

**IN THE MATTER OF AN OPPOSITION
by Changepoint Corporation to application
No. 1,054,655 for the trade-mark
CHANGEPOINT filed by Chequepoint
Franchise Corporation**

On April 11, 2000, Chequepoint Franchise Corporation (the “Applicant”) filed an application to register the trade-mark CHANGEPOINT (the “Mark”) based upon proposed use of the Mark in Canada.

The application was advertised for opposition purposes in the Trade-marks Journal of February 6, 2002. At that point of time, the statement of services read:

Bureau de Change services, the sale of coins and related financial services namely cheque cashing services, traveller’s cheque issuance and cashing services, money order issuance and cashing services, credit card cash advance services, international money transfer services, including franchise/concessions; wholesaling activities in respect of currency, namely purchase and sale of foreign currency and travellers cheques; automatic teller and point of sale foreign currency; ticket agency services; travel and booking agency services.

On June 25, 2002, Changepoint Corporation (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

As rule 41 evidence, the Opponent filed the affidavit of Bruce J.H. Bishop, its Chief Financial Officer.

The Applicant elected to not file any evidence.

In March 2005, the Applicant amended its application, with the result that the statement of services now reads:

Providing international money transfer services to the general public through concession outlets, specifically excluding services related to computer systems and computer software, and specifically excluding services related to management of information technology; wholesaling activities in respect of

currency, namely, the purchase and sale of foreign currency through concession outlets, specifically excluding services related to computer systems and computer software, and specifically excluding services related to management of information technology.

Each party filed a written argument. An oral hearing was not requested.

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The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”). There is however 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.).]

Section 38(2)(b) Ground of Opposition

The Opponent’s strongest ground of opposition is as follows:

The Mark is not registrable pursuant to s. 12(1)(d) the Act because it is confusing with the Opponent’s prior identical trade-mark CHANGEPOINT, registered in Canada on January 20, 1998 under Registration No. TMA487,867.

Registration No. TMA487,867 issued for the trade-mark CHANGEPOINT based on use of the mark in Canada in association with the following wares and services since at least as early as October 1994:

Wares: computer software in the fields of project and resource management, work management, and workgroup collaboration.

Services: consulting, development, implementation and training services in the fields of project and resource management, work management, and workgroup collaboration; leasing and customizing computer software and systems in the same fields.

The Opponent has satisfied its initial burden by filing a certified copy of registration No. TMA487,867.

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. 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 or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them.

In *Polo Ralph Lauren Corp. v. United States Polo Association et al.* (2000), 9 C.P.R. (4th) 51 (F.C.A.) at 58-59, Malone J.A. summarized the guidelines to be applied when assessing the likelihood of confusion as follows:

A review of some of the leading cases also establishes some practical guidelines. For example, the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later 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 of the earlier. With respect to the degree of resemblance in appearance, sound or ideas under subparagraph 6(5)(e), the trade-marks at issue must be considered in their totality. As well, since it is the combination of elements that constitutes a trade-mark and gives distinctiveness to it, it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks when applying the test for confusion. In addition, trade-marks must not be considered in isolation but in association with the wares or services with which they are used. When dealing with famous or well-known marks, it may be more difficult to demonstrate that there is no likelihood of confusion, especially if the nature of the wares are similar. Lastly, the enumerated factors in subsection 6(5) need not be attributed equal weight. Each particular case of confusion might justify greater emphasis being given to one criterion than to others.

The material date to assess the likelihood of confusion under this ground of opposition is today's date. [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

Although the parties' marks are identical, it is possible for them to have different degrees of inherent distinctiveness if CHANGEPOINT is more suggestive with respect to one of the party's services/wares. I find however that CHANGEPOINT has the same degree of inherent distinctiveness in the hands of each of the parties.

Mr. Bishop attests that the Opponent has used its mark continuously in Canada since October 1994. He provides materials that he says are representative of the manner in which the mark has been used since its adoption, such as User Guides that display the Opponent's trade-mark on the front (Exhibits B1-3). Mr. Bishop does not provide his company's Canadian sales (only its worldwide sales) but he does provide representative invoices that evidence sales to customers in Canada (Exhibit C1). There are invoices, which display the trade-mark CHANGEPOINT at the top, that bear dates from 1994 to 1998. In addition, there are invoices dated 2000 and 2003 that refer to CHANGEPOINT in the body of the invoice.

Although I am satisfied that the Opponent does advertise and promote its wares/services in association with its mark in Canada, I cannot determine from Mr. Bishop's evidence the extent of such promotion since his statements typically provide information that relates to both Canada and the United States.

Nevertheless, since the application was filed based on proposed use and the Applicant has not filed any evidence, s. 6(5)(a) favours the Opponent.

s. 6(5)(b) - the length of time each trade-mark has been in use

This factor favours the Opponent.

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

Mr. Bishop describes his company's business as follows, at paragraph 4 of his affidavit:

Changepoint provides corporate information technology departments with business process

automation software to improve efficiency and align information technology investments with corporate objectives, enabling the proactive management of operational and employee performance. For example, the activities of Changepoint include the development and sale of computer software in the fields of project and resource management, work management, and workgroup collaboration, the offering of consulting, development, implementation and training services in those fields and the leasing and customizing of computer software and systems also in those fields.

