

**LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS**

**Citation: 2019 TMOB 101
Date of Decision: 2019-09-30**

IN THE MATTER OF OPPOSITION

Align Technology, Inc.

Opponent

and

Osstemimplant Co., Ltd.

Applicant

Application

1,749,696 for Magicalign

[1] Osstemimplant Co., Ltd. (the Applicant) has applied for the trademark Magicalign (the Mark) for use in association with custom orthodontic instruments; mouthpieces for orthodontics; orthodontic appliances (the Goods).

[2] Align Technology, Inc. (the Opponent) has opposed this application primarily on the basis that the Magicalign trademark is confusing with its registration for and previous use of the trademarks ALIGN and INVISALIGN and trade names Align Technology and Align Technology, Inc. with various orthodontic and dental goods and related services.

[3] For the reasons that follow, I find that this opposition should be rejected.

Background

[4] On October 8, 2015 the Applicant filed an application for the Mark based on its proposed use in association with the Goods. The application claims a priority filing date of September 24, 2015. The application was advertised for opposition on May 25, 2016.

[5] On October 20, 2016, the Opponent opposed the application on several grounds pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (Act). This Act was amended on June 17, 2019. All references are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[6] The Opponent has pleaded non-compliance with section 30(e) of the Act as the basis of one of its grounds of opposition. The remaining grounds of opposition turn on the determination of the likelihood of confusion between the Opponent's registrations for the trademarks ALIGN, INVISALIGN, INVISALIGN Design, INVISLIGN INTERLINK and ALIGNTECH INSTITUTE Design and its use of these trademarks and its trade names Align Technology and Align Technology, Inc. pursuant to sections 12(1)(d), 16 and 2 of the Act. The Applicant filed and served a counter statement denying the Opponent's allegations. The Opponent's evidence consists of the affidavits of Karrie Anger, Mary P. Noonan, and Joanne Berent. The Applicant did not file any evidence. Both parties filed a written argument and attended a hearing.

Material Dates and Onus

[7] While various grounds of opposition are pleaded, the determinative issue for decision is whether the applied-for trademark Magicalign is confusing with the Opponent's trademarks INVISALIGN and ALIGN. The earliest material date to assess the issue of confusion is the priority filing date, September 24, 2015, while the latest material date is the date of my decision [*American Assn of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206-208 for a review of material dates in opposition proceedings.]

[8] Before considering the issue of confusion between the parties' marks, 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.


[9] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an 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 an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (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.


Section 12(1)(d) Ground of Opposition

[10] The material date for this ground of opposition is the date of the decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[11] In support of the section 12(1)(d) ground of opposition, the Opponent relies on the following registrations listed in the statement of opposition and attached to the affidavit of Mary P. Noonan.

Trademark (Registration No.)	Goods and Services
ALIGN (TMA721,063)	(1) Dental apparatus, namely plastic orthodontic appliances, namely orthodontic devices for use in treating malocclusions. (2) Dental apparatus, namely plastic orthodontic appliances.
ALIGN (TMA721,064)	(1) Training in the use of orthodontic appliances; orthodontic services.
INVISALIGN (TMA565,855)	(1) Dental apparatus, namely, plastic orthodontic appliance.

