



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 228
Date of Decision: 2015-12-22

IN THE MATTER OF AN OPPOSITION

Fortress Properties Inc.

Opponent

and

Fortress Real Developments Inc.

Applicant

**1,514,906 for FORTRESS REAL
CAPITAL & Castle Design**

Application

[1] Fortress Properties Inc. opposes registration of the trade-mark FORTRESS REAL CAPITAL & Castle Design (the Mark), shown below, that is the subject of application No. 1,514,906 by Fortress Real Developments Inc.



[2] Filed on February 11, 2011, the application is based on use of the Mark in Canada since at least as early as October 2008 in association with “financial services, namely providing an investment product structured as a syndicated mortgage that allows for retail and institutional

clients to invest in real estate development projects in both non-accredited form and RSP eligible form”.

[3] The Opponent alleges that: (i) the Applicant is not the person entitled to registration of the Mark under section 16 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); and (ii) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I refuse the application.

The Record

[5] The Opponent filed its statement of opposition on February 20, 2012, following which the Registrar granted leave to the Opponent to make certain amendments on May 14, 2014. The Registrar also granted leave to a further amended statement of opposition on August 29, 2014. The Applicant filed and served its counter statement on April 16, 2012, which was amended on July 24, 2014 with leave from the Registrar, denying all of the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of John Kearley, Executive Vice-President of the Opponent. Mr. Kearley was cross-examined; the transcript of his cross-examinations has been made of record. In support of its application, the Applicant filed the affidavit of Jawad Rathore. Mr. Rathore was not cross-examined.

[7] Only the Applicant filed a written argument; neither party requested a hearing.

The Parties' Respective Burden or Onus

[8] 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Was the Applicant the Person Entitled to Registration of the Mark?

[9] The Opponent alleges that the Applicant is not the person entitled to the registration of the Mark as it was confusing with the trade-name Fortress Properties, which has been previously used in Canada by the Opponent in association with services including property management services, having regard to sections 38(2)(c) and 16(1)(c) of the Act.

[10] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-name, the Opponent has the initial onus of proving that its trade-name was used prior to the date of first use claimed in the subject application, namely October 2008, and that it had not been abandoned at the date of advertisement of the application, namely October 19, 2011, pursuant to section 16(5) of the Act.

[11] I shall begin with a review of evidence pertaining to the Opponent's use of its trade-name.

Use of the Opponent's Trade-name

[12] According to Mr. Kearley, the Opponent was incorporated on October 26, 1995 in Saskatchewan in the business of "property management and development". The Opponent was then extra-provincially incorporated in Alberta on August 10, 2005. Mr. Kearley states that the Opponent has been active in Saskatchewan since 1995 and in Alberta since 2005, in commercial property management and development and has made significant sales of its services throughout Western Canada. In this regard, Mr. Kearley states that at the time of the affidavit, the Opponent's property management portfolio in the two provinces consists of more than 60 properties. However, Mr. Kearley did not provide any information regarding the Opponent's revenue or sales figures. Attached as Exhibit D to the Kearley affidavit is a listing of the Opponent's residential, commercial and industrial properties in Saskatchewan and Alberta, along with the leasable square footage of each, as of July 1, 2012. During the cross-examination, Mr. Kearley stated that the Opponent acquires two to three properties on a yearly basis [Q20].

[13] Mr. Kearley states that since at least 2001, the Opponent has actively promoted and advertised services in association with its trade-name Fortress Properties. Notably, attached as Exhibit E to the Kearley affidavit are copies of classified ads dated between June 2001 and December 2003 published in a newspaper titled “The StarPhoenix”, said to have widespread circulation throughout the City of Saskatoon and the province in general. However, there is no information on the extent of the newspaper’s circulation in that area. I note references to “FORTRESS” and “FORTRESS PROPERTIES INC.” in the classified ads for residential, retail and commercial lease spaces, similar to the one shown below.



[14] Mr. Kearley explains that the Opponent continues to advertise in The StarPhoenix on a regular basis, attached as Exhibits F and G to his affidavit are emails sent by an employee of the Opponent to the newspaper regarding the content of the Opponent’s upcoming advertisements in 2010 and 2011. Copies of the classified ads are attached as Exhibit G, some of which with handwritten 2010 and 2011 dates near the advertisements. I note references to “FORTRESS PROPERTIES INC.” and the slogan “Specialty supplier of storefront, office, commercial spaces” appear in each of the advertisements, similar to the one shown below.



