

TRADUCTION/TRANSLATION

**IN THE MATTER OF THE
OPPOSITION** by Groupe Conseil
Parisella, Vincelli Associés Inc./Parisella
Vincelli Associates Consulting Group Inc. to
application for registration no. 871,365 for
the PVA trade-mark owned by the CPSA
Sales Institute

On March 6, 1998, CPSA Sales Institute (“the Applicant”) filed an application for the registration of the PVA certification mark. The application was published in the Trade Marks Journal on July 14, 1999, in association with the following services:

Services of a professional sales person, and sales manager, on behalf of others.

The Applicant claims use starting at least as early as February 23, 1998, in association with these services. Groupe Conseil Parisella, Vincelli Associés Inc./Parisella Vincelli Associates Consulting Group Inc. (the Opponent) filed a statement of opposition on September 13, 1999. The Applicant submitted a counter-statement denying essentially all of the grounds, set out below, that were stated in the Opponent’s statement of opposition.

The evidence of the opponent consists of the statutory declaration of Normand Parisella, filed on April 28, 2000. The Applicant, for its part, filed the affidavit of Tarence J. Ruffel on September 11, 2000. None of the affiants were cross-examined. Each party filed written pleadings. There has been no hearing in this matter.

The Opponent’s opposition is based on the following grounds:

[TRANSLATION]

(a) the Opponent’s opposition is based on section 38(2)(a) of the Act, because application No. 871,365 does conform to the requirements of section 30 of the Act for the following reasons:

- (i) the applicant did not use the Mark from the date of first use set out in application No. 871,365;

- (ii) the Applicant could not validly state that it was satisfied that it was entitled to use the Mark in Canada in association with the services set out in the application given the reasons set out below;
- (b) the Opponent's opposition is also based on section 38(2)(b) of the Act as the Mark is not registrable because it is confusing with the registered trade-mark of the Opponent PVA & drawing, TMA508,335, thereby contravening section 12(1)(d) of the Act;
- (c) The Opponent's opposition is also based on section 38(2)(c) of the Act as the Applicant is not the person entitled to the registration of the Mark under section 16(2) because, on February 23, 1998, the date of first use alleged by the Applicant, the Mark was confusing with
 - (i) the trade-mark PVA & drawing (TMA508,335), which was previously used in Canada by the Opponent in association with management consulting and management training services, and which continues to be used in this manner by the Opponent (section 16(1)(a));
 - (ii) the PVA trade-mark, which was previously used in Canada by the Opponent in association with management consulting and management training services, and which continues to be used by the Opponent in this way (section 16(1)(b));
 - (iii) the PVA trade-name, which was previously used in Canada by the Opponent as part of and for the purpose of operating its business, and which continues to be used by the Opponent in this way (section 16(1)(c));
- (d) the Opponent's opposition is also based on section 38(2)(d) of the Act as the Mark is not distinctive within the meaning of section 2 since it does not actually distinguish, and is not adapted to distinguish, the services of the Applicant from the services of the Opponent, because it is confusing with Opponent's trade-marks PVA & drawing (TMA508,335) and PVA, and with Opponent's trade-name PVA;

The first ground of the opposition is based on section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 ("the Act"). Although the burden of proof is on the Applicant to show that the application for registration conforms to the requirements of section 30 of the Act, there is an initial burden of proof on the Opponent to establish certain facts on which this ground of opposition is based. However, this initial burden of proof on the Opponent is minimal. Moreover, the Opponent may refer to the evidence submitted by the Applicant to discharge this initial burden (*Tune Masters v. Mr. P's Mastertune Ignition Services Ltd. (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)*, *Hearst Communications Inc. v. Nesbitt Burns Corp. (2000), 7 C.P.R. (4th) 161 (T.M.O.B.)*, *Labatt Brewing Co. v. Molson Breweries, a Partnership (1996), 68*

C.P.R. (3d) 216 (F.C.T.D.) and Williams Telecommunications Corp. v. William Tell Ltd. (1999), 4 C.P.R. (4th) 107 (T.M.O.B.)

