



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

Citation: 2012 TMOB 159
Date of Decision: 2012-08-08

**IN THE MATTER OF AN OPPOSITION
by Mortgagestogo.ca Inc to application
No. 1,382,757 for the trade-mark GO
MORTGAGES in the name of Randy
Wall.**

[1] On February 8, 2008 Randy Wall, (the Applicant) filed an application to register the trade-mark GO MORTGAGES (the Mark), based upon use in Canada since April 10, 2002 in association with the following services:

Mortgage broker services, namely, on behalf of third parties for consideration or other compensation, the soliciting of persons to borrow or lend money to be secured by a mortgage, the negotiating of mortgage transactions, the referral of mortgage providers, and the provision of lines of credit, credit cards, loans and life insurance to insure debt obligations.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 15, 2008. A statement of opposition was filed by Mortgagestogo.ca Inc. on December 12, 2008. The Applicant filed and served a counter statement on March 18, 2009, denying all the allegations in the statement of opposition.

[3] The Opponent filed the affidavit Paul Izzard on July 14, 2009; the Applicant filed the affidavit of Randy Wall on November 16, 2009 and an additional affidavit of Randy Wall,

attaching a certified copy of the subject application, on November 24, 2009. Only the Opponent filed a written argument; an oral hearing was not held.

Grounds of Opposition pursuant to the *Trade-marks Act* R.S.C. 1985, c. T-13

Section 38(2)(a)/30(a)and(i)

[4] The Opponent pleaded that the application does not contain a statement of services in ordinary commercial terms.

[5] The Opponent pleaded that the Applicant could not have been satisfied that it was entitled to use the Mark since the Applicant had not been using the Mark since April 10, 2002, as claimed, and was or should have been aware of the Opponent's prior use of its trade-mark MORTGAGESTOGO.CA in association with the following services:

- (1) Consulting services related to mortgage, credit card and loan services, namely, researching mortgage rates.
- (2) Consulting services related to mortgage, credit card and loan services, namely, preparation of mortgage applications.
- (3) Consulting services related to mortgage, credit card and loan services, namely, facilitation of mortgage applications.
- (4) Consulting services related to mortgage, credit card and loan services, namely, facilitation of mortgage approvals.
- (5) Consulting services related to mortgage, credit card and loan services, namely, facilitation of mortgage insurance applications.
- (6) Consulting services related to mortgage, credit card and loan services, namely, facilitation of credit card applications.
- (7) Consulting services related to mortgage, credit card and loan services, namely, facilitation of lines of credit applications.
- (8) Provision of an Internet website related to mortgage services, namely, researching mortgage rates.
- (9) Provision of an Internet website related to mortgage services, namely, preparation of mortgage applications.
- (10) Provision of an Internet website related to mortgage services, namely, facilitation

of mortgage applications.

(11) Provision of an Internet website related to mortgage services, namely, facilitation of mortgage approvals.

(12) Provision of an Internet website related to mortgage services, namely, facilitation of mortgage insurance applications.

(13) Provision of an Internet website related to mortgage services, namely, facilitation of credit card applications.

(14) Provision of an Internet website related to mortgage services, namely, facilitation of lines of credit applications.

Section 38(2)(c)/16(3)(a)(c)

[6] The Opponent pleaded that the Applicant is not the person entitled to registration because at the filing date, the application was confusing with the Opponent's trade-mark MORTGAGESTOGO.CA which has been used in Canada since at least as early as April 2004 and is now a registered trade-mark, TMA761,904. I note that this allegation is not properly pleaded in view of the fact that the application is based on use in Canada. This is discussed further below.

Section 38(2)(d)/2

[7] The Opponent alleged that the Mark is not distinctive within the meaning of section 2 of the Act as the Mark does not actually distinguish and is not adapted to distinguish the services of the Applicant from the services of others, and more particularly from the services in association with which the Opponent's trade-name and trade-mark MORTGAGESTOGO.CA has been previously used and is still used in Canada, and which has not been abandoned by the Opponent.

Onus

[8] 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 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].