In its written argument, the Applicant submits that the email exchange along with copies of the advertisements attached as Exhibit G should not be given any weight in view of Mr. Kearley’s inability to provide the date of the exchange during cross-examination [Qs50-51]. Furthermore, the Applicant points to Mr. Kearley’s confirmation during cross-examination that the copies of advertisements in Exhibit G were not attached to the actual emails but were assembled for the

purpose of his affidavit and that he was not able to identify the handwritten dates above the advertisements [Qs52-60]. Thus, the Applicant submits that the Exhibit G is “suspect”.

[15] Even though Mr. Kearley was unable to provide the date of the email during cross-examination, I note that the Opponent did not request an undertaking in this regard. Since the email discusses advertisements that are to be published as of the first week of 2011, in reference to the ones that ran in 2010, I am prepared to accept that the email is dated sometime in 2010. As for the copies of advertisements, I note that Mr. Kearley simply states in his affidavit that “a copy of those advertisements is attached to that email”. Setting aside the handwritten dates, for which I agree with the Applicant cannot be relied upon, I am not prepared to disregard the evidence in its entirety. The email clearly identifies the ad that was to be published in the newspaper in a particular week by its tag line, which corresponds to the tag lines that can be seen on the copies of advertisements attached. Under these circumstances, I am prepared to accept the copies of the advertisements attached as Exhibit G to the Kearley affidavit as those that were referenced in the emails attached as Exhibits F and G.

[16] Mr. Kearley further states that since at least May 2006, the Opponent has promoted and advertised its services in association with its trade-name Fortress Properties in a newspaper titled “The Lloydminster Meridian Booster”, said to have widespread circulation throughout the City of Lloydminster in Alberta. However, there is no information on the extent of the newspaper’s circulation in that area. Attached as Exhibit H to the Kearley affidavit is a copy of an advertisement dated May 26, 2006, I note reference to “FORTRESS PROPERTIES INC.” and the slogan “Specialty supplier of storefront, office, commercial spaces” in the ad, and a copy of the invoice for the ad of the same date attached as Exhibit G. Copies of advertisements with similar information published in a newspaper titled “The Edmonton Journal” dated September 19, 2008, said to have widespread circulation throughout the City of Edmonton in Alberta, are attached as Exhibit J. However, there is no information on the extent of the newspaper’s circulation in that area.

[17] Numerous screenshots of photos of leasing signages marked “Fortress Properties Inc.”, said to be on properties managed by the Opponent in the city of Saskatoon, are attached as Exhibit K, along with properties of the photos including the make and the model of the camera,

the date and time, the shutter speed, the resolution, etc. In its written argument, the Applicant submits that the evidence should not be given any weight because Mr. Kearley stated during cross-examination that the dates and times that appear as part of the screenshots of the photographs “may be the date that the picture was taken”, or “may be the date that the request was made to pull up the screenshot” [Qs70-75].

[18] While I agree that the date and time of the photos cannot be relied upon in view of the affiant’s answer during cross-examination, I am not prepared to disregard the photos in their entirety showing the signages marked “Fortress Properties Inc.” on properties managed by the Opponent. I am however unable to determine when these photos were taken.

[19] According to Mr. Kearley, the Opponent sponsored a Christmas season light show in Saskatoon in 2008 called the Enchanted Forest. Attached as Exhibit L is a copy of the press release of the event dated November 18, 2008 in which “Fortress Properties” is identified as a sponsor.

[20] Mr. Kearley states that the Opponent has maintained an active presence online for the last 8 to 10 years through its website located at *www.fortressproperties.ca* where a list of all of the Opponent’s properties and available space is kept. A copy of the homepage printed on August 2, 2012 is attached as Exhibit N, with references to “Fortress Properties” and “Fortress Properties Inc.” The description “Storefront, office, commercial and industrial lease space” with the names of the following locations “Saskatoon”, “Edmonton”, “Leduc”, and “Lloydminster” appear at the top of the homepage. Mr. Kearley did not provide the number of Canadians who have accessed the website.

[21] Finally, according to Mr. Kearley, the Opponent’s annual advertising expenditures vary between \$28,000 and \$40,000, with a combined total of more than \$174,000 from 2007 to 2011.

