

**IN THE MATTER OF OPPOSITIONS
by Royal Bank of Canada / Banque Royale
du Canada to applications Nos. 713,527 and
713,540 for the trade-marks EXPRESS
DEPOSIT & Design and DEPOT EXPRESS &
Design filed by The Toronto-Dominion Bank**

On September 25, 1992, the applicant, The Toronto-Dominion Bank, filed applications to register the trade-marks EXPRESS DEPOSIT & Design and DEPOT EXPRESS & Design (illustrated below) based on proposed use in Canada with the following services:

banking, insurance, real estate, securities and computerized data processing services.

The first application was amended to include a disclaimer to the word DEPOSIT and the second application was amended to include a disclaimer to the word DEPOT. Both applications were advertised for opposition purposes on July 7, 1993.



The opponent, Royal Bank of Canada / Banque Royale du Canada, filed essentially identical statements of opposition against the two applications on December 7, 1993. A copy of each statement was forwarded to the applicant on February 24, 1994.

The first ground of opposition in each case is that the applicant's application does not comply with the provisions of Section 30(i) of the Trade-marks Act. In support of this ground, the opponent alleged that the applicant could not have been satisfied that it was entitled to use the applied for trade-mark because it was aware that its mark was confusing with the opponent's previously used trade-mark FASDEPOSIT.

The second ground 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 FASDEPOSIT registered under No. 206,773 for "banking services." The third ground in each

case is that the applicant is not the person entitled to registration 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 FASDEPOSIT previously used in Canada by the opponent with "banking services" in general and, more particularly with "a deposit-gathering vehicle [sic] service."

The applicant filed and served a counter statement in each proceeding. As its evidence in each case, the opponent submitted an affidavit of its Manager Retail Services, Don Dempster. The applicant filed virtually the same evidence in each case consisting of the affidavits of Jeffrey T. Imai and Meera Kamra-Kelsey and certified copies of registrations Nos. 427,854 and 432,274 for the applicant's trade-marks TD EXPRESS DEPOSIT and DEPOT EXPRESS TD. Both parties filed a written argument and an oral hearing was conducted at which only the applicant was represented.

As for the first ground of opposition in each case, the onus is on the applicant to show that its application complies with Section 30(i) of the Act. There is, however, an evidential burden on the opponent to show that the applicant was aware of the opponent's mark FASDEPOSIT as of the filing of the applicant's application. Since there is no evidence of record on point, the first ground of opposition in each case is unsuccessful. If the opponent had been able to meet its evidential burden, the success of the first ground would have been contingent on a finding of confusion between the marks of the parties.

As for the second ground of opposition, 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.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, 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 mark FASDEPOSIT would be viewed by the average consumer as equivalent to the words "fast deposit." When used with banking services in the nature of deposit services, the opponent's mark is highly suggestive (if not descriptive) of the nature of those services. The opponent's mark is therefore inherently very weak.

The Dempster affidavit establishes that the opponent has used the trade-mark FASDEPOSIT on deposit boxes and deposit envelopes in or near about 270 of its branches in Canada for the period 1991 to 1994. Mr. Dempster states that the opponent has distributed more than 1.3 million deposit envelopes during that period. However, the sample envelope appended as Exhibit B to the Dempster affidavit shows that the trade-mark FASDEPOSIT is a minor element on the envelope compared to the words DEPOSIT ENVELOPE and ROYAL BANK. On the other hand, the trade-mark FASDEPOSIT is fairly prominently displayed on the deposit boxes. Thus, I am able to conclude that the opponent's mark has become known to some extent in Canada.

The applicant's marks EXPRESS DEPOSIT & Design and DEPOT EXPRESS & Design are also inherently weak since the words "express deposit" and "dépôt express" are highly suggestive (if not descriptive) of the nature of the applied for services in general and deposit services in particular. Both of the applicant's marks, however, do contain significant distinctive design matter. Thus, the applicant's marks possess a greater measure of inherent distinctiveness than the opponent's registered mark.

According to Ms. Kamra-Kelsey, the applicant commenced using its two trade-marks in September of 1992 in association with an automated commercial deposit machine. It appears that the trade-mark EXPRESS DEPOSIT & Design was used at eight of the applicant's branches in Canada and the trade-mark DEPOT EXPRESS & Design was used at one location in Montreal. Ms. Kamra-Kelsey states, in her affidavit, that between 80 and 140 deposits a week have been made at each of the applicant's nine machines. The envelopes used at those machines bear one or other of the applicant's marks although the machines

themselves do not bear either mark. Given the relatively low level of use evidenced to date of the applicant's mark EXPRESS DEPOSIT & Design, I am only able to conclude that it has become known to a limited extent. The mark DEPOT EXPRESS & Design has only become known to a limited extent in Montreal.

