



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

Citation: 2014 TMOB 78
Date of Decision: 2014-04-03

**IN THE MATTER OF AN OPPOSITION
by Chicago Climate Exchange, Inc. to
application No. 1,312,728 for the trade-
mark MONTREAL GREEN
EXCHANGE in the name of Bourse de
Montréal Inc.**

[1] On August 11, 2006, Bourse de Montréal Inc. (the Applicant) filed an application to register the trade-mark MONTREAL GREEN EXCHANGE (the Mark) in association with the services “operation of a marketplace for the trading of environmental products and/or instruments related to environment and climate, namely, without limitation, greenhouse gases, sulphur dioxide, weather or water” based on proposed use in Canada.

[2] The application for the Mark disclaims the words “Montreal”, “Green” and “Exchange” apart from the Mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 9, 2008.

[4] On December 9, 2008, Chicago Climate Exchange, Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(b) and 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Mark is confusing with the Opponent’s registered trade-marks MONTREAL CLIMATE EXCHANGE (TMA729,552) and MARCHÉ CLIMATIQUE DE MONTREAL (TMA729,186) (the Opponent’s Marks) both registered in association with the following services:

commodity exchange services, namely, dioxide and other greenhouse gas emissions exchange services that facilitate the trading or sale of carbon dioxide and other greenhouse gas emissions allowances and offsets between business and other market participants (the Opponent's Services);

- pursuant to sections 38(2)(c) and 16(3)(a) of the Act, the Applicant is not entitled to registration of the Mark because at the filing date, and at all other material dates, the Mark was confusing with the Opponent's Marks used and/or made known in Canada since prior to the filing date by the Opponent or a licensee thereof in association with the Opponent's Services or services similar thereto or in promotion thereof – and not abandoned at the date of advertisement or otherwise;
- pursuant to sections 38(2)(c) and 16(3)(b) of the Act, the Applicant is not entitled to registration of the Mark because it is confusing with the Opponent's Marks, applications for which were filed prior to the filing date and remained pending at the advertisement date (application Nos. 1,278,088 and 1,285,927);
- pursuant to sections 38(2)(a) and 30(i) of the Act, despite the Applicant's statement in the application that it is satisfied that it is entitled to use the Mark in Canada in association with the Services, the Applicant could not have been so satisfied because the Applicant was aware or ought to have been aware that the Mark is confusing with the Opponent's Marks and because the Applicant was contractually prohibited from using/registering the Mark in Canada;
- pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not, and cannot be, distinctive because it does not actually distinguish nor is it adapted to distinguish and is not capable of distinguishing the Services from the Opponent's Services advertised and performed in Canada in association with the Opponent's Marks.

[5] The Applicant served and filed a counter statement in which it denied the Opponent's allegations.

[6] In support of its opposition, the Opponent filed certified copies of the registration certificates for its trade-marks MONTREAL CLIMATE EXCHANGE (TMA729,552) and MARCHE CLIMATIQUE DE MONTREAL (TMA729,186).

[7] In support of its application, the Applicant filed an affidavit of Francois Gilbert, the Vice President, Legal Affairs for the Applicant as well as certified copies of the following registrations owned by the Applicant:

- BOURSE DE MONTREAL & Dessin (TMA468,712);

- BOURSE DE MONTREAL & Dessin (TMA468,873);
- BOURSE DE MONTREAL & Dessin (TMA702,729);
- MONTREAL EXCHANGE & Design (TMA468,652);
- MONTREAL EXCHANGE & Design (TMA469,251); and
- MONTREAL EXCHANGE & Design (TMA702,730).

[8] Only the Applicant filed a written argument and an oral hearing was not held.

Onus and Material Dates

[9] 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(3) - the date of filing the application [see section 16(3) of the Act]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Summary Dismissal of Grounds of Opposition

Non-compliance with section 30(i) of the Act

[11] As pleaded, the section 30(i) ground of opposition has two prongs, the first is based on an allegation of the Applicant's awareness of the Opponent's allegedly confusing trade-marks and

the second on an allegation that the Applicant was contractually prohibited from using/registering the Mark in Canada.