[22] In its written argument, the Applicant submits that the Opponent has not met its initial evidential burden to show that its trade-name has acquired a reputation in connection with property management.

[23] The emphasis should be placed on use of the Opponent’s trade-name instead. The Opponent’s initial burden under the non-entitlement ground is set out in section 16(1)(c) of the

Act, which states that “[a]ny applicant who has filed an application in accordance with section 30 for registration of a trade-mark that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with goods or services is entitled, subject to section 38, to secure its registration in respect of those goods or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with a trade-name that had been previously used in Canada by any other person” [my emphasis].

[24] When the evidence is viewed as a whole, including the length of time the Opponent has been operating under its trade-name in Alberta and Saskatchewan, the length of time it has been regularly advertising its services in local newspapers in Alberta and Saskatchewan under its trade-name (despite the lack of information on their circulation numbers), and the considerable number of commercial and residential properties that the Opponent was managing in Alberta and Saskatchewan as of 2008, I am satisfied that the Opponent has carried on a business under the trade-name Fortress Properties in association with property management services in Canada prior to October 2008 and that it had not abandoned its trade-name as of October 19, 2011.

The test for confusion

[25] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trade-name Fortress Properties.

[26] The test for confusion is one of first impression and imperfect recollection. Section 6(3) of the Act states that use of a trade-mark causes confusion with a trade-name if the use of both in the same area would be likely to lead to the inference that the goods or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[27] 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 trade-mark and the trade-name 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 trade-mark and the trade-name in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[28] I will now turn to the assessment of the likelihood of confusion between the Mark and the Opponent's trade-name Fortress Properties, having regard to the surrounding circumstances of this case.

Section 6(5)(a) – the inherent distinctiveness of the trade-mark and trade-name, and the extent to which they have become known

[29] The overall consideration of the section 6(5)(a) factor, which involves a combination of inherent and acquired distinctiveness of the parties' trade-mark and trade-name, does not significantly favour either party.

[30] I assess the Opponent's trade-name and the Mark to be inherently distinctive in view of the term FORTRESS. In addition, I am of the view that the design of a fortress also contributes to the inherent distinctiveness of the Mark. However, I do not find that the words PROPERTIES and REAL CAPITAL contribute to the inherent distinctiveness of the Opponent's trade-name and to the Mark respectively given their descriptive/suggestive nature.

[31] The strength of a trade-mark or a trade-name may be increased by means of it becoming known in Canada through promotion or use. Having reviewed the Opponent's evidence of use of its trade-name earlier, I will now assess the Applicant's evidence of use of the Mark.

Use of the Mark by the Applicant

[32] According to Mr. Rathore, the application was initially filed by Fortress Real Capital Inc. on February 11, 2011, who later assigned the application to the Applicant on July 5, 2013. The assignment was recorded by the Canadian Trade-marks Office on July 10, 2013. Mr. Rathore

states that he has been employed by the Applicant since its incorporation in July 2012, prior to which he was President and CEO of Fortress Real Capital Inc. and continues to act in that capacity. Mr. Rathore adds that he is an officer and director of both companies.

[33] Mr. Rathore states that the Applicant is in the business of “identifying and developing real estate projects either alone or with other companies”. In particular, Mr. Rathore explains that the Applicant “identifies real estate development opportunities in various Canadian markets and assists with various aspects of the development of a project”. In this regard, the Applicant provides “ongoing expertise and stewardship from the inception of a real estate development to completion”; it “gets involved in identifying and, in some cases, purchasing, sites for development, building the sales centre and retaining the planners who obtain building permits and approvals from municipalities”. At the time of the affidavit, Mr. Rathore states that the Applicant is active in nine markets in Canada and is focused on “residential low-rise, high-rise, commercial and industrial projects”.

[34] In terms of use of the Mark, Mr. Rathore states that the Mark is advertised in association with the Applicant’s syndicated mortgage products that are sold to clients through licensed mortgage agents and brokers across Canada. On this note, the Applicant is involved in the preparation of marketing material and other documentation bearing the Mark, used in the selling of the products. Mr. Rathore further states that since the Applicant creates the syndicated mortgage products, it has direct control over the character and quality of these financial services. Mr. Rathore adds that the Centro Mortgage Inc. is an authorized licensee of the Applicant and is the lead mortgage brokerage that offers the Applicant’s syndicated mortgage products.