Grounds that may be summarily dismissed

[9] With respect to the ground of opposition pleaded under section 30(a), as worded, the allegation consists merely of the wording of the Act, the “offending” services are not listed, and no facts or argument are provided in support of this ground. Accordingly, I am of the view that this ground is insufficiently pleaded and is therefore dismissed.

[10] With respect to the ground of opposition pleaded under section 30(i), I would first observe that an allegation that the trade-mark was not in use at the claimed date of first use is not proper under this ground; rather such an allegation should be raised under section 30(b) of the Act. Secondly, it is well settled that where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]; in the absence of evidence of bad faith, awareness of another party’s trade-mark is not considered an exceptional case. The Opponent has not met its initial burden under this ground and accordingly, this ground is dismissed.

[11] With respect to the grounds pleaded under sections 16(3)(a) and (c), as noted above, this pleading is incorrect. Since the subject application is based on use in Canada, entitlement must be assessed pursuant to section 16(1) and not 16(3). I am of the view that the incorrect section numbers cannot be considered mere typographical errors in this case, since the Opponent’s written submission reiterates reference to section 16(3) and goes on to assert that the material date is the date of application (and not the claimed date of first use pursuant to section 16(1)). Accordingly, I am of the view that the reference to section 16(3) was intentional, and not a clerical error; this ground appears to have been improperly pleaded and should be dismissed.

Opponent’s Evidence

Affidavit of Mr. Paul Izzard

[12] Mr. Izzard is the President of the Opponent, and has been employed in that capacity since 2004. His duties include sales, marketing, recruitment and financial functions; as such the affairs of the Opponent over the last five years are very well known to him.

[13] It appears that the Opponent is in the business of negotiating mortgages, accepting applications from borrowers (buyers of residential, commercial and farm property with diverse credit backgrounds) and matching them with lenders. The Opponent gathers all necessary documents, and submits them to the lender who then handles loan approval and disbursement.

[14] Mr. Izzard provides that MORTGAGESTOGO.CA is listed in the 15 Yellow Page books throughout Alberta and British Columbia. The affiant also provides evidence of White Page listings (Medicine Hat) in 2006/2007 and 2007/2008. I note that the listings display the Opponent's trade-mark marked with the designation TM.

[15] With respect to the advertising Mr. Izzard states that the Opponent has advertised and marketed its mortgage services in Canada over the internet, through consumer-directed print advertisements, trade-directed print advertisements, radio, television, flyers and billboards.

[16] Regarding the internet, the Opponent advertises its services over its website at *www.mortgagestogo.ca*; the domain name was registered on April 19, 2004 and the website went live shortly thereafter. Mr. Izzard attaches representative pages from the website as Exhibit I; he states that since it went live and continuing to the present, each page of the website includes the trade-mark. I note that each page provided displays the Opponent's trade-mark with the designation TM.

[17] Mr. Izzard states that the Opponent has also received exposure for its services in newspaper and magazine articles, and provides an example of an article appearing in what appears to be a special publication of the Calgary Sun - the 2008 edition of THE DIFFERENCE MAKERS.

[18] With respect to print advertising, the Opponent advertises through advertisements placed in newspaper, trade related publications and listings in various agent/office directories. Mr. Izzard provides as examples, copies of consumer-directed print advertisements, trade-directed advertisements and flyers, all of which prominently display the Opponent's trade-mark. I note that these also evidence use of the trade-name, since, in addition to appearing on the front of the publications, MORTGAGESTOGO.CA appears on the outside back cover, as the name of the business, above the address and telephone contact information for the Opponent's various offices. Dates for these exhibits are not provided. However, Mr. Izzard also attaches photos of

billboards clearly displaying the Opponent's trade-mark; he states that such billboards are located throughout Alberta and have been since 2006.

[19] In addition, Mr. Izzard states that the Opponent has used the trade-mark in dealing with its clients, on items such as letterhead, business cards, promotional items, mugs, calendars, key chains and tote bags, as well as on a monthly column entitled *Ask the Experts* published in the *Calgary Sun* in Calgary, Red Deer and Medicine Hat.

[20] Mr. Izzard provides that the Opponent spent between \$12,000 and \$25,000 advertising and promoting its trade-mark and its business in 2004 and 2005; expenditures from 2006 until 2008 are listed as follows: 2006 - \$119,576; 2007-\$365,652; and 2008- \$625,124.

