



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 77

Date of Decision: 2024-04-19

IN THE MATTER OF AN OPPOSITION

Opponent: Manpowerdemolition Inc.

Applicant: Punam Pathak

Application: 2,049,880 for DFYR & Design

INTRODUCTION

[1] Punam Pathak (the Applicant) has applied to register the trademark DFYR & Design (the Mark), applied for in association with “Demolition services” and shown below:



[2] Manpowerdemolition Inc. (the Opponent) opposes registration of the Mark. The opposition is based primarily on allegations that the Mark is confusing with the Opponent’s unregistered trademark “No Nail Left Behind” (the Opponent’s Mark), which

has been used in Canada in association with demolition services since at least as early as October 9, 2019.

[3] For the reasons that follow, the application is refused.

THE RECORD

[4] The application was filed on September 3, 2020. The application was advertised for opposition purposes in the *Trademarks Journal* on December 1, 2021. On June 1, 2022, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[5] The grounds of opposition are summarized below:

- Contrary to sections 38(2)(a.1) of the Act, the application was filed in bad faith as the Applicant would have been aware of the Opponent's prior use of the Opponent's Mark in the same Canadian geographic area in which the Applicant is located, in association with the same services as those claimed in the application.
- Contrary to sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not entitled to registration of the Mark in Canada because, at the time of the filing date of the application, the Mark was confusing with the Opponent's Mark which had been previously used and/or made known in the same geographic area in Canada in association with the same services as those claimed in the application.
- Contrary to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the Applicant because it does not distinguish, nor is it adapted to distinguish, the Applicant's services from the Opponent's services given the prior use of the Opponent's Mark by the Opponent in association with the same services as the Applicant, in the same Canadian geographic area in which the Applicant is located.
- Contrary to section 38(2)(f) of the Act, at the filing date of the application, the Applicant was not entitled to use the Mark in Canada in association with the services given the prior use of the Opponent's Mark by the Opponent in

association with the same services as the Applicant, in the same Canadian geographic area in which the Applicant is located.

[6] On August 4, 2022, the Applicant served and filed a counter statement. Only the Opponent filed evidence, which is discussed below. No cross examination was conducted. Only the Opponent filed written representations and was represented at an oral hearing.

EVIDENCE

[7] As its evidence in this proceeding, the Opponent filed the affidavit of Fernando Morales, Operations Manager of the Opponent, sworn November 30, 2022. He states that the Opponent has used the Opponent's Mark in association with demolition services in the Greater Toronto Area (the GTA) since at least as early as October 9, 2019, and currently offers demolition and related services in the GTA, the Niagara Region, the Muskoka Region, and the Ottawa area. As Exhibits A to I, Mr. Morales attaches copies of the Opponent's marketing materials and merchandise, and confirms that the Opponent was offering demolition services in the aforementioned regions at the time these materials were published and/or distributed. The exhibits consist of the following:

- Exhibits A, B, C, D, E, and H: posts from the Opponent's Instagram account showing the Opponent's Mark in association with advertising for the Opponent's demolition services in 2019, 2020, 2021, and 2022. I note that Exhibit H, a post from October 9, 2019, shows a photograph of the affiant wearing a shirt displaying the Opponent's Mark.
- Exhibit F: photographs showing a vehicle displaying the Opponent's Mark. Mr. Morales states that this vehicle was used by the Opponent when performing demolition services in the aforementioned regions, and that the first four such photographs were taken on November 14, 2022, for the industry publication *Equipment Journal*.
- Exhibits G and I: a photograph of a shirt displaying the Opponent's Mark and contact information which Mr. Morales states would be worn by the Opponent's

employees and contractors in the performance of the Opponent's demolition services, as well as invoices for the Opponent's purchase of such shirts in 2021 and 2022.

- Exhibit J: viewership data for the Opponent's Instagram account from October 18 to November 16, 2022, showing that the account had over 1.9 million impressions and over 250,000 Instagram accounts reached. Mr. Morales states that the Opponent has spent over \$100,000 on advertising on Facebook and Instagram.

