



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

**Citation: 2013 TMOB 183**  
**Date of Decision: 2013-10-25**

**IN THE MATTER OF AN OPPOSITION  
by Christine Stover to application  
No. 1,493,497 for the trade-mark  
ParaLegal Solutions in the name of Toni  
L. Wallner, trading as Paralegal Solutions**

Introduction

[1] This opposition relates to an application filed by Toni Wallner, trading as Paralegal Solutions (the Applicant) on August 24, 2010 to register the trade-mark ParaLegal Solutions (the Mark) based on use since February 26, 2004 in association with legal documents (the Wares) and legal services that do not require legal advice (the Services).

[2] The grounds of opposition raised by Christine Stover (the Opponent) in a statement of opposition dated May 9, 2011 are based on sections 30(a), (b), (i), 12(1)(b), 16(1)(c), and 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13, (the Act). The specific grounds of opposition are detailed in Schedule A annexed to this decision.

Legal Onus and Burden of Proof

[3] There is an initial evidential burden on the Opponent to file sufficient admissible evidence from which it could reasonably be concluded that there exist enough facts to support each ground of opposition pleaded. If those facts exist, then the Applicant must show that the application complies with the provisions of the Act and the grounds of opposition raised by the Opponent should not prevent the registration of the trade-mark applied for [see *Joseph E*

*Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FCTD)].

[4] The first issue is to determine if the Opponent has furnished sufficient evidence to support each of its grounds of opposition. I conclude for the reasons detailed hereinafter that the Opponent has not met her initial burden with respect to ground of opposition based on section 16(1)(c) of the Act. Even though the Opponent has met her initial burden with respect to all grounds of opposition based on section 30, only grounds of opposition based on section 30(a) (with respect to the Wares only) and (b) of the Act are maintained. I also conclude that the Mark is clearly descriptive of the character of the Services. Finally as I am maintaining some the other grounds of opposition, I do not need to rule on the issue of the distinctiveness of the Mark.

#### Preliminary Remarks

[5] Both the Applicant and the Opponent are paralegals. The Opponent has been licensed as a paralegal by the Law Society of Upper Canada (LSUC) since September 26, 2008. She is located in Ontario. The Applicant is also a paralegal. She claims to have been a paralegal in the Province of Alberta since July 4, 2002. It appears from the evidence filed by both parties the academic requirements to become a paralegal and the list of acts that can be performed by a paralegal differ from one province to another.

[6] In coming to my decision I have considered all of the evidence, namely the affidavits of Christine Stover and Toni L. Wallner, and the written arguments filed by the parties. However, only the portions of the evidence and submissions which are directly relevant to my findings will be discussed in the body of my decision. The parties, having some legal knowledge did cross, on some occasions, the boundary between material facts and legal opinion. I have disregarded any legal opinion in the affidavits filed, in the absence of evidence of the deponents' expertise in the field of trade-mark law.

[7] The application was filed on the basis of a claimed date of first use since February 26, 2004 in association with both the Wares and Services. The Opponent claims a date of first use since October 10, 2007, which predates the filing date of the application (August 24, 2010) but

not the claimed date of first use. The Opponent has however challenged the claimed date of first use alleged by the Applicant. There is no doubt that the parties' marks and/or trade names are confusing being identical and because both parties operate in the same general field, namely legal services. In fact the Applicant admits in paragraph 22 of Ms. Wallner's affidavit that the parties' services are virtually identical.

[8] I also wish to point out that I did not consider any allegations contained in the parties' written arguments that are not supported by the evidence in the record. For example the Applicant states in her written argument that she spoke to her bank and confirmed that she opened an account under the Mark on April 9, 2003. There is no evidence of that fact in the record.

[9] Finally, in her statement of opposition the Opponent alleges having filed an application to register PARALEGAL SOLUTIONS on May 9, 2011 but failed to identify the application number. Moreover since the latter application was filed subsequent to the present application, as expected there is no ground of opposition based on this unidentified application.

#### Ground of Opposition based on section 30(a) of the Act

[10] The Opponent argues that the *Wares and Services Manual* published by the Canadian Intellectual Property Office (CIPO) only refers to 'legal services' and not the Services as drafted. The *Wares and Services Manual* contains a detailed list of wares and services but it is not exhaustive. In the absence of other evidence I consider the Services to have been described in ordinary commercial terms.

