



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB INTERLOCUTORY RULING 86

Date of Decision: 2024-05-01

INTERLOCUTORY RULING

Opponent: Gurok Turizm Ve Madencilik Anonim Sirketi

Applicant: Groupe Avnew Inc.

Application: 1836884 for L'AVENUE DESSIN

INTRODUCTION

[1] By way of Office letter dated March 20, 2024, Gurok Turizm Ve Madencilik Anonim Sirketi (the Opponent) was invited to make its submissions in respect of Groupe Avnew Inc.'s (the Applicant) request for a ruling on the sufficiency of paragraphs 38(2)(e) and 38(2)(f) of the statement of opposition currently of record in this opposition. Receipt is acknowledged of the Opponent's correspondence dated April 16, 2024 advising the Registrar that it will not make submissions in reply to the Applicant's request.

[2] The sufficiency of a statement of opposition is governed by section 38 of the *Trademarks Act* (the Act). Section 38(2) of the Act details an exhaustive list of the grounds upon which an opposition may be based, and section 38(3) of the Act requires a statement of opposition to be set out in sufficient detail to enable the applicant to reply. Pursuant to section 38(6) of

the Act, the Registrar may strike all or part of a statement of opposition if it does not raise a valid ground of opposition within the scope of section 38(2) or does not set out a ground in sufficient detail to enable the applicant to reply to it.

[3] A proper pleading alleges the material facts but not the evidence which the party intends to adduce to establish those facts [see *Pepsico Inc. and Pepsi-Cola Canada Ltd v Registrar of Trademarks* (1975), 22 CPR (2d) 62 (FCTD)]. Further, it is not the purpose of an interlocutory ruling to determine whether or not a valid ground of opposition has a reasonable prospect of success, but rather, whether it contains sufficient material facts.

PARAGRAPH 38(2)(E)

[4] Paragraph 38(2)(e) of the statement of opposition is reproduced below:

The applicant was not using and did not propose to use the trademark for the following reasons:
Pursuant to the Section 38(2)(e) of the Act, at the filing date of the application in Canada (and at any relevant date), the applicant was not using the opposed trademark and did not propose to use it in Canada in association with each of the following goods specified in the application: Class 21 - Glasses, coasters, dishes, pitchers, cutting boards.

[5] I first note that the Applicant's application also covers goods and services falling under Nice classes 29, 30 and 31. However, only the goods falling under Nice class 21 (the Class 21 Goods) are being objected to under the Opponent's section 38(2)(e) ground of opposition.

[6] Section 38(2)(e) of the Act has two portions. An opponent must allege: (a) that the applicant was not using the trademark at issue in Canada; AND (b) that the applicant did not propose to use the trademark in Canada.

[7] In this case, while the Opponent's pleading specifically alleges that the Applicant was not using the subject mark as of the application date with

each of the Class 21 Goods, and as such may support the "first portion" of section 38(2)(e) of the Act, the Opponent's pleading fails to provide specific material facts as to the reason(s) why the Applicant did not propose to use the subject mark in Canada in association with the Class 21 Goods in support of the "second portion" of section 38(2)(e). It is not up to the Applicant to try to speculate as to why the Opponent considers there to have been no intention to use the subject mark [see by analogy, *Engineers Canada/Ingénieurs Canada v Kokuyo Co. Ltd.*, 2023 TMOB 89, at para 33; and *Pax Labs, Inc v Shenzhen Topgreen Technology Co, Ltd*, 2023 TMOB 17, at paras 90-91].

[8] Accordingly, paragraph 38(2)(e) of the statement of opposition is hereby struck.

PARAGRAPH 38(2)(F)

[9] Paragraph 38(2)(f) of the statement of opposition is reproduced below:

The applicant is not entitled to use the trademark in Canada for the following reasons:

At the filing date of the application in Canada (and at any relevant date), the applicant was not entitled to use the applied-for trademark in Canada in association with the goods "glasses, coasters, dishes, pitchers, cutting boards" in class 21 specified in the application, since:

a) such use was, is and would be unlawful in that such use would direct public attention to applicant's goods in such a way as to cause or be likely to cause confusion in Canada between those goods and the goods or business of the Opponent, contrary to Section 7(b) of the Act;

b) such use was, is and would be an act of passing off, contrary to section 7(c) of the Act.

[10] I find it is not necessary to discuss whether a ground of opposition based on the *combination* of section 38(2)(f) of the Act with either sections 7(b) or 7(c) of the Act, may constitute a valid ground of opposition. Indeed, as pleaded, the Opponent's mere reference to sections 7(b) and 7(c) of the Act, without more, is, in any event, insufficient to maintain this ground of opposition since each of sections 7(b) and 7(c) of the Act requires more than use or confusion with an opponent's trademark. An opponent

must allege facts to support its allegation that it has goodwill (or these facts must be able to be inferred from the statement of opposition considered as a whole). Confusion alone is not sufficient to find a diminishment of goodwill.

[11] As the Opponent's statement of opposition, when considered as a whole, fails to provide specific material facts in support of the Opponent's section 38(2)(f) ground of opposition, this ground of opposition is hereby struck.

DEADLINE TO FILE THE COUNTERSTATEMENT

[12] In accordance with its request of March 15, 2024, the Applicant is granted one month from the date of this ruling to file and serve its counter statement.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Agents of Record

For the Opponent: Neomark Ltd

For the Applicant: Canyon IP Inc.