

**IN THE MATTER OF AN OPPOSITION
by Robert Bruce Storey and Bereskin & Parr
to application no. 1,062,683 for the trade-
mark RBS filed by Richards Buell Sutton**

Application

On June 8, 2000, the applicant Richards Buell Sutton filed an application to register the trade-mark RBS for use in association with legal services based on use in Canada since at least January 1992. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 12, 2001 and was opposed by Robert Bruce Storey and Bereskin & Parr on January 21, 2002. The Registrar forwarded a copy of the statement of opposition to the applicant on February 5, 2002. The applicant responded by filing and serving a counter statement.

Grounds of Opposition

The grounds of opposition allege that

- (a) the application does not conform to section 30 of the *Trade-marks Act* because (i) the date of first use cited in the application is false, (ii) the applicant could not have been satisfied that it is entitled to use the mark RBS as the applicant was aware of the opponents' prior use of the initials RBS,
- (b) the applied for mark is not registrable because (i) it is primarily merely the name of a living individual, (b) its adoption is prohibited by section 9(1)(k) of the *Act*,
- (c) the applicant is not entitled to registration because at the alleged date of first use it was confusing with the initials RBS which had previously been used by the opponents as a trade-mark and trade-name.

(d) the applied for mark is not distinctive of the applicant's services having regard to the use of the initials RBS in connection with the practice of law by the opponents and others.

Evidence

The opponents' evidence consists of the affidavits of Jonathon G. Colombo, Aaron Mitchel Sawchuk, Robert B Story, Christopher G. Tortorice, Richard B. Smith, Ralph B. Steinberg, Richard B. Strype and Richard B. Swan. The applicant's evidence consists of the affidavit of Jeffery J. Lowe. Both parties submitted a written argument and both were represented at an oral hearing. At the oral hearing counsel for the opponents advised the Board that the first ground of opposition was withdrawn.

Mr. Colombo's evidence may be summarized as follows. He is a partner of the law firm Bereskin & Parr. It is the practice at his law firm to refer to lawyers by their initials. Mr. Colombo identifies another lawyer at the firm, namely Robert Bruce Storey, by the initials RBS. As an associate, Mr. Colombo routinely placed the initials of the partner responsible for the file after his name on letters to clients, as shown below, indicating that Robert Bruce Storey had reviewed the letter.

Mr. Sawchuk's affidavit serves to introduce into evidence names of Canadian lawyers with the initials RBS found in the *Canada Law List 2002*. Fifteen names were located. The affidavit of Mr. Tortorice serves to introduce into evidence names of Canadian lawyers with the initials RBS found in the *Canadian Law List 1998*. Mr. Tortorice contacted eight of the lawyers by telephone, however, the statements attributed to them by Mr. Tortorice (in paragraphs 3- 10 of his affidavit) are inadmissible hearsay.

The affidavits of Messrs. Smith, Steinberg, Strype and Swan are generally to the same effect, that is, each uses the initials RBS on internal memoranda, handwritten notes and in letters to clients. In such letters and billings the initials RBS appear beneath the signature.

Mr. Storey's evidence is also to the effect that his initials RBS appear on internal correspondence, and that other members of the staff refer to him using his initials RBS. Mr. Storey also uses his initials RBS to indicate his authorization on firm documents, on letters to clients under his signature, on accounts rendered, on business attire, and on other personal items such as a brief case, jacket buttons and shirt cuffs. He has done so since 1983.

The affidavit of Jeffery J. Lowe, filed on behalf of the applicant, may be summarized as follows. Mr. Lowe is the Managing Partner of the applicant law firm Richards Buell Sutton. In January 1992 the applicant formally adopted the acronym RBS and began using it as a trade-mark on business cards, letterhead, brochures, standard terms of engagement letters and partnership announcements. The applicant is the registered owner of Canadian trade-marks RBS.LAWYERS

& Design and RBS.COM. The trade-mark RBS also appears in advertising the applicant's legal services in various print media and four times a year on newsletters distributed by mail to clients. The manner of use of the applied for mark is extensively demonstrated in exhibits attached to Mr. Lowe's affidavit.