ANALYSIS

Ground of Opposition: Section 16(1)(a)

[8] The Opponent pleads that pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not entitled to registration of the Mark in Canada because, at the time of the filing date of the application, the Mark was confusing with the Opponent's Mark which had been previously used or made known in Canada in association with the same services as those claimed in the application.

[9] In order to meet its initial burden under this ground, the Opponent must show that its trademark was used prior to the Applicant's filing date (September 3, 2020) and was not abandoned at the date of the advertisement of the application (December 1, 2021). Accordingly, the relevant evidence on which the Opponent can rely is evidence of use that pre-dates the filing date of the application.

[10] I note that Exhibit A shows posts from the Opponent's Instagram account from October 2019, advertising the Opponent's demolition services and displaying the Mark in the form of the hashtag "#NoNailLeftBehind". Several of these posts show dozens of "likes", while others show view counts in the hundreds. Given Mr. Morales' description of the Opponent as a demolition company operating in Ontario, I am prepared to conclude that at least some of these "views" were by Canadians during the relevant period [for a similar conclusion, see *Thor Tech, Inc v Quantum Enterprises Incorporated*, 2020 TMOB 108 (*Thor Tech*) at para 53]. Further, Mr. Morales confirmed that the Opponent was offering and prepared to perform demolition services during this

time and continues to do so (as evidenced by the Exhibit D Instagram posts advertising the Opponent's services in 2022). Accordingly, I am satisfied that the Opponent has met its burden with respect to this ground of opposition.

[11] Since the Opponent has discharged its evidentiary burden regarding this ground of opposition, I must assess whether the Applicant has discharged its legal onus to prove, on balance of probabilities, that there is no reasonable likelihood of confusion between the Applicant's Mark and the Opponent's Mark as of the material date. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22, and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 (*Masterpiece*)]. Moreover, in *Masterpiece*, the Supreme Court stated that the degree of resemblance between the trademarks is often likely to have the greatest effect on the confusion analysis.

[12] Finally, section 6(2) of the Act does not concern confusion of the trademarks themselves, but confusion regarding goods or services from one source as being from another source. In this case, the question posed by section 6(2) is whether there would be confusion regarding the services sold under the Mark such that they would be thought to have emanated from the Opponent.

Inherent and acquired distinctiveness

[13] The Mark includes the letters "DFYR", stylized with images of tools, and the words "No Nail Left Behind", the latter of which is descriptive to some extent of the Applicant's services. I find that the Mark possesses a fair amount of inherent distinctiveness owing to the combination of the text and design elements. By contrast,

given that the Opponent's Mark contains only the somewhat descriptive phrase "No Nail Left Behind", I find that it has a lower degree of inherent distinctiveness than the Mark.

[14] The distinctiveness of a trademark can be increased through its use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. The Opponent submits that the Opponent's Mark has greater acquired distinctiveness as it was in use more than a year prior to the Applicant filing the application for the Mark. I concur. While it is not clear how much of the \$100,000 in advertising expenditures referenced in the affidavit of Mr. Morales would have been spent as of the material date, it is nevertheless clear that the Opponent was using and promoting its services in association with the Opponent's Mark to some extent as of the material date. By contrast, the Applicant has filed no evidence to show that the Mark would have acquired distinctiveness as of the material date.

[15] As such, the inherent distinctiveness factor favours the Applicant, while the acquired distinctiveness factor favours the Opponent. Accordingly, neither party is favoured by this factor.

Length of time in use

[16] As noted above, the Opponent has shown use of the Opponent's Mark since October 2019, while the Applicant has submitted no evidence of use of the Mark in Canada. Accordingly, this factor favours the Opponent.

Nature of the services or business and nature of the trade

[17] The Opponent submits, and I agree, that the Applicant's services are identical to the services used by the Opponent in association with the Opponent's Mark, and the channels of trade are likely to be identical as well. Accordingly, these factors favour the Opponent.

Degree of resemblance

[18] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks. The Supreme Court of Canada in *Masterpiece* has advised that the preferable approach when comparing trademarks is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique.

