

**IN THE MATTER OF AN OPPOSITION by
Desjardins Sécuritaire Financière,
compagnie d'assurance-vie, to
Application No. 880593 for the Trade-
mark SOLO filed by The Bank of Nova
Scotia**

On June 4, 1998, The Bank of Nova Scotia («Applicant») filed an application to register the trade-mark SOLO («Mark»), based on proposed use, in association with a list of wares and services which was subsequently amended in response to an office action from an examiner to read:

WARES: Printed material, namely product brochures, posters, newspapers, periodicals, newsletters and books (“Wares”);

SERVICES: banking services, securities investment services and trust company services. (“Services”).

The application was subsequently advertised in the Trade-marks Journal on November 24, 1999, for opposition purposes.

On January 27, 2000, Assurance-Vie Desjardins-Laurentienne inc (the «Opponent») (which later merged with L'Impérial, compagnie d'assurance-vie du Canada to form Desjardins sécurité financière , compagnie d'assurance-vie) filed a Statement of Opposition. The Opponent alleges that:

- a) The Applicant couldn't be satisfied that it was entitled to the registration of the Mark as the trade-mark SOLO is used by the Opponent since at least November 3 1989 in association with insurance services, namely: life insurance, health insurance, invalidity insurance, medication insurance, paramedical expenses insurance and dental insurance. (“Opponent's services”);
- b) The Mark is not registrable as it is confusing with the Opponent's trade-mark SOLO used since November 3, 1989;
- c) The Applicant is not the person entitled to registration as it is confusing with the Opponent's trade-mark SOLO used since November 3, 1989;
- d) The Opponent's trade-mark SOLO has acquired notoriety and is well known.

The wording of the statement of opposition to describe the various grounds of opposition might not be of the style generally used by trade-mark agents but the Applicant was able to respond to it as appears from its counter statement. In fact when responding to ground c) above, it did refer to Section 16(3) (a) of the Trade-Marks Act (“Act”).

The Opponent didn’t allege any registered trade-mark in its statement of opposition nor in its evidence; therefore ground b) above is ill founded as registrability of a trade-mark can only be assess against a registered trade-mark [See Section 12(1)(d) of the Act]. Ground a) is not a proper ground of opposition and is also dismissed. Should I be wrong in reaching this conclusion, the outcome of such ground of opposition rests on the issue of likelihood of confusion between the Mark and the Opponent’s trade-mark SOLO. As for ground d) described above, it is one of the criteria mentioned in section 6(5) of the Act when assessing the likelihood of confusion and as such it doesn’t form per se a valid ground of opposition. Finally, the ground of opposition described in c) above really means that the Applicant is not the person entitled to the registration of the Mark as it is confusing with the Opponent’s trade-mark SOLO previously used or made known in Canada.

The evidence filed by the Opponent consists of the solemn declaration of Claude Gaboury while the Applicant filed the affidavits of Amanda Cardinal and Linda Victoria Thibeault. Both parties submitted written arguments and were represented at an oral hearing.

Before reviewing the evidence filed, I shall deal first with two preliminary issues raised in the written submissions and at the hearing. The Opponent argues in its written submissions that the mark is confusing with the registered trade-mark SOLO PRIME certificate of registration 461970 which was assigned to it subsequent to the filing of the statement of opposition and apparently recorded on the register on August 27, 2001.

The Opponent wanted to introduce evidence of the existence of such certificate of registration. The Applicant objected to such evidence since the Opponent never raised this registered trade-mark as the basis of a ground of opposition. Mr David J. Martin, member of the Board, in *MacDonald’s Corp & al v. Victorian Dairy Industries Authority*, (1987) 17 C.P.R. (3d) 82 at 86 stated:

“During the course of the oral hearing, the agent for the opponents sought leave pursuant to s. 42 of the Trade Marks Regulations, C.R.C. 1978, c. 1559, to amend the second ground of opposition to include reliance on prior use by the first opponent McDonald's Corporation of the various registered trade marks. Both parties were given an opportunity to speak to the request for leave.

