

**IN THE MATTER OF AN OPPOSITION by
Investec Solutions Inc. to application No. 1,239,010
for the trade-mark INVESTEK CANADA filed by
Investek Canada Mortgage Corporation**

[1] On November 29, 2004, Investek Canada Mortgage Corporation (the Applicant) filed an application to register the trade-mark INVESTEK CANADA (the Mark) based upon use of the Mark in Canada. The current statement of services and the associated dates of first use are:

- Financial services, namely, financial analysis and consultation, financial investment in the field of real estate, financial management, financial valuation of personal property and real estate, credit inquiry and consultation, debt counselling, creditor protection consulting, credit repair, financing services, financing personal loans, financing business loans, real estate investment analysis – since at least as early as February 2000;
- Financial services, namely, financial evaluation for insurance and financial planning - since at least as early as April 2003;
- Mortgage services, namely, mortgage banking – since at least as early as February 2000;
- Mortgage services, namely, mortgage brokerage and mortgage lending – since at least as early as May 9, 2000;
- Providing seminars in the field of financial planning – since at least as early as November 2002;
- Personal coaching services in the field of financial planning – since at least as early as October 1999.

[2] The application originally also covered wares, but they were deleted from the application in 2008.

[3] The Applicant has disclaimed the right to the exclusive use of the word CANADA apart from the Mark.

[4] The application was advertised for opposition purposes in the Trade-marks Journal of March 2, 2005. On October 3, 2005, Investec Solutions Inc. (the Opponent) filed a statement of opposition. The Opponent has pleaded grounds of opposition under s. 38(2)(a) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

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

[6] The Opponent filed an affidavit of Allison Huff in support of its opposition. Ms. Huff is a trade-mark agent and an employee of the law firm that is representing the Opponent in the present proceedings. Ms. Huff's evidence largely comprises copies of pages that she printed from the Applicant's website and a discussion of an affidavit that was filed on behalf of the present Applicant in a different opposition proceeding, which occurred with respect to an application to register INVESTEC filed by the present Opponent.

[7] The Applicant filed an affidavit of Bozica Jurcevic in support of its application. Ms. Jurcevic, the Applicant's President, provides various details concerning the Applicant's business activities. The affidavit from the other proceeding, which is attached and discussed in Ms. Huff's affidavit, was also sworn by Ms. Jurcevic.

[8] No cross-examinations were conducted.

[9] Only the Applicant filed a written argument. An oral hearing was not requested.

Grounds of opposition

[10] The grounds of opposition are as follows:

1. Contrary to s. 38(2)(a) and 30(a) of the Act, at the date of filing the application, the Applicant did not provide a statement in ordinary commercial terms of the

specified wares and services in association with which the Mark was allegedly used.

2. Contrary to s. 38(2)(a) and 30(b) of the Act, the Applicant has not used the Mark in Canada from the date indicated in the application in association with the specified wares and services.
3. Contrary to s. 38(2)(d) and 2 of the Act, the Mark is not distinctive because it is not capable of distinguishing the Applicant's wares or services from the wares and services of others, nor is it adapted to so distinguish them, because the Mark has been used by entities other than the Applicant.

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[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 38(2)(a)/30(a) Ground of Opposition

[12] There is no evidence before me that supports the Opponent's allegation under s. 30(a). Accordingly, the Opponent has not met its initial burden with respect to this ground and it is dismissed.

Section 38(2)(a)/30(b) Ground of Opposition

[13] The Opponent's burden with respect to s. 30(b) can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230]. However, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is 'clearly' inconsistent with the claims set forth in the Applicant's application.

[14] Ms. Huff generally submits that the Jurcevic affidavit filed in the earlier proceedings either contradicts the claims made in the present application or fails to support such claims. However, the Huff affidavit only establishes that an affidavit was filed in another opposition, it does not establish the truth of the contents of that affidavit. It is the evidence of Ms. Jurcevic in the present proceedings that is probative. The Opponent had the right to cross-examine Ms. Jurcevic on the affidavit that she filed in the present proceedings and could have explored any alleged inconsistencies between her two affidavits on cross-examination; however, the Opponent chose to not conduct a cross-examination. Accordingly, I am not giving any weight to the contents of the affidavit filed in the earlier proceedings.

[15] The Opponent has not submitted any argument to the effect that the Applicant's evidence in this proceeding is clearly inconsistent with its claimed dates of first use. Ms. Jurcevic has attested at paragraph 3 of her affidavit that she strongly denies the Opponent's allegation that the Applicant has not used the Mark in Canada from the dates indicated. Although Ms. Jurcevic has also attested that the Applicant's activities prior to 2003 did not result in any income, this does not mean that the Mark was not in use in association with services prior to 2003. If the services were offered to prospective customers in Canada in association with the Mark and were available to be performed in Canada as of the claimed dates of first use, then the Mark was used in association with the services as of those dates in accordance with s. 4(2) of the Act [*Wenward (Canada) Ltd. v. Dynaturf Co.* (1976), 28 C.P.R. (2d) 20 (T.M.O.B.)]. Thus, the lack of sales prior to 2003 is not clearly inconsistent with the Applicant's claims.

[16] As the Opponent has not met its initial burden, this ground of opposition is dismissed.

Section 38(2)(d)/2 Ground of Opposition

[17] The material date for establishing distinctiveness is the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[18] To meet its initial burden with respect to this ground of opposition, the Opponent must support its pleading by showing that someone other than the Applicant was using the Mark as of

October 3, 2005. Ms. Huff's evidence does not show that. She does provide as Exhibit "E" a print out of a page from the Applicant's website, which she points out states that the Applicant works with experts and has links to two other companies. However, this is not evidence that third parties have been using the Applicant's Mark. In any event, the page is dated May 29, 2006, i.e. after the material date.

[19] As the Opponent has not met its initial burden with respect to this ground, it is dismissed.

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 26th DAY OF NOVEMBER 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board