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LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 150

Date of Decision: 2017-10-31

IN THE MATTER OF AN OPPOSITION

Remo Cannabrands Inc.

Opponent

and

Advanced Nutrients Ltd.

Applicant

1,524,879 for Urban Grower

Application

INTRODUCTION

[1] Advanced Nutrients Ltd. (the Opponent) opposes registration of the trade-mark Urban Grower (the Mark) in the name of Remo Cannabrands Inc. (the Applicant).

[2] A key issue in this proceeding is which party owned the Mark and which party was using it. The Opponent alleges that it conceived of the Mark in 2004 for use with a video series to assist people grow marijuana and has owned it since then with the Applicant having a license to use it; whereas the Applicant alleges that it owns the Urban Grower video series which it stars in and the Opponent is a mere sponsor of the series. Determining the owner of the Mark is necessary in order to assess each of the grounds of opposition pleaded with respect to whether (i) the Applicant is the person entitled to registration of the Mark pursuant to section 16 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act), (ii) the Mark is distinctive of the Applicant

pursuant to section 2 of the Act, and (iii) the application includes the requirements set forth in section 30 of the Act.

[3] For the reasons that follow, this application is refused as the Applicant has failed to show that it is entitled to use the Mark in Canada. The Opponent's opposition to the Mark for use in association with the goods described as instructional videos in the field of horticulture and entertainment videos in the field of horticulture also succeeds on the basis that the Applicant was not the person using the Mark as of the date claimed in the application.

BACKGROUND

[4] On April 26, 2011, Remo and Sandra Colasanti, a Partnership filed an application to register the Mark. The application was filed based on use of the Mark in Canada in association with instructional videos in the field of horticulture and entertainment videos in the field of horticulture since June 1, 2005 and proposed use of the Mark in association with:

Clothing, namely t-shirts, ball shirts, and sweatshirts, hats. Accessories, namely smoking pipes, wallets, bracelets.

Instructional services, namely providing online videos in the field of horticulture.

Entertainment services, namely, providing online videos in the field of horticulture.

The application for this trade-mark was assigned on June 20, 2014 to Remo Cannabrands Inc. The Applicant is used collectively to refer to both the partnership of Remo and Sandra Colasanti and Remo Cannabrands Inc.

[5] The application was advertised for opposition purposes in the Trade-marks Journal of April 17, 2013.

[6] On June 4, 2013, the Opponent opposed the application. The grounds of opposition are summarized below:

- (a) The application does not comply with section 30(i) of the Act as at the date of filing of the application, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the goods and services, since at the date of filing, the Applicant was or should have been aware that the

Opponent was the owner of the Mark and had not consented to the filing of the application.

- (b) The application does not comply with section 30(b) of the Act as the Applicant had not used the Mark in association with instructional videos in the field of horticulture and entertainment videos in the field of horticulture since June 1, 2005, the date of first use alleged in the application. Any use of the Mark by the Applicant as of this date was under the control of and enured to the Opponent.
- (c) The Applicant is not the person entitled to registration of the Mark pursuant to sections 16(1)(a), 16(1)(c), 16(3)(a) and 16(3)(c) of the Act as the Mark is confusing with the Opponent's trade-mark and trade-name URBAN GROWER.
- (d) The Mark is not distinctive within the meaning of section 2 of the Act as the Mark does not distinguish, nor is adapted to distinguish, the Applicant's goods and services from the goods and services of others, including the Opponent's goods and services sold and performed in association with its trade-mark URBAN GROWER.

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

[8] The Opponent filed as its evidence the affidavit of Nick Maltchev. Mr. Maltchev was cross-examined.

[9] The Applicant filed as its evidence the affidavits of Remo Colasanti and David Blair Walters. Both Mr. Colasanti and Mr. Walters were cross-examined.

[10] The Opponent was granted leave to file the affidavit of Jason Wettstein. The Opponent filed as its reply evidence the affidavit of Mike Straumietis and was granted leave to file a further affidavit of Mr. Straumietis attaching a picture which should have been attached to his reply evidence. Mr. Wettstein and Mr. Straumietis were cross-examined (with Mr. Straumietis' examination covering both affidavits).

[11] Both parties filed a written argument and attended a hearing.