[35] According to Mr. Rathore, syndicated mortgage products bearing the Mark are advertised in electronic and printed publications and are directed to mortgage agents and brokers, some of which are then distributed to prospective investors. In support, Mr. Rathore attaches numerous sample publications, including:

- Exhibit A – copy of a pamphlet bearing the Mark regarding Fortress Real Capital’s RSP eligible syndicated mortgage products on real estate developments offered by Centro Mortgage Inc. The pamphlet is said to have been provided to mortgage agents and brokers in January 2010;

- Exhibit B – copy of an investor’s guide to the development process of a real estate development in which the Mark is shown. The pamphlet is said to have been provided to mortgage agents and brokers in April 2011; and
- Exhibit C – copies of brochures regarding the Applicant’s syndicated mortgage products bearing the Mark, said to be available at seminars and presentations given by Centro Mortgage Inc.

[36] Additional sample publications and advertisements in the form of information folders, brochures and fact sheets bearing the Mark, said to be distributed between 2011 and 2012 at presentations and seminars, as well as to licensed mortgage agents and brokers, are attached as Exhibits D to X to the Rathore affidavit, including brochures about a number of specific residential and commercial real estate projects in various cities in Ontario including London, Toronto, St. Catharines and Barrie, as well as Calgary and Edmonton, Alberta. Mr. Rathore states that representatives from Fortress Real Developments Inc. sometimes attend the seminars held by Centro Mortgage Inc. to discuss syndicated mortgage products that bear the Mark; typically 45 to 60 people attend each seminar.

[37] In addition, Mr. Rathore attaches copies of articles and print advertisements pertaining to syndicated mortgage products bearing the Mark published in a number of magazines in 2012 and 2013 as Exhibits Y to DD to his affidavit; a list of trade shows across Canada in which the Applicant’s syndicated mortgage products were advertised in 2012 and 2013; representative printouts related to syndicated mortgage products bearing the Mark from three websites launched in 2010 and 2012 that are administered by Centro Mortgage Inc. as Exhibits EE to GG; photos of various promotional items bearing the Mark said to have been given to prospective investors by Centro Mortgage Inc. in 2010 to 2012 as Exhibits HH to KK; and documents pertaining to various sponsorship events in 2010 to 2013 where the Mark was displayed as Exhibits LL to OO. Finally, copies of business cards bearing the Mark used since March 2012 are attached as Exhibit PP to the Rathore affidavit.

[38] According to Mr. Rathore, Fortress Real Capital Inc. spent in excess of \$200,000 annually from 2010 to 2013 in advertising expenditures for the Mark.

[39] When the evidence is viewed as a whole, I am satisfied that the Applicant has shown evidence of use of the Mark in association with financial services in the form of syndicated mortgage products in Canada from 2010 and on, despite having no information on the number of Canadians who have accessed the above-mentioned websites, no information on the number of Canadians who would have attended the trade shows, no information on the number of Canadians who would have attended the events sponsored by the Applicant, and no information on the extent to which the promotional items or the business cards were distributed is provided.

[40] In the end, despite the deficiencies in both parties' evidence, I am satisfied that the Opponent's trade-name and the Mark have both acquired distinctiveness to some extent through promotion and use. Both the Opponent and the Applicant elected not to provide their sales or revenue figures. Thus, I am left with information related to advertising, marketing and sponsorship of the Opponent's trade-name and the Applicant's Mark in association with their respective services. Even so, I am satisfied that both parties have provided ample evidence regarding their businesses and their advertising practices and materials in association with the Opponent's trade-name and the Mark.

[41] I note that while the Applicant's annual advertising expenditures for the Mark are much higher than those of the Opponent, the Opponent has provided evidence of promotion and use of its trade-name for a much longer period of time (from 2001 and on) than that of the Applicant (from 2010 and on) in Canada. I further note that while the Applicant's advertising materials seem to be more elaborate than those of the Opponent, which may explain in part the discrepancy in the parties' advertising expenditures, the evidence does not allow me to conclude that the extent to which that the Mark has become known is greater than that of the Opponent's trade-name considering the limited number of participants for the seminars and presentations, the lack of information regarding the circulation numbers of the Applicant's advertising materials, and the lack of information on the trade shows in general.

