



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

Citation: 2012 TMOB 128
Date of Decision: 2012-07-18

**IN THE MATTER OF AN OPPOSITION
by Cirrus Systems, LLC to application
No. 1,432,726 for the trade-mark
CIRRIUS filed by Karen Filice**

File Record

[1] On March 27, 2009, Karen Filice (the Applicant) filed an application to register the trade-mark CIRRIUS (the Mark) for the services described as follow: “real estate sales, service and financing” (the Services) based on use since March 3, 2006.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 25, 2009.

[3] On April 27, 2010 Cirrus System, LLC (Cirrus) filed a statement of opposition which was forwarded by the Registrar to the Applicant on May 20, 2010. The grounds of opposition can be summarized as follow:

1. The application does not comply with the requirements of section 30(a) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that it does not contain a statement in ordinary commercial terms of the specific services in association with which the Mark has allegedly been used. The words “service” and “financing” are insufficiently described;
2. The application does not satisfy the requirements of section 30(b) of the Act in that the Applicant has not used the Mark from the claimed date of first use, namely March 3, 2006;

3. The application does not satisfy the requirements of section 30(i) of the Act in that the application does not contain a statement that the Applicant is the owner of the Mark and cannot state that she is satisfied of her entitlement to use the Mark in Canada in association with the Services in view of her relationship with Cirrius Realty Inc;
4. The application is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's (as defined hereinafter) registered trade-mark CIRRUS, certificate of registration TMA310,087;
5. The Applicant is not entitled to the registration of the Mark pursuant to section 16(1)(a) of the Act in that at the alleged date of first use and at the filing date of the application the Mark was confusing with the Opponent's trade-mark CIRRUS which had been previously used in Canada in association with "automatic teller machine (ATM) access cards, magnetically encoded bank and ATM cards and debit cards, banking services, financial services rendered through the medium of ATM and other electronic terminals, debit card services and ATM services";
6. Pursuant to section 38(2)(d), the Applicant's Mark is not distinctive in that it cannot not distinguish and is not adapted to distinguish the Services from the wares and services of others, and most particularly of the Opponent.

[4] In its counter statement filed on July 20, 2010 the Applicant denied all grounds of opposition.

[5] The Opponent filed as its evidence certified copies of registration No. TMA310,087 and application No. 1,447,030 as well as the affidavits of Dane Penney, Roy Gonzalez and James Hinton. The Applicant filed the affidavits of Karen Filice and Karen Lau Cardinell.

[6] Both parties filed a written argument and no hearing was requested.

Legal Onus and Burden of Proof

[7] The legal onus is upon the Applicant to show that the application complies with the provisions of the Act, but there is however 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

Section 30(b) Ground of Opposition

[8] Regarding the second ground of opposition, the Opponent has an evidential burden with respect to its allegation that the Applicant had not used the Mark at the alleged date of first use claimed in the application in association with each of the Services. Such burden has been characterized as a light one. Moreover the Opponent can rely on the evidence filed by the Applicant herself [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156]. If that is the case, such evidence must raise serious doubts on the accuracy of the statements made by the Applicant in her application [See *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB), *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) and *Williams Telecommunications Corp v William Tell Ltd*, (1999) 4 CPR (4th) 107 (TMOB)]. I shall now review the relevant evidence concerning this ground of opposition.

[9] Mr. Penney is a searcher employed by the Opponent's agent. He conducted a search on the ONCORP DIRECT database which provides corporate and business name information for Ontario businesses. He filed the results of a search concerning Cirrius Realty Inc. which reveals that such entity was incorporated on March 6, 2006 and that the Applicant is an administrator. He also conducted a search of the Canadian Internet Registration Authority for the domain name cirriusrealty.ca. It was registered on March 14, 2006.

[10] Ms. Cardinell has been a legal secretary employed by the Applicant's agent. She filed a copy of the Corporation Profile Report obtained from the Ontario Ministry of Government Services on March 2, 2011 for Cirrius Finance Corp. which shows that such entity was incorporated on June 20, 2006.

[11] Ms. Filice is the Applicant. She states in paragraph 2 of her affidavit that "Cirrius Finance Corp. and Cirrius Realty Inc. under licence have been using the CIRRIUS mark since March 3rd 2006 under licence (sic)." The word "use" is a legal term defined in section 4 of the Act. One must look at the evidence filed in order to determine if in fact there has been use of a trade-mark in association with wares and services within the meaning of section 4. A simple allegation of "use" is not sufficient.

