



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

Citation: 2011 TMOB 213
Date of Decision: 2011-11-07

**IN THE MATTER OF THREE
OPPOSITIONS by Canadian Western
Bank to application Nos. 1,310,790;
1,310,791; 1,310,792 for the trade-
marks CW CAPITAL; CWCAPITAL
& DESIGN; CWCAPITAL
INVESTMENTS, respectively, in the
name of CW Financial Services LLC**

APPLICATION No. 1,310,790 - CW CAPITAL
FILE RECORD

[1] On July 27, 2006, CW Financial Services LLC (hereinafter “CW Financial”) filed an application to register the trade-mark CW CAPITAL, based on (i) use and registration of the mark in the United States of America and (ii) proposed use in Canada, in association with various financial services as well as with banking services.

[2] On April 20, 2007, a trade-mark application Examiner with the Canadian Intellectual Property Office (“CIPO”) objected to the application on the basis that the applicant CW Financial was required to disclaim the right to the exclusive use of the word CAPITAL, apart from the trade-mark as a whole, because the term CAPITAL is clearly descriptive of the applicant’s services. The Examiner also requested the applicant (i) to confirm that it is authorized to perform banking services under the *Bank Act* and (ii) to provide a certified copy of the applicant’s United States trade-mark registration.

[3] On August 20, 2007, the applicant responded to the Examiner's objection concerning the word CAPITAL by relying on a CIPO practice notice dated August 15, 2007, shown below:

This notice is intended to provide guidance on current practice of the Office of the Registrar and interpretation of relevant legislation. However, in the event of any inconsistency between these notices and the applicable legislation, the legislation must be followed.

Effective immediately, the Registrar will generally no longer require an applicant for registration of a trade-mark to enter disclaimers pursuant to Section 35 of the Trade-marks Act.

Voluntary disclaimers will continue to be accepted.

[4] The Examiner accordingly withdrew the request for the component CAPITAL to be disclaimed. The applicant further (i) advised the Examiner that the applicant was not authorized to provide banking services and consequently submitted a revised application deleting banking services, and (ii) provided a certified copy of its United States trade-mark registration. The applicant was subsequently granted leave (see the Board ruling dated July 21, 2009) to further amend its statement of services as follows:

commercial mortgage financing, mortgage lending, loan origination, loan servicing, loan brokerage, mortgage brokerage, real estate equity financing namely the provision of mezzanine lending, and the purchase and sale of commercial mortgage backed securities, all of which are provided solely to commercial real estate borrowers and investors.

[5] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 28, 2007 and was opposed on April 28, 2008 by Canadian Western Bank. The Registrar forwarded a copy of the statement of opposition to the applicant on June 19, 2008 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent was subsequently twice granted leave to amend its statement of opposition: see the Board rulings dated March 16 and July 21, 2009.

[6] The opponent's evidence consists of two affidavits of Peter Kenneth Morrison sworn on November 24 and 25, 2008. The applicant's evidence consists of the affidavits of Jeffery M. Goodman, Leanne Notenboom, and Kathryn Stewart. The opponent's reply

evidence consists of a further affidavit of Peter Kenneth Morrison sworn April 22, 2009. Both parties filed written arguments. An oral hearing was scheduled for February 1, 2011 where both parties attended.

[7] Shortly before the oral hearing, the opponent corresponded with the Board to request leave to file a further affidavit of Peter Kenneth Morrison, sworn January 25, 2011, as additional evidence. The opponent also undertook to make Mr. Morrison available for cross examination. As time did not permit the Board to attend to the opponent's request for leave before the scheduled hearing date, I addressed the issue as a preliminary matter at the oral hearing. After hearing the parties' submissions regarding the opponent's request for leave, I ruled that (i) the additional evidence should form part of the evidence of record, (ii) the applicant should be permitted to file a supplementary written argument to address the new evidence, (iii) the hearing was adjourned, to be rescheduled on an expedited manner at a later date.

[8] My formal ruling, with reasons, issued on February 3, 2011 and is of course part of the file record. Cross-examination took place on April 27, 2011; the transcript thereof was filed on May 4, 2011; and the applicant's supplementary written argument was filed on May 31, 2011. The oral hearing was then rescheduled for September 8, 2011. As before, both parties attended.

