



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

Citation: 2016 TMOB 23
Date of Decision: 2016-01-11

IN THE MATTER OF AN OPPOSITION

Moody's Analytics Global Education (Canada) Inc.	Opponent
and	
Chartered Institute for Securities & Investment	Applicant
1,587,146 for the trade-mark CISI Griffin Design	Application

Introduction

[1] Moody's Analytics Global Education (Canada) Inc. (the Opponent) opposes registration of the trade-mark CISI Griffin Design as illustrated below:



[2] The original application was filed by Chartered Institute for Securities & Investment (the Applicant) on July 20, 2012 on the basis of use in Canada since at least as early as October 2009.

[3] A revised application was filed on August 12, 2013. It covers the following services:

Education services, namely, providing courses in the field of securities related to finance, investment management, corporate finance, derivatives related to finance; providing of professional training in the field of securities related to finance, investment management, corporate finance, derivatives related to finance; publication of books; arranging and conducting of conferences, seminars, symposiums and workshops in the field of securities related to finance, investment management, corporate finance, derivatives related to finance; production of radio and television programmes (sic); videotape film production; providing education information for studies in the field of securities related to finance, investment management, corporate finance, derivatives related to finance (the Services).

[4] The grounds of opposition pleaded are based on sections: 30(a), (b) and (i) (requirements), 12(1)(d) (registrability), 16(1) (entitlement), and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). Except for the grounds based on section 30 of the Act, they all turn on the issue of likelihood of confusion with the Opponent's trade-marks listed in paragraph 4(a) of its statement of opposition.

[5] For the reasons explained below, I refuse the application.

The Record

[6] The application was advertised in the *Trade-marks Journal* on January 22, 2014. The Opponent filed its statement of opposition on February 25, 2014. The Applicant filed and served a counter statement on May 2, 2014 in which it denied each and every ground of opposition pleaded by the Opponent, except for an admission that the Applicant did previously filed an application for the registration of the trade-mark CISI CHARTERED INSTITUTE FOR SECURITIES & INVESTMENT & Design, application No. 1,505,991 and that, subsequent to an opposition filed by the Opponent, it was deemed abandoned on January 30, 2014.

[7] The Opponent filed as its evidence the affidavit of Ms. Marie Muldowney sworn on August 28, 2014 (Muldowney Affidavit). The Applicant elected not to file evidence.

[8] Only the Opponent filed a written argument; no hearing was held.

The parties' respective burden or onus

[9] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Preliminary remarks

[10] Given that the Applicant did not file any evidence, or a written argument, and did not request a hearing, the Registrar wrote, on September 14, 2015, a letter to the Applicant inquiring if it intended to proceed with its application. By letter dated October 14, 2015, the Applicant informed the Registrar of its intention to proceed with the above-noted application.

[11] Obviously, in the absence of evidence, a written argument and a hearing, it is difficult for me to outline the Applicant's position with respect to the grounds of opposition raised by the Opponent. However, I still have to determine if the Opponent has evidenced facts that support each of the grounds of opposition pleaded and if so, if they are well founded.

[12] The Muldowney Affidavit is quite lengthy: 76 paragraphs long; and quite voluminous: 45 exhibits in total. Given that the Applicant has not filed any evidence or written argument, I will only refer to what appears to be the most relevant portions of that affidavit.

Grounds of opposition turning on the issue of confusion

[13] The grounds of opposition based on sections 12(1)(d), 16(1)(a), and distinctiveness are all based on the allegation that the Mark, when used in association with the Services, is likely to cause confusion with the following Opponent's trade-marks:

