

**IN THE MATTER OF AN OPPOSITION by
Canadian Imperial Bank of Commerce to application No. 891,377
for the trade-mark CASH CONVENIENCE & Design
filed by The ATM Resource Corporation**

On September 24, 1998, the applicant, The ATM Resource Corporation, filed an application to register the trade-mark CASH CONVENIENCE & Design. The mark is shown below:

CASH CONVENIENCE

The application is based upon use of the trade-mark in Canada in association with automated banking machine services since at least as early as March 1998.

The application was advertised for opposition purposes in the Trade-marks Journal of June 21, 2000. On February 21, 2001, the opponent, Canadian Imperial Bank of Commerce, filed a statement of opposition against the application. The applicant filed and served a counter statement.

As rule 41 evidence, the opponent filed the affidavit of Cheryl L. Zeldin. The applicant filed the affidavits of Renata Snidr and Simon Taylor as rule 42 evidence. The opponent obtained an order for the cross-examination of Mr. Taylor on his affidavit but a cross-examination was not conducted.

Written arguments were filed by both parties. An oral hearing was held in which only the opponent participated.

Grounds of Opposition

The grounds of opposition are summarized below:

1. the application does not comply with the requirements of s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) because the applicant has not used the trade-mark in Canada since March 1998 in association with the services described in the application;

2. the application does not comply with the requirements of s. 30(i) of the Act because at the date of filing such application, the applicant was aware of the opponent’s registered trade-marks (identified below) and could not therefore have been satisfied as to its entitlement to use the applied for mark in Canada;

3. the applied for mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the following registered trade-marks of the opponent, all for use in association with banking services:

i) 348,135:



ii) 377,680:

CONVENIENCE CARD

iii) 407,270:

CATCH THE CONVENIENCE

iv) 408,519:



v) 410,837:



vi) 427,797: CIBC CONVENIENCE CENTRE

vii) 466,471: BUSINESS CONVENIENCE ACCOUNT

viii) 470,215: GOLD CONVENIENCE CARD

4. the applied-for mark is not, and cannot be, distinctive of the applicant because it is confusing with the opponent's above-mentioned registered trade-marks, which have been extensively used in Canada in association with banking services.

Onus

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act, there is an initial burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Material Dates

The material dates with respect to the grounds of opposition are as follows: s. 30 - the date of filing of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475]; s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v.*

Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (F.C.A.); non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

Opponent's Evidence

Zeldin Affidavit

Ms. Zeldin is the opponent's General Manager, Personal Bank Accounts Consumer Deposits and Payment. She provides us with information concerning the opponent's use of the trade-mark CONVENIENCE CARD. Before summarizing this information, I will note that Ms. Zeldin indicates in only one instance that her evidence relates to Canada (paragraph 11 concerning the availability of application forms).

The CONVENIENCE CARD trade-mark has been used since August 1979 in association with various banking services, in part by being displayed on wallet-sized plastic cards. "The CONVENIENCE CARD allows customers to use automated banking machines and make Interac® payments, and provides access to telephone and PC banking capabilities."

As of November 5, 2001, more than 5 million customers had been issued a CONVENIENCE CARD and during the previous 5 years over 51 million transactions were conducted annually by customers using their CONVENIENCE CARD. It is noted that the materials attached to Ms. Zeldin's affidavit indicate that transactions can be conducted worldwide.

The trade-mark CONVENIENCE CARD also appears on the opponent's website and on various printed materials, copies of which are attached as exhibits. For example, between 1996 and 2001, close to a million Convenience Banking Service Agreements, which contain a reference to the mark CONVENIENCE CARD, have been produced. During that same time period, the opponent spent approximately \$1.5 million on printed materials on which the CONVENIENCE CARD trade-mark appears.

Ms. Zeldin also provides certified copies of the 8 trade-mark registrations relied upon by the opponent in its statement of opposition.