Trademark (Registration No.)	Goods and Services
INVISALIGN (TMA657,972)	(1) Computer software, namely digital imaging software used to depict tooth movement and proposed treatment plan; computer software used to provide, track and modify proposed courses of orthodontic treatment and patient data and information related thereto. (2) Dental apparatus, namely plastic orthodontic appliance.
INVISALIGN (TMA711,091)	(1) Training in the use of orthodontic appliances. (2) Orthodontic and dental services.
 (TMA783,865)	Goods (1) Computer software, namely digital imaging software used to depict tooth movement and proposed treatment plans; computer software used in creation of individually customized courses of orthodontic treatment; computer software used to provide, track and modify proposed courses of orthodontic treatment and patient data related thereto; dental apparatus, namely, orthodontic appliances. Services (1) Custom manufacture of orthodontic appliances; dental laboratory services; training in the fields of dentistry and orthodontia; dentistry; orthodontic services; consultation services in the fields of dentistry and orthodontia.
INVASLIGN INTERLINK (TMA927,465)	Goods (1) Computer software, namely, digital imaging software used to depict tooth and jaw movement and proposed treatment plans; computer scanning software for scanning images for use in providing diagnosis and treatment in the fields of dentistry and orthodontia; digital dental impression software; computer software, namely, software applications for use on portable internet devices, namely, software for use in the fields of dentistry and orthodontia for providing diagnosis and treatment plans; telemedicine systems consisting of computer software, computer hardware, and intra-oral scanning cameras used for medical digital image capture, storage, retrieval and transmission over telecommunications media for use in the field of dentistry and orthodontics; computer software used in creation of individually customized courses of orthodontic treatment; computer software used to provide, track and modify proposed courses of orthodontic treatment and patient data related thereto; software for dental professionals for use in evaluation of individual dentition and for planning orthodontic treatments and for use in restorative dentistry, in the preparation and fitting of crowns and bridges, and in restorative dental treatment.

Trademark (Registration No.)	Goods and Services
	Services (1) Electronic storage and retrieval of digital dental and orthodontic images; Dental services; orthodontic and dentistry services; dental, orthodontic, periodontic, endodontic and paedodontic services and treatments; design and creation of orthodontic treatment plans for individuals; consulting services in the dental and orthodontic industries; advisory services and the provision of information relating to dental and orthodontic techniques, materials and products; advisory and consultancy services relating to orthodontics, endodontics, paedodontics, periodontics, and restorative dental treatments, including the provision of such services online via the Internet or extranets; providing online access to software application for use in providing dental or orthodontic services and treatment.
 (TMA817,051)	(1) Services in the dental field, namely, training in the fields of dentistry and orthodontia; services in the dental field, namely, consultation services in the fields of dentistry and orthodontia, dentistry, orthodontic services.

[12] I have exercised the Registrar’s discretion to confirm that these registrations are in good standing as of today’s date and, as such, the Opponent has met its burden [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 at 411-412 (TMOB)]. I will focus my analysis on the likelihood of confusion between the Mark and the Opponent’s registrations for the trademarks ALIGN and INVISALIGN as I consider these marks most closely resemble the Mark.

[13] There is a likelihood of confusion if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person (section 6(2) of the Act). In assessing confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[14] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

inherent distinctiveness

[15] This factor favours neither party. The trademarks INVISALIGN and Magicalign have a similar degree of inherent distinctiveness as they are coined words which suggest products and services which can be used to correct misalignment of teeth due to the presence of the word ALIGN. With respect to the trademarks ALIGN and ALIGN TECHNOLOGY, I find that these trademarks lack, or at most have a very low degree of inherent distinctiveness, given the descriptive nature of the word align in association with the goods and services of the parties.

[16] The *Canadian Oxford Dictionary* (2nd ed) defines align as “put in a straight line or bring into line” and “esp. (Politics) [usu. foll. by with] bring (oneself etc.) into agreement or alliance with (a cause, policy, political party, etc.) [see also *Tradall SA v Devil’s Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29 which provides that the Registrar can take judicial notice of dictionary definitions]. The Opponent’s evidence of articles attached to the affidavit of Joanne Berent, a reference librarian, and corporate documents attached to the affidavit of Karrie Anger, the Opponent’s Vice President and Associate General Counsel is consistent with the first dictionary definition and shows that the words alignment, aligners and to a lesser extent align are used to suggest or describe the function of the parties’ goods. For example (*emphasis added*):