STATEMENT OF OPPOSITION

[9] 1 & 2. The first and second grounds of opposition, pursuant to s.16(2)(a) and s.16(3)(a) of the *Trade-marks Act*, allege that the applicant is not entitled to register the applied for mark CW CAPITAL because at the date the application was filed, the applied for mark was confusing with the opponent's registered marks, listed below, previously used and made known in Canada by the opponent "in association with substantially the same type of financial services as those set forth in the Applicant's Trade-mark application."

CANADIAN WESTERN CAPITAL

CWB
CWEB
CWT

CWB DIRECT
CWBDIRECT ADVANCED INTERNET BANKING

CANADIAN WESTERN
CANADIAN WESTERN BANK
CANADIAN WESTERN BANK & Design
CANADIAN WESTERN TRUST
CANADIAN WESTERN TRUST & Design

CANADA'S WESTERN BANK
CANADA'S WESTERN BUSINESS BANK

CWB CANADIAN WESTERN FINANCIAL
CANADIAN WESTERN BANK & TRUST & Design

3. The third ground of opposition, pursuant to s.12(1)(d), alleges that the applied for mark CW CAPITAL is not registrable because it is confusing with the opponent's above cited registered marks used in association with a variety of financial services.

4. The fourth ground alleges that the applied for mark CW CAPITAL is not capable of being distinctive of the applicant's services as the applied for mark is confusing with the opponent's above cited marks.

5. The fifth ground, pursuant to s.30(i), alleges that the applicant could not have asserted in good faith that it was satisfied that it was entitled to use the applied for mark CW CAPITAL in view of the opponent's prior use of its above cited marks.

6 & 7. The sixth and seventh grounds of opposition, pursuant to s.16(2)(c) and s.16(3)(c), allege that the applicant is not entitled to register the applied for mark CW CAPITAL because at the date the application was filed, the applied for mark was confusing with the opponent's trade-names, listed below, previously used in Canada by the opponent "in association with substantially the same services as those set forth in the Application."

Canadian Western Bank
Canadian Western Financial Ltd.
Canadian Western Bank Leasing Inc.
Canadian Western Trust Company

OPPONENT'S EVIDENCE

Peter Kenneth Morrison - affidavit of November 24, 2008

[10] Mr. Morrison identifies himself as a senior executive with the opponent Canadian Western Bank. The opponent is a chartered bank having its head office in Edmonton, with 35 branches in Western Canada. The opponent's trust companies Canadian Western Trust Company and Valiant Trust Company, registered to do business federally, operate in Ontario and as well as in Western Canada. The financial services offered by the opponent include banking, insurance, securities investments, mutual funds, and trusts. The opponent also offers (i) personal financial services such as deposit accounts, mortgages and loans as well as (ii) business financial services including commercial loans, equipment financing and real estate financing. The opponent commenced business under its current business name, trade-name and trade-mark CANADIAN WESTERN BANK in April 1988 at which time the opponent began to use its mark CWB in association with banking services and as an acronym for its share symbol on the Alberta and Toronto Stock Exchanges.

[11] The table below summarizes paragraphs 10 – 29 of Mr. Morrison's affidavit concerning the dates of first use of the opponent's marks:

MARK	DATE OF FIRST USE
CANADIAN WESTERN BANK	April 1988
CANADA'S WESTERN BANK	(acquired from a third party, registered since 1976)
CWB CANADIAN WESTERN FINANCIAL	January 1999
CANADIAN WESTERN TRUST CANADIAN WESTERN TRUST & Design	January 1999 for both marks
CWT	April, 1996
CANADIAN WESTERN BANK & TRUST & Design	September 1996
CANADAIN WESTERN CAPITAL	January 1988
CWB DIRECT	1998

MARK	DATE OF FIRST USE
CWEB	September 1999
CANADA'S WESTERN BUSINESS BANK	2003
CWBDIRECT ADVANCED INTERNET BANKING	2006

[12] The opponent registered its domain name "cwbank.com" in July 1996 at which time its then existing trade-marks began appearing on the website. The website receives thousands of "visits" and tens of thousands of "hits" per day. For example, in October 2008 the site received 131,000 visits and 2.9 million hits.

[13] Financial services advertised and marketed in connection with the opponent's business name, trade-name and trade-mark CANADIAN WESTERN BANK are available in 26 branches across Canada. The opponent's financial services have been advertised by means of building signage, brochures, posters and stuffers displayed and made available to the opponent's customers and to the public at all of the opponent's branch locations. As of November 2008, the opponent had about 430,000 customers of which 22,600 use the CWB DIRECT Internet banking services.