Applicant's Evidence

Taylor Affidavit

Mr. Taylor is the applicant's President. He attests that, since its incorporation on November 26, 1997, the applicant has carried on a business providing automated banking machine services ("ATMs"). The applicant installs and operates ATMs at the premises of others, such as convenience stores, the first such ATM being installed in March 1998. As of June 4, 2002, 46 such ATMs had been installed.

At a prominent location near each of the applicant's ATMs, there is a sign displaying the trademark CASH CONVENIENCE & Design (a photograph has been provided). Each ATM also bears a label sticker displaying the applicant's phone number for patrons who have complaints and concerns. Mr. Taylor informs us that he fields substantially all calls for the applicant and has never had contact with, or heard of contact with, any person who indicated that he/she perceived the applicant's ATMs to be associated, affiliated, operated, authorized or in any way related to the opponent. Mr. Taylor also attests that bank cards issued by the opponent are used in approximately 12.54% of the transactions that take place on the applicant's ATMs.

Mr. Taylor provides revenue figures generated through the applicant's ATMs for each of the months of August 2001 through May 2002.

Mr. Taylor also provides printed materials concerning the use of automated bank machines that he obtained from the Royal Bank in 2001, which contain reference to the word "convenience". References include: "bank at your convenience"; "For added convenience,..."; "Choice and convenience"; "Debit card convenience".

Snidr Affidavit

Ms. Snidr, an articling student, provides copies of brochures that she obtained from various financial institutions in 2002. She also provides the results of an Internet search that she

conducted on June 3, 2002 for the keywords “bank Canada convenience card”. These materials show that the word “convenience” is often used to describe various banking services.

Section 30(b) and (i) Grounds

At the oral hearing, the opponent’s agent conceded that it had not filed any evidence to meet its evidential burden with respect to its s. 30(b) and (i) grounds of opposition and advised that it was no longer pursuing those grounds. If the opponent had not withdrawn these grounds, I would have dismissed them.

Likelihood of Confusion

The remainder of the grounds of opposition are based on the likelihood of confusion between CASH CONVENIENCE & Design and the various trade-marks owned by the opponent which include the word CONVENIENCE. At the oral hearing, the opponent admitted that it had not proven that it owns a family of CONVENIENCE marks and advised that it was no longer relying on its marks other than its CONVENIENCE CARD mark.

As stated by the opponent at the oral hearing, this opposition therefore boils down to the issue of whether there is a likelihood of confusion between CASH CONVENIENCE & Design and CONVENIENCE CARD. This issue will decide the two outstanding grounds of opposition and, in the circumstances of this case, nothing turns on which of the two material dates the issue of confusion is determined as of.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in s. 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. Those factors specifically set out in s. 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances. [see *Clorox Co. v. Sears Canada Inc.*

(1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]

The opponent conceded at the oral hearing that the inherent distinctiveness of the mark CONVENIENCE CARD is extremely low. This is because the word CONVENIENCE is a very commonly used English word with a clear meaning. The opponent admitted that the word “convenience “ is commonly used, not only at large, but also in the banking industry. However, the opponent only is admitting that “convenience” is commonly used in a descriptive sense, not that it is commonly incorporated into trade-marks.

Furthermore, the opponent’s submission is that although inherently weak, the opponent’s CONVENIENCE CARD has become an extremely strong mark through extensive use and promotion. It argues that its mark has in fact acquired secondary meaning. In support of its position, it points to the testimony concerning there being more than 51 million transactions each year between 1996 and 2001. I note however that the card shown in Exhibit “B” to the Zeldin affidavit prominently displays CIBC in a logo form in front of the much smaller and less conspicuous CONVENIENCE CARD. Although the accompanying paperwork does refer in two instances to Convenience Card, it also states “This is your CIBC Convenience Card®!” and “Your CIBC Convenience Card identifies you as a valued CIBC customer.” This raises some doubt in my mind as to whether these numerous transactions have added to the notoriety of either CIBC or CIBC Convenience Card more than of CONVENIENCE CARD. Unfortunately we have no evidence concerning how consumers refer to these cards or their associated services. There is also the question of how many of the opponent’s transactions take place in Canada.