<p>Berent affidavit Exhibit B</p> <p>Page 64</p>	<p>Times Colonist (Victoria, British Columbia)</p> <p>December 5, 2006</p>	<p>... They’re called Invisalign, and that’s what they do: <i>align</i> teeth nearly invisibly. ...</p> <p>...</p> <p>The process begins when Kersten takes a mold and photos of the teeth and sends it to Invisalign’s head office ... The company designs a batch of <i>aligners</i> – typically 30 for a 60 week treatment. The orthodontist approves them or suggests adjustments and back come <i>aligners</i>, every one slightly different.</p>
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Berent affidavit Exhibit B Page 104	Edmonton Journal (April 8, 2009)	... Braces: Wires are attached to the teeth and are periodically tightened to bring them into <i>alignment</i> . A new system, called Invisalign , does the same thing with a series of plastic trays that fit on the teeth.
Berent affidavit Exhibit B Page 157	Ottawa Citizen July 14, 2012	... There are other treatments for crooked teeth. They include <i>aligners</i> . Clear and removable, they are sometimes called invisible braces (one product name is Invisalign).
Berent affidavit Exhibit B Page 166	Windsor Star November 27, 2012	... “ <i>Misaligned</i> teeth can lead to other dental problems including abnormal wearing of tooth surfaces and difficulty chewing”. ... “It’s possible to have braces for only six months for a cosmetic <i>alignment</i> , but if you want your teeth to stay stable, expect it’ll take longer”...
Berent affidavit Exhibit B Page 46	National Post August 23, 2006	After an evening of smiling widely, the 29-year-old finally had to tell her then-fiance that she had been fitted earlier in the day with clear, removable trays, called <i>aligners</i> , designed to push her eye teeth back into place... ... Besides the <i>aligners</i> that Ms. Mays chose to fix her teeth, adult patients can “lingual braces” ...
Anger affidavit Exhibit 1	Corporate Fact Sheet	The Invisalign system is used for straightening teeth with a series of custom made <i>aligners</i> for each patient. ... Invisalign Express 10 / Invisalign Express 5/ Invisalign Lite / Invisalign i7 Shorter-duration options for <i>alignment</i> of teeth and treating minor crowding/spacing cases.
Anger affidavit, Exhibit 5	Use and Care Instructions for your Invisalign Aligners	Daily Care and Maintenance of Your Invisalign Aligners Clean your <i>aligners</i> prior to each insertion. ... Rinse each <i>aligner</i> thoroughly with water after each cleaning. DO NOT use denture cleaners to clean <i>aligners</i> ...
Anger affidavit, Exhibit 26, Page 2	Art & Advertising Standards Guide for Invisalign® Providers	The Invisalign clear <i>aligner</i> system is an important development in the world of orthodontics, and leads clear aligner treatment for straightening teeth based on the Invisalign system.

Anger affidavit, Exhibit 27, Page 2	Grow Your Practice With INVISALIGN	Invisalign is the #1 clear aligner orthodontic brand for patients.
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extent of use and length of time in use

[17] The strength of a trademark may be increased by means of it becoming known through promotion or use. These factors strongly favour the Opponent as there is no evidence that the Applicant has commenced use of its trademark in Canada. In contrast, Ms. Anger's evidence is:

- The Opponent is a global medical device company that designs, manufactures, and markets a wide variety of products and related services for the orthodontic and restorative dentistry industries (para 5).
- The Opponent's best known product is its INVISALIGN system for straightening teeth. The INVISALIGN system consists of a series of clear orthodontics worn by the patient (para 7). This system is prescribed to teenage and adult patients by orthodontists and dentists who have received training (para 9). The Opponent also sells the iTERO scanner which produces 3D digital images which can be used for various dental and orthodontic products and services including crowns, implant abutments, and orthodontic workflows (para 12).
- Since as early as January 2000, the Opponent's various products and services have been sold in Canada in association with trademarks consisting of or including ALIGN (para 18) as discussed below:
 - One or more of the ALIGN trademarks have been prominently featured on product labels, packaging, product literature, and forms including use and care instructions (Exhibit 5 and 6), patient starter kits (Exhibit 7 and 8), packaging for INVISALIGN devices, retainers and cleaning systems (Exhibits 9-13), prescription and informed consent agreements (Exhibits 14-19), sales invoices to orthodontist and dentists (Exhibit 24), brochures targeting orthodontists and dentists (Exhibits 27), training and educational materials for orthodontists and