At paragraph 15, Mr. Bishop states, “Changepoint offers its services around the world and Canadian companies that do business around the world make use of Changepoint’s wares and services. In particular, many companies with an office or head office in Canada and with offices around the world have purchased and in many cases continue to purchase Changepoint’s wares and services.” He then lists some of his company’s clients, which include Microsoft Corporation, Dell Products LP, MasterCard International, LLC, AT&T Canada Corp., COGNICASE (Canada) Inc. and SAS Institute (Canada) Inc. The invoices provided in Exhibit C1 also show that Canadian National Railways, Ontario Hydro, Zurich Canada, Globe & Mail, and Sun Life Assurance Company of Canada are among the Opponent’s clients.

It appears from Mr. Bishop’s evidence that the Opponent often has its employees attend at the client’s place of business in order to provide its services.

On the other hand, the Applicant’s statement of services makes it clear that its services are offered to members of the general public and are provided at concession outlets.

In its written argument, the Opponent submits that its CHANGEPOINT services are familiar to travellers because the business executives who make the decisions to purchase the Opponent’s wares/services tend to travel a lot and because the Opponent’s CHANGEPOINT services have been advertised in magazines that are distributed to passengers on United Airlines’ flights [paragraph 20, Bishop affidavit]. As I understand it, the opponent’s argument is that there is an overlap between the parties’ wares, services and businesses because travellers will be exposed to both parties’ marks. To me this seems like a tenuous connection and I find that there are significant differences between the parties’ wares, services, businesses, and channels of trade.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

The marks are identical in appearance and sound. When considering the idea suggested, one must consider the associated wares and services. I find that the Applicant's CHANGEPOINT mark suggests that this is the place where one can exchange or obtain currency. On the other hand, the idea suggested by the Opponent's CHANGEPOINT mark is that the use of their wares/services will induce a changing point that will lead to better management of the client's business. Nevertheless, I find that overall s. 6(5)(e) favours the Opponent.

further surrounding circumstances

The Applicant submits that the Opponent's evidence shows that another party, Changepoint Inc., has been using CHANGEPOINT in Canada in association with the same type of business/wares/services as the Opponent. [See invoices in Exhibit C2, Bishop affidavit.] I will not discuss this point further as my decision does not turn on it.

conclusion re likelihood of confusion

Even though the majority of the s. 6(5) factors favour the Opponent, I conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion as of today's date between the Applicant's CHANGEPOINT and the Opponent's CHANGEPOINT marks. This conclusion is premised on the differences between the parties' wares, services, businesses, channels of trade and clientele. It does not seem reasonable to conclude that an end user who has an imperfect recollection of the Opponent's CHANGEPOINT mark, as associated with business management computer software and consulting services, would be likely to think that a concession performing currency exchange services under the mark CHANGEPOINT shares the same source as the business management computer wares and services. The Opponent's evidence falls far short of supporting a conclusion that the Opponent's mark should be entitled to that broad a scope of protection. Moreover, the Applicant has taken extra care to ensure that its statement of services cannot be interpreted as overlapping with the Opponent's services. The s. 38(2)(b) ground of opposition therefore fails.

Section 38(2)(c) and (d) Grounds of Opposition

The Opponent has pleaded three other grounds of opposition that also turn on the likelihood of confusion.

The first two of these are pursuant to s. 38(2)(c), namely that the Applicant is not the person entitled to register the applied-for mark because, contrary to s. 16(3)(a) and (c), the applied-for mark is confusing with the trade-mark CHANGEPOINT and the trade-name Changepoint Corporation, which have been previously used and/or made known in Canada by the Opponent. The material date for considering the issue of confusion under these grounds is the filing date of the Applicant's application.

The remaining ground of opposition is pursuant to s. 38(2)(d), namely that the Applicant's mark is not distinctive because it does not actually distinguish and is not adapted to distinguish the services covered by the application from the services and wares of the Opponent. The material date for considering the issue of confusion under this ground is the filing date of the statement of opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

As intimated previously, I do not consider these grounds of opposition to be as strong as the Opponent's s. 38(2)(b) ground, primarily because the earlier material dates applicable to the s. 38(2)(c) and (d) grounds of opposition result in several of the s. 6(5) factors weighing less in favour of the Opponent.

For reasons similar to those discussed with respect to the s. 38(2)(b) ground of opposition, the s. 38(2)(a) and (c) grounds of opposition also fail.

Section 38(2)(a) Ground of Opposition

The outstanding grounds of opposition plead that the application does not conform with the requirements of s. 30(a) and (i). The material date for assessing these grounds of opposition is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475].

The s. 30(a) ground of opposition fails because the Opponent did not satisfy its evidential burden. The Opponent did not file any evidence or submit any argument in support of its claim that the Applicant's specific services have not been stated in ordinary commercial terms. In any event, it is noted that the specific wording objected to by the Opponent no longer appears in the Applicant's statement of services.

The s. 30(i) ground also fails. Where an applicant has provided the statement required by s. 30(i), a s. 30(i) 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 any event, I would not have found that there was a likelihood of confusion between the marks under this ground either, for reasons similar to those set out earlier.

Disposition

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).

DATED AT TORONTO, ONTARIO, THIS 28th DAY OF SEPTEMBER 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board