[11] In her affidavit Ms. Stover asserts that she 'cannot understand what kind of wares comprises the 'Legal Documents''. Ms. Stover states that Legal Documents are usually the end result of legal services, such as contracts, issued deeds, court orders and articles of incorporation after they have been issued by a government authority. Ms. Stover alleges that all these documents are not off-the-shelf wares that may be mass produced and sold under a trade-mark. Ms. Stover further claims that 'legal forms' could be off-the-shelf wares that may be mass produced and sold under a trade-mark. Examples of these documents could be: leases, wills, power of attorney, bond.

[12] I am not prepared to accept the distinction made by the Opponent between 'legal documents' and 'legal forms'. A will or a lease for example can be considered as a 'legal document'. A Deed of Purchase could be found in print form and still be a 'legal document'. However given the numerous type documents that may be included under the designation 'legal documents' I consider it to be too general. An analogy can be made with the broad designation 'articles of clothing'. If an applicant uses such description, it will have to specify which articles of clothing are covered by its application.

[13] I conclude that the Wares are not written in ordinary commercial terms. Therefore this ground of opposition is maintained but for the Wares only.

#### Ground of Opposition based on Section 30(i) of the Act

[14] Section 30(i) of the Act only requires the Applicant to declare that it is satisfied that it is entitled to use the Mark in Canada in association with the wares and services described in the application. Such a statement is included in this application. An opponent may rely on section 30(i) in specific cases such as where fraud by the applicant is alleged [see *Sapodilla Co Ld v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[15] The Opponent argues that the Applicant was in bad faith when she filed her application on August 24, 2010 for the reasons described hereinafter.

[16] Ms. Stover explains in her affidavit that on October 6, 2007 she ordered a Nuans pre-search for the name 'PARALEGAL SOLUTIONS' which she filed as exhibit B to her affidavit. She alleges that the report did not reveal any business name or trade name registration owned by the Applicant, who claims to have operated her business under that trade name since February 26, 2004 in Red Deer, Alberta. However the report does cite 'PARALEGAL SOLUTIONS' as an active trade name from Alberta, but the date referred to for such citation is June 24, 1998. In a subsequent report, as described hereinafter, details of such citation have been provided. From those details it is apparent that this citation does not relate to the Applicant.

[17] Ms. Stover alleges that she did not find in October 2007 any active telephone listings in Canada for a business called PARALEGAL SOLUTIONS in her 'online telephone directory

searches'. However she has not mentioned which online telephone directories were searched at that time.

[18] Ms. Stover then alleges that in November 2010 she ordered another Nuans pre-search report that reveals the existence of two Alberta trade name registrations for PARALEGAL SOLUTIONS, and she filed a copy of the report. She then ordered in December 2010, two Alberta Trade Name searches for those two listings and the results are annexed to her affidavit. One search discloses that 787403 Alberta Ltd operated under the trade name PARALEGAL SOLUTIONS registered on June 24, 1998 in Alberta. There is no reference to any individual on the report, exhibit D to Ms. Sover's affidavit, but nonetheless she affirms that such company is not related to the Applicant. That company has been 'struck' for failure to file its annual returns as appears from another report issued by the Alberta Corporate Registration System on January 10, 2012. The report, under the heading 'Struck Off Date', has the mention '2006/12/02'.

[19] The other report from the Alberta Corporate Registration System relates to the Applicant. She registered the trade name PARALEGAL SOLUTIONS on August 16, 2010 but under the heading 'Commencement Date' the information reads '2004/02/26' which is the date of first use claimed in the present application.

[20] Then Ms. Stover alleges that she did not find any evidence in any public records which would show that Ms. Wallner used the Mark as an Alberta Trade Name in association with her services or as a trade-mark prior to 2010. However Ms. Stover does not enumerate which records she searched to support that contention.

[21] Ms. Stover also states that it was in or about August 2010 that she discovered that the Applicant listed her phone number in an online telephone directory under 'Paralegal Solutions'. She called the Applicant to ask her to cease and desist from using the Mark as she claimed to have prior rights to the Mark. Ms. Wallner admits in her affidavit having received phone calls from Ms. Stover, the first one going back to August 14, 2010. There were other phone calls made by the Opponent in August 2010 as appears from Ms. Wallner and Ms. Stover statements to that effect in their affidavits.

[22] The Opponent argues that subsequent to these phone calls the Applicant was well aware of the Opponent's rights. It was only after these phone calls that the Applicant filed both her Alberta Trade Name registration (August 16, 2010) and the present application (August 24, 2010). Consequently, according to the Opponent the application for the registration of the Mark was filed by the Applicant in bad faith.