[14] Promotion and advertising of the opponent's services, via print, radio and television, in association with its business name, trade-name and trade-mark CANADIAN WESTERN BANK, and its other marks, have totalled about \$840,000 in 2001; \$3.7 million in 2004 and \$5.3 million in 2007. Having regard to the affidavit as a whole, and in the absence of cross-examination on this point, I am prepared to assume that advertising expenditures for the missing years can be approximated by interpolation.

Peter Kenneth Morrison - affidavit of November 25, 2008

[15] In addition to the trade-marks described above, the opponent owns business names and trade-names that contain the components "Canadian Western" and the acronym "CW." One of the opponent's subsidiaries is Canadian Western Financial Ltd., originally called CWB Canadian Western Financial Ltd. until changing its name on or about August, 2007. The opponent uses its trade-name CWF as an acronym for Canadian Western Financial Ltd. Two other subsidiaries, operating under the business

names and trade-names Canadian Western Trust Company and Canadian Western Bank Leasing Inc., have been operating since 1996 and 2008, respectively. The opponent uses the trade-name CWT as an acronym for Canadian Western Trust Company.

APPLICANT'S EVIDENCE

Jeffrey M. Goodman

[16] Mr. Goodman identifies himself as a senior executive with the applicant company. The applicant has been in business through predecessor companies since 1972 and has been acting as a commercial real estate and investment management company since 2002. The applicant licenses one of its family of companies, CWCapital LLC , to use its marks CWCAPITAL and CWCAPITAL & Design, shown below:



[17] Unlike the opponent, the applicant does not offer any consumer banking services. Rather, the applicant's financial services are targeted solely to commercial real estate borrowers and lenders. Commercial mortgage origination involves communication between a commercial loan borrower and the applicant as a lender. The origination process involves extensive communication with the borrower for the purpose of establishing the borrower's identity, financial abilities and the value of the potential property used to secure the loan. The applicant only lends on commercial real property such as hotels, apartment complexes, retail shopping centers, office buildings and the like. Commercial loan servicing involves collecting payments from borrowers related to existing commercial mortgage loans. Commercial mortgage loan brokerage involves finding a lender, be it the applicant or another entity, for commercial real estate. The nature of the applicant's business is such that the borrower is involved in extensive communication with the lender and as a result the borrower will have a complete understanding of which entity it is borrowing from. Paragraph 18 of Mr. Goodman's affidavit further explains:

All clients and potential clients of CWCapital LLC are business entities, who have the sophistication and requisite background

knowledge to understand the identity of the party they are dealing with. The due diligence process is involved and protracted, such that clients of CWCapital LLC are afforded the time and opportunity to fully understand their business partner. As a result, our clients would not be misled into thinking they are dealing with Canadian Western Bank.

[18] Minimum loan levels are generally not less than \$3 million. New customers are generally word-of-mouth referrals or personal contacts or business contacts. According to Mr. Goodman (at para. 20 of his affidavit):

It is highly unlikely that a commercial real estate borrower would reach our lending platform without knowledge of the entity being contacted.

[19] The opponent also licenses CWCapital Investments LLC, another in its family of companies, to use the marks CWCAPITAL and CWCAPITAL & Design, as well as the mark CWCAPITAL INVESTMENTS. The mark CWCAPITAL INVESTMENTS is used in association with investment management, the issuance and purchase and sale of commercial real estate debt instruments and the like. CWCapital Investments LLC deals with institutional investors and solely relates to commercial real estate investments. CWCapital Investments LLC does not conduct business with individual investors. New customers are generally word-of-mouth referrals or personal contacts or business connections.

[20] As I understand it, Mr. Goodman's above evidence relates to the applicant's present business activities in the United States and envisages the applicant developing a similar business practise in Canada.

Leanne Notenboom

[21] Ms. Notenboom identifies herself as a research consultant employed by the firm representing the applicant. She conducted computer searches of various news databases to locate the terms "CWB" and "managed futures" appearing together in an article. Her evidence indicates that the term CWB is an acronym for the Canadian Wheat Board. The results of her searches are attached as exhibits to her affidavit.

Kathryn Stewart

[22] Ms. Stewart identifies herself as a technical consultant employed by the firm representing the applicant. She conducted a search for the term “CWB Managed Futures” using the Google search engine to locate information concerning the family of investment vehicles promoted by the Canadian Wheat Board using the acronym “CWB.” Other searches she performed indicate that (i) the term “CWB Notes” has been used by Tricycle Asset Management to designate Canadian Wheat Board notes, (ii) Canadian Wealth Management Group Inc. has been using the term “CWM” as an abbreviation of its name since about 1998.