In considering the first ground of the opposition, it is helpful to refer to the relevant provisions of the Act:

2. In this Act,

“certification mark” means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to:

(a) the character and quality of the wares services;

(b) the working conditions under which the wares have been produced or the services performed;

(c) the class of persons by whom the wares have been produced or the services performed, or

(d) the area within which the wares have been produced or the services performed

from wares or services that are not of that defined standard.

“Trade-mark” means

(b) a certification mark;

4.(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

23. (1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

(2) The owner of a certification mark may license others to use the mark in association with wares or services that meet the defined standard, and the use of the mark accordingly shall be deemed to be use thereof by the owner.

It is also useful to reproduce relevant extracts from the affidavit of Tarence J. Ruffel:

3. The Association recognized the importance for salespersons across Canada to be acknowledged by the business community at large for the

contributions they make to the Canadian economy. To that end, the Association caused the Institute to be founded in 1994 for the purpose of certifying those individuals that meet standards prescribed by the Institute.

4. The Institute's certification program is one by which salespersons can meet the standards prescribed by the Institute, and be publicly recognized for having attained those standards. The Institute's prescribed standards are met by a salesperson successfully:

- (A) completing at least two years work experience as a salesperson;
- (B) committing himself or herself to continued learning;
- (C) acknowledging and complying with the Institute's Code of Ethics; and
- (D) completing an oral and/or written examination on selling.

5. Upon completion of the certification program, the successful candidate is issued a certificate, and is permitted to use the designation CSP (in English), or PVA (in French). CSP is the acronym for "Certified Sales Professional" and PVA is the acronym for « Professionel de la Vente Agréé ». Now produced and shown to me and marked Exhibit "A" to this my Affidavit is a copy of the certificate in both English and French, which the Institute issues.

6. Gail Hekkema and Greg Peterson were the first persons to be granted the CSP designation, on October 9, 1997. Gail Hekkema was also granted the PVA designation on February 23, 1998. Since the certificate program began, approximately five hundred people have been granted CSP designations, and ten have been granted PVA designations.

...

8. The Institute allows a person who has been granted either the CSP or PVA designation, to display the designation on his or her business card and letterhead, after his or her name, and to display the certificate referred to in Paragraph 5 in a place of prominence, such as in the salesperson's place of work or office. When the designation is displayed on the salesperson's business card or letterhead, the name of the salesperson's employer is generally, if not always, shown, so that there is no mistaking with whom the salesperson is associated, or to what the designation refers. Now produced and shown to me and marked Exhibit "B" to this my Affidavit are copies of business cards showing how the designations are displayed.

...

13. Neither the Institute nor the Association uses either mark CSP or PVA. The Institute only permits qualified salespersons to use the marks, CSP in English speaking Canada, and PVA in French speaking Canada.

It appears from the affidavit of Mr. Ruffell that PVA is an acronym for « professionnel de la vente agréé » which is used as part of Applicant’s certification program. Only salespersons that meet the standards prescribed by the Applicant, which include passing exams, complying with a code of ethics and committing oneself to continued learning, can use the PVA certification mark. In addition, the document entitled *Programme d’agrément pour les professionnels de la vente* [certification program for sales professionals], Exhibit C in support of the Ruffel affidavit, contains the following passage:

[TRANSLATION]

When you have passed the exams, you will receive a certificate and pin from the CPSA Sales Institute and will be authorized to use the title Professionnel de la vente agréé/Professionnelle de la vente agréée (PVA) next to your name. The title is reserved for individuals, and cannot be used to indicate the certification of an association or business.
(Emphasis added.)

Thus, the evidence tendered by the Applicant shows that the acronym PVA is actually a professional title that can only be used by individuals who comply with the standards described in paragraph 4 of the Ruffel affidavit. The acronym can only be used by individuals for the purpose of informing third parties that they possess the title. Sales enterprises cannot use it in the ordinary course of business.

According to the Opponent, the acronym PVA is a certification for individuals only, who use it on their letterheads or on their business cards next to their names. We will come back to the question whether the PVA mark is truly being used within the meaning of sections 2 and 4 of the Act.