The policy of the Trade Marks Opposition Board is to grant leave to amend a statement of opposition where it is satisfied that it is in the interest of justice to do so having regard to all the surrounding circumstances including (i) the stage the opposition proceeding has reached, (ii) whether the request for leave to amend could have been made at an earlier stage, (iii) the importance of the proposed amendment to the opponent and (iv) the extent to which the applicant would be prejudiced if leave was granted: see *Nabisco Brands Ltd., also trading as Christie Brown & Co. v. Perfection Foods* (1986), 12 C.P.R. (3d) 456 at p. 458 (F.C.T.D.).

In the present case, the request was made at a very late stage and it could have been made much earlier.”

I maintain the Applicant’s objection for the following reasons:

- i) The Opponent didn’t request permission to amend its statement of opposition to raise as an additional ground of opposition that the Mark is not registrable because it is confusing with its registered trade-mark SOLO PRIME as per the provisions of Section 12(1)(d) of the Act;
- ii) Even if such demand had been made at the hearing, I would have refused it as being requested too late. The oral hearing is not a mechanism for introducing evidence into an opposition proceeding. [See *Aero Garment Ltd v. Stella Handbags Ltd. (1980) 79C.P.R. (2d) 146*] The recordal of such transfer to the Opponent appears to have occurred more than two years ago;
- iii) The issue of the ownership of the trade-mark SOLO PRIME was raised by the Opponent only after the filing of the Applicant’s evidence which includes state of the register evidence that cites such trade-mark, owned by the Opponent’s predecessor-in-title at the time of filing of such evidence;

- iv) Even if the Opponent raised the issue of registrability of the Mark as a ground of opposition (ground b) above), it didn't refer to any registration and could not have referred to such registration as it didn't own the trade-mark SOLO PRIME at the time of filing of the statement of opposition; and
- v) Despite the fact that registrability must be assessed as of the date of the decision [see *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) 413 at 424 (F.C.A)], there had to be facts alleged in the statement of opposition to support such ground of opposition.

The other issue results from the content of Mr Gaboury's solemn declaration that contains numerous references to the trade-mark SOLO SÉCURITERRE, which is also not raised in the statement of opposition. I shall disregard as a ground of opposition any prior use of the trade-mark SOLO SECURITERRE (note that SOLO SECURITERRE and SOLO SÉCURITERRE are used interchangeably in his solemn declaration. I shall use SOLO SÉCURITERRE in the remainder of this decision) because:

- (i) The Opponent didn't request permission to amend its statement of opposition to raise as an additional ground of opposition the prior use of such trade-mark;
- (ii) Even if such request had been made at the hearing, I would have refused it as being requested too late. The Opponent was aware or should have been aware, since at least October 4, 2000, the date of execution of Mr Gaboury's affidavit, of the "use" of such trade-mark.

I shall deal hereinafter with the additional issue raised by the Opponent that, if I disregard the evidence of "use" of the trade-mark SOLO SÉCURITERRE for the reasons outlined above, I should still take into consideration such evidence as it constitutes evidence of "use" of the trade-mark SOLO.

The Opponent's Evidence

Mr Gaboury has been an employee of the Opponent since 1974 and is responsible for the marketing of the SOLO and SOLO SÉCURITERRE insurance programs offered by the Opponent. The Opponent is in the business of offering for sale and selling, to its customers, the Opponent's services. These services are offered through more than 1100 independent advisors, partners of the Opponent. There are no details provided as to the form of partnership and if there exists any form of license agreement for the use of the Opponent's trade-mark SOLO. The Opponent's services are offered in association with the trade-marks SOLO and SOLO SÉCURITERRE to individuals that are unable to benefit from group insurance plans.

Between 1989 and June 2000, the Opponent issued more than 8400 insurance policies under the trade marks SOLO and SOLO SÉCURITERRE. The annual premiums for these policies represent more than \$7,6 million. It should be noted that there is no breakdown of the policies issued under the trade-mark SOLO and those issued under the trade-mark SOLO SÉCURITERRE. There is also no breakdown on a yearly basis of these sales figures. Filed as Exhibit CG-1 are two propositions dated in November 1989 bearing the trade-mark SOLO and design, one signed in Lévis-Lauzon. There are also various samples of insurance policies, all of which bear the trade-mark SOLO and design.