OPPONENT’S REPLY EVIDENCE

Peter Kenneth Morrison - affidavit of April 22, 2009

[23] Mr. Morrison asserts that the opponent offers all of the services offered by the applicant, some directly and others through its subsidiaries Canadian Western Trust Company and Adroit Investment Management Ltd. (acquired by the opponent in 2008). In this regard, 20% of the opponent’s loan portfolio is in the general commercial sector; 21% is in the commercial mortgage sector; and 23% is in respect of real estate projects. Only 13% of the opponent’s loan portfolio is comprised of personal loans and mortgages. The opponent is aware of the activities of the Canadian Wheat Board but does not consider that its “managed futures and futures notes to be competitive with any of the Opponent’s services.” The opponent began to offer the same type of financial services as Canadian Wealth Management Group Inc. when the opponent acquired Adroit Investment in 2008.

ADDITIONAL EVIDENCE AND TRANSCRIPT OF CROSS-EXAMINATION

[24] With respect to Mr. Morrison’s last filed affidavit of January 25, 2001, and his testimony on cross-examination, I am in general agreement with the applicant’s submissions in its Supplementary Written Argument, shown below, that the additional evidence does little to advance the opponent’s case:

10. In the case of Canadian Western Trust Company, Mr. Morrison did not know whether there was an oral trade-mark license agreement between the Opponent and this company.

Cross-examination, p. 13, q. 46

11. He was able to identify two documents that were put to him (Exhibits "A" and "B" to his cross-examination) as a written trade-mark license agreement between the Opponent and Canadian Western Trust Company and an addendum to such agreement.

12. It is to be noted that Exhibit "A", an April 5, 2005 agreement, does not contain the mark CWT in the list of marks that are licensed from the Opponent to Canadian Western Trust Company.

13. Also, Exhibit "B", which purports to be an April 15, 2009 agreement that amends the April 5, 2005 license agreement, adds the CWT trade-mark to the list of marks being licensed but also states that such amendment is "effective as of the date of this Amending Agreement" [i.e., only as of April 15, 2009].

14. In other words, even though the Opponent had fair notice of the Applicant's objections to the Opponent's evidence, the Opponent either could not, or chose not to, confirm in writing that the Opponent had, prior to April 15, 2009, licensed Canadian Western Trust Company to use the CWT mark. Instead, it chose to only grant a license to Canadian Western Trust Company to use this mark effective as of April 15, 2009.

15. When the trade-mark agent for the Applicant tried to cross-examine Mr. Morrison on Exhibit "B", the trade-mark agent for the Opponent objected to such questions, stating that Exhibit "B" spoke for itself.

Cross-examination, p. 10, q. 26

16. Given the Opponent's position that Exhibit "B" speaks for itself, it cannot now take the position that this document somehow constitutes proof that the Opponent had licensed Canadian Western Trust Company to use the CWT mark prior to the April 15, 2009 date of the document. Therefore, at most, this document establishes that the Opponent only licensed Canadian Western Trust Company to use the trade-mark CWT after April 15, 2009.

17. Furthermore, the only inference that can be drawn from Exhibit "B" is that any use that Canadian Western Trust Company

made of the CWT mark prior to April 15, 2009 was unlicensed, thereby impairing the ability of such mark to distinguish the Opponent's services.

[25] Further, it appears to me, from a review of the transcript of cross-examination, that Mr. Morrison did not have sufficient personal knowledge and did not inform himself adequately to provide probative evidence regarding the opponent's license agreements or the extent to which the opponent exercised control over services provided by its licensee Canadian Western Trust.

[26] I would also mention that Exhibit A to the cross-examination, referred to in paragraphs 11 and 12 of the applicant's Supplementary Written Argument, above, was incomplete. By agreement between the parties a complete copy of the agreement was submitted (on September 7, 2011) in substitution for the incomplete version. At the hearing on September 8, 2011, I accepted the complete copy in substitution for the earlier version.

[27] I would also mention that during the course of the oral hearing on September 8, 2011, the applicant requested and was granted leave to amend the subject application, as shown below, to further indicate that its financial activities were of a commercial rather than of a personal nature:

commercial mortgage financing, commercial mortgage lending, commercial loan origination, commercial loan servicing, commercial loan brokerage, commercial mortgage brokerage, commercial real estate equity financing namely the provision of mezzanine lending, and the purchase and sale of commercial mortgage backed securities, all of which are provided solely to commercial real estate borrowers and investors.