Applicant's Evidence

Affidavit of Mr. Randy Wall

[21] Mr. Wall provides that he is the President and owner of GO Ltd, operating under the trade name GO MORTGAGES. He has been employed in this capacity since December 9, 2002, and his duties include "sales, marketing, and the financial functions".

[22] Mr. Wall states further that he is the owner of an existing registration for the trade-mark GO registered on November 1, 2005 (TMA 652,041). He states that since at least as early as June 3, 2002, he has been using and continues to use the GO mark in association with real estate sales and services. He also provides that since at least as early as April 10, 2002 and continuously to date, operating as GO MORTGAGES, he has been using and continues to use the GO trade-mark for mortgage services, namely mortgage lending services, mortgage brokerage services. It appears from these statements that Mr. Wall, personally, has been operating under the trade-name GO MORTGAGES using the trade-mark GO, since at least as early as April 10, 2002.

[23] It must be noted, however, that the affidavit continues in a somewhat confusing and ambiguous manner. It also appears that Mr. Wall conducted mortgage and real estate services business under the trade name GO MORTGAGES on behalf of Silverton Management Ltd, (predecessor in title to GO Ltd) which was incorporated on December 9, 2002. Then, in the final paragraph of his affidavit, Mr. Wall states that he has "conducted the mortgage and real estate

services business known as GO MORTGAGES since December 9, 2002.” I note that this is after the claimed date of first use of GO MORTGAGES as a trade-mark.

[24] Relevant corporate registration documents are provided in Exhibit B, and I note that the name change from Silverton Management Ltd to GO Ltd appears to have been registered on June 17, 2009. These documents also indicate associated registrations of trade-names: GO MORTGAGES and GOMORTGAGES.CA. In this regard, Mr. Wall states that GO Ltd. registered the trade name GO MORTGAGES in Alberta for use in association with mortgage brokering on August 12, 2008. However, I note that the Documentation for the Alberta Registration System indicates that the trade-name was registered by its predecessor - Silverton Management Ltd. (Exhibit C).

[25] The affiant further provides that GO Ltd registered a different version of the trade name - GOMORTGAGE.CA, in Alberta for use in association with mortgage brokering on November 2, 2005. I note that the Documentation for the Alberta Registration System indicates that the trade-name was registered by Silverton Management Ltd. (Exhibit D).

[26] Mr. Wall states that he is a licensed member of the Real Estate Council of Alberta, authorized to trade in mortgages on behalf of Silverton Management Limited operating as GO MORTGAGES. A copy of his license and registration certificate for the year October 1, 2008 to September 30, 2009, is attached as Exhibit E. I note that the certificate states that Mr. Wall is authorized to trade in mortgages on behalf of Silverton Management Ltd, operating as Go Mortgages.

[27] Accordingly, it would appear that Mr. Wall is the owner of the subject trade-mark application, which Mark is also the trade-name of a company of which he is the president - GO Ltd. (formerly Silverton Management Ltd). When Mr. Wall describes his business activities related to the Mark, he refers to GO MORTGAGES as the provider of the applied for services.

[28] The affidavit sets out that GO MORTGAGES provides the services to residential, commercial and farm clients, with diverse credit backgrounds. GO MORTGAGES earns a commission in exchange for bringing borrowers and lenders together, paid by the buyer and the lender in the form of closing costs. Mr. Wall identifies Exhibit I as sample mortgage applications and sales contracts downloaded from the GO MORTGAGES website and sent to him, operating

as GO MORTGAGES. In actual fact, it appears that Exhibit I includes what appears to be a standard form BUYER BROKERAGE AGREEMENT, completed by various clients, identifying the Broker as CIR Realtors. Exhibit I also includes Residential Real Estate Purchase Contracts that indicate either CIR Realtors or Randy Wall as the Buyer's representative. None of these documents displays the Mark, and no mortgage contracts appear to be in evidence. Further it is unclear how they were downloaded and sent to the Applicant, since the personal information completed on the forms appears to be handwritten, signed, dated and witnessed. The documents appear to be dated from 2006 to 2009.