This matter is similar to *Flowers Canada/ Fleurs Canada Inc v. Maple Ridge Florist Ltd. (1998), 86 C.P.R. (3d) 110 (T.M.O.B.)*. In that case, the applicant attempted to register the certification mark MASTER FLORIST in association with “wholesale and retail florist services.” The title was granted to individuals who passed mandatory tests that were part of an accreditation program. Only individuals could use it. Gary Partington, then Chair of the Trade-marks Opposition Board, held as follows:

The paragraphs from the Cull affidavit indicate that the mark MASTER FLORIST is a title accorded to those individuals who have achieved a certain skill level in the florist industry. However, the opponent has submitted in its written argument that the designation of the qualification of an individual cannot function as a certification mark and has relied upon the decision in *Life Underwriters Assn. of Canada v. Provincial Assn. of Quebec Life Underwriters* (1988), 22 C.P.R. (3d) 1 (F.C.T.D.), in support of its argument. At page 9 of the reported decision, Mr. Justice Dubé stated the following:

On the other hand, the Provincial argues, first, that the titles at issue we professional designations, not certification marks, and may not be registered. In fact, the documentary evidence submitted by the National shows in many instances that it considers chartered life underwriters as professionals and the designations in question to be professional titles. As they are professional titles, they are used in association with persons, not in association with wares or services.

Just as the words "lawyer", "notary", "physician", "engineer" and so on cannot be registered as certification marks, so the title "chartered life underwriter" cannot be regarded as a certification mark. In my view, the name of a profession itself cannot be used as a standard, a definite norm, a distinguishing mark that can be placed on wares or services.

Even if a title could arguably be used so as to distinguish certain wares or services associated with it, it is apparent in the present case that the applicant was precluding any activities which might be perceived as use of the mark MASTER FLORIST in association with florist services of any kind (see paragraph 35 of the Cull affidavit). I have concluded, therefore, that the opponent has met the evidential burden upon it of showing that the mark MASTER FLORIST has not been used as a certification mark in association with florist services. Furthermore, the applicant has failed to meet the legal burden upon it in respect of this ground. Thus, the s. 30(b) ground of opposition is successful.

Based on the evidence in this matter, I agree with the Opponent that, as stated in its written pleadings, the acronym PVA is not used in association with "services of a professional sales person, and sales manager, on behalf of others," since it is not used in association with services, but is instead used as a professional title that appears after the name of an individual on business cards, letterheads or certificates of accreditation. Thus, it is clear that the PVA certification mark is not used to distinguish the services of a business for which the accredited person works, but rather, to identify a professional title by its acronym. As Mr. Justice Dubé stated in *Life Underwriters Association of*

Canada/Association des assureurs-vie du Canada v. Provincial Association of Quebec Life Underwriters/Association provinciale des assureurs-vie du Québec, [1989] 1 F.C. 570 at 581:

... the name of a profession itself cannot be used as a standard, a definite norm, a distinguishing mark that can be placed on wares or services.

Under the circumstances, having regard to the evidence submitted by the Applicant, the Opponent has discharged its burden of proof. That evidence shows that the acronym PVA is not used as a trade-mark within the meaning of sections 2, 4 and 23 of the Act cited above. In addition, the Applicant did not discharge its burden of proof in relation to this ground of the opposition. For these reasons alone, I must allow this ground of the Opponent's opposition.

Assuming that an abbreviated professional title granted to an individual can be the subject of a certification mark, it is my duty to consider the Opponent's argument that the evidence submitted by the Applicant establishes no proof of use of the PVA certification mark from the date of first use alleged in the Applicant's application for registration.

In paragraph 6 of his affidavit, Mr. Ruffel states that the title PVA was granted to Mr. Gail Hekkema on February 23, 1998, which is the date of first use alleged in the application for the registration of the PVA certification mark. One of Hekkema's business cards was produced as an element of Exhibit B to the Ruffel affidavit. Surprisingly, the mark PVA does not appear on the business card; rather, it is the acronym CSP that appears thereon. Moreover, there is no evidence about the date on which Hekkema began using the PVA certification mark. There are many business cards of Luce Dudemaine, François Asselin and Raphael Viscardi, on which PVA is written next to their respective names, but there is no evidence in the record that these persons used the cards at the time that this application for registration was submitted.