Section 6(5)(b) – the length of time the trade-mark and the trade-name have been in use

[42] The overall consideration of the section 6(5)(b) factor favours the Opponent. As previously discussed, the Opponent has shown some evidence of use and promotion of the trade-name in association with property management services in Canada since 2001.

Sections 6(5)(c) – the nature of the services

[43] Section 6(5)(c), which involves the nature of the services, favours the Opponent.

[44] While I agree with the Applicant that there is no direct overlap between the Opponent's and the Applicant's services, both parties offer related real estate services, from the financing a real estate project to the leasing of that space. In this regard, the Opponent provides property management services specialising in commercial leasing while the Applicant offers financial services in the form of syndicated mortgage products in residential and commercial real estate projects designed for both retail and institutional clients.

Sections 6(5)(d) – the nature of the trade

[45] Section 6(5)(d) factor, which involves the nature of the trade, favours the Applicant.

[46] In its written argument, the Applicant submits that the parties' services are provided through significantly different channels of trade. I agree. There is no evidence to suggest that there is an overlap or a connection between the channels of trade in which the parties' respective services circulate.

[47] The Opponent's property management services for residential and commercial spaces are offered and advertised to the general public through local newspapers, on its website and on-site signage displays. In comparison, while the application does not restrict the Applicant's financial services to specific channels of trade, the evidence shows that the services are offered to prospective investors through licensed mortgage agents and brokers and are advertised in targeted seminars, presentations, trade shows, trade magazines and via various websites [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB) regarding the use of the actual channels of trade in determining the probable type of business or trade intended by the parties].

Section 6(5)(e) – the degree of resemblance between the trade-mark and trade-name in appearance or sound or in the ideas suggested by them

[48] When considering the degree of resemblance, the law is clear that the trade-marks and trade-names must be considered in their totality. While it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks and trade-names, it is nevertheless possible to focus on particular features that may have a determinative influence on the public's perception [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)]. The preferable approach when comparing trade-marks and trade-names is to begin by determining whether there is an aspect of the trade-mark or trade-name that is particularly striking or unique [see *Masterpiece* at para 64].

[49] I am of the view that the particularly striking element of the Opponent's trade-name is the term FORTRESS. Likewise, the particularly striking element of the Mark is the combination of the same term FORTRESS with a design of a fortress. Both convey the idea of a fortified stronghold or a place of refuge or protection [see *Canadian Oxford Dictionary*]. The remaining written materials of the Opponent's trade-name, namely PROPERTIES INC., and that of the Mark, namely REAL CAPITAL, are descriptive/suggestive of their respective services.

[50] When the parties' trade-name and trade-mark are viewed in their entirety, I find that there is a significant degree of resemblance in sound, appearance and in ideas suggested. Accordingly, the 6(5)(e) factor favours the Opponent.

Additional surrounding circumstance – Absence of actual confusion

[51] In its written argument, the Applicant submits that the Opponent has not provided any evidence of actual confusion between the Opponent's trade-name and the Applicant's Mark despite concurrent use in the marketplace.

[52] Absence of evidence of actual confusion over a relevant period of time, despite an overlap in the parties' services and channels of trade, may entitle the Registrar to draw a negative inference about the likelihood of confusion [see *Mattel*, supra at p 347.] Nevertheless, the Opponent is under no obligation to submit evidence of instances of actual confusion. Moreover,

the absence of such evidence does not necessarily raise any presumptions unfavourable to the Opponent for the burden is on the Applicant to demonstrate the absence of likelihood of confusion.

[53] In the present case, given the different geographical areas in which the parties have primarily provided their services thus far, namely the Opponent in Saskatchewan and Alberta, and the Applicant in Ontario, I am not prepared to draw any negative inference regarding the likelihood of confusion from the lack of evidence of actual confusion.