[29] Mr. Wall provides evidence of multiple domain names similar to "gomortgages" and "gohomesmortgages", which are registered in his name, apparently to assist consumers and clients in finding the GO MORTGAGES website, the Applicant's actual website. I note that the WHOIS listing (Exhibit J) of the *gomortgages.ca* domain name indicates that the domain name was registered on April 2, 2002, in the name of Randy Wall who is also listed as the administrative contact.

[30] Mr. Wall states that this website has been used as a key advertising and information hub for people to access further information about GO MORTGAGES real estate and mortgage services. Representative pages from the website are attached; each page includes the Mark, which appears as GO ® MORTGAGES TM. The affiant states that this website has been in existence since 2004, (I note that this is 2 years after the domain name was registered), and that between July 2007 and November 2009 there were more than 52, 000 visitors to the website. However, although website traffic statistics are attached (Exhibit M), there is no indication that these figures are restricted to Canadian visitors to the website.

[31] Mr. Wall states that GO MORTGAGES has used the following in dealing with its clients; letterhead, business cards and promotional note pads, all of which prominently display the Mark. Only note paper and business cards are provided; the notepaper letterhead identifies Randy Wall as member of CIR Realtors, with a website address - *www.gohome.ca*, and the trade-mark GO in a diamond design adjacent to the words HOME.ca. The other samples appear to be business cards bearing the trade-mark GO and a leaf design as well as GO® MORTGAGE above the name Randy Wall; appearing below his name is the domain name *www.gomortgage.ca*. I note that these exhibits appear to be attached to affidavits of two customers, which are in turn

attached to Mr. Wall's affidavit. Both affiants state that they have had knowledge of the GO MORTGAGES real estate and mortgage services since August 2005, and that they received the promotional item on or about December 2007.

Remaining Ground of Opposition

Section 38(2)(d)/(2) of the Act – Non-Distinctiveness

[32] Regarding the ground of opposition based on lack of distinctiveness pursuant to section 2 of the Act, to be successful under this ground, the Opponent needs to have shown that as of the date of filing of the opposition (December 12, 2008) its trade-mark had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.), *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Bojangles International, LLC v Bojangles Café Ltd* (2006), 48 C.P.R. (4th) 427), [*Bojangles*]. It is not necessary for the Opponent to show that its mark had become well known; as stated by Noel J in the *Bojangles* case at p.444: “A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient”.

[33] I am satisfied that the Opponent's initial evidential burden has been met for this ground to be considered. The evidence demonstrates that the Opponent has been providing mortgage services, primarily in Alberta, since 2004. I am of the view that the existence of its website, print and billboard advertising, telephone listings, coverage in special editions of the Calgary Sun, are sufficient to establish that the Opponent's trade-mark had become known as of the material date. It must now be determined if the Opponent's trade-mark was sufficiently known at the material date negate the distinctiveness of the Mark.

[34] A consideration of the likelihood of confusion between the trade-marks at issue is the critical factor in determining whether or not the Opponent's trade-mark can negate the distinctiveness of the Mark at issue.

[35] A review of the Applicant's evidence (without the benefit of submissions from the Applicant), indicates that on a reasonable interpretation of the facts, the most that can be said is that Mr. Wall started using the trade-mark GO in April 2002, and registered the trade-name and

domain name GO MORTGAGES shortly thereafter in the name of Silverton Management Ltd, (predecessor to GO Ltd). Apart from the website it does not appear that either of these companies provided services in association with the trade-mark GO MORTGAGES. Arguably some services were provided by Mr. Wall in his own name in association with the Mark; however, given the somewhat confusing assertions of the affiant, it is difficult to find that there was use of the Mark (by anyone) before it is stated to have appeared on the website in 2004.

[36] In so finding, I am aware that the information Mr. Wall provided in his affidavit regarding the use of the trade-mark GO, might have provided a basis for (at least) arguing that use of GO in April 2002 should be considered use of the Mark as applied for (given the obvious descriptiveness of the second element “mortgages”). I am also aware that the ambiguity surrounding *who* was using the Mark raises a serious issue with respect to distinctiveness. However, without the benefit of submissions I am not prepared to address these issues, since in any event, the findings on the likelihood of confusion will be determinative in this opposition.

