

**IN THE MATTER OF OPPOSITIONS  
by Wakefield Realty Corporation to applications  
Nos. 758,126 and 758,127 for the trade-marks  
CUSHMAN & WAKEFIELD and CUSHMAN &  
WAKEFIELD Design filed by Cushman & Wakefield, Inc.**

**On June 30, 1994, the applicant, Cushman & Wakefield, Inc., filed applications to register the trade-marks CUSHMAN & WAKEFIELD and CUSHMAN & WAKEFIELD Design (shown below) based on proposed use in Canada for the following services:**

real estate brokerage services, namely, the leasing and sale of commercial industrial and multi-family residential property; real estate management and facilities operations; appraisal; insurance; real estate project consulting; research and development, including evaluations and reports, site plan analysis and feasibility studies.

**Both applications were amended to include a disclaimer to the word CUSHMAN and both were advertised for opposition purposes on November 8, 1995.**

**CUSHMAN &  
WAKEFIELD**

**The opponent, Wakefield Realty Corporation, filed identical statements of opposition against the two applications on November 17, 1995. A copy of each statement was forwarded to the applicant on December 27, 1995.**

**The first ground of opposition in each case is that the applicant's application does not conform to the requirements of Section 30(i) of the Trade-marks Act. In this regard, the opponent alleged that the applicant could not have been satisfied that it was entitled to use its mark in view of the prior use and registration of the opponent's trade-mark WAKEFIELD and the prior use of its trade-name Wakefield Realty Corporation.**

**The second ground of opposition in each case is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent's trade-mark WAKEFIELD Design (shown below) registered under No. 321,079 for the following services:**

Real estate services including all of the services inherent in the operation of a real estate brokerage, a mortgage brokerage, a business brokerage, property management, and appraisal service.

**Wakefield**

The third ground in each case is that the applicant is not the person entitled to registration of the applied for mark pursuant to Section 16(3)(a) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark WAKEFIELD previously used in Canada by the opponent with real estate services. The fourth ground in each case is also one of prior entitlement based on the opponent's prior use of its trade-name Wakefield Realty Corporation. The fifth ground is that the applied for trade-mark is not distinctive in view of the opponent's use of its trade-mark and trade-name.

The applicant filed and served a counter statement in each opposition. As its evidence in each case, the opponent submitted an affidavit of Howard Freeman. Mr. Freeman was cross-examined on his affidavit and the transcript of that cross-examination and the replies to undertakings given form part of the record of both proceedings. As its evidence in each case, the applicant submitted the affidavits of Jamie Bocking and Frank Ziska. Both parties filed a written argument in each case and an oral hearing was conducted at which both parties were represented.

#### The Opponent's Evidence

In his affidavit, Mr. Freeman identifies himself as the President of the opponent. According to Mr. Freeman, the opponent commenced business in July of 1977 and, since then, has been operating primarily as a residential real estate broker in Toronto and vicinity under the trade-mark WAKEFIELD and the trade-name Wakefield Realty Corporation. Mr. Freeman states that his company also deals in new, commercial, suburban, rural and recreational properties although on cross-examination he conceded that about 95% of the properties sold by his company in the preceding ten years were residential (see the replies to the undertakings given on pages 7-8 of the Freeman transcript).

**Mr. Freeman states that his company listed and sold about 3,000 properties from 1977 to 1996. Furthermore, the opponent has regularly advertised its trade-mark and trade-name in The Globe & Mail and other publications. According to Mr. Freeman, the opponent has spent in excess of \$850,000 on advertising since commencing operations in 1977. Thus, the opponent's trade-mark WAKEFIELD Design and its trade-name Wakefield Realty Corporation have become known to some extent in Toronto and vicinity.**

#### **The Applicant's Evidence**

**The Bocking affidavit evidences eight entries for businesses which include the word Wakefield in their name that Mr. Bocking located in several Canadian telephone directories. Apart from an entry in a Toronto directory for the opponent, only one other entry appears to relate to the real estate business. However, Mr. Bocking did not evidence any use of that business name.**

**In his affidavit, Mr. Ziska identifies himself as the Managing Director, United States/Canadian Operations of the applicant, Cushman & Wakefield, Inc. which carries on the business of development, construction, rental and sale of commercial real estate in the United States. Cushman & Wakefield, Inc. owns Canadian registration No. 476,589 for the trade-mark CUSHMAN & WAKEFIELD WORLDWIDE for services similar to those covered by the present applications.**

**Mr. Ziska states that Royal LePage Commercial Inc. ("Royal LePage") is an Ontario corporation that carries on the same type of business as the applicant across Canada. He further states that the applicant and Royal LePage are both members of Cushman & Wakefield Worldwide which he identifies as an association of seven of the world's leading real estate firms. According to Mr. Ziska, the applicant has authorized Royal LePage to use the trade-mark CUSHMAN & WAKEFIELD WORLDWIDE in Canada.**

**Much of the Ziska affidavit deals with supposed use of the trade-mark CUSHMAN & WAKEFIELD WORLDWIDE in Canada by Royal LePage on letterhead, business cards,**

annual surveys, newsletters, posters and advertisements. First, it should be noted that Mr. Ziska's statements on point are hearsay and are thus inadmissible.

Second, even if Mr. Ziska's statements were admissible, there is insufficient evidence to establish that Royal LePage has used the trade-mark CUSHMAN & WAKEFIELD WORLDWIDE under license from Cushman & Wakefield, Inc. The applicant has not evidenced any such license and the Royal LePage materials appended as exhibits to Mr. Ziska's affidavit do not point to any such license. Rather, those materials typically include a notation that Royal LePage is "An Independent Member of Cushman & Wakefield Worldwide" with no indication as to any trade-mark licensing arrangement.

