



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

**Citation: 2013 TMOB 24**  
**Date of Decision: 2013-02-11**

**IN THE MATTER OF AN OPPOSITION  
by PricewaterhouseCoopers LLP to  
application No. 1,425,038 for the trade-  
mark CLARITY DEFINED in the name  
of Collins Barrow National Cooperative  
Incorporated**

[1] On January 20, 2009, Collins Barrow National Cooperative Incorporated (the Applicant) filed an application to register the trade-mark CLARITY DEFINED (the Mark) based on proposed use in Canada. The statement of services of the application of record, as revised on January 20, 2010, reads:

accounting services; auditing services, namely the review and analysis of financial statements in accordance with applicable laws and professional standards; business acquisition and merger consulting services; business management consulting and advisory services; business valuation services; management planning services; business management supervision and oversight; business financial planning, management, consulting services in the field of reduction of operating costs and profit enhancement; estate and succession planning services; forensic accounting services; personal financial planning services; securities services, namely the preparation of initial public offerings; taxation services, namely, preparation of business and personal tax returns, and preparation of tax minimization strategies; management and consultation in the field of human resources services; computer and information technology advisory services; financial consulting and accountancy services relating to bankruptcy, liquidation, insolvency and financial restructuring; litigation support in accounting and finance (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 12, 2010.

[3] PricewaterhouseCoopers LLP (the Opponent) filed a statement of opposition on October 12, 2010. The grounds of opposition allege, in summary, that:

- a) the application does not conform to the requirements of sections 30(a), (e) and (i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act);
- b) the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the following registered trade-marks: CLARITY AND COMMITMENT (TMA656,967), CLARITY THROUGH DIALOGUE (TMA555,288), THERE'S A LOT TO BE SAID FOR CLARITY (TMA582,428), THERE'S A LOT TO BE SAID FOR CLARITY (Cantonese version) (TMA582,145), THERE'S A LOT TO BE SAID FOR CLARITY (Mandarin version) (TMA582,146), CLARICA/CHINESE CHARACTERS & Design (TMA552,966), and CLARICA/CHINESE CHARACTERS & Design (No. 2) (TMA552,975);
- c) the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act because at the filing date of the application, the Mark was confusing with the aforementioned registered trade-marks as well as with the trade-marks CLARITY CHINA (Appl. No. 1,458,857) and CLARITY FOR WOMEN (Appl. No. 1,108,749) that had been previously used or made known in Canada by their respective owners, which are listed in Schedule A to the statement of opposition as follows:
  - Sun Life Assurance Company of Canada (TMA552,966, TMA552,975, TMA555,288, TMA582,428, TMA582,145 and 582,146)
  - Keith M.J. Anderson, Professional Corporation (TMA656,967)
  - Clarity Management L.P. (1,458,857); and
  - Clarica Life Insurance Company (1,108,749);
- d) the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(b) of the Act because at the filing date of the application, the Mark

was confusing with the trade-mark CLARITY CHINA of application No. 1,458,857 in respect of which an application had been previously filed in Canada;

e) the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(c) of the Act because at the filing date of the application, the Mark was confusing with the trade-names listed in schedule B to the statement of opposition, namely Clarity.ca Inc., Clarity International, Clarity Accounting, Clarity Accounting and Tax Solutions, Clarity Systems Ltd., Clarity Financial Corporation, Clarity Financial Strategy Inc., Clarity Group, Clarity Corporate Consulting, Clarity SB, NTG Clarity Network Inc. and Clarity Advantage, previously used by their respective owners; and

e) the Mark is not distinctive pursuant to section 2 of the Act.

[4] The Applicant filed and served a counter statement on November 1, 2010 essentially denying the grounds of opposition.

[5] Both the Applicant and the Opponent filed evidence and written arguments and were represented at an oral hearing.

#### Onus and Material Dates

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[7] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(a), (e) and (i)- the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(3)(a) to (c) - the filing date of the application [section 16(3) of the Act]; and
- sections 38(2)(d)/2 - the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Opponent's Evidence

[8] In support of its opposition, the Opponent filed an affidavit of Sarah D. Carnegie, sworn October 8, 2010, with its Exhibits 1 to 54. Ms. Carnegie was not cross-examined.