The applicant’s mark is also inherently weak as CASH CONVENIENCE & Design suggests that the associated ATMs offer a convenient way to get cash. The CASH CONVENIENCE & Design mark has however acquired some distinctiveness through use.

The opponent’s mark has been used much longer in Canada than has the applicant’s mark.

Both parties' services are of the same general class and their channels of trade overlap. The applicant notes however that there is no evidence that the opponent displays its CONVENIENCE CARD mark on ATMs. I would add that banking services are a type of service where one would expect consumers to exercise some care in their selection.

As stated in *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) 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." Here the first word in the mark that the applicant seeks to register is not identical to the first word of the opponent's mark. Moreover, the resemblance between the two marks stems simply from their common use of the ordinary word "convenience". Despite this common feature, the marks as a whole are distinguishable one from the other both visually and aurally. In addition, there are differences between the idea that each suggests, namely a card that will make it easier for you to do all your banking and ATM machines that make it easy for you to acquire cash.

Another surrounding circumstance to be considered is the applicant's evidence of the state of the marketplace. This evidence shows that many banks use the word "convenience" to describe their services, and the opponent concedes that this is true.

A further surrounding circumstance is the lack of evidence of confusion despite approximately three years co-existence. It is of course not necessary for the opponent to evidence confusion in order for me to find that there is a likelihood of confusion but the absence of confusion despite the overlap of the services and channels of trade may entitle one to draw a negative inference about the opponent's case. [see *Dion Neckware Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) at 164, *Monspport Inc. v. Vetements de Sport Bonnie (1978) Lteé* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.), *Mercedes-Benz A.G. v. Autostock Inc. (formerly Groupe T.C.G. (Québec) Inc.)*, 69 C.P.R. (3d) 518 (T.M.O.B.)]

In its written submissions, the applicant presented an interesting argument based on the numbers provided by Mr. Taylor with respect to the percentage of transactions conducted at the

applicant's CASH CONVENIENCE & Design ATMs and the percentage of transactions conducted at its unbranded ATMs by users of the opponent's CONVENIENCE CARD services. It submitted that if consumers considered the CASH CONVENIENCE & Design mark to be associated with the CONVENIENCE CARD mark, then the percentage of CONVENIENCE CARD holders using the applicant's CASH CONVENIENCE & Design ATMs ought to exceed the number of CONVENIENCE CARD holders using the applicant's unbranded ATMs, which is not the case. However, the opponent has rightfully pointed out that there is no evidence that consumers prefer to use ATMs that are associated with their own bank. Moreover, there may be other reasons that explain the applicant's figures, such as the location of the applicant's CASH CONVENIENCE & Design ATMs as compared to the location of its unbranded ATMs.

Having considered all of the surrounding circumstances, I conclude that on a balance of probabilities there is not a reasonable likelihood of confusion between the applicant's CASH CONVENIENCE & Design automated banking machine services and the opponent's CONVENIENCE CARD banking services, either as of today's date or as of February 21, 2001. The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks and it is my view that the differences between the two marks at issue here are sufficient to make confusion unlikely. [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70]

The word "convenience" is a difficult one for any party to monopolize and consumers are likely to distinguish one service associated with the word "convenience" from another service associated with the word "convenience" by reference to other indicia or words in the trade-mark. Even if the opponent's CONVENIENCE CARD mark has acquired secondary meaning in Canada, I would still find that there was not a reasonable likelihood of confusion due to the differences between the two marks.

For the foregoing reasons, I dismiss the s. 12(1)(d) and distinctiveness grounds of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) I reject the opposition.

DATED AT TORONTO, ONTARIO, THIS 13th DAY OF DECEMBER 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board