Third, even if Mr. Ziska's statements regarding the activities of Royal LePage are admissible, they provide little, if any, evidence of use of the two applied for trade-marks. For the most part, the Royal LePage materials evidence use of the trade-mark or trade-name CUSHMAN & WAKEFIELD WORLDWIDE rather than the applied for marks CUSHMAN & WAKEFIELD and CUSHMAN & WAKEFIELD Design. Exhibit E to the Ziska affidavit includes one advertising sheet which shows the CUSHMAN & WAKEFIELD Design trade-mark next to the trade-mark ROYAL LEPAGE & Design but there is no clear indication as to who is using the mark or the extent to which that sheet was distributed in Canada.

### **The Grounds of Opposition**

As for the first ground in each case, it does not raise a proper ground of opposition since the opponent did not allege that the applicant's mark was confusing with the opponent's trade-mark and trade-name or that the applicant was aware of any such confusion. Thus, the first ground of opposition in each case is unsuccessful.

As for the second ground of opposition in each case, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks

at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the opponent's registered trade-mark WAKEFIELD Design is dominated by the word WAKEFIELD which has surname and geographical connotations. Thus, the opponent's trade-mark is not inherently strong. However, as discussed, the opponent has evidenced continuous and not insignificant use of its mark in Toronto and surrounding areas for many years. Thus, I am able to conclude that the opponent's registered trade-mark has become known to some extent in Toronto and vicinity.

The applicant's two marks are comprised of the two words CUSHMAN and WAKEFIELD. The applicant has conceded that the component CUSHMAN is non-distinctive by disclaiming it in both applications, presumably due to its surname significance. In the context of the applicant's two marks, the word WAKEFIELD would likely also be perceived as a surname. Thus, the applicant's two marks are also not inherently strong marks. As discussed, the applicant has failed to evidence any use of those two marks in Canada by itself or a licensed user. Thus, I must conclude that those two marks have not become known at all in this country.

The length of time the marks have been in use favors the opponent. As for the services and trades of the parties, it is the applicant's statement of services and the opponent's statement of services in registration No. 321,079 that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The services of the parties are very similar, both parties being engaged in the real estate business. Thus, the trades of the parties would, or could, overlap. The applicant contends that the services and trades of the parties are distinct because the opponent engages in residential real estate services and the applicant is restricted to commercial real estate services. However, the statements of services at issue are not so restricted. Furthermore, the evidence establishes that although the opponent's primary business is residential real estate services, it does occasionally get involved in other areas of real estate such as rural, recreational and commercial properties.

As for Section 6(5)(e) of the Act, I consider that there is a fairly high degree of resemblance in all respects between the marks at issue. The applicant has conceded that the first component of its two marks (namely, the word CUSHMAN) is non-distinctive. Thus, it has adopted the entirety of the opponent's trade-mark WAKEFIELD as the second and more distinctive component of its two trade-marks.

As an additional surrounding circumstance, the applicant sought to rely on third party uses of trade-names or business names incorporating the word Wakefield in the same area of business. However, as discussed, Mr. Bocking was only able to locate one such name which appears to relate to the real estate business and he failed to evidence any use of that name. Thus, the applicant has failed to evidence common adoption of trade-names including the word Wakefield by third parties in the real estate field.

The opponent relied on the evidence of record pointing to possible incidents of actual confusion or mistake between the marks at issue. On cross-examination, Mr. Freeman was asked about actual confusion and he stated that he was aware of two or three such incidents where customers who had seen the mark CUSHMAN & WAKEFIELD WORLDWIDE assumed some connection with the opponent. Given the limited number of such incidents in evidence, I have not given this circumstance a great deal of weight but it does underscore the likelihood of mistake occurring between the marks of the parties.

**In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the marks at issue, the overlap in the services and trades of the parties and the reputation associated with the opponent's mark at least in the Toronto area, I find that the applicant has failed to satisfy the onus on it to show that its two trade-marks are not confusing with the opponent's registered trade-mark WAKEFIELD Design. Thus, the second ground of opposition in each case is successful.**

**As for the third ground of opposition in each case, the opponent has met its initial burdens by evidencing use of its trade-mark WAKEFIELD prior to the applicant's filing date and showing non-abandonment of that mark as of the applicant's advertisement date. The ground therefore remains to be decided on the issue of confusion between the marks as of the applicant's filing date. My conclusions respecting the second ground are, for the most part, also applicable here. I therefore find that the applicant has failed to show that its two applied for marks were not confusing with the opponent's trade-mark WAKEFIELD as of the applicant's filing date. Thus, the third ground of opposition in each case is also successful.**

**As for the fourth ground of opposition in each case, the opponent has shown prior use of its trade-name and non-abandonment of that name as of the applicant's advertisement date. The fourth ground therefore remains to be decided on the issue of confusion between the applicant's marks and the opponent's trade-name Wakefield Realty Corporation. My conclusions respecting the second ground of opposition are, for the most part, applicable to this ground as well. Thus, the fourth ground of opposition in each case is also successful.**

**As for the fifth ground of opposition in each case, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - November 17, 1995): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons**

**Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.**

**The fifth ground essentially turns on the issue of confusion between the applicant's marks and the opponent's trade-mark and trade-name. Given my conclusions above respecting the issue of confusion respecting the second, third and fourth grounds, it also follows that the applicant's marks are confusing with the opponent's trade-mark and trade-name as of the filing of the present opposition. Thus, the fifth ground in each case is also successful.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's applications.**

**DATED AT HULL, QUEBEC, THIS 8<sup>TH</sup> DAY OF DECEMBER, 2000.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**