Mr Gadoury states that, since 1989, the Opponent has allocated important sums of money for the marketing and advertising of the Opponent's services. Unfortunately there is no reference in his affidavit to the actual sums of money spent in Canada to promote the Opponent's services in association with the trade-mark SOLO. He does allege that the annual costs for operating the Opponent's services are in excess of \$1,5 million. One must distinguish the costs of operation of the Opponent's services from the sums of money spent in advertising such services. The annual costs for operating the Opponent's services are of little assistance in the determination of the issues described above.

He filed, as exhibit CG-2, a sample of the Opponent's promotional and publicity pamphlets on which appear the trade-marks SOLO or SOLO SÉCURITERRE or both of them in various stylised forms. We have no indication as to when, where and how many of these brochures were used in Canada.

Mr Gadoury states that trade-mark applications to register the trade-marks SOLO and SOLO SÉCURITERRE were filed on January 26, 2000 under application numbers 1,043,978 and 1,043,979 respectively. As these applications were filed subsequently to the present application, they can't be cited under ground of opposition c) above. [See section 16(3)(b) of the Act and *ConAgra Inc v. McCain Foods Ltd (2001), 14 C.P.R. (4th) 288*]

Finally he states that the trade-mark SOLO is well known because of its use, the marketing efforts to promote it and the sales made by the Opponent over the last 10 years. The question as to whether or not a mark is well known is an issue to be determined by the Registrar from the evidence filed in the record. I shall therefore disregard such allegation.

The Applicant's evidence

Ms. Thibeault has been a trade-mark searcher at Trade-Marks Reflections Ltd for 17 years. She received instructions from the Applicant's agents to conduct a search of the register to locate trade-mark applications and registrations which incorporate the word SOLO in connection with "financial and insurance services". She located eight (8) citations listed in exhibit A to her affidavit, which include the present application and the Opponent's subsequently filed applications for the trade marks SOLO and SOLO SÉCURITERRE, thus leaving only five (5) other pertinent citations. She also conducted a search of the register to locate co-existing identical or similar registered trade-marks owned by different registrants in connection with "financial services" and "insurance services". She located eighteen (18) pairings filed as Exhibit C to her affidavit. There hasn't been any evidence of use of any of these trade-marks. The state of the register evidence can be used only if one can make inferences from it about the state of the marketplace. [See *Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R. (3d) 432 (T.M.O.B.)*, *Welch Foods Inc. v. Del Monte Corp. (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)* and *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R. (3d) 349 (F.C.A.)*] A review of exhibit C reveals that the majority of the pairings consist of weak trade-marks (for example DOMINION LIFE vs. DOMINION SECURITIES, ROYAL vs. THE ROYAL, etc.) and as such are able to co-exist as

any difference in their respective list of wares or services is sufficient to negate any likelihood of confusion.

Ms. Cardinal is Group Product Manager at Scotia Securities Inc (“SSI”) a subsidiary of the Applicant. Part of her responsibilities includes, the marketing and sale of Scotiabank’s products and services. She describes the Applicant as a full service financial institution, which provides financial products and services in Canada. She doesn’t explain what she means by a “ full service financial institution” and doesn’t list the products and services offered by such institution.

She states that the Applicant offers various portfolio management services to customers who invest in mutual funds, including accounts comprising the mutual funds portfolio an investor’s chooses. One of such Applicant’s account bears the Mark. She alleges that the Applicant first used the Mark on August 20, 1998, through a mass mailing to 460,000 homes in Canada. A copy of one of the publications sent to potential customers was filed as exhibit A to her affidavit. She also filed, as Exhibit B to I to her affidavit, samples of other brochures distributed between October 1998 and May 3, 2001 (the date of her affidavit) in which there is a description of the various accounts, including references to the account bearing the Mark.