The amendment was formally recorded at a later date: see the Board ruling of October 25, 2011.

LEGAL ONUS & EVIDENTIAL BURDEN

[28] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of

opposition. The presence of a legal onus on the applicant 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, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298 (F.C.T.D.). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

MAIN ISSUE & LEGAL ONUS

[29] The main issue in this proceeding is whether the applied for mark CW CAPITAL for use in association with the financial services specified in the subject application is confusing with one or more of the opponent's marks and trade-names pleaded in the statement of opposition. The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability; (ii) the date filing of the application (July 27, 2006), with respect to grounds of opposition alleging non-entitlement and (iii) the date of opposition (April 28, 2008), with respect to the issue of non-distinctiveness: for a review of case law concerning material dates in opposition proceedings: see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). In the instant case, nothing turns on whether the issue of confusion is considered at a particular material date.

[30] The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meanings of s.6(2) and s.6(3) of the *Trade-marks Act*, paraphrased below, between the applied for mark CW CAPITAL and the opponent's marks and trade-names:

The use of a trade-mark causes confusion with another trade-mark (or trade-name) if the use of both trade-marks (or trade-mark and trade-name) in the same area would be likely to lead to the inference that the services associated with those trade-marks (or trade-names) are performed by the same person, whether or not the services are of the same general class.

Thus, s.6(2) and s.6(3) do not concern the confusion of the marks and trade-names themselves, but confusion of services from one source as being from another source. In the instant case, the issue is whether there would be confusion of financial services provided by the applicant under the mark CW CAPITAL as being financial services provided by or endorsed by the opponent Canadian Western Bank.

[31] As noted by the applicant at paragraphs 43 – 54 of its written argument, the opponent’s evidence with respect to its alleged use of some of the trade-marks and trade-names being relied on in the statement of opposition is somewhat ambiguous. In this regard, some examples of alleged use referred to by Mr. Morrison, and purportedly demonstrated in the exhibit material attached to his affidavits, are not use by the opponent itself but apparently by subsidiaries of the opponent. I agree with the applicant that corporate structure *per se* is not sufficient to raise a presumption that the parent company has licensed the subsidiary to use the parent’s marks, or that the parent has direct or indirect control over the services offered by the subsidiary in association with the parent’s marks: see, for example, *London Drugs v. Purepharm Inc.* (2006) 54 C.P.R.(4th) 87 (TMOB); *Ricard v. Molson Canada* 2005 (2007), 60 C.P.R.(4th) 338 (TMOB) for discussion of the licensing provisions set out in s.50 of the *Trade-marks Act*.

[32] In my view, the opponent has not demonstrated use of any of its marks above a minimal level except for its marks CANADIAN WESTERN BANK and CWB. I also agree with the applicant that the opponent cannot rely on the trade-names of its subsidiaries to support the non-entitlement grounds of opposition: see s.17(1) of the *Trade-marks Act*. Accordingly, the only trade-name which the opponent may rely on is Canadian Western Bank.

[33] In view of the foregoing, a determination of whether the applied for mark CW CAPITAL is confusing with one or more of opponent’s marks CANADIAN WESTERN BANK (which is also the opponent’s trade-name); CWB; and CWT will decide this proceeding. With respect to the mark CWT, there is no onus on the opponent to establish a reputation for a registered mark being relied on pursuant to s.12(1)(d).

TEST FOR CONFUSION

[34] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R.(4th) 361 (S.C.C.), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of Section 6(5) Factors

[35] The applied for mark CW CAPITAL possesses a relatively low degree of inherent distinctiveness as the first component of the mark is merely a sequence of letters and the second component CAPITAL is suggestive of the opponent’s financial services. The opponent’s mark and trade-name CANADIAN WESTERN BANK also possesses a relatively low degree of inherent distinctiveness as the mark as a whole is highly suggestive, if not descriptive, of the opponent’s business and services performed for the most part in Western Canada. Similarly, the opponent’s marks CWB and CWT possess relatively low degrees of inherent distinctiveness as the marks are merely a sequence of letters. Their significance as acronyms for CANADIAN WESTERN BANK and CANADIAN WESTERN TRUST, respectively, does not add any distinctiveness. I am prepared to infer from the opponent’s evidence that its mark and trade-name CANADIAN WESTERN BANK and its mark CWB have acquired a fair degree of distinctiveness, at least in Western Canada, at all material times. However, third party use of the acronyms CWB and CWM evidenced by the applicant tend to lessen to some

extent the distinctiveness of the opponent's mark CWB. As discussed in paragraphs 28 and 29 above, it is not clear that the opponent can claim the benefit of any reputation for its registered mark CWT.