[23] On the other hand, Ms. Wallner alleges that subsequent to the August 14, 2010 phone call from the Opponent, she requested on August 16, 2010 a NUANS report from the Federal Database for the name Paralegal Solutions. Two citations were located: a Sole Proprietorship under Ontario Jurisdiction registered on October 10, 2007 and a trade name in Alberta registered on June 24, 1998 (corresponding to the citation described above) and she filed a copy of that report.

[24] It is obvious from those facts that the Applicant claims prior rights based on her alleged date of first use of the trade name Paralegal Solutions of February 26, 2004 while the Opponent claims that she has prior rights because she was unable to find any evidence of use of the trade name Paralegal Solutions by the Applicant prior to August 2010. In any event according to the Opponent, it was only in August 2010 that the Applicant obtained a registration for that trade name in Alberta, which is after the Opponent's own registration obtained in Ontario in October 2007.

[25] In her affidavit Ms. Wallner does state that, contrary to the Province of Ontario, in Alberta the Law Society of Alberta does not govern the operation of Paralegals. She goes on to state that she has been a paralegal in the Province of Alberta since July 4, 2002. She then began operating her business as a Sole Proprietor under the name 'ParaLegal Solutions' on April 14, 2003 on a part-time basis and began full-time operation under that name on February 26, 2004.

[26] On the basis of her alleged date of first use the Applicant was entitled to file the present application. In fact she has been consistent in claiming a date of first use of February 26, 2004 as she referred to that date in her application to register the trade name 'ParaLegal Solutions' in Alberta, in the present application, and in her affidavit.

[27] From all this evidence I cannot conclude that the Applicant was in bad faith when she filed the present application. Consequently this ground of opposition is dismissed.

Ground of Opposition Based on Section 30(b)

[28] The Opponent has an initial burden to file some evidence to support this ground of opposition. Alternatively, the Opponent may rely on the Applicant's evidence to meet her light evidential burden [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)].

[29] I am satisfied that the Opponent has met her initial burden of proof. All the searches performed by Ms. Stover in October 2007 and described earlier did not reveal that the Applicant was carrying on business in Alberta under the trade name 'ParaLegal Solutions'.

[30] Consequently the Applicant had to prove that it was using the Mark within the meaning of sections 4(1) and (2) of the Act as of the claimed date of first use, namely February 26, 2004. A bald statement of use of the Mark as of the claimed date of first use is not sufficient.

[31] Aside from the statements made by Ms. Wallner about her use of the Mark on a 'part-time basis' starting in April 2003 and on a full-time basis as of the claimed date of first use, the earliest document filed that makes reference to the Mark is a Telus phone statement dated August 23, 2006 filed as exhibit A to her affidavit on which appears the Applicant's name and the Mark underneath. Ms. Wallner alleges that the statement was issued subsequent to the Applicant's request for an additional telephone line. She also alleges that she holds a business license granted by the City of Red Deer under the name 'Paralegal Solutions'. Later on in her affidavit Ms. Wallner admits that she received her first telephone account bearing the Mark on August 23, 2006 and that she is listed in the Telus Directory since November 2006 (see paragraph 18 of Ms. Wallner's affidavit). The Applicant is arguing that her date of first use of August 23, 2006 would, in any event, predate the date of first use of October 2007 claimed by the Opponent.

[32] I have been unable to find any evidence other than a bald statement of use of the Mark going back to February 26, 2004 as claimed in the application. If the Applicant started using the

Mark at such date it could have filed business cards used at that time, sample of invoices issued for services rendered, any promotional material used when she started her business under the Mark.

[33] Ms. Wallner makes mention of August 23, 2006 as the possible date of first use of the Mark in paragraph 19 of her affidavit where she states: ‘The Applicant has, as evidenced by her telephone account, (Exhibits ‘A’ & ‘G’) been using ‘PARALEGAL SOLUTIONS’ at least since August 23, 2006 and respectfully submits that the Opponents (sic) use of the name beginning in 2007 would be confusing with the Applicants (sic) name rather than the opposite...’.

[34] Under this ground of opposition I do not have to determine which party has used the Mark first. I must decide if the evidence in the record supports the claimed date of first use of February 26, 2004 alleged by the Applicant in her application. As it appears from the evidence described above, the Applicant has not discharged her burden to show her use of the Mark in association with the Wares and Services on or about February 26, 2004 within the meaning of sections 4(1) and (2) of the Act.