To cite D.J. Martin in *Hearst Communications Inc.*, *supra*, "the applicant's own evidence casts doubt on the claimed date." Consequently, the Opponent has discharged its burden of proof with regard to its ground of opposition based on section 38(2)(a) of

the Act. The Applicant has submitted no evidence in support of the date of its first use of the PVA certification mark within the meaning of sections 2, 4 and 23 of the Act. For these reasons, I must allow this ground of opposition invoked by the Opponent.

I will also analyze the other grounds of the opposition pertaining to the confusion that the PVA certification mark causes with the registered trade-mark PVA and drawing, reproduced hereunder, certificate of registration 508,335 (“trade-mark PVA and drawing”)



the trade-mark PVA and the trade-name PVA of the Opponent, all of which the Opponent previously used in Canada in association with management consulting and management training services. Lastly, the Opponent alleges that the certification mark is not distinctive within the meaning of section 2 of the Act.

The material date for assessing the ground of opposition based on section 12(1)(d) of the Act is the date of the decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991)*, 37 C.P.R. (3d) 413 (F.C.A.)]. The material date for assessing the grounds of opposition based on section 16(1) of the Act is the date of first use alleged in the Applicant’s application for registration, specifically February 23, 1998. Lastly, the material date for assessing the ground based on the lack of distinctiveness of the PVA certification mark is generally recognized to be the date the opposition was filed, specifically September 13, 1999 [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., infra.]

To determine whether the use of the PVA certification mark is likely to be confusing with the Opponent's trade-mark and trade-name identified in his statement of opposition, I must follow the method prescribed by section 6 of the Act, which reads as follows:

6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

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

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

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

(b) the length of time the trade-marks or trade-names have been in use;

(c) the nature of the wares, services or business;

(d) the nature of the trade; and

(e) 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 is on the Applicant to satisfy the Registrar that there is no reasonable possibility of confusion within the meaning of section 2 of the Act between the trade-marks and trade-name of the parties at the relevant dates described above [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd. (1982)*, 61 C.P.R.(2d) 53]. It is clearly established that the list of circumstances in subsection 6(5) of the Act is not exhaustive, and that it is not necessary to give each of them equal weight [see for example *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.)].

The pronouncements of the Honourable Mr. Justice Décarie of the Federal Court of Appeal in *Dion Neckware Ltd. v. Christian Dior, S.A.*, [2002] 3 F.C. 405, should be recalled:

The Registrar must 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. The "beyond doubt" standard imposes an insurmountable burden because certainty in matters of likelihood of confusion is rare. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is resolved in favour of the opponent. A registrar should avoid resorting to the concept of doubt, which is treacherous and confusing in civil proceedings.

In his statutory declaration, Mr. Parisella describes the Opponent's activities and states that it offers management consulting and training courses to all types of businesses. An advertising brochure that contains the mark PVA and drawing, and describes the Opponent's activities, was produced as Exhibit P-3 in support of its statutory declaration. The following text appears under the heading "NOTRE EXPERTISE" (OUR EXPERTISE):

[TRANSLATION]

Our approach is universal and can be applied to all types of businesses.
Some examples: manufacturing, services, processing, sales,
communications, etc.

In his declaration, Mr. Parisella also states that the Opponent has provided services in association with the trade-marks PVA and PVA and drawing, and with the trade-name PVA, in connection

with approximately 250 contracts, including about ten that pertain specifically to the sales business, and in particular the training of salespersons and the development of sales systems. This evidence is not contradicted. I will therefore proceed to analyse the factors in section 6 of the Act having regard to the relevant evidence tendered by the parties.