[19] Given that the Mark consists of stylized letters and the words “No Nail Left Behind”, which are suggestive to some degree of the Applicant’s services, I find that it is the combination of all the words and design elements of the Mark that give it its uniqueness. Although the Opponent submits that there is a high degree of resemblance between the Mark and the Opponent’s Mark, the fact that one component of the Mark is identical to the Opponent’s Mark is not determinative of the degree of resemblance between the trademarks [see *GNR Travel Centre Ltd v CWI, Inc*, 2023 FC 2 at para 91]. Nevertheless, the fact remains that the Applicant has still incorporated the Opponent’s Mark in its entirety into the Mark and it has done so in a way that does place some emphasis on that part of the Mark. The result is that there is some degree of resemblance between the parties’ trademarks phonetically and in terms of ideas suggested, and to a lesser extent, visually [for a similar conclusion, see *385MKE Ltd v ServiceMaster Co*, 2014 TMOB 257 at paras 47-48].

[20] Overall, I find that this factor favours the Opponent, but only to a limited extent.

Conclusion

[21] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection of the average consumer in somewhat of a hurry, and have considered all of the surrounding circumstances. Factors are not necessarily to be attributed equal weight; in most instances, it is the degree of resemblance between the trademarks that is the most crucial factor in determining the issue of confusion [*Masterpiece*; *Beverley Bedding & Upholstery Co v Regal Bedding &*

Upholstery Ltd (1980), 47 CPR (2d) 145 (FCTD) at 149, aff'd 60 CPR (2d) 70]. Here, the nature of services and business, nature of trade, acquired distinctiveness, and length of time in use factors favour the Opponent, while the inherent distinctiveness factor favours the Applicant. Notably, the degree of resemblance factor favours the Opponent only to a limited extent. As such, I find that the assessment is evenly balanced between a finding of confusion and a finding of no confusion. In the absence of evidence or representations from the Applicant to support its position that there would be no reasonable likelihood of confusion, I find that the Applicant has not discharged its burden with respect to this ground of opposition.

[22] Accordingly, the section 16(1)(a) ground of opposition is successful.

Ground of Opposition: Section 2

[23] The Opponent has also pleaded that contrary to section 2 of the Act, the Mark does not actually serve to distinguish and is not adapted to distinguish the Applicant's services from the services associated with the Opponent's Mark.

[24] The material date for this ground of opposition is the filing date of the opposition (June 1, 2022) [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 at para 25].

[25] In *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33-34, the Federal Court provided that a trademark could negate another mark's distinctiveness if it was known at least to some extent and its reputation in Canada was substantial, significant or sufficient or, alternatively, if it was well known in a specific area of Canada. A ground of opposition based on non-distinctiveness is not restricted to the sale of goods or services in Canada.

[26] The screenshots from the Opponent's Instagram page include a large number of posts dated before the material date displaying the Opponent's Mark, many of which have numbers of "likes" and "views" in the hundreds, if not thousands. Moreover, the invoices attached as Exhibit J to the affidavit of Mr. Morales show that the Opponent spent approximately \$10,000 on shirts displaying the Opponent's Mark prior to the

material date. Given that the Opponent has specified that it operated in the GTA and other regions in Ontario as of the material date, I accept that the aforementioned advertising and promotional activities were directed at those regions, and am prepared to infer that the social media posts would have "reached" and been accessed by people in those regions [see *Thor Tech, supra* at para 53]. I am therefore satisfied that the Opponent has met its burden to show that the Opponent's Mark was well-known in a specific area of Canada.

[27] As the later material date strengthens the Opponent's position due to additional relevant evidence of use of the Opponent's Mark, I reach the same conclusions with respect to confusion as those set out in the section 16(1)(a) ground. Accordingly, this ground of opposition is successful.

Remaining grounds of opposition

[28] As the Opponent has already succeeded under two grounds of opposition, it is not necessary to address the remaining grounds of opposition.

DISPOSITION

[29] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act

G.M. Melchin
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-01-25

APPEARANCES

For the Opponent: Lorraine May Fleck

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Lorraine May Fleck (Fleck Professional Corporation o/a
Fleck Innovation Law)

For the Applicant: Smart & Biggar LP