dentists (Exhibit 28-33). These materials feature the trademark INVISALIGN prominently and also feature the trademarks ALIGN, ALIGN TECHNOLOGY and ALIGNTECH INSTITUTE and trade name Align Technology to a lesser extent (typically once or twice near the Opponent's address).

- The ALIGN trademarks are also licensed to dentists and orthodontists for use in marketing materials for their own practices, and on their websites, as set out in and subject to Align's Art & Advertising Standards Guide (Exhibit 26, paras 47-48; Exhibits 40-47). Further, the Opponent provides materials to orthodontists and dentists to be distributed to patients (Exhibits 37-39).
- The trademark and trade name ALIGN TECHNOLOGY and the trademark INVISALIGN also appears on promotional brochures and training manuals for the Opponent's 3D iTERO scanner (Exhibits 20-21).
- Total Canadian sales revenues of the ALIGN products and services from 2011-2016 were in excess of \$200 million Cdn (para 40). The Opponent has over 7500 Canadian orthodontists and dentists who have received training from the Opponent in the use of the INVISALIGN system; of those, over 6800 maintain active accounts (para 46).
- The Opponent's websites *www.aligntech.com* and *www.invisalign.com* feature the INVISALIGN and ALIGN trademarks prominently and have been accessed for over 350,000 visits from Canadians in 2016 (para 76, Exhibits 55-57). The Opponent also maintains several social media accounts (Exhibits 59-61).
- ALIGN trademarks are also featured in professional journals, magazines and newspapers (Exhibits 65-66; and affidavit of Joanne Berent). I take judicial notice that many of the referenced publications have been circulated in Canada, in particular, that the National Post has wide circulation in Canada and other papers such as the Ottawa Citizen, Edmonton Journal, The Toronto Star, and Vancouver Sun have circulation in their named areas [*Milliken & Co v Keystone Industries (1979) Ltd* (1986), 12 CPR (3d) 166 (TMOB) at 168-169].

[18] Such extensive use increases the ambit of protection to be afforded to the Opponent's INVISALIGN trademark and to a lesser extent its ALIGN trademark as this trademark features less prominently in packaging and advertising [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 6 (FCTD)].

degree of resemblance

[19] In considering the Mark and the trademark ALIGN, I do not find a high degree of resemblance in appearance, sound or idea suggested. There is of course some resemblance between the parties' marks as a result of their common use of the word ALIGN. However, as stated in *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) at 188, "It is axiomatic that the first word or the first syllable in a trade mark is far the more important for the purpose of distinction." In applying that reasoning, the first portion of the Mark MAGIC, would serve to distinguish the Mark in appearance, sound and idea suggested. Importantly, the Supreme Court of Canada notes in *Masterpiece* that "While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade mark that is particularly striking and unique". In the present case, I do not consider the fact that the Applicant has essentially incorporated the Opponent's mark as the second component into its Mark to be decisive, because the most striking feature of the Mark is that it consists of a unique coined word.

[20] In considering the Mark and the trademark INVISALIGN, both of the parties' marks are formed of a single coined word, the second part of which is ALIGN. Given that ALIGN may be, in addition to being recognized as the Opponent's trademark and trade name, associated with or recognized as being a reference to the function of the parties' goods, I do not consider this aspect of either of the parties' marks to be particularly striking or unique. Each of the marks as a whole essentially consists of a coined word having a suggestive element. It is true that they bear some similarity to one another in appearance, sound and idea suggested due to the inclusion of ALIGN. However, their prefixes differ substantially. There is a big difference in sound and appearance between the prefix INVISA and the prefix MAGIC. Finally, I find the trademarks differ in idea suggested with the Opponent's trademark suggesting that its teeth straighteners are

invisible and the Mark suggesting that its goods straighten the teeth in a magical fashion. Contrary to the Opponent's submissions, I do not find that these ideas significantly overlap, nor that magic and invisible can be equated since being invisible is a magical power.