PRELIMINARY ISSUE: LEAVE TO AMEND THE STATEMENT OF OPPOSITION

[12] In its written argument, the Opponent requested leave to amend the statement of opposition to include an additional ground of opposition [Opponent's Written Submissions, paras 91-98]. Specifically, that in contravention of section 30(e) of the Act, the Applicant had used the Mark in association with the services prior to the filing date. Unfortunately, the Registrar did not follow its usual practice of soliciting comments from the Applicant and ruling upon the requested amendment at the time it was filed. At the hearing, the Applicant objected to the Opponent's request.

[13] I refuse leave to amend the statement of opposition as it is not in the interests of justice to do so. The practice notice *Practice in Trade-marks Opposition Proceedings* indicates that in assessing whether a proposed amendment is in the interests of justice, the Registrar will have regard to: (i) the stage the opposition proceeding has reached; (ii) why the amendment was not made earlier; (iii) the importance of the amendment; and (iv) the prejudice which will be suffered by the other party. First, the Opponent's submission that the ground only became apparent when preparing the written argument does not adequately explain the delay between receiving the Applicant's evidence on July 10, 2014 and/or cross-examining Mr. Colasanti on December 16, 2014 and requesting leave to amend the statement of opposition on October 17, 2016. Second, at the time the request was made the opposition was at an advanced stage. Third, the amendment is important as it introduces a new ground of opposition which was not alleged or based on facts set out in the statement of opposition. Finally, if granted the Applicant will suffer significant prejudice since at the time of filing its evidence, it did not know such a ground of opposition was contemplated and did not have the opportunity to address this allegation. While the Opponent is prejudiced by the denial of its request, I do not find that given the amendment was requested at a late stage, namely, the filing of the written arguments, that this outweighs the potential prejudice to the Applicant who would not have been aware of the case it had to meet during the evidence stage of this proceeding.

EVIDENCE

[14] At the outset, I note that the evidence of the parties is similar in almost all respects, with the exception of the evidence given about the ownership of the trade-mark URBAN GROWER.

Opponent's Evidence

Evidence of Nick Maltchev

[15] Mr. Maltchev is the General Manager of the Opponent. His evidence is that in February 2004, the Opponent entered into an arrangement with Mr. Colasanti whereby Mr. Colasanti would produce videos for the Opponent in exchange for nutrient products from the Opponent (para 7). Mr. Maltchev states that the first video produced by Mr. Colasanti was entitled "The Urban Grower – Volume 1" and was posted on Advanced Nutrients' website *www.urbangrower.com* in April, 2004 (para 8). The video series is very popular and between December 2012 and December 2013 the *urbangrower.com* website received over 11 million hits (para 12). The accounting records of the Opponent indicate from 2006 until 2013, Mr. Colasanti received reimbursement of expenses through compensation in nutrient products valued between a low of \$27,000 (in 2009) and high of \$248,000 (in 2012) (para 7). Mr. Maltchev states that it was the intention of the parties that Mr. Colasanti would merely produce the videos with ownership of the videos and the Mark belonging to the Opponent (para 9). On cross-examination, Mr. Maltchev admitted that the negotiations regarding the Mark took place before he joined the company (Cross-examination Q8).

Evidence of Mike Straumietis

[16] Mr. Straumietis, Chief Executive Officer of the Opponent, states that in 2004 the Opponent entered into an arrangement with Mr. Colasanti, whereby Mr. Colasanti would produce videos for the Opponent in exchange for nutrient products (para 9). Mr. Straumietis states that while no formal agreement was entered into, the parties followed this arrangement from mid-2004 until May, 2013 (para 9).

[17] With respect to the issue of the name Urban Grower, Mr. Straumietis states (para 10):

... At no time did I or anyone at Advanced Nutrients promise to give Mr. Colasanti the URBAN GROWER name. In fact, at the time of my initial meetings with Mr. Colasanti to discuss the production of these videos I made it very clear to him that the name “Urban Grower” would remain the property of Advanced Nutrients.

Similar statements were made at his cross-examination (Straumietis, Q44).

[18] Mr. Straumietis also states that there have been no sales of instructional videos. He explains at para 16:

... The videos that Mr. Colasanti produced were initially posted on the *www.urbangrower.com* website and subsequently on YouTube. These videos were intended for viewing only and were not intended for downloading or for sale.