[12] With respect to the first prong of this ground of opposition, I note that where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and the facts alleged do not create such an exceptional case.

[13] With respect to the second prong of this ground of opposition, the Opponent has not provided any evidence in support of its allegation that the Applicant was contractually prohibited from using/registering the Mark in Canada and thus the Opponent has clearly failed to meet its evidential burden.

[14] Based on the foregoing, the section 30(i) ground is accordingly dismissed in its entirety.

Non-entitlement (section 16(3)(a) of the Act) and non-distinctiveness (sections 38(2)(d) and 2)

[15] The Opponent has failed to provide any evidence of use of or reputation in Canada for its pleaded marks. I note that any reference to use in the Opponent's registrations for the trade-marks MONTREAL CLIMATE EXCHANGE (TMA729,552) and MARCHE CLIMATIQUE DE MONTREAL (TMA729,186) is not sufficient to satisfy the Opponent's evidential burden under section 16(3)(a) of the Act [see *Roos, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)]. The same is true with respect to the non-distinctiveness ground. Accordingly, I find that the Opponent has failed to meet its evidential burden with respect to both the non-entitlement and non-distinctiveness grounds of opposition.

[16] Based on the foregoing, I dismiss the grounds of opposition based on sections 38(2)(a) and 30(i); 38(2)(c) and 16(3)(a); and 38(2)(d) and 2 of the Act.

Non-registrability Ground – section 12(1)(d) of the Act

[17] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the Opponent's registrations for the trade-marks MONTREAL CLIMATE EXCHANGE (TMA729,552) and MARCHE CLIMATIQUE DE MONTREAL (TMA729,186) remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[18] I consider the Opponent's case strongest with respect to the trade-mark MONTREAL CLIMATE EXCHANGE registered under No. TMA729,552. Thus, the determination of the issue of confusion between the Mark and this mark will effectively decide this ground of opposition

[19] 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.

[20] 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-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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

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

[21] Both parties' marks are made up of dictionary words which have some meaning in relation to the associated wares and services. Accordingly, I find the inherent distinctiveness of the parties' marks to be the same and relatively low.

[22] A trade-mark may acquire distinctiveness through use or promotion. However, in the present case neither party has filed evidence to show use or promotion of its marks in Canada.

[23] The Applicant provided evidence regarding its business activities and history in Canada as well as evidence which it submits establishes use and reputation by the Applicant and its predecessors of the trade-marks MONTREAL EXCHANGE and BOURSE DE MONTREAL. However, the Applicant has provided no evidence of use or reputation for the Mark whatsoever.

[24] While it is true that the registration for the Opponent's MONTREAL CLIMATE EXCHANGE trade-mark issued subsequent to the filing of a declaration of use on October 31, 2008 in the absence of actual evidence of use or making known of the mark, at most this entitles me to assume minimal use of the Opponent's mark [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. Minimal use does not support a conclusion that the Opponent's MONTREAL CLIMATE EXCHANGE trade-mark had become known to any significant extent.

[25] As a result, this factor does not favour either party to any significant extent.

Section 6(5)(b) – the length of time each has been in use

[26] As discussed further above in the analysis of the section 6(5)(a) factor, the Opponent's registration only enables me to assume minimal use of MONTREAL CLIMATE EXCHANGE trade-mark. While it may be true that minimal use is more than no use, in the absence of evidence of actual use of either party's marks, this factor does not significantly favour either party.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[27] When considering the nature of the parties' wares, services and business and the nature of the parties' trade, it is the statement of wares and services in the application and the statement of wares and services in the Opponent's registration that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. 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, particularly where there is ambiguity as to the wares or services covered in the application or registration at issue [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[28] In the present case, neither party has provided evidence of their actual trades. As a result, I am left with the wording of the specifications in the application and registration at issue.