Trade-mark	Registration No.	Filing Date	Registration Date (Date of first use)
CSI	TMA541,898 TMA732,545	June 10, 1999 October 13, 2004	March 5, 2001 (used since at least 1970) January 16, 2009 (used since (1) 1970 and (2) 2000)
CSI & Design	TMA732,541 (colour) and TMA732,543	October 14, 2004	January 16, 2009 (used since at least April 2006)
THE CANADIAN SECURITIES INSTITUTE	TMA459,179	June 30, 1989	June 14, 1996 (used since at least 1970)
CANADIAN SECURITIES INSTITUTE & Design	TMA480,237	December 6, 1994	August 12, 1997 (used since 1994)
FCSI	TMA631,168	April 13, 2004	January 26, 2005 (used since 1976)
FELLOW OF CSI	TMA733,242	July 28, 2005	January 27, 2009 (used since at least 2004)
FELLOW OF THE CANADIAN SECURITIES INSTITUTE	TMA644,311	April 13, 2004	July 14, 2005 (used since 1976)
CSC	TMA541,849	May 26, 1999	March 2, 2001 (used since at least 1964)
THE CANADIAN SECURITIES COURSE	TMA449,504	June 30, 1989	November 3, 1995 (used since at least 1964)

collectively referred as the Opponent's registered marks.

[14] Before I assess those grounds of opposition, I consider that the Opponent has its best chances of success, under anyone of them, with its word marks CSI and its CSI & Design trade-marks, as illustrated herein:



TMA732,541 TMA732,543 (both design marks collectively referred to as the CSI Design marks; the word marks CSI and the CSI Design marks will collectively be referred to as the CSI marks).

[15] The CSI Design marks are registered in association with, amongst other:

Educational services namely developing and providing programs, designations, awards, assignments, examinations, quizzes, forums, seminars, workshops and printed publications and materials, all in the field of financial services; providing educational programs, assignments, quizzes, forums, seminars and workshops in the field of financial services via the Internet.

[16] Registration TMA732,545 for the word mark CSI covers:

(1) Educational services namely developing and providing programs, designations, awards, assignments, examinations, quizzes, forums, seminars and workshops and by the dissemination of printed publications and materials, all in the field of financial services.

(2) Educational services namely providing programs, assignments, quizzes, forums, seminars and workshops, all via the Internet and all in the field of financial services.

[17] Registration TMA541,898 for the word mark CSI covers:

Developing and administering educational programs concerning securities, investment and finance.

[18] The various grounds of opposition turning on the issue of likelihood of confusion must be assessed at different dates:

- Ground of opposition based on section 12(1)(d) of the Act: 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)];
- Ground of opposition based on section 16(1)(a) of the Act: the alleged date of first use of the Mark (October 2009) [see section 16(1) of the Act];
- Ground of opposition based on lack of distinctiveness of the Mark: the filing date of the statement of opposition (February 25, 2014) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317].

[19] Firstly, I must determine if the Opponent has met its initial burden of proof, namely:

- Under section 12(1)(d), that the registered marks listed above are still extant. Ms. Muldowney is the Opponent's Managing Director-Credentials and Licensing. She filed a photocopy of the certificate of registration for each of the Opponent's registered marks. I checked the register and the registrations for the CSI marks are extant;
- Under section 16(1) of the Act, the Opponent must establish use of its CSI marks or that they were known in Canada prior to the claimed date of first use of the Mark (October 2009). As it will appear from the Opponent's evidence to be described after, the Opponent has met its initial burden;
- Under section 2 of the Act, the Opponent must show that its CSI marks had become sufficiently known in Canada on February 25, 2014 to negate any distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. As it will also appear from a summary of the evidence described below the Opponent has met such initial burden.

[20] The difference in the relevant dates associated to these grounds of opposition will not have an impact on the assessment of the various relevant surrounding circumstances to determine whether there was a likelihood of confusion between the Mark and the Opponent's CSI marks at each of the relevant dates.

[21] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Mattel Inc v 3894207 Canada Inc* 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 623(CanLII), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC)].

[22] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's CSI marks, who sees the Applicant's Services in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

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

[23] The word mark CSI is an acronym and has therefore a low degree of inherent distinctiveness [see *Gemological Institute of America Inc v Gemology Headquarter International LLC*, 2014 FC 1153, 127 CPR (4th) 163]. The CSI Design marks do possess a higher degree of inherent distinctiveness because of the design portion. However, given that the dominant portion of these marks is the acronym CSI, overall, they do not possess a high degree of inherent distinctiveness.