nature of goods, business and trade

[21] The nature of the goods and trade are identical since both parties goods appear to be the same and target the same consumers, namely orthodontists, dentists and patients.

family of trademarks

[22] The Opponent has relied on its family of trade marks as a further surrounding circumstance. Where there is a family of marks there is an increased likelihood of consumers assuming that an applied-for trademark is simply another mark of an opponent [*McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD); *Air Miles International Trading B.V. v SeaMiles LLC* (2009), 76 CPR (4th) 369 (TMOB) at para. 46]. In order to rely on a family of trademarks an opponent must prove use of each mark of the alleged family [*McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB)]. In addition, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered or used by others [*Thomas J. Lipton Inc v Fletcher's Fine Foods Ltd* (1992), 44 CPR (3d) 279 (TMOB) at 286 -7].

[23] I am satisfied that the Opponent has evidenced at least some use of its trademarks in association with its registered goods and services including ALIGN, INVISALIGN, ALIGN TECHNOLOGY, INC and ALIGNTECH INSTITUTE. I am therefore satisfied that the Opponent has shown use of a small family of ALIGN trademarks. However, the small size of the Opponent's family of ALIGN trademarks and trade name and the fact that the Opponent does not have a family of trademarks with ALIGN in a suffix position tempers the weight that can be afforded to it as a surrounding circumstance. As such, this case can be contrasted with the *Unilever Canada v Rain Shields* 2019 TMOB 32 case relied upon by the Opponent where the trademark STARSICLES was refused in part on the basis of the opponent's evidence of a family of trademarks including the suffix SICLE.

conclusion re likelihood of confusion

[24] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Magicalign trademark on the Applicant's Goods when he or she has no more than an imperfect recollection of each of the Opponent's registered trademarks, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[25] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, despite the significant acquired distinctiveness of INVISALIGN and to a lesser extent ALIGN, the length of time the Opponent's trademarks have been in use, the identical nature of the goods and trade and the fact that the Opponent has a small family of ALIGN trademarks, I find the overall differences between the parties' marks sufficient to shift the balance of probabilities regarding confusion in favour of the Applicant. I am of the view that the ordinary consumer would not, as a matter of first impression, be likely to think that the goods associated with the Mark would emanate from the same source as those associated with the INVISALIGN or ALIGN trademark or vice versa. Consequently, I find that there is no reasonable likelihood of confusion between the parties' trade marks.

Section 16 Grounds of Opposition

[26] The Opponent has pleaded that the Applicant is not the person entitled to registration pursuant to sections 16(3)(a) and 16(3)(c) of the Act on the basis that the Mark is confusing with the Opponent's INVISALIGN and ALIGN trademarks listed in paragraph 11 and trade names Align Technology, Inc. and Align Technology. The Opponent has an initial burden to evidence use of its marks and trade name prior to the Applicant's priority filing date and non-abandonment of its marks and trade name as of the date of advertisement of the Applicant's application [sections 16 and 34 of the Act, *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB) at 282]. While the Opponent has alleged in its statement of opposition that the requirements for a priority filing date were not met, no evidence has been submitted in support of this allegation.

[27] I find the Opponent's evidence set out in paragraph 27 of this decision sufficient to meet its evidential burden with respect to each of these grounds of opposition. The conclusion reached with respect to the section 12(1)(d) ground of opposition is equally applicable to the section 16(3)(a) and 16(3)(c) grounds of opposition. Accordingly, these grounds of opposition are rejected.