[9] Ms. Carnegie is a project manager and statistical consultant with CorbinPartners Inc., which she describes as an established provider of business intelligence, statistical measurement and forensic market research. Ms. Carnegie states that as part of her employment duties, she is “regularly called upon to conduct internet investigations, to search for and identify evidence of use of words and phrases by individuals and/or business as part of their wares, services, business, advertising or otherwise” and that she is “experienced at conducting such searches” [para. 1].

[10] Ms. Carnegie states at paragraph 3 of her affidavit:

I was retained by Gowling Lafleur Henderson LLP to conduct an internet investigation to search for and identify examples of use of the following words and phrase by individuals and/or businesses in Canada: CLARITY (and variations of the word “clarity”), DEFINED (and variations of the words “defined”), and the phrase “CLARITY DEFINED” in association with the following services or wares, or similar services or wares: accounting, audits, business, consulting, financial consulting, management consulting, estate planning, securities, taxes, human resources services, information technology consulting, bankruptcy and litigation services.

[11] Ms. Carnegie describes the findings of Internet searches that she conducted between August 6, 2010 and August 20, 2010 for the following terms:

- “clarity” [paras. 5 to 9, Exhibits 1 to 6];
- “clarity + accounting” [paras. 10 to 12, Exhibits 7 to 11];

- “clarity + audits” [paras. 13 to 19, Exhibits 12 to 21];
- “clarity +financial planning” [para. 20, Exhibits 22 and 23];
- “clarity + financial" [paras. 21 to 24, Exhibits 24 to 27];
- “clarity +business consulting” [paras. 25 to 28, Exhibits 28 to 35];
- “clarity + estate planning” [paras. 29 to 31, Exhibits 36 to 39];
- “clarity + human resources” [paras. 32 to 34, Exhibits 40 to 43];
- “clarity + securities” [paras. 35 and 36, Exhibits 44 and 45];
- “clarities + forensic accounting” [paras. 37 to 40, Exhibits 46 to 49];
- “define + business consulting” [paras. 42 and 43 Exhibits 50 and 51]; and
- “define + financial consulting” [paras. 44 and 45, Exhibits 52 to 54].

[12] As part of her findings, Ms. Carnegie references telephone calls that she made to confirm that companies located by her searches were active.

[13] The Applicant made various submissions as regard to the affidavit of Ms. Carnegie, these submissions being essentially to the effect that her evidence constitutes inadmissible hearsay and that the Opponent has not set forth any facts that would justify the admissibility of such evidence on the basis of necessity and reliability or any other hearsay exception. However, as I understand the Opponent’s oral submissions, it seeks to rely on the affidavit of Ms. Carnegie only to establish the existence of the websites. The Opponent also submits that the portions of the affidavit referencing telephone conversations are admissible as evidence because they corroborate that there were live entities behind the websites accessed by Ms. Carnegie.

[14] In the end, I consider that the evidence introduced by Ms. Carnegie is admissible to the extent that it establishes the existence of the websites (as opposed to the truth of their contents) when they were accessed by Ms. Carnegie. Hence, I will return to her affidavit in my analysis of the grounds of opposition, where appropriate.

#### Applicant’s Evidence

[15] In support of its application, the Applicant filed an affidavit of Sina Giugno, sworn August 5, 2011, with its Exhibits A to F. Ms. Giugno, a legal assistant with the firm acting as the Applicant’s trade-marks agent, was not cross examined.

[16] Besides providing printouts from the trade-marks database of the Canadian Intellectual Property Office (CIPO) for the registrations and applications alleged in the statement of opposition [para. 6, Exhibit E], Ms. Giugno provides the following evidence:

- the results of searches of CIPO's trade-marks database with respect to registrations and applications for trade-marks containing the word CLARITY [paras. 2 and 3, Exhibits A and B] as well as for trade-marks containing the word DEFINED [paras. 4 and 5, Exhibits C and D]; and
- the results of a NUANS search conducted by Ms. Yaromich of her firm for the proposed corporate name Clarity Ltd. [para. 7, Exhibit F].