Conclusion on the likelihood of confusion

[54] In its written argument, the Applicant submits that its clients are unlikely to invest in its syndicated mortgage products without investing significant time in researching and understanding the services offered, as evidenced by the invitations to seminars to prospective investors by the licensed mortgage agents and brokers. To the extent that the Applicant's services are of a specialised nature that demand a relatively significant financial commitment, Justice Rothstein states in *Masterpiece* that although consumers in the market for expensive services may be less likely to be confused, the test is still one of first impression. Justice S n gal of the Superior Court of Qu bec in *De Grandpr  Joli-Coeur v De Grandpr  Chait* (2011) 94 CPR (4th) 129 summarizes the Supreme Court of Canada's discussion on this point in *Masterpiece* as follows at para 97-98:

[TRANSLATION]

In *Masterpiece*, the Supreme Court stated that it is an error to believe that, since consumers of expensive goods and services generally take considerable time to inform themselves about the source of those goods and services, there is a reduced likelihood of confusion. Confusion must instead be assessed from the perspective of the first impression of the consumer approaching a costly purchase when he or she encounters the trade-mark. It is not relevant that consumers are unlikely to make choices based on first impressions or that they will generally take considerable time to inform themselves about the source of expensive goods and services. Careful research which may later remedy confusion does not mean that no confusion ever existed or that it will not continue to exist in the minds of consumers who did not carry out that research.

In the view of the Supreme Court, consideration must be limited to how a consumer with an imperfect recollection of a business's mark would have reacted upon seeing the other company's mark. The question of cost is unlikely to lead to a different conclusion in

cases where a strong resemblance suggests a likelihood of confusion and the other factors set out in subsection 6(5) of the Act do not point strongly against a likelihood of confusion.

[emphasis added]

[55] In *Masterpiece*, the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion. Specifically, the Court noted that the degree of resemblance is the statutory factor that is often likely to have the greatest effect on the confusion analysis; the other factors become significant only once the trade-marks or trade-names are found to be identical or very similar.

[56] In addition, the Federal Court of Appeal had previously stated in *Miss Universe, Inc v Bohna* [1995] 1 FC 614, 58 CPR (3d) 381, that “[f]or a likelihood of confusion to be found, it is not necessary that the parties operate in the same general field or industry, or that the services be of the same type or quality” and that “[t]rade-marks for wares and services of one quality intended for one class of purchasers may be confusing with trade-marks for wares and services of a different type or quality, intended for a different class of purchasers” [para 14].

[57] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular, the strong resemblance between the Mark and the Opponent’s trade-name, evidence of use of the Opponent’s trade-name in Canada for a longer period of time, and the connection between the parties’ services in the field of real estate, despite evidence of the parties’ different channels of trade, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between Mark and the Opponent’s trade-name.

[58] In the end, I am of the view that the casual consumer, somewhat in a hurry, seeing the Mark with real estate investment services in the form of syndicated mortgage, would be likely to think that they were from the same source as property management services offered by Fortress Properties Inc.

Was the Mark Distinctive of the Applicant's Services?

[59] The Opponent has pleaded that the Mark is not distinctive as it does not actually distinguish the Applicant's services from those of the Opponent in view of the provisions of section 2 of the Act. The ground of opposition as pleaded is based upon the likelihood of confusion between the Mark and the Opponent's trade-name.

[60] In order to meet its initial burden, the Opponent must establish that as of the filing date of the statement of opposition, namely, October 19, 2011, the Opponent's trade-name had become known to such an extent that it could negate the distinctiveness of the Mark. In *Bojangles' International, LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC) at para 33, the Federal Court provided that a mark could negate another mark's distinctiveness if it was known to some extent in Canada or alternatively, if it is well known in a specific area of Canada.

[61] In the present case, I accept that the Opponent has established promotion and use of its trade-name in Saskatchewan and Alberta since at least 2001 and that its trade-name has become known to some extent in those two provinces. However, based on the evidence of this case, I am unable to determine whether the extent of that use and the degree of reputation associated with the Opponent's trade-name would have been sufficient to enable the Opponent to satisfy its initial burden under the non-distinctiveness ground. As mentioned previously under the non-entitlement discussion, the Opponent did not provide any sales or revenues figures. While the Opponent provided evidence that it was managing over 60 properties by 2012 and that it has continuously ran classified ads in local newspapers for an extended period of time, the evidence does not allow me to determine the extent of its leasing business in a quantifiable manner such that it would allow me to conclude that its trade-name has become well known in Saskatchewan and Alberta by the material date.

[62] As such, the non-distinctiveness ground of opposition is dismissed for the Opponent's failure to meet its initial evidential burden.

Disposition

[63] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

Smart & Biggar

FOR THE OPPONENT

Norton Rose Fulbright Canada LLP/S.E.N.C.R.L., S.R.L.

FOR THE APPLICANT