

**IN THE MATTER OF OPPOSITIONS  
by Visions Financial Group Inc. to applica-  
tions Nos. 641,644 and 647,224 for the trade-  
marks VISION and VISION & Design filed  
by The Royal Trust Company**

**On September 28, 1989, The Royal Trust Company filed an application to register the trade-mark VISION for “trust company services and credit card services.” On December 15, 1989, The Royal Trust Company filed an application to register the trade-mark VISION & Design (illustrated below) for the same services. Both applications are based on proposed use in Canada. The first application was advertised for opposition purposes on July 4, 1990 and the second was advertised on August 22, 1990.**

**The opponent, Visions Financial Group Inc., filed a statement of opposition against the first application on November 5, 1990 and a statement of opposition against the second application on December 20, 1990. The two statements of opposition are essentially identical, the first ground in each case being that the application does not comply with Section 30(a) of the Trade-marks Act because the description of services is indefinite and too broad. The second ground of opposition in each case is that the applied for trade-mark is not distinctive in view of the opponent’s use of its trade-marks and trade-names Visions Financial Group and Visions Financial Group Inc. with financial planning services.**

**The applicant filed and served a counter statement in each opposition. As its evidence in each case, the opponent filed the affidavit of its President, Alexander DiMauro. Mr. DiMauro was cross-examined on his affidavit and the transcript of that cross-examination forms part of the record in both proceedings. As its evidence in each case, the applicant filed**

the affidavits of Nancy Joan Perkins, Naushina Panju and Robert W. White. Ms. Perkins was cross-examined on her affidavit and the transcript of that cross-examination and the subsequently filed replies to undertakings form part of the record in both proceedings.

Both parties filed a written argument in each case and an oral hearing was conducted on June 18, 1996 by way of telephone conference call. Both parties were initially represented at the hearing but the opponent's agent did not make any substantive submissions and indicated that he would not be staying on line to listen to the submissions of the applicant's agent.

By letter dated June 14, 1993, the applicant sought to amend both applications by changing the statement of services to read as follows:

trust company services, namely providing automated teller machine privileges and credit card services, namely the extension of credit to applicant's cardholders for the purchase of goods and services and arranging for the subsequent payment for such purchases.

The amended applications were accepted on July 16, 1993.

The two applications were assigned to Shell Canada Limited by means of a document dated July 19, 1993 which purports to be effective as of May 28, 1993. The assignment was made of record on December 10, 1993.

As for the first ground of opposition in each case, I agree with the applicant's contention that, in view of the amendments to the statement of services, it is now moot. The opponent's allegations of fact in support of its first ground were only in relation to the original statement of services and no attempt was made to amend the first ground in response to the applicant's amendments. In any event, the amended statement of services would appear to be in ordinary commercial terms. Thus, the first ground of opposition in each proceeding is unsuccessful.

As for the ground of opposition based on non-distinctiveness 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 5, 1990 respecting the first opposition and December 20, 1990 respecting the second opposition): 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 supporting its ground of non-distinctiveness.

Mr. DiMauro, in his affidavit, states that he incorporated Matrix Marketing Inc. on January 29, 1988 and that articles of amendment changing the company name to Visions Financial Group Inc. were registered on November 10, 1989. A license to sell securities and financial instruments was granted to the opponent on May 31, 1990 by the Ontario Securities Exchange Commission and the opponent then commenced providing commercial services.

Although Mr. DiMauro, in his affidavit, sought to portray his company's activities as generating a significant reputation for his company's trade-name Visions Financial Group, on cross-examination it became apparent that the opponent's activities prior to the material times were minimal. The evidence is unclear as to whether the opponent's trade-name acquired any reputation prior to May 31, 1990 and the number of customers served up to the end of 1990 was about 40 to 45 (page 38 of the DiMauro transcript). The commercial activity engaged in by the opponent was the sale of mutual funds and the opponent's income from that activity for 1990 was about \$10,000 (page 40 of the DiMauro transcript). Mr. DiMauro referred to radio and newspaper ads and a brochure featuring the opponent's trade-name but these activities were after the material times. Thus, as of the material times, the opponent's trade-name had acquired a very limited reputation in the Toronto area in association with the sale of mutual funds.