[17] The results of the searches of CIPO's trade-marks database cannot be afforded any significance as they are deficient in a number of respects. Ms. Giugno simply appends listings that provide incomplete particulars of the entries located. We do not know the statement of wares or services associated with the trade-marks, nor the names of their owners and where a design mark has been located, no representation of the design has been provided. I note that in opposition proceedings, the Registrar does not exercise his discretion to have regard to anything appearing on the register that is not properly proved by evidence, except to verify whether properly pleaded trade-mark registrations and applications are extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB); *Royal Appliance Mfg. Co v Iona Appliance Inc.* (1990), 32 CPR (3d) 525 (TMOB)].

[18] I find that the NUANS search report, which was apparently generated on August 2, 2011, does not qualify as admissible hearsay evidence as it does not satisfy the test of necessity and reliability. No indication was given as to why Ms. Yaromich could not have sworn an affidavit on her own. Even if the contents of the search report were admissible, I could not give Ms. Giugno's evidence much weight, if any, for several reasons. There is no indication that any of the corporations and trade names listed from pages 1 to 4 of the report have been brought to the attention of consumers in the marketplace, or indeed that these names are in use in Canada. Assuming that a number of the businesses were in operation at the date of the report, there is no indication as to their field of activities and no evidence that they used their names as trade-marks or trade-names in Canada. Finally, the listing of trade-marks at pages 5 and 6 of the report

provides incomplete particulars of the entries located as in many cases the statement of wares or services are incomplete.

[19] Having regard to the foregoing, I will not further discuss the affidavit of Ms. Giugno, except for its Exhibit E, in my analysis of the grounds of opposition.

#### Analysis of the Grounds of Opposition

[20] I now turn to the analysis of the grounds of opposition, although not in their order of pleading.

#### Non-Entitlement Pursuant to Section 16(3) of the Act

[21] As a first matter, I note that the Opponent did not make any representations, be it in written or oral arguments, with respect to the non-entitlement grounds of opposition. For the reasons that follow, I dismiss each of the non-entitlement grounds of opposition.

[22] Section 17(1) of the Act states that no application for the registration of a trade-mark shall be refused due to previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant or his predecessor in title, except at the instance of that other person or his successor in title. Therefore, an opponent can only rely upon prior use or making known of its own trade-marks or prior use of its own trade-names in support of a non-entitlement ground of opposition. However, there seems to be no requirement that an opponent be the owner of a previously filed application alleged in support of a non-entitlement ground of opposition [see *Professional Pharmaceutical Corp v Laboratoires Ed Fromont SA* (1996), 69 CPR (3d) 501 (TMOB) for a discussion of the operation of sections 16 and 17(1) of the Act].

[23] The section 16(3)(a) ground of opposition is based on prior use or making known in Canada of trade-marks owned by other parties than the Opponent. Further, there is no evidence to establish that the Opponent owned any of the alleged marks at the material date. Likewise, the Opponent bases its section 16(3)(c) ground of opposition on trade-names previously used in Canada “by their respective owners”; no evidence has been provided to establish a connection between the alleged trade-names and the Opponent. Accordingly, the sections 16(3)(a) and (c) grounds of opposition are dismissed as invalid grounds of opposition.

[24] According to Exhibit E to Giugno affidavit, application No. 1,458,857 for the trade-mark CLARITY CHINA was filed by Clarity Management, LP on November 12, 2009 claiming a priority filing date of October 29, 2009, which is subsequent to the filing date of the application for the Mark, namely January 20, 2009. Accordingly, the section 16(3)(b) ground of opposition is dismissed as an invalid ground of opposition.

Non-Conformity to the Requirements of Section 30 of the Act

[25] The Opponent did not expand on the sections 30(a), (e) and (i) grounds of opposition in its written argument, but it briefly discussed them at the oral hearing. For the reasons that follow, I dismiss each of these grounds of opposition.

Section 30(a) of the Act

[26] The Opponent alleges that the application “does not contain a statement in ordinary commercial terms of the specific services in association with which the mark is proposed to be used”.

[27] The Federal Court of Appeal held in *Novopharm Ltd v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA) that the sufficiency of pleadings should be assessed having reference to the evidence of record. However, the