[12] Neither Cirrius Realty Inc. nor Cirrius Finance Corp. was in existence on March 3, 2006, the alleged date of first use of the Mark claimed by the Applicant in her application. Such fact raises a serious doubt on the accuracy of the date of first use alleged in the application. The Opponent has discharged its initial burden of proof. Consequently the Applicant has to show that she was using the Mark in Canada in association with the Services as of March 3, 2006.

[13] There is no allegation in Ms. Filice's affidavit that she has personally used the Mark in Canada prior to the incorporation of Cirrius Finance Corp. and Cirrius Realty Inc. She simply relies on the use of the Mark by such entities in accordance with the terms and conditions of a licence agreement concluded with them. None of the documentary evidence filed to establish use of the Mark such as business cards, advertisements and real estate listings, go back to March 3, 2006. In fact the earliest date mentioned in her affidavit is November 2006 (see paragraph 7 of her affidavit).

[14] Accordingly I conclude that the Applicant has failed to establish that she was using the Mark in Canada in association with the Services as of March 3, 2006. Consequently I maintain the second ground of opposition.

Registrability under section 12(1)(d) of the Act

[15] The relevant date is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[16] The Opponent has filed a certificate of authenticity for registration No. TMA310,087 for the trade-mark CIRRUS registered in association with ATM access cards; banking services and financial services rendered through the medium of ATM and other electronic terminals. I checked the register and such registration is extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats Ltée v Menu Foods Ltd*, 11CPR (3d) 410].

[17] Therefore the Opponent has met its initial burden of proof. As such the Applicant has the onus to prove, on a balance of probabilities, that the use of the Mark in association with the Services is not likely to cause confusion with the Opponent's registered trade-mark CIRRUS. The test to determine this issue is set out in section 6(2) of the Act. I must take into consideration

all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[18] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. I also refer to the decisions of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada inc* (2006), 49 CPR (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) of the Act to determine if there is a likelihood of confusion between two trade-marks.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[19] The word “cirrus” is defined in *The Canadian Oxford Dictionary* as “clouds form at high altitudes as delicate white wisps”. I agree with the Opponent that such word has no connection with the services described above, and as a result the trade-mark CIRRUS is distinctive when used in association with the Opponent’s services.

[20] The Mark is a coined word. It is therefore inherently distinctive. The distinctiveness of a trade-mark may be enhanced through use or promotion in Canada.

[21] Mr. Gonzalez has been the Canada Region Counsel for MasterCard International Incorporated (MasterCard), formerly Cirrus. He states that on October 1, 2010 Cirrus merged into MasterCard. I shall hereinafter refer to Cirrus and/or MasterCard indistinctively as the Opponent, unless stipulated otherwise.

[22] He explains that the Opponent operates in association with the trade-mark CIRRUS a worldwide interbank network that links MasterCard credit cards, MasterCard debit cards, Maestro-brand MasterCard debit cards, as well as the credit cards, debit cards and prepaid cards of many third parties to a network of over 1,000,000 ATMs in over 93 countries. In Canada the

CIRRUS network includes over 57,000 ATMs. He states that there are approximately 9 million CIRRUS cardholders in Canada. He asserts that Canadian financial institutions that are part of the CIRRUS network include, without limitation, the National Bank of Canada, the Bank of Montreal and MBNA. The financial institutions that are members of the CIRRUS network use the CIRRUS trade-mark pursuant to a license granted by MasterCard. He filed a sample of such licence agreement. The CIRRUS debit and credit cards can be used to withdraw cash from any ATM that is part of the CIRRUS network. The cardholders can also use their cards for cash advances, deposits, mortgage payments and pay other bills.

[23] Mr. Gonzalez explains that all debit and credit cards issued by members of the CIRRUS network prominently display the CIRRUS trade-mark. Also all ATMs that are part of the CIRRUS network feature the CIRRUS trade-mark. He filed photographs of a credit card, a debit card and an ATM on which are displayed the CIRRUS trade-mark. He asserts that the CIRRUS trade-mark has been used in Canada with ATM access cards and banking services since at least as early as November 4, 1985 and with financial services rendered through the medium of ATMs and other electronic terminals since at least as early as April 26, 1988.