Relating the evidence to the grounds of opposition

With respect to the first branch of the second ground of opposition, section 12(1)(a) of the *Trade-marks Act* reads as follows:

- 12(1) Subject to section 13, a trade-mark is registrable if it is not
 - (a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

In the instant case, the term RBS is neither a name nor a surname, nor would it be perceived as such. Accordingly, section 12(1)(a) does not prohibit registration of the applied for mark.

With respect to the second branch of the second ground of opposition, Section 9(1)(k) reads as follows:

- 9(1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,
 - (k) any matter that may falsely suggest a connection with any living individual;

I am prepared to infer from the evidence submitted by the opponents that there are several lawyers

in Canada with the initials RBS who provide legal services to the public, and that such individuals use their initials in the usual way on documents and on correspondence. By "the usual way" I mean that their initials appear in close proximity to their signature, and that their initials may be accompanied by the initials of the clerk or secretary who prepared the document or by the initials of a supervisor. I do not believe that such routine use of the initials RBS in communications results in the applied for mark RBS being likely to be mistaken for initials that falsely suggests a connection with any of the above-mentioned lawyers. This is because the manner of use of the applied for trade-mark RBS is very different than the manner of use of the initials RBS evidenced by the opponents. In this regard, the applied for mark RBS is boldly and prominently displayed in connection with the applicant's services, while the initials RBS are used in a unobtrusive and nondescript way as evidenced by the opponents. Such trade-mark use by the applicant would not suggest a connection with any of the above-mentioned lawyers, at any material time, because the above-mentioned lawyers use the letters RBS in a manner very different than the applicant. In view of the foregoing, the second ground of opposition is rejected.

With respect to the third ground of opposition, the opponents submit that they have provided "ample evidence of prior use of the initials RBS both as a trade mark[sic] and a trade name[sic] in association with providing legal services in Canada." I agree that the opponents have provided ample evidence of prior use of the initials RBS by Mr. Storey, but I disagree that Mr. Storey has used the letters RBS either as a trade-mark or as a trade-name. From my perusal of the exhibit evidence, it is the firm name ROGERS, BERESKIN & PARR, and later the firm name BERESKIN & PARR, that functioned as a trade-mark or trade-name for legal services provided by

Mr. Storey. I ascribe no significance to Mr. Storey's use of the letters RBS other than as an indication of his initials. In view of the above, the third ground of opposition, which requires an opponent to demonstrate use of a trade-mark or trade-name, is rejected.

With respect to the final ground of opposition, the onus or legal burden is on the applicant to show that its mark RBS is adapted to distinguish or actually distinguishes its services from those of the opponents, and others, throughout Canada: see *Muffin Houses Inc. v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of a legal burden means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case January 21, 2002: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). In the context of distinctiveness, it is immaterial whether Mr. Storey or other lawyers in Canada used the letters RBS as a trade-mark or trade-name or otherwise. The pertinent question in this case is whether any manner of use of the letters RBS evidenced by the opponents is sufficient to negate the distinctiveness of the applied for mark RBS: see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R.(2d) 44 at 58 (F.C.T.D.). Having regard to the manner of use of the term RBS by the applicant and by others, as discussed in relation to the grounds of opposition based on entitlement and section 9(1)(k), I find that use of the initials RBS by Mr. Storey and others is not

sufficient to negate the distinctiveness of the applied for mark RBS, albeit that it is a weak mark.

Accordingly, the fourth ground of opposition is rejected.

In view of the foregoing, the opponents' opposition is rejected.

DATED AT GATINEAU, QUEBEC, THIS 8th DAY OF DECEMBER, 2005.

Myer Herzig,
Member,
Trade-marks Opposition Board