Finally, she alleges that she is not aware of any instances of confusion between the Mark and the Opponent’s trade-mark SOLO.

From the evidence filed in the record, I conclude that there is evidence of use, as defined in Section 4 of the Act of the Applicant’s Mark since August 1998 in association with the Services. There is however no evidence of use of the Mark in association with the Wares.

The Legal Issues

The material time for considering the issue of non-entitlement based on Section 16(3) of the Act is the filing date of the application (June 4, 1998) [Section 16 of the Act].

In order to determine whether the Mark is confusing with the Opponent's trade-mark SOLO, Section 6(5) of the Act directs the Registrar to have regards to all of the surrounding circumstances, including:

- i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- ii) The length of time the trade-marks or trade-names have been in use;
- iii) The nature of the wares, services, or business;
- iv) The nature of the trade; and
- v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them.

The burden of proof lies on the Applicant who must convince the Registrar, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-mark SOLO at the abovementioned relevant date [*see Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982), 61 C.P.R. (2d) 53* and *Christian Dior, S.A. v. Dion Neckwear Ltd [2002] 3 C.F.405*].

It has been established that the criteria listed in section 6(5) of the Act 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 C.P.R. (3d) 483 (F.C.T.D.)* and *Gainers Inc. v. Marchildon (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)*].

Mr Justice Décarý in *Dion Neckwear op. cit.* stated:

“A review of some of the leading cases also establishes some practical guidelines. For example, the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier.”
(...)

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare

commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favour of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a registrar should avoid resorting to it.”

It is with these principles in mind that I shall now review the circumstances listed in Section 6(5) of the act.

i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

The Mark is a dictionary word, however it doesn't suggest the character or quality of the Services to be provided by the Applicant in association with it. It is only after reviewing the Applicant's brochures, Exhibit B to Ms. Cardinal's affidavit, in which there is a description of the Services to be provided in association with the Mark, that we can understand the choice of the word "solo" as a trade-mark for the Applicant's Services. The consumer, who will be using the banking services offered by the Applicant in association with the Mark, will be designing alone the asset mix to be included in such account. The Opponent's services provided in association with the trade-mark SOLO, as appears from the Opponent's brochures, Exhibit CG-2 to Mr. Gaboury's affidavit, are specially designed for self-employed worker or those who don't have group insurance coverage. As such, I conclude that the Mark and the Opponent's trade-mark SOLO have the same degree of inherent distinctiveness.

The Applicant is arguing that there is no evidence of use in Canada of the Opponent's trade-mark SOLO. I disagree with the Applicant. One proposition filed as Exhibit CG-1 to Gaboury's affidavit was signed in Levis-Quebec, while there are numerous indications in the sample insurance policies (part of Exhibit CG-1 to Mr. Gaboury's affidavit) and in the brochures, Exhibit CG-2 to his affidavit that the Opponent's services are provided in Canada.

As for the extent to which they have become known as of the critical date (June 4, 1998), the Applicant's Mark was not in use at that date. There has been some evidence of use of the trade-mark SOLO by the Opponent. The Opponent argues that any evidence of use of the trade-mark SOLO

SÉCURITERRE shall also be considered as evidence of use of the trade-mark SOLO. They constitute two different trade-marks for the Opponent's services aimed at two different category of end users. In fact, from the text of the brochures CG-2, it is obvious that the Opponent's services offered in association with the trade-mark SOLO SÉCURITERRE are aimed solely for farmers. The sales figures were not broken down by year and by trade-mark and as such, I can't conclude from the evidence filed, that the Opponent's trade-mark SOLO has become known to any great extent in Canada. Therefore such circumstance doesn't favour any of the parties.

- ii) The length of time the trade-marks or trade-names have been in use;

The Applicant's application is based on proposed use. As mentioned above, there is some evidence of use of the trade-mark SOLO by the Opponent in November 1989. There is however no yearly breakdown in the sales figures of the insurance policies issued by the Opponent in association with its trade-mark SOLO [See *Randob Entreprises Ltd. v. Spacemaker Ltd. (1986) 8 C.P.R. (3d) 65*]. Moreover as the Affiant is referring to the use of the trade-marks SOLO and SOLO SECURITERRE without distinguishing them, and because I have determined that they constitute two separate trade-marks, all that I can conclude from the Opponent's evidence, is that the trade-mark SOLO was used by the Opponent in 1989, but I cannot infer that it has been continuously used since then.