[35] Thus, this ground of opposition is maintained.

#### Ground of Opposition Based on Section 16(1)(c) of the Act

[36] Since the Opponent was successful under her ground of opposition based on section 30(b) of the Act, the material date to assess the ground of opposition based on section 16(1) becomes the date of filing of the application (August 24, 2010) and not the alleged date of first use claimed by the Applicant in her application [see *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)].

[37] The Opponent had to establish use of her trade name Paralegal Solutions in Canada prior to August 24, 2010 and that she had not abandoned such use at the advertisement date of this application (March 9, 2011) [see section 16(5) of the Act].

[38] There is no definition in the Act of what constitute use of a trade name. The topic was discussed in the case of *Mr. Goodwrench Inc v General Motors Corp*, (1994) 55 CPR (3d) 508 (FCTD) wherein Simpson J. stated:



There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207 Mr. Justice Strayer considered the problem and held that the principles in ss. 2 and 4(1) of the Act apply to trade name use. In this regard, His Lordship said:

While there is no definition in the Trade Marks Act of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

Accordingly, use in the normal course of trade will be the test applied in these reasons.

[39] I also refer to the decision of *Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc*, (1995) 62 C.P.R (3d) 108, where Hearing Officer D. Martin stated:

“However, the formation or registration of a company under a particular name does not, by itself, constitute use of that name as a trade mark or a trade name.”

[40] I shall apply these principles in my review of the evidence to be described hereinafter in order to determine if the Opponent has established prior use of her trade-name Paralegal Solutions in association with paralegal services.

[41] Ms. Stover alleges that she has been licensed as a paralegal by the LSUC since September 26, 2008. She filed a copy of her profile listing with the LSUC. I do not consider this document per se as establishing use of her trade name Paralegal Solutions. In fact the document refers to the business name Paralegal Solutions Professional Corporation, a trade name that has not been alleged in the statement of opposition. Also there is no indication on the document filed that the Opponent obtained her license from the LSUC on that date.

[42] In paragraph 14 of her affidavit Ms. Stover claims to be the proprietor of the trade name Paralegal Solutions under the laws of Ontario duly registered on October 10, 2007. She filed as exhibit F to her affidavit her ‘Master Business Licence’ issued on that date. However such document does not establish use of a trade name within the parameters defined above.

[43] Ms. Stover asserts that she is the President of Paralegal Solutions Professional Corporation (the Corporation), a corporation duly registered under the laws of the Province of Ontario on September 1, 2011 and she filed a copy of the Articles of Incorporation. There are numerous problems relating to this allegation. Firstly that entity is not a party to this opposition.

Secondly, this corporation did not exist at the material date and finally, in any event corporate documents do not constitute proper evidence of use of a trade name.

[44] Ms. Stover then alleges using her website PARALEGALSOLUTIONS.BIZ to advertise her legal services across North America and alleges having received many inquiries for her legal services. She filed a copy of the home page on which appears the trade name and/or trade-mark PARALEGAL SOLUTIONS. However Ms. Stover did not provide the date when the website was created. Therefore that portion of the Opponent's evidence is of little assistance as I cannot determine if her website was accessible to Canadians prior to the material date.

[45] Ms. Stover alleges that her trade-mark PARALEGAL SOLUTIONS has been displayed on her store front signs, in front of her office, in newspaper ads, business cards, letterhead and she filed photos and samples of these items. I note that again there is no date associated with each of the photos or documents filed. I cannot determine if any of this material was in use prior to the relevant date. Also the letterhead and business card filed refer to the Corporation, incorporated after the material date. Finally the Opponent has not raised as a ground of opposition section 16(1)(a) of the Act, namely that the Applicant was not entitled to the registration of the Mark as it was confusing with the Opponent's trade-mark PARALEGAL SOLUTIONS, previously used in Canada, but instead has pleaded section 16(1)(c) of the Act which refers to prior use of a trade name. Even if I were to consider the use of the term trade-mark in her affidavit to be a typo, and I read in 'trade name' instead, it would not alter the outcome of my decision.

[46] She alleges that her 'businesses' are both listed in the municipality of Chatham-Kent's online business directory and she filed a printout of the listings for paralegals in that municipality. Again no date has been provided as to when the trade name Paralegal Solutions was first published in that directory. Moreover since the Corporation appears on the document filed and because it was incorporated after the relevant date, I have to assume that the listing filed was published after the relevant date and consequently can be of no support to the Opponent.