[24] Mr. Gonzalez does make reference to another registration, namely No. TMA782,725 for the trade-mark CIRRUS & Design allegedly used since June 1992 in association with magnetically encoded bank and ATM cards and debit cards; financial services, namely, debit card services, and ATM services. However such registration has not been alleged in support of the ground of opposition under section 12(1)(d) of the Act. The Opponent has not amended its statement of opposition to include such registration. Nevertheless I consider the use of the trade-mark CIRRUS & Design to be use of the trade-mark CIRRUS [see *Promafil Canada Ltd v Munsingwear Inc* (1992), 44 CPR (3d) 59].

[25] From all this evidence I conclude that the trade-mark CIRRUS is known in Canada but in association with debit cards, credit cards and ATMs. There is no evidence of use within the meaning of section 4(2) of the Act of the trade-mark CIRRUS in Canada in association with any kind of services.

[26] Ms. Filice filed real estate listings where she is identified as broker of record at Cirrius Realty Inc. Those listings are for the period of November 2006 to December 2010. However there is no reference to the Mark on these listings.

[27] She filed business cards used since 2006 on which she alleges the Mark appears. I wish to point out that I only consider the business card of Mr. Joseph Filice to be evidence of use of the Mark. Even though the business card makes reference to the Applicant's licensee, Cirrius Finance Corp., CIRRIUS is written in bold letters much bigger than "Finance Corp.". However Ms. Filice's business card makes reference to "Cirrius Realty Inc." written in letters of the same size and font. Such reference is simply the identification of a corporate name and does not constitute use of the Mark.

[28] Finally Ms. Filice filed samples of advertising material published in local newspapers since 2006. However we do not have the names and the circulation figures of these local newspapers and the exact date of their publication.

[29] It is difficult with such evidence to determine to what extent, if any, the Mark has been known in Canada since 2006. Consequently this factor favours the Opponent.

The length of time the trade-marks have been in use

[30] From the evidence described above this factor does favour the Opponent when considering the use of the trade-mark CIRRIUS in association with debit cards, credit cards and ATMs.

The nature of the wares and services and their channels of trade

[31] A good portion of the argumentation turns on this issue. The Opponent argues that there is an overlap, thus increasing the chances of a likelihood of confusion while the Applicant asserts an opposite view. When assessing the registrability ground of opposition, one must compare the Services as described in the application with the services described in the Opponent's certificate of registration.

[32] Under its ground of opposition based on section 30(a) of the Act, the Opponent argues that the Services are not described in ordinary commercial terms. For the purpose of the present ground of opposition I shall interpret the Services to read: Real estate sales, real estate services and real estate financing. The Opponent's registration for the trade-mark CIRRUS covers inter alia, banking services.

[33] Mr. Hinton was at the time of execution of his affidavit a student employed by the Opponent's agent. He filed extracts of the National Bank of Canada's website which contain information about mortgage solutions as well as extracts of the Bank of Montreal's website containing a section entitled "mortgage options". In *ITV Technologies Inc v Wic Television Ltd* 2003 FC 1056 Madam Justice Tremblay-Lamer stated:

17 With regard to the reliability of the Internet, I accept that in general, official web sites, which are developed and maintained by the organization itself, will provide more reliable information than unofficial web sites, which contain information about the organization but which are maintained by private persons or businesses.

18 In my opinion, official web sites of well-known organisations can provide reliable information that would be admissible as evidence, the same way the Court can rely on Carswell or C.C.C. for the publication of Court decisions without asking for a certified copy of what is published by the editor. For example, it is evident that the official web site of the Supreme Court of Canada will provide an accurate version of the decisions of the Court.

19 As for unofficial web sites, I accept Mr. Carroll's opinion that the reliability of the information obtained from an unofficial web site will depend on various factors which include careful assessment of its sources, independent corroboration, consideration as to whether it might have been modified from what was originally available and assessment of the objectivity of the person placing the information on-line. When these factors cannot be ascertained, little or no weight should be given to the information obtained from an unofficial web site.

There is no further comment on what constitutes an official website. I consider the website of two Canadian banks to be within the concept of "an official website". In any event there is no controversy about the fact that Canadian banks do offer mortgage loans and financial services.

[34] However I wish to point out that, as mentioned by the Applicant in her written argument, nowhere in these extracts is there a reference to the trade-mark CIRRUS. Those extracts do not constitute evidence of use of the trade-mark CIRRUS in association with either banking or

financial services. I consider this portion of the Opponent's evidence to simply illustrate the type of services offered by a Canadian bank.