[29] On their face, the parties' services are essentially identical, namely commodity trading/exchanging in relation to environmental products and/or gas emissions.

Section 6(5)(e) – the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[30] The parties' marks share some degree of similarity in sound and appearance by virtue of the inclusion of the common words MONTREAL and/or EXCHANGE.

[31] The parties' marks also share some similarities in terms of ideas suggested by virtue of the meanings ascribed to the word GREEN (in the Mark) and the word CLIMATE (in the Opponent's mark). I may refer myself to a dictionary to determine the meaning of words [see *Insurance Co of Prince Edward Island v Prince Edward Island Insurance Co* (1999), 2 CPR (4th) 103 (TMOB)]. The *Canadian Oxford Dictionary* includes the following as a definition for the word GREEN: "concerned with or supporting protection of the environment as a political principle". This suggests a link between the word GREEN and the word CLIMATE which is

defined as “the prevailing weather conditions of an area” and thus also has a connection to issues surrounding the environment (e.g. climate change).

Additional Surrounding Circumstance

[32] The Applicant puts into evidence certified copies of six registrations it owns for the trade-marks BOURSE DE MONTREAL & Dessin (TMA468,712, TMA468,873, TMA702,729) and MONTREAL EXCHANGE & Design (TMA468,652, TMA469,251, TMA702,730) all of which include the words MONTREAL and EXCHANGE. In his affidavit Mr. Francois makes sworn statements regarding the Applicant’s business activities and history in Canada. Specifically, Mr. Francois explains how the Applicant has offered stock exchange services in Canada in association with the trade-marks and trade-names MONTREAL EXCHANGE and BOURSE DE MONTREAL for a number of years. In terms of documentary evidence supporting these sworn statements, Mr. Francois provides only printouts from the Applicant’s website.

[33] This does not form a relevant surrounding circumstance supporting the Applicant’s position. Firstly, the fact that the Applicant owns these registrations does not give it the automatic right to the registration of the Mark [see *Mister Coffee & Services Inc v Mr Coffee, Inc* (1999), 3 CPR (4th) 405 (TMOB) at 416 and *American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 572 (TMOB) at 576]. Secondly, while the evidence suggests coexistence between the Applicant’s trade-marks/trade-names MONTREAL EXCHANGE and BOURSE DE MONTREAL and the Opponent’s Marks, the validity of the Opponent’s registrations is not at issue. There is no evidence of coexistence without confusion of the Mark with the Opponent’s Marks. I am of the view that this evidence is thus of little importance.

Conclusion

[34] 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, I find that the similarity in the nature of the services and the degree of resemblance between the marks at issue favour the Opponent. The remaining factors do not significantly favour either party such that I am of the view that the balance of probabilities is evenly balanced between a finding of

confusion between the Mark and the Opponent's trade-mark MONTREAL CLIMATE EXCHANGE and a finding of no confusion.

[35] As the onus is on the Applicant to establish on a balance of probabilities that the Mark is not confusing with one or more of the Opponent's Marks, I must decide against the Applicant. Based on the foregoing, I find that the ground of opposition based on section 12(1)(d) of the Act is successful.

Non-entitlement ground – section 16(3)(b) of the Act

[36] The Opponent has the initial onus of proving that the trade-mark applications alleged in support of its ground of opposition based on section 16(3)(b) of the Act were pending at the date of filing the Applicant's application, August 11, 2006, and remained pending at the date of advertisement of the application for the Mark, July 9, 2008 [section 16(5) of the Act]. The Opponent's Marks form the basis of the section 16(3)(b) ground of opposition as well. Having exercised my discretion to check the register, I see that the applications for the Opponent's Marks were filed prior to the filing date for the Mark and remained pending at the date of advertisement. The Opponent has thus satisfied its evidential burden.

[37] The difference in material dates is insignificant such that this ground of opposition is successful based on the same analysis as that applied to the section 12(1)(d) ground above.

Disposition

[38] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the Mark pursuant to section 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office