[47] Ms. Stover then asserts having written articles published in legal publications and electronic legal publications, such as the British Columbia Paralegal Association's newsletter

distributed to its members and she filed a copy of such article. The article appears to have been published in the Spring of 2008. It describes the requirements under the LSUC to become a paralegal, her personal experience going through this process, and some biographical notes and achievements. The publication of an article of that nature does not constitute use of a trade name in association with paralegal services.

[48] Overall, the Opponent's evidence falls short from establishing use by her of a trade name in the normal course of trade in Canada in association with paralegal services prior to August 24, 2010. There is no reference to sales figures prior to the relevant date (in this case it would probably be fees for paralegal services rendered in association with the trade name Paralegal Solutions); no evidence of advertising published prior to the relevant date. There is no reference to a date of publication on the one advertisement filed.

[49] For all these reasons I conclude that the Opponent has failed to meet her initial burden of proof and therefore this ground of opposition is dismissed.

#### Ground of Opposition based on Section 12(1)(b) of the Act

[50] The purpose of section 12(1)(b) of the Act is to prevent a single trader to monopolize a term that is clearly descriptive, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD) at para. 15]. Also the decision that a trade-mark is clearly descriptive is to be based on the initial impression having regard to the wares or services in question and on common sense [see *Ontario Teachers' Pension Plan Board v Canada (Attorney General)* (2010), 89 CPR (4th) 301 (FCTD); aff'd (2012), 99 CPR (4th) 213 (FCA)].

[51] The relevant date associated with this ground of opposition is the filing date of the application (August 24, 2010) [see *Fiesta Barbeques Ltd v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FCTD)].

[52] As appears from the fourth ground of opposition described in Schedule A only the Services are in issue under this ground of opposition.

[53] Ms. Stover attached to her affidavit the Government of Alberta Occupational Profile for Paralegals in which we find the following extract: ‘Paralegals do independent legal work under the supervision of lawyers. They perform routine legal and administrative functions and assists lawyers with more complex matters.’.

[54] In response to this ground of opposition the Applicant in her counter statement states that the Mark is ‘nearly identical to the Opponents (sic) Ontario registered trade name PARALEGAL SOLUTIONS in it’s (sic) descriptive quality’. Essentially the Applicant is arguing ‘if my trade-mark is descriptive, so is the Opponent’s trade-mark’. The trade-mark in issue is not the Opponent’s trade-mark but the Mark.

[55] The word ‘Paralegal’ could be a noun or an adjective. In the *Canadian Oxford Dictionary* it is defined in the following terms:

Paralegal: *Adjective* of or relating to auxiliary aspects of the law.

*Noun* a person trained in subsidiary legal matters, but not fully qualified as a lawyer, a legal aide.

[56] Without doing an in-depth grammatical analysis of the Mark and applying common sense, I find that the Mark is clearly descriptive of the character of the Services. The Mark clearly describes the fact that the Services would be performed by ‘paralegals’ and would consist in ‘solutions to legal issues provided by paralegals’.

[57] I maintain this ground of opposition in so far as the Services are concerned.

#### Ground of Opposition based on section 2 of the Act (distinctiveness of the Mark)

[58] Given that the Opponent has been successful with her ground of opposition based on section 30(b) of the Act; partially successful with her ground of opposition based on section 30(a) (for the Wares only); and also partially successful with her ground of opposition based on section 12(1)(b) (for the Services only), I do not need to consider this last ground of opposition.

Disposition

Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule A

The grounds of opposition can be summarized as follow:

1. The application does not comply with the requirements of section 30(a) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that it does not describe the Wares and Services in ordinary commercial terms;
2. The application does not comply with the requirements of section 30(b) of the Act in that the Mark has not been continuously used, or at all, by the Applicant since the date claimed of February 26, 2004;
3. The application does not comply with the requirements of section 30(i) of the Act in that the Applicant could not have been satisfied that she was entitled to use the Mark in Canada, as the Applicant was well aware of the Opponent's trade name registration and prior use in Canada before the filing date of the Applicant's application;
4. The Mark is not registrable in view of section 12(1)(b) of the Act since the Mark is clearly descriptive, in English, of the character of the services in association with which it is used;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to sections 16(1)(c) in that at the filing date of the application, the Mark was confusing with the trade name Paralegal Solutions that had been previously used and made known in Canada by the Opponent;
6. Pursuant to section 38(2)(d) of the Act, the Mark is not and cannot be distinctive of the wares and services of the Applicant within the meaning of section 2 of the Act.