[19] At the hearing there were many submissions about the fact that Mr. Straumietis appears to have been facing criminal charges and was subject to a deportation order in 2004-2005 (Straumietis examination, Qs 31-35; 49-52; Exhibit 1). The Applicant submits that the Opponent chose to merely be a sponsor in order to distance Mr. Straumietis and his company, Advanced Nutrients, from any potential legal issues (Applicant’s Written Submissions, para 45). While Mr. Straumietis may have chosen not to be involved with the filming or production of the video series due to his own legal issues, I do not find that I can make the inference that he gave ownership of the trade-mark rights to Mr. Colasanti as a result of this. Particularly, in view of the fact from 2004-2006 the Opponent owned the domain name *urbangrower.com* and was in charge of posting the URBAN GROWER videos on-line.

Evidence of Mr. Wettstein

[20] Mr. Wettstein is a web designer and graphic artist (para 1). He was employed by the Opponent as its Creative Director and was working with the Opponent from 2001-2006 (paras 1-2). His evidence is that initially Mr. Colasanti’s role was to be the on-air personality and that the content and production of videos was to be Mr. Wettstein’s and Mr. Straumietis’ responsibility (para 8). On cross-examination, Mr. Wettstein’s evidence is that he shot the first three episodes and trained Mr. Colasanti in the production of the videos going forward (Qs26-30; para 8). In his affidavit, Mr. Wettstein makes several statements about Mr. Straumietis’ control over the content of the videos (para 10). While this may have been the case when the videos were being posted to the *urbangrower.com* website in 2004-2006, once Mr. Colasanti began posting the

videos to his own Youtube channel there is no evidence on which I can make an inference that any control over the quality of the videos was being exercised by the Opponent other than it must have been satisfied with the content as Mr. Colasanti continued to be remunerated. As such, I do not place any weight on Mr. Wettstein's comments regarding control by Mr. Straumietis to the extent these comments are intended to apply to the period of time after 2006.

Applicant's Evidence

Evidence of Remo Colasanti

[21] Mr. Colasanti explains that in 2003 him and his wife Sandra were performing charity work, assisting persons suffering from AIDS, HIV and other illnesses grow medical marijuana legally, and safely, in order to relieve stress and pain (paras 2-3). As there was no funding, Mr. Colasanti paid for all supplies from his own resources (para 3). In 2004, Mr. Colasanti's acquaintance Mr. Walters invited Mr. Colasanti to meet with Mr. Straumietis who was looking for a vehicle to assist in the sale of the products of the Opponent (para 5).

[22] Mr. Colasanti describes the arrangement as follows (para 5):

... The video series would feature the products of Advanced Nutrients Ltd. Advanced Nutrients Ltd. would not pay anything, but would provide us with plant nutrients for use in the videos. Mike had no interest in the video series, per se, and it was agreed that the video series would belong to me. Advanced Nutrients Ltd. was not prepared to pay me anything for my time and involvement. I accepted, in order to gain access to the free nutrients for my charity work.

[23] As the video series expanded in April/May 2005, the Opponent reimbursed Mr. Colasanti for his expenses (para 7) and then paid for monthly sponsorships (para 9). At this time, Mr. Colasanti became a retailer of the Opponent and had the opportunity to purchase additional nutrients at wholesale prices (para 8). Ultimately, the video series has proven to be successful extending to hundreds of episodes involving millions of online hits (para 12).

[24] The following paragraphs of Mr. Colasanti's affidavit are relevant to the issue of ownership:

- 11 That YouTube was not known at the time, so the URBAN GROWER series was placed on a website *urbangrower.com*. In view of the relationship with Advanced Nutrients and their interest in promoting their products, the hosting of the website was arranged by Advanced Nutrients.
- 13 That over the course of the years the public has come to identify the URBAN GROWER name with my personality ... marked as Exhibit B is a DVD jacket ... sold to the public in 2007 ... on the DVD jacket I am identified as the URBAN GROWER. ...
- 14 That my relationship with Advanced Nutrients has deteriorated and at this stage I regret that I allowed them to arrange for the hosting of the website, as it has complicated what would otherwise be a straightforward matter.

Evidence of David Blair Walters

[25] Mr. Walters identifies himself as the producer/director/ writer and video editor of all Urban Grower videos produced between 2004-2007 (para 1).