Confusion

[37] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. The purchaser in mind is described as the casual consumer somewhat in a hurry (*Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) at para. 58 [*Mattel*]). The question is whether this mythical consumer with a vague recollection of the first mark will, on seeing the second comer’s mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares bearing the first mark [*United States Polo Assn. v. Polo Ralph Lauren Corp.*, [2000] 9. C.P.R. (4th) 51 (F.C.A.) at 58].

[38] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the

nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[39] These factors need not be attributed equal weight; rather, 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. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)]. Furthermore, the list of factors set out is not exhaustive of matters that could be considered [see in general *Mattel supra*; *United Artists Corp. v. Pink Panther Beauty Corp.* (1988), 80 C.P.R. (3d) 247 (Fed. C.A.) at 263-264; *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée.* (2006), 49 C.P.R. (4th) 401 (S.C.C.)].

[40] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. Recently, in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.), the Supreme Court of Canada considered the importance of s. 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

... the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar ... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

Section 6(5)(e) – Degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested

[41] It is a generally accepted principle that it is not the proper approach to break the marks into their elements and concentrate upon the elements that are similar, since it is the effect of the marks in their totalities that must be considered [see *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.* (1965), 44 C.P.R. 189 (S.C.C.)]; however, it is still acceptable to "focus on a particular feature of the mark that may have a determinative influence on the public's perception

of it" [*United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at 263) and see *Masterpiece supra*].

[42] In this case, the trade-marks at issue are MORTGAGESTOGO.CA and GO MORTGAGES. In my view the dominant feature of both trade-marks in appearance and when sounded, is the element – GO. Regardless of positioning, GO is the most memorable element of both trade-marks, since MORTGAGES is descriptive of the principle services and .CA clearly indicates a Canadian domain name. I am of the view that in this context, the use of GO (albeit an ordinary dictionary word), is memorable enough to have a determinative influence on the public's perception of the respective trade-marks. Further, both trade-marks convey the idea of mortgages "to go" or "on the go", or in other words, mortgages arranged quickly. I find this factor is therefore in the Opponent's favour.

Section 6(5)(a) - Inherent distinctiveness of the trade-marks and the extent to which they have become known

[43] In this regard I would note that the use of GO in the Opponent's trade-mark is in normal word order as part of a phrase, whereas in the Mark, the use of GO as an adjective in front of MORTGAGES is not usual, and thus as a whole the Mark is slightly more inherently distinctive. However, with respect to acquired distinctiveness through use, I note that the documentary evidence provided by the Applicant is weak and ambiguous. On the other hand, the Opponent's evidence of use is stronger, given the print, internet, billboard advertising leading up to the material date, including the 2008 advertising and promotion expenses of over \$600,000. I am therefore prepared to conclude that the Opponent's trade-mark has acquired sufficient distinctiveness for this factor to be in the Opponent's favour.

Section 6(5)(b) -The length of time each has been in use

[44] The Opponent has evidenced use since 2004, and the Applicant's date of first use is ambiguous at best; setting aside the issue of who was actually using the Mark at the time, the most that can be said is that the Mark appeared on the website in 2004. Accordingly, I am of the view that on balance it cannot be said that this circumstance significantly favours either party.

Section 6(5)(c) and (d) - The nature of the wares, services or business; the nature of the trade

[45] The Applicant applied to register its Mark in association with essentially the same services as those provided by the Opponent. The nature of the services and the nature of the trade appear to be virtually identical, and accordingly this circumstance is in the Opponent's favour.

Likelihood of Confusion

[46] Taking into consideration all of the surrounding circumstances, I find that there is a reasonable likelihood of confusion between GO MORTGAGES and MORTGAGESTOGO.CA.

Non-Distinctiveness

[47] In view of the fact that there is a likelihood of confusion between the Mark and the Opponent's trade-mark, and based on the evidence that the Opponent's trade-mark has been used and was known in Canada at the material date, I conclude that the Opponent's trade-mark is sufficiently known to negate the distinctiveness of the Mark.

Disposition

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

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office