[24] The Mark is also composed of an acronym (CISI) and a design portion. However, as in the case of the CSI Design marks, the dominant portion of the Mark is the acronym. Consequently its degree of inherent distinctiveness is similar to the one associated to the CSI Design marks. Finally, given its design portion, the Mark has a higher degree of inherent distinctiveness than the CSI word marks.

[25] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. The application is based on use. However, there is no evidence of use of the Mark in the record.

[26] As for the evidence of use and promotion of the Opponent's CSI marks, it is contained in the Muldowney Affidavit. The relevant portions can be summarized as follows:

- Since being founded in 1970, the Opponent has provided extensive financial education, career training and development, and certifications and designations to professionals in the financial, securities and insurance services areas [para. 8-9 to Muldowney Affidavit];
- The Opponent has an established legacy in the Canadian financial services education industry and is considered to be the most experienced and trusted financial educator in Canada, endorsed by authorities across the country, and encountered by nearly every financial services professional practicing in Canada [para. 33 to Muldowney Affidavit];
- The Opponent currently offers more than 120 courses in Canada, covering a variety of subjects in the securities and mutual funds trading, financial derivatives, risk management, compliance and management, credit and lending, financial planning and wealth management, investment management, trusts, and insurance areas. The Opponent's most well-known course, THE CANADIAN SECURITIES COURSE ("CSC"), has been provided in Canada since at least 1964. By about 1967, most provinces adopted the CSC as a base requirement to sell securities. As the Opponent's course offering expanded, so did the incorporation of those courses into the provinces' basic proficiency requirements. Ms. Muldowney attached to her affidavit examples of provincial requirements [para. 12, 15 and 41 to Muldowney Affidavit];
- Numerous Canadians enroll in the Opponent's courses annually. For example, between 2003 and 2013, the Opponent had an average of about 41,000 regular course enrollments per year. During the same time period, the Opponent also typically secured more than 10,000 continuing education (CE) course enrollments, annually. For each of the last 10 years, the enrollment in the CSC exceeded 10,000 registrants. The current retail price for enrolling in the CSC is \$985.00. Attached to her affidavit are numerous examples of textbooks, screen shots, and other materials associated with the Opponent's courses, much of which is now available electronically. The Opponent's CSI marks are used prominently throughout these exhibits [para. 14, 16 and exhibits 5 to 8 to Muldowney Affidavit];
- The Opponent's designations are considered to be industry-leading credentials and the Opponent meets or exceeds global standards for certification bodies. Indeed, many professionals who have successfully completed the Opponent's programs publicly hold out the credentials that they have attained. Moreover, certain professional designation programs grant pre-qualification, advanced standing, or exemptions to the Opponent's graduates [para. 43-44, 47, 49 to Muldowney Affidavit];

- The Opponent has expended considerable sums of money building the goodwill in the CSI marks to strengthen its brand through various media. The Opponent has invested over \$11 million in marketing the CSI wares and services. For example, over \$600,000 was spent on advertising in 2013 and more than \$400,000 was allocated towards marketing efforts for the Opponent's credentials and designations. The Opponent also spends approximately \$9,000 per month on Google AdWords to generate traffic to its website. Numerous examples of the Opponent's advertising, including print and online advertisements are contained in the Muldowney Affidavit. The Opponent's CSI marks are used prominently throughout these advertisements [para. 21-23, Exhibits 9-10 to Muldowney Affidavit];
- Over the last three years, the Opponent has an average of over 2 million unique visitors to its website each year. As seen from the screen shot in paragraph 24 of the Muldowney Affidavit, the Opponent's website uses the CSI marks prominently on its homepage;
- The Opponent also uses a number of other electronic initiatives to promote its brand. For example, the Opponent conducts extensive email campaigns, sending hundreds of thousands of emails annually to past, current, new and prospective students. The Opponent also maintains Facebook, LinkedIn and Twitter pages, screen shots of which were attached to the Muldowney Affidavit. The Opponent's CSI marks are used prominently throughout each of these social media pages [para. 25, 26 and Exhibit 12 to Muldowney Affidavit];
- The Opponent invests over \$ 100,000 per year in public relation initiatives. Examples of some of the Opponent's other public activities include: member of the non-profit International Forum for Investor Education, and various public education campaigns; partnership with a number of post-secondary institutions across Canada to offer or use the Opponent's courses and seminars within their curriculums [para. 27- 32 to Muldowney Affidavit].