By way of contrast, the Perkins affidavit establishes that, as of the material times, the applicant's trade-marks had acquired a very significant reputation in association with a particular credit card service. At the time of signing her affidavit, Ms. Perkins was a Partner, Personal Lending Services at Royal Trust Corporation of Canada which, like The Royal Trust Company, was a wholly owned subsidiary of Royal Trustco Limited. The Royal Trust Company operated primarily in Quebec and was the owner of the applied for trade-marks. Royal Trust Corporation of Canada operated in the rest of Canada and was a proposed registered user of the marks. Throughout her affidavit, Ms. Perkins referred to the two companies collectively as Royal Trust. Although Ms. Perkins did not specifically state that Royal Trust Corporation of Canada had been licensed to use the trade-marks applied for by The Royal Trust Company, a fair reading of her affidavit suggests that such was the case.

Royal Trustco and Shell Canada Products Limited ("Shell") entered into negotiations in late 1988 with a view to transferring Shell's credit card business. Those negotiations were successful and in June of 1989, Royal Trust took steps to select a new name for the new credit card. In September of 1989, Royal Trust selected VISION as the new name and in January of 1990 commenced converting Shell credit cards to VISION cards. The cards feature the trade-marks VISION, MASTERCARD, ROYAL TRUST and a seashell logo owned by Shell. Royal Trust is a licensee of the trade-mark MASTERCARD and the VISION card appears to be a particular type of MASTERCARD credit card representing a joint venture between Royal Trust and Shell. In particular, the VISION credit card customers get a specific breakdown of Shell purchases on their monthly statements and mailings to such customers can include promotional material of both Royal Trust and Shell.

According to Ms. Perkins, by December of 1990, Royal Trust had issued more than 650,000 VISION cards and 1990 purchases by VISION cardholders totalled in excess of \$437 million representing more than 11.7 million transactions. In 1990, Royal Trust and Shell spent more than \$4 million to produce, issue, manage and advertise the VISION card. Throughout 1990, Royal Trust mailed significant numbers of cards, applications and advertising materials featuring the trade-marks VISION and VISION & Design. Thus, within the space of one year,

the applicant's trade-marks had acquired a fairly significant reputation throughout Canada.

Having reviewed the evidence of record, I find that the applicant did, in fact, distinguish the services of The Royal Trust Company from those of the opponent as of the material times. As of those two dates, the trade-marks VISION and VISION & Design had acquired a significant reputation throughout Canada in association with a credit card service. The opponent's trade-name, on the other hand, had acquired a very limited reputation within a localized area. Furthermore, the opponent's name had been used in association with the sale of mutual funds which is different from the particular services covered by the present applications. Finally, the opponent had notice of the applicant's applications as of its date of advertisement (i.e. - July 4, 1990) and thus the opponent's subsequent evidence of use of its trade-name should be given less weight: see Humpty Dumpty Foods Ltd. v. George Weston Ltd. (1989), 24 C.P.R.(3d) 454 at 462 (F.C.T.D.). Thus, I find that the applicant has satisfied the onus on it to show that its two trade-marks are distinctive and the second ground of opposition in each case is therefore also unsuccessful.

In reviewing the applicant's evidence, there is some question as to whether the two trade-marks distinguished the services of The Royal Trust Company as of the material times since the VISION card and accompanying advertising and promotional material are ambiguous as to source. The card and the material seem to point not only to Royal Trust but also to Shell and possibly also to the owner of the MASTERCARD trade-mark. Although Royal Trust was licensed to use the MASTERCARD trade-mark, it is less clear that Royal Trust was licensed to use any of Shell's marks and vice versa. Apparently Shell was not a proposed registered user of the applicant's trade-marks as of the material times (see the reply to the undertaking given at question 244 of the Perkins transcript). However, the Perkins cross-examination suggests that Royal Trust and Shell may well have cross-licensed one another to use the marks in question. In any event, the opponent's second ground of opposition in each case is restricted to reliance on use of the opponent's own trade-name. Therefore, I am precluded from considering this additional ground of non-distinctiveness: see Imperial Developments Ltd. v. Imperial Oil Limited (1984), 79 C.P.R.(2d) 12 at 21 (F.C.T.D.).

**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 20th DAY OF JUNE, 1996.**

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