. Vadnais-Alcide filed excerpts of 19 marks in the register. Only one trade-mark, 'überbabe,' registered under No. LMC721157, covers services similar to those of the parties in this case. None of the other marks cited in Mr. Vadnais-Alcide's affidavit concerns services that are similar or of the same type as the Services or those provided by the Opponent in connection with its mark ÜBERMEDIA. Hence, evidence regarding the state of the register is not a decisive factor in this case.

[78] Mr. Vadnais-Alcide also searched the Internet to check the use of the term 'uber' by companies in Canada as a component of their company name and/or any trade-mark. He found four companies, namely:

- ÜBER MARKETING, for which he filed excerpts of its website and an excerpt from the Ontario Business Registration, showing that the company was incorporated on September 22, 2006;

- ÜBER DESIGN, for which he filed excerpts from its website. However, we do not know when this entity began its business operations;
- UBERTUS, for which he filed excerpts from its website as well as excerpts from the Corporations Canada registry, showing that this company was incorporated in January 2008; and
- UBERFLIP, for which he filed excerpts from its website. However, we have no information on the entity running this website and for how long the entity has been in business in Canada.

[79] I have noted that Mr. Vadnais-Alcide is referring, with respect to UBERFLIP, to a trade-mark registration application and mentions having filed a copy of this application. However, Exhibit GVA-12 to which he refers does not contain this registration application.

[80] Therefore, the state of the marketplace evidence is very slight, both quantitatively and qualitatively. In fact, only two citations seem relevant (ÜBER MARKETING and UBERTUS), and even in these two cases we have no information on the scope of their business activities in Canada.

[81] I believe that the state of the marketplace evidence is insufficient to constitute a relevant factor in this case.

Conclusion

[82] I have concluded, based on an analysis review of the evidence of record and the parties' arguments, that the Applicant has not met its burden of proof to show that the Mark is distinctive under the meaning of section 2 of the Act, given the use of the mark ÜBERMEDIA by the Opponent at the time its statement of opposition was filed. Said use had the effect of negating the distinctiveness of the Mark on this date, given that the Services are of the same type as those of the Opponent provided in connection with the mark ÜBERMEDIA and that there is a phonetic and visual resemblance between the parties' marks. Thus, a casual consumer somewhat in a hurry who sees the Mark while having only a vague recollection of the Opponent's mark ÜBERMEDIA would probably think that the Applicant and Opponent are one and the same supplier of advertising services.

[83] I therefore maintain this ground of opposition.

Disposition

[84] 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.

Jean Carrière
Member of the Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified translation
Carole Biondic

Appendix A

The grounds of opposition can be summarized as follows:

1. The registration application does not comply with the provisions of section 30(a) of the *Trade-marks Act*, R.S.C. 1985, c T-13 (the Act) in that the Services are not described as stipulated in said section;
2. The registration application does not comply with the provisions of section 30 b) of the Act in that the Applicant has not used the Mark in connection with the Services since January 1, 2004, given that the Applicant only became incorporated on January 5, 2004;
3. The registration application does not comply with the provisions of section 30 b) of the Act in that the Applicant has not used the Mark in connection with the Services starting January 1, 2004, given that this date is a statutory holiday;
4. The registration application does not comply with the provisions of section 30 b) of the Act in that the Applicant has not used the Mark in connection with the Services since January 1, 2004, given that over the years the Applicant was instead providing services under marks and/or designations different than the Mark, namely UBER PUBLICITÉ and/or UBER COMMUNICATIONS;
5. The registration application does not comply with the provisions of section 30 b) of the Act in that the Applicant has not used the Mark in connection with each of the Services since January 1, 2004.
6. The Mark is not distinctive.