[26] Mr. Walters states that he and Mr. Straumietis had discussed making a medical cannabis growing show which would feature Advanced Nutrients' products (para 4). Mr. Walters knew about Mr. Colasanti's work in helping people grow medical marijuana and Mr. Straumietis agreed to sponsor the show (para 5). Advanced Nutrients had registered several domain names and Mr. Walters reviewed those domain names to see if any were suitable for the project with Mr. Colasanti. The domain name *urbangrower.com* was chosen for the project and Mr. Colasanti appeared in videos as the Urban Grower (para 7).

[27] At paragraph 6 of his affidavit, Mr. Walters provides his evidence on the issue of ownership and control of the Mark:

After the agreement, there were very few, if any, further discussions between Michael Straumietis and I, about the structure of the video series. It was left up to Mr. Colasanti and I to create video content, from conceptualizing to rendering. Michael Straumietis did not care about the content or what name was used, as long as there were Advanced Nutrients Ltd products being featured. Advanced Nutrients Ltd made no agreement to pay anything for Mr. Colasanti's time, but did agree to provide Mr. Colasanti with free nutrient products. Mr. Colasanti would have the rights to the name and Mr. Colasanti would have the rights to the content produced. In 2004, Youtube was not know, so it was agreed that the videos would be placed on a website. The name of the video series had not been determined at that time.

LEGAL ONUS AND EVIDENTIAL BURDEN

[28] Before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[29] With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

GROUND OF OPPOSITION

Section 30(b) Ground of Opposition

[30] Turning first to the section 30(b) ground of opposition, the application for the Mark claims a first use date of June 1, 2005 in association with “instructional videos in the field of horticulture and entertainment videos in the field of horticulture”.

[31] Section 30(b) of the Act requires that there be continuous use of the applied for trademark in the normal course of trade from the date claimed to the date of filing of the application by the applicant or its named predecessors in title [see also *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[32] The Opponent alleges the following in its statement of opposition:

The application does not comply with section 30(b) of the Act as the Applicant had not used the Mark in association with “instructional videos in the field of horticulture

and entertainment videos in the field of horticulture” since June 1, 2005, the date of first use alleged in the application. Any use of the Mark by the Applicant as of this date was under the control of and enured to the Opponent.

[33] In its written submissions, the Applicant submits that the sale of videos from the Applicant to the Opponent for posting on the Opponent’s *urbangrower.com* website constitutes use (Applicant’s written submissions, para 40):

The current application has been based upon use. As such, use must be demonstrated. Depending upon how the issue of ownership of the [Mark] is viewed, the sale of videos from the Applicant to the Opponent constitutes use. Exhibit 1, from the Examination of Wettstein places before [the Registrar] all 24 pages of the *urbangrower.com* website. Also relevant to the issue of use, is the evidence of the sale of videos directly to the public, albeit on a somewhat limited basis.

[34] Based on the evidence set out below, I find that the Opponent was the owner of the Mark and any use by the Applicant would have enured to the Opponent as of the date of first use claimed in the application:

- (a) The Opponent sought to make a medical cannabis growing show that would feature and promote the Opponent’s products (Walters affidavit, paras 4-5).
- (b) The name for the show was chosen from a list of domain names registered by the Opponent (Walters affidavit, para 7; Colasanti cross-examination, Q61).
- (c) Mr. Wettstein, an employee of the Opponent’s, directed the first three videos and showed Mr. Colasanti how to use the camera and edit (Wettstein cross-examination, Qs 26-31).
- (d) Mr. Colasanti was compensated for out of pocket expenses for travel, production and equipment. Specifically, for each \$100 of out of pocket expenses, he would receive \$100 worth of nutrients (based on their wholesale price) (Colasanti affidavit, para 7; Exhibits A and C).
- (e) The Opponent owned the domain name *urbangrower.com* and was responsible for posting the videos made by Mr. Colasanti (see Q107 of the Colasanti cross-examination where Mr. Colasanti attests that he created a YouTube account on

June 5, 2006 “because they did not post my materials fast enough on *urbangrower.com*”). The Applicant’s Written Submissions at para 22 concede this:

It is common ground that the first episodes of the video instructional series were placed on a website *urbangrower.com* which was owned and controlled by the Opponent and later moved to U-tube channels controlled by the Applicant [citing the Maltchev affidavit, paras 8, 11; Walters affidavit – para 7; Colasanti affidavit- para 11 and Straumietis affidavits, paras 10-11].