[27] From this evidence, I conclude that the CSI marks are known in Canada in association with educational programs concerning securities, investment and finance.

[28] In all, this factor favours the Opponent.

Length of time the marks have been in use

[29] From the evidence described above, this factor also favours the Opponent since there is no evidence of use of the Mark in Canada in the record, while there is evidence of use of the CSI marks since at least 2002 [see exhibit 9 to Muldowney Affidavit].

The nature of the services and their channels of trade

[30] There is clearly an overlap between the Services and the services covered by the Opponent's registrations for its CSI marks as well as the services it provides and advertises in

association with those marks, as appears from the summary of the content of the Muldowney Affidavit.

[31] There has been no evidence of the Applicant's channels of trade except for the content of paragraphs 57 to 59 to the Muldowney Affidavit. She states that the Applicant and the Opponent are known competitors offering products of the same nature, in the same industry. She filed as Exhibit 32 to her affidavit an extract of the Applicant's website listing the courses and exams offered by the Applicant. In paragraph 58 of her affidavit, she compares the Applicant's and the Opponent's course offering to demonstrate the similarities between them.

[32] Given that such evidence has not been contradicted, and that there exists a similarity and an overlap in the parties' services, I can infer that there would be, as well, an overlap in the parties' channels of trade.

Degree of resemblance

[33] As stated by the Supreme Court of Canada in *Masterpiece*, in the majority of cases, the degree of resemblance between the marks in issue is the most important factor.

[34] The test for confusion has been set out in the following terms by Mr. Justice Binnie in *Veuve Clicquot, supra*, at para. 20:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark], at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[35] As mentioned previously, the dominant portion of the Mark is the acronym portion CISI. The griffin design is smaller and in lighter shade of gray. Visually, the dominant portion of the Mark and the CSI marks do resemble one another as the only difference is the letter 'I' inserted between the 'C' and the 'S' in the Mark. When sounded, and the letters are pronounced individually (C-S-I versus C-I-S-I), there is some similarities between the marks in issue. In *Gemological*, the Court held that, given the acquired distinctiveness of the mark GIA through its

use, it deserved protection such that small differences between the marks would not avoid confusion. The same conclusion applies in the present case.

[36] Therefore, this factor also favours the Opponent.

Conclusion

[37] From this analysis of the relevant criteria, I conclude that the Applicant has failed to meet its legal onus to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's CSI marks. I base my decision on the fact that the Opponent's CSI marks are known in Canada in association with educational programs concerning securities, finance and investment; there is an overlap in the parties' services and their channels of trade; and there is a fair degree of resemblance between the parties' marks in sound and appearance. As for the differences between the Mark and the Opponent's CSI marks, namely the griffin design and the addition of the letter 'I' between the 'C' and the 'S' in the Mark, I do not consider them to be sufficient to enable a consumer, with a vague recollection of the Opponent's CSI marks, on a first impression basis, to associate the Applicant as the source of the Services.

[38] Consequently I maintain the grounds of opposition based on section 12(1)(d), 16(1) and 2 (distinctiveness) of the Act.

Other grounds of opposition

[39] The Opponent having been successful under three separate grounds of opposition, it is not necessary to assess the remaining grounds of opposition.

Disposition

[40] 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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
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No Hearing Held

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