[35] Ms. Filice filed an advertisement (exhibit C-3 to her affidavit) which contain the following mention:

“Not only do we sell homes & help people buy, we can provide staging assistance, pre-inscription services, brochures, photography, mortgage pre-qualification & through our sister company, Cirrius Finance Corp, first & second mortgages, debt consolidation, investment financing, renovation loans, and construction financing. Truly a one stop shop!!” (My underlines)

[36] Obviously mortgages and financing services are part of banking services. The Applicant argues that the banking services provided by the Opponent in association with the trade-mark CIRRUS are offered through ATM only while the Applicant offers the Services through privately owned companies. Thus there appears to be a distinction in the actual channels of trade. However the Opponent's registration and the present application do not contain restrictions that would limit the parties in their channels of trade.

[37] I consider that there exists an overlap in the nature of the parties' services. The potential customers of both parties include those that are looking for mortgage financing.

Degree of resemblance

[38] In its recent judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

[39] The Applicant's evidence addresses this issue. Firstly Ms. Filice asserts that she pronounces the Mark like the word “serious”. Ms. Filice has not provided any evidence on how the average Canadian consumer would pronounce the Mark. She has not alleged that she is a linguist. It is difficult to determine how a coined word would be pronounced. However in this case it is conceivable that the Mark would be pronounced as “se-rius” while the Opponent's trade-mark is pronounced “se-rus”. Despite the fact that the marks appear to be pronounced slightly differently, there still exists some resemblance in the pronunciation of the marks in issue.

The ideas suggested by them are different. Finally there is a close visual resemblance between the Mark and CIRRUS. It is always the first impression that matters (see *Masterpiece, supra*).

Additional surrounding circumstances

[40] Ms. Cardinell has also included in her affidavit the results of a search conducted using the search engine ONSCOPE which contains the Canadian Trade-marks Office database. She located all active trade-marks containing the words “cirrius”, “cirrus” and “serious” including some spelling variations. She located 80 active marks. There is no in depth analysis of these results in her affidavit or in the Applicant’s written argument save and except for a comment to the effect that there is a significant number of registrations for trade-marks identical to the Opponent’s trade-mark CIRRUS, all for different wares and held in the name of different owners. The Applicant argues that this would suggest that the trade-mark CIRRUS is only entitled to a very narrow scope of protection. I do not consider it being the duty of the Registrar to look at the state of the register evidence and try to determine which of the 80 citations the Applicant should rely on. A party may present an argument based on the evidence filed but there is no obligation on the Registrar to independently ascertain if an argument could be made in favour of a party from the results of a search of the register.

[41] Should I be wrong in this conclusion, I wish to state that I looked at Exhibit A to Ms. Cardinell’s affidavit, and excluding the Opponent’s registered trade-marks mentioned above, there are only 6 registrations for the identical trade-mark but all for totally unrelated wares and services. I do not consider such results to support the Applicant’s contention.

[42] The Applicant also refers to the statement made by Ms. Filice in her affidavit that she is unaware of any instances of confusion despite the concurrent use of the parties’ trade-marks. From the evidence described above, I cannot quantify the extent of the Applicant’s use of the Mark in Canada. The absence of instances of confusion could be explained by the limited use of the Mark in a confined area, namely Hamilton, Ontario.

Conclusion

[43] This is a case where the weight of the criteria favouring the Applicant (inherent distinctiveness of the Mark, the difference in the channels of trade, and the difference in the ideas suggested by the trade-marks) is at best for the Applicant equally weighed by the criteria favouring the Opponent (the CIRRUS trade-mark is more known than the Mark and has been in use for a longer period of time; the Services overlap; and the marks do resemble visually one to another). The difference in the pronunciation of the marks is a non-factor as it is so slight that it does not favour the Applicant. I must consider the casual consumer somewhat in a hurry having an imperfect recollection of the Opponent's trade-mark who might encounter the Mark in association with the Services [see *Matte, l supra*].

[44] Since the burden lies on the Applicant to prove, on a balance of probabilities, that there is no likelihood of confusion between the marks in issue, I conclude that the Applicant has failed to discharge her burden. There exists, on a balance of probability, a likelihood that the average consumer, having an imperfect recollection of the Opponent's trade-mark CIRRUS, seeing the Services being offered in association with the Mark, thinks that they come from the same source or that the Mark has been licensed by the Opponent for use in association with the Services.

[45] Consequently I maintain the fourth ground of opposition.

Other grounds of opposition

[46] The Opponent having been successful under two separate grounds of opposition, it is not necessary for me to assess the other grounds of opposition (entitlement, distinctiveness and compliance with the provisions of section 30(a) of the Act).

Disposition

[47] 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.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office