- iii) The nature of the wares, services, or business;

It is the Applicant's statement of Wares and Services as defined in its application versus the Opponent's services that govern this issue. [See *Esprit International v. Alcohol Countermeasure Systems Corp. (1997) 84 C.P.R. (3d) 89*] The Wares are different than the Opponent's services. As for the Services, there is a difference between banking services and the Opponent's insurance services that are offered to individuals who cannot benefit from a group insurance plan. I have no evidence before me that the Services would overlap the Opponent's services.

iv) The nature of the trade;

The Opponent argues that the Applicant has been described in the Cardinal's affidavit as a full service financial institution. It is well known, according to the Opponent, that such financial institutions do offer insurance services. I'm aware of the decision rendered by the Registrar in *Central Data Systems Ltd. v. Paul Revere Life Insurance Co. (1992) 46 C.P.R.(3d) 157* where the evidence filed allowed the hearing officer Mr. David J. Martin to conclude that there existed a relationship between banking and insurance services. Such evidence was a key element in that case to enable the Registrar to rule that there was a likelihood of confusion between the marks in issue.

There has been no evidence filed in this record to support a similar argument. I cannot take judicial notice of the existence of a relationship between banking and insurance services. In *Astrazeneca Canada Inc. v. Apotex et al, unreported decision, T660-02*, Madame Justice Layden-Stevenson of the Federal Court stated:

"Judicial notice" is defined in Sopinka and Lederman, *The Law of Evidence in Canada*, 2d ed. (Toronto: Butterworths, 1999) at p. 1055 as "the acceptance by a court or judicial tribunal, in a civil or criminal proceeding, without the requirement of proof, of the truth of a particular fact or state of affairs". The following excerpts are instructive:

"Facts which are (a) so notorious as not to be the subject of dispute among reasonable persons, or (b) capable of immediate and accurate demonstration by resorting to readily accessible sources of indisputable accuracy, may be noticed by the court without proof of them by any party (p. 1055).

There are some facts which, although not immediately within the judge's knowledge, are indisputable and can be ascertained from sources to which it is proper for the judge to refer. These may include texts, dictionaries, almanacs and other reference works, previous case reports, certificates from various officials and statements from various officials and statements from witnesses in the case (p. 1058).

The cases, however, are in conflict as to the extent to which, if at all, facts of nature and scientific facts, which are capable of accurate demonstration from reliable sources, can be noticed (p. 1059)."

Moreover there is no evidence that, if insurance services are offered in a full service financial institution, such institution is the source of those insurance services. It could very well be that the insurance services offered by a financial institution, such as the Applicant, emanate from a third party source. In the absence of evidence, I can't conclude that there is an overlap in the channel of trade of the parties' wares and services.

v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them.

The Mark is identical to the Opponent's word portion of the trade-mark SOLO and design used by it in association with insurance services. Where the question of confusion arises between two identical trade-marks, the type of wares or services and the nature of the trade then become very important surrounding circumstances. [See *A. Lassonde & Fils Inc. v. Imperial Tobacco Ltd. (1987) 17 C.P.R. (3d) 8*]

I conclude, from the evidence filed in the record, that the Applicant has discharged its burden to prove, on a balance of probabilities, that the Mark, used in association with the Wares and Services, is not likely to cause confusion with the Opponent's trade-mark SOLO. I reach this conclusion on the basis that there is no evidence in the record that there is an overlap in the parties' channels of trade. Moreover, the Services and Wares are different from the Opponent's services.

Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I reject the opposition filed by the Opponent against the Applicant's application for the registration of the Mark, the whole pursuant to Subsection 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 23rd DAY OF FEBRUARY 2004.

Jean Carrière,
Member,
Trade-mark Opposition Board