Distinctiveness Grounds of Opposition

[28] Regarding the ground of opposition based on lack of distinctiveness pursuant to section 2 of the Act, the Opponent needs to have shown that as of the date of filing the statement of opposition its INVISALIGN and ALIGN trademarks and trade names Align Technology, Inc. and Align Technology had become known sufficiently to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657, 48 CPR (4th) 427 (FCTD)]. To do so, the Opponent must establish that one or more of its trademarks and trade names are either known to some extent in Canada or are well known in a specific area of Canada [*Bojangles, supra* at paras 33-25]. While the Opponent's evidence set out in paragraph 17 of this decision is sufficient to meet its burden, the conclusion reached with respect to the section 12(1)(d) and section 16(3) grounds of opposition are equally applicable to this ground of opposition. Consequently, this ground of opposition is rejected.

Section 30(e) Ground of Opposition

[29] There is an evidential burden on the Opponent in respect of its section 30(e) ground of opposition alleging that the Applicant did not intend to use the Mark, albeit a light one. As no evidence to support its allegation was submitted by the Opponent, it has failed to meet its evidential burden. Accordingly, the section 30(e) ground is rejected.

Section 30(i) Ground of Opposition

[30] The section 30(i) ground of opposition is set out below:

The Application contravenes the provisions of s. 30(i) of the Act. At the date of filing of the Application, the Applicant was fully aware of the Opponent's rights in its family of ALIGN trademarks and trade names, registered and used in Canada ... all in association with orthodontic and dental devices and

appliances and related services, of a highly similar, if not identical, nature to those recited in the Application.

The Applicant's attempt to register the MAGICALIGN trademark constitutes bad faith, as it represents a deliberate attempt to take advantage of the reputation developed by the Opponent in its family of ALIGN trademarks and trade names, and to deceive consumers into the mistaken belief that the Applicant's goods are in some way related to, associated with, or endorsed by the Opponent, with full knowledge and flagrant disregard of the Opponent's rights.

Further, because the MAGICALIGN trademark conveys such a false, misleading or deceptive impression, the Applicant could not have been satisfied that it was entitled to use or register the trademark in Canada in association with the goods and services described in the Application, because such use would be contrary to s. 7(b), 19, 20 and 22 of the Act.

[31] Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no evidence of bad faith or other exceptional circumstances, this part of the section 30(i) ground is rejected.

[32] The section 30(i) ground of opposition further alleges that the Applicant could not have been satisfied that it was entitled to use or register the Mark in Canada in association with the Goods given the Opponent's registrations and use in Canada and sections 7, 19, 20, and 22 of the Act. Even though it is far from certain that the combination of section 30(i) with any of sections 7(b), 19, 20 and 22 of the Act constitutes a valid ground of opposition [*Euromed Restaurant Limited v Trilogy Properties Corporation*, 2012 TMOB 19 at para 13 citing *Parmalat Canada Inc v Sysco Corp* (2008), 69 CPR (4th) 349 (FC) at paras 38-42], the Opponent has not met its initial burden with respect to its allegation that the Applicant could not be satisfied it was entitled to use the Mark in view of these sections of the Act. Specifically:

- a. The Opponent has failed to adduce evidence of one of the elements required to show a violation of section 7(b) of the Act: deception of the public due to a misrepresentation [see the three elements set forth in *Ciba-Geigy Canada Ltd v Apotex Inc*, 1992 CanLII 33

(SCC), [1992] 3 SCR 120 at para 33 cited by *Pharmacommunications Holdings Inc v Avencia International Inc*, 2008 FC 828 at para 41].

- b. Section 19 requires the use of an identical trademark which is not the situation here.
- c. Section 20 requires a finding of confusion; however, I have found that the Mark is not confusing with any of the Opponent's registrations.
- d. The Opponent has failed to adduce any evidence of a depreciation of goodwill of one or more of the Opponent's registrations as required to show a violation of section 22 of the Act [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, supra at paras 46 and 63 to 68].

Disposition

[33] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2019-05-19

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