- (f) Contact information for Advanced Nutrients appears at the end of some of the videos. For example, Mr. Colasanti agrees that the video *Urban Grower Volume 1 End* includes at the end “Send us an email and have Remo visit your garden” and provides the contact as *info@advancednutrients.com* (Colasanti examination 118; Exhibit 5).
- (g) In finding that the Opponent was the owner of the Mark at the date of first use claimed in the application, I did not rely on the statements provided by the affiants with respect to the issue of ownership. Mr. Straumietis and Mr. Maltchev gave evidence that the Opponent owned the rights in the trade-mark URBAN GROWER and the Applicant was advised accordingly (Straumietis affidavit, para 10; Maltchev affidavit para 9). Mr. Colasanti and Mr. Walters gave evidence that the Applicant owned the Mark and the video series (Walters affidavit, para 6; Colasanti affidavit, para 6; Colasanti cross-examination, Qs 39-40; 62). These bare assertions and bald statements were offered more than seven years after the material date and are largely unsubstantiated by the few documents provided. In the circumstances, I am placing no weight on them and resolve the issue of ownership based on inferences I can make from the few documents provided and the parties’ actions around 2005.

[35] As such, it appears that use of Mark in association with instructional videos in the field of horticulture and entertainment videos in the field of horticulture as of June 1, 2005 was use by the Opponent and not the Applicant. This ground of opposition therefore succeeds.

[36] Finally, the Applicant cannot rely on sales of the DVDs to meet its legal onus. Mr. Colasanti's evidence is that he first offered for sale a DVD featuring the Mark to the public in 2007 (Colasanti affidavit, para 13, Exhibit B) which is well after the date of first use claimed. Further, it appears no sales were made (Colasanti, Answers to Undertakings).

Section 30(i) Ground of Opposition

[37] The Opponent alleges the following in its section 30(i) ground of opposition:

The Application does not comply with the requirements of Section 30(i) in that at the date of filing the Application, the Applicant could not have been satisfied that it was entitled to use the Trade Mark in Canada in association with the [applied-for goods and services], since ... the Applicant was or should have been aware that the Opponent was the owner of the Trade Mark URBAN GROWER ... and had not consented to the filing of the Application.

[38] The material date for considering this ground of opposition is April 26, 2011, the date of filing the application [*Georgia-Pacific Corp. v Scott Paper Ltd.* (1984), 3 CPR (3d) 469 at 475].

[39] Section 30(i) requires an applicant to indicate as part of its application that it is satisfied that it is entitled to use the trade-mark in Canada in association with the applied-for goods and services. The statement provided by section 30(i) purports to be evidence of the applicant's good faith in submitting its application [*Cerverceria Modelo S.A. de C.V. v Marcon* (2008), 70 CPR (4th) 355 (TMOB) at 366]. Where an applicant has provided the statement required by section 30(i), this ground of opposition should only succeed in exceptional cases. The Registrar has previously found exceptional cases where (i) there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]; and (ii) where there is a prima facie case of non-compliance with a federal statute such as the *Copyright Act* RSC 1985, c C-42 or, *Food and Drugs Act*, R.S.C. 1985, c. F-27 [*Interactiv Design Pty Ltd. v Grafton-Fraser Inc.* (1998), 87 CPR (3d) 537 (TMOB) at 542-543].

[40] In this case, for the reasons set out in paragraph 34, I find that in 2005 the Opponent owned the Mark and the use by the Applicant enured to it. Further, I do not find that the evidence supports the fact that the Opponent abandoned its ownership of the trade-mark URBAN GROWER or transferred it to the Applicant subsequently. In particular, I note that it maintained

the domain name registration for *urbangrower.com* and continued to make payments to Mr. Colasanti. At the material date, while the Opponent may not have been controlling or involved with the content of the videos, posting them or updating the *urbangrower.com* website, it was compensating the Applicant for its production of them. Furthermore, the Applicant concedes that the primary purpose of the video series was to promote the products of the Opponent (see Applicant's Written Submissions, para 19 citing Walters affidavit, para 4; Straumietis affidavit, para 7; Wettstein affidavit, para 6). There is no evidence that at the material date the videos were still not a promotional vehicle for the Opponent. In the alternative, if I had accepted that the trade-mark URBAN GROWER had been transferred to the Applicant, I would have found that such a transfer depended on the series continuing to promote the products of the Opponent due to the long standing relationship between the parties. I note that the goods and services applied-for have no such restriction.