A) Distinctiveness

The trade-mark PVA and drawing contains a disclaimer of the exclusive use of all words with the exception of PVA and INC. In *Hughes on Trade Marks*, the author describes distinctiveness as follows at para. 63:

A strong, inherently distinctive trade mark is one consisting of a striking inventive name or an original design, and as such, will be entitled to a wide scope of protection: on the other hand a trade mark lacking these qualities is inherently less distinctive and is considered to be a weaker mark; the ambit of protection afforded to a weak mark is much less than a strong mark, and registration of other marks containing small differences may be permitted.

Given the drawing component of the mark PVA and drawing, seen together, the mark benefits from a certain inherent distinctiveness, while the acronym PVA has an a less distinctive inherent character. However, the Applicant submits that the Registrar must conclude that the PVA certification mark has a certain inherent distinctiveness since there is no evidence in the record about the existence of other trade-marks in the register containing the letters “PVA.” The burden of proof is on the Appellant and it has not submitted evidence in the record to show that there are no other registered trade-marks [or] other trade-names containing the letters “PVA.”

B) Time in use

In paragraph 5 of his statutory declaration, Mr. Parisella alleges that the trade-mark PVA was used by the Opponent’s predecessor in title from September 1996 to August 1997. Thereafter, the Opponent used the said trade-mark and the mark PVA and drawing from September 1997 onward. In support of these allegations, the affiant tendered samples of invoices, cheques, advertising brochure, stationery, business cards and newspaper advertising in evidence. For its part, the Applicant alleges use of its PVA certification mark since February 23, 1998. It should

be noted that I have already found that there is no evidence of use of this certification mark since that date in association with the services described in the application for registration. Even if one considers that the certification mark was used from that date onward within the meaning of the Act, this consideration would be equally favourable to the Opponent.

C) Nature of services

The uncontradicted evidence of the Opponent discloses that it has performed contracts related to the sales business, specifically the training of salespersons and the development of sales systems. These activities overlap with one of the standards that the Applicant has established for entitling a salesperson to use the PVA certification mark: the salesperson's commitment to continued learning (paragraph 4 B of the Ruffell affidavit.)

D) Nature of the trades

Based on the evidence submitted by the parties and cited or summarized above, I can conclude that the nature of the Applicant's trade differs from the commercial activities of the Opponent.

E) Degree of resemblance

I must consider the marks in question in their entirety rather than comparing each of the elements in segments [see *Park Avenue, infra*]. Applying this method, I conclude that the PVA certification mark does not cause confusion with the mark PVA and drawing, since there are rather substantial differences between these marks, specifically the drawing and the text incorporated into the mark PVA and drawing.

However, I cannot come to the same conclusion when comparing the Opponent's PVA trade-mark with the PVA certification mark. But in order for me to allow this third ground of the opposition, the Opponent must prove that it had not abandoned the use of its PVA trade-mark on the date that this application for registration was advertised (section 16(5) of the Act). The uncontradicted evidence submitted by the Opponent clearly establishes that the Opponent used

the PVA trade-mark as part of its business activities at October 14, 1999. By way of illustration, I refer to the brochure constituting Exhibit P-3. According to the allegations in paragraph 5 of Mr. Parisella's statutory declaration, the Opponent has been using the brochure since September 1997. Having regard to all the criteria set out above, I must allow the third ground of the opposition, which is based on sections 38(2)(c) and 16(1)(a) of the Act.

Since I have found that the PVA certification mark causes confusion with the Opponent's PVA trade-mark and trade-name, I must also conclude that the PVA certification mark is not distinctive. Thus, I allow the fourth ground of the Opponent's opposition as well.

Consequently, the grounds of the opposition based on sections 38(2)(a) and (c), 30(b), 16(1)(a) and 2 of the Act are allowed, and by virtue of the powers delegated to me by the Registrar of Trade-marks under section 63(3) of the Act, I refuse the Applicant's application for the registration of the PVA certification mark, the whole in accordance with the provisions of section 38(3) of the Act.

MONTRÉAL, QUEBEC, THIS 18TH DAY OF JULY, 2003.

Jean Carrière
Member of the Opposition Board