Although the opponent's registration for its mark FASDEPOSIT indicates that a declaration of use was filed on April 21, 1975, the opponent has only been able to evidence use since September of 1991. The applicant has evidenced use of its marks since September of 1992. Thus, the length of time the marks have been in use is not a significant circumstance in the present cases.

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. 206,773 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.).

In the present case, there is an overlap between the services of the parties because the opponent's registration and the applicant's applications all cover "banking services." Thus, the potential trades of the parties are the same. Furthermore, the evidence shows that there is an exact overlap in the actual services provided to date in association with the marks at issue, all three marks having been used with automated deposit machines. Also of note is the fact that the evidence of both parties shows that their automated deposit service is provided through machines that are located in or near their branches and that the bank's name and its various other trade-marks and indicia would be apparent to the user of those machines. Thus, it would appear that the nature of the trade in the banking industry is to provide such services

at the branches of a bank thereby minimizing the risk of confusion with a competitor's trade-marks used for the same or similar services.

As for Section 6(5)(e) of the Act, there is some visual and phonetic resemblance between the marks at issue primarily due to the use of the word DEPOSIT or DEPOT. The degree of visual resemblance is, however, less pronounced due to the distinctive design component of each of the applicant's marks. On the other hand, the degree of resemblance between the marks at issue in the ideas suggested by the marks is somewhat greater although the idea of a fast, rapid or express deposit service is not an idea which can be monopolized by any one party.

As an additional surrounding circumstance, the applicant has relied on the state of the register evidence in the Imai affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In his affidavit, Mr. Imai states that he conducted a computerized search of applications and registrations of record in the Trade-marks Office restricted to class 36 where the statement of wares or services contained the word "money", "banking", "finance" or "currency." It appears from the search report appended as Exhibit A to Mr. Imai's affidavit that he also restricted his search to those trade-marks which included the word EXPRESS, FAST, QUICK, RAPID, SPEED or SWIFT.

I agree with the opponent that the Imai search is deficient in a number of respects. Rather than provide photocopies of the entries located, Mr. Imai simply appended a copy of

the computer-generated search report which provides incomplete particulars of the applications and registrations located. For example, in most cases, the statement of wares or services is incomplete. In many cases, the name of the applicant or the registrant is incomplete. Where a design mark has been located, no representation of the design has been provided. Thus, Mr. Imai's search report must be given diminished weight.

Mr. Imai's search report lists 104 trade-marks. However, most of those marks are irrelevant for the purposes of this opposition. Many are the subject of applications which may be based on proposed use or may be the subject of present or future oppositions. Many more are registered for wares or services unrelated to those at issue in the present cases. However, once the irrelevant entries have been weeded out and even when the deficiencies of the search report have been taken into account, the report does show over two dozen trade-marks for banking services and the like which include a word connoting fast service such as EXPRESS, FAST, QUICK and RAPID. Given that at least some of those marks are in active use, it appears that consumers would be at least somewhat accustomed to seeing such marks in the marketplace and would find it easier to distinguish between them based on their differences.

The applicant also relied on the observation of Ms. Kamra-Kelsey, in her affidavit, that she was not aware of any instances of reported confusion between the marks of the parties. However, given the short period of time all three marks had been in use, the relatively low level of use of the applicant's marks and the fact that the use of the marks of both parties has been restricted to their own branches, the absence of instances of actual confusion to date is not surprising. Thus, I do not find Mr. Kamra-Kelsey's observation to be of great significance in the present cases.

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 inherent weakness of all of the marks, the use by other banks of trade-marks with a similar connotation and the fact that the nature of the trade restricts the services of the parties to their own branches, I find that the applicant has satisfied the onus on it to show that

its trade-marks EXPRESS DEPOSIT & Design and DEPOT EXPRESS & Design are not confusing with the opponent's registered mark FASDEPOSIT. Thus, the second ground of opposition in each case is unsuccessful.

As for the third ground of opposition in each case, it, too, turns on the issue of confusion although the material time is the filing date of the applicant's applications. My conclusions respecting the second ground are, for the most part, also applicable to the second ground. Although the applicant's marks were not known at all as of the earlier material time, the opponent's mark had not achieved any reputation of note as of that date. Having considered all of the surrounding circumstances, I find that the marks at issue are also not confusing as of the applicant's filing date. Thus, the third ground is also unsuccessful in each case.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's oppositions.

DATED AT HULL, QUEBEC, THIS 15th DAY OF SEPTEMBER, 1997.

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