[41] Mr. Colasanti explains in his cross-examination that Mike Straumietis said "it's your show, do whatever you want" and "Advanced Nutrients had absolutely zero input into any of the content, any of the locations, what we did" ... "when you do the entire video and you edit it, when you produce it, when you shoot it and you provide all the actors or people in it and everything, that makes it a hundred percent your video" (Colasanti examination, Qs 39-40; 62). I do not find based on these statements that the Opponent had confirmed to the Applicant that it owned the rights to the trade-mark URBAN GROWER. Rather it appears to me that the parties had reached an agreement whereby the video series was a vehicle to promote Advanced Nutrients; albeit one at this date which did not involve input from the Opponent (Colasanti cross-examination, Q123). Therefore, the Opponent has met its evidential burden of adducing evidence from which it may reasonably be concluded that the facts alleged to support this ground of opposition exist [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at para 34 for the requirements to meet an evidential burden].

[42] Where an applicant has provided the statement required by section 30(i), the case law confirms that this ground should only succeed in exceptional cases. This is an exceptional case. The parties had a long standing relationship beginning in 2004 whereby Mr. Colasanti hosted videos with the goal of promoting use of the Opponent's nutrient products and was compensated accordingly. Further, it appears that all parties agreed that the purpose of the URBAN

GROWER videos was to promote the products of the Opponent (Walters affidavit, para 4; Straumietis affidavit, para 7; Wettstein affidavit, para 6) and so long as the Opponent's products were featured, the Opponent did not care about the content (Walters affidavit, para 6).

[43] Even though Mr. Colasanti may not have understood that it was inappropriate to file the application, this does not preclude the Opponent from succeeding on the section 30(i) ground since the Applicant cannot meet its burden of showing that it could make the statement it was entitled to use the Mark in Canada [*Lifestyles Improvement Centers, LLP v. Chorney* (2007), 63 CPR (4th) 261 (TMOB) at 274-275]. As the ultimate onus is on the Applicant and I cannot determine that the Applicant's version of the facts is the correct one, namely, that at the material date the Applicant owned the rights in Canada to the trade-mark URBAN GROWER for use in association with the goods and services, the balance of probabilities favours the Opponent. The section 30(i) ground therefore succeeds.

Grounds of Opposition Based on Sections 16(1)(a), 16(3)(a) and 2

[44] I will next consider the grounds of opposition based on sections 16(1)(a) 16(3)(a), and 2 of the Act. Each of these grounds of opposition is founded on an allegation that at the material date the Opponent was the owner of the trade-mark URBAN GROWER.

[45] The material date for the section 16 grounds of opposition is April 26, 2011, the filing date of the application [see section 16(3) of the Act and *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB) which provides that if an opponent successfully challenges the date of first use, the material date becomes the filing date of the application]. The material date for the section 2 ground of opposition is June 4, 2013, the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[46] In order to meet its evidential burden, the Opponent must provide evidence from which I can find on the balance of probabilities it was the owner of the trade-mark URBAN GROWER as of April 26, 2011 and June 4, 2013 and that any use of the trade-mark at this date enured to it. The Opponent fails to meet its burden as it cannot rely on use of the videos made by Mr. Colasanti since there is no evidence that the Opponent controlled the quality of the videos posted

such that I could find that Mr. Colasanti's use enures to the Opponent [see section 50 of the Act]. As such, these grounds of opposition are rejected.

Sections 16(1)(c) and 16(3)(c) Grounds of Opposition

[47] I will lastly consider the grounds of opposition based on sections 16(1)(c) and 16(3)(c) of the Act in which the Opponent alleges that it has used the trade-name URBAN GROWER and as such the Applicant is not the person entitled to registration of the Mark.

[48] The Opponent fails to meet its burden with respect to the sections 16(1)(c) and 16(3)(c) ground of opposition as the Opponent has not evidenced use of the trade-name Urban Grower pursuant to section 4(2) of the Act [*Professional Publishing Associates Ltd v Toronto Parent Magazine Inc* (1986), 9 CPR (3d) 207 at 217 (FCTD)] at the date of filing the application. There is no evidence that the Opponent used the trade-name Urban Grower and, in this regard I do not consider the use of the domain name *urbangrower.com* to be use of a trade-name. Accordingly, the sections 16(1)(c) and 16(3)(c) grounds of opposition are rejected.

DISPOSITION

[49] 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.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2017-06-06

APPEARANCES

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