[36] The subject application for CW CAPITAL is based on proposed use in Canada and on use and registration in the United States. There is no evidence that the applied for mark acquired any reputation in Canada at any material time. The length of time that the marks in issue have been in use favours the opponent as it has been using its marks and trade-name in Canada for about eighteen years before the applicant indicated its intention to use the applied for mark CW CAPITAL in Canada.

[37] As far as I am able to infer from the evidence of record, the parties' services and the nature of their businesses are generally similar as both parties are involved in making funds available to third parties to enable commercial real estate transactions. However, it appears that the applicant intends to fill a specialty brokerage niche not offered by the opponent.

[38] With respect to the resemblance between the marks in issue, in my view the differences in the parties' marks outweigh their similarities. In this regard, the overall impact of the marks CANADIAN WESTERN BANK; CWB; and CWT, visually and in sounding, are quite different from CW CAPITAL when the parties' marks are considered in their totalities. Further, there is little commonality in the ideas suggested by the parties' marks other than the implication in CANADIAN WESTERN BANK that a bank is a source of capital.

[39] As surrounding circumstances, factors which weigh in favour of the applicant are the sophistication of its clients and the fact that its clients may be expected to contact the applicant through referrals or personal contacts or business connections. These factors give credence to Mr. Goodman's uncontradicted evidence (see para. 20, above) that it is highly unlikely that a commercial real estate borrower would be requesting the applicant's services without knowledge of the party being contacted.

Conclusion

[40] In view of the foregoing, I find that at all material times the applicant has met the legal onus on it to show that, on a balance of probabilities, there is no reasonable

likelihood of confusion between the applied for mark CW CAPITAL and any of the opponent's marks or trade-names relied on in the statement of opposition.

APPLICATION NO. 1,310,791 - CWCAPITAL & DESIGN

[41] The application for the mark CW CAPITAL & Design, shown below, was filed contemporaneously with the application for the mark CW CAPITAL, discussed above.



[42] The application for CW CAPITAL & Design covers the same services as the application for CW CAPITAL and is likewise based on (i) use and registration of the mark in the U.S.A. and (ii) proposed use in Canada. The pleadings, issues, evidence and material dates in the two oppositions are essentially the same. Further, the applied for mark CW CAPITAL & Design may be considered to be a variant of the mark CW CAPITAL as the design features of the mark do not alter the inherent distinctiveness or significantly affect the identity of the mark CW CAPITAL. Applying the same reasoning as was applied in the opposition to the mark CW CAPITAL, it follows that that at all material times the applicant has met the legal onus on it to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for mark CWCAPITAL & Design and any of the opponent's marks or trade-names relied on in the statement of opposition.

APPLICATION NO. 1,310,792 - CWCAPITAL INVESTMENTS

[43] The application for the mark CWCAPITAL INVESTMENTS was filed contemporaneously with the two related applications discussed above, and is likewise based on (i) use and registration of the mark in the U.S.A. and (ii) proposed use in Canada. The services covered by the application for CWCAPITAL INVESTMENTS, shown below, are different than but related to the services covered by the two related applications:

investment management services, investment advisory services namely the provision of advice relating to the acquisition and sale of commercial mortgage backed securities and other commercial real estate debt instruments, investment underwriting, investment research, and investment consulting, all of which are provided solely to commercial real estate investors

Otherwise, the pleadings, issues, evidence and material dates in the opposition proceeding concerning CWCAPITAL INVESTMENTS are essentially the same as in the two related oppositions discussed above. However, one difference of note is that the applied for mark CWCAPITAL INVESTMENTS, considered in its entirety, bears a lesser degree of resemblance to the opponent's marks and trade-names than do either of the marks CW CAPITAL and CWCAPITAL & Design. Applying the same reasoning as was applied in the opposition to the mark CW CAPITAL, it follows that at all material times the applicant has met the legal onus on it to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for marks CWCAPITAL INVESTMENTS and any of the opponent's marks or trade-names relied on in the statement of opposition.

DISPOSITION

[44] In view of the foregoing, the oppositions to applications Nos. 1,310,790; 1,310,791 and 1,310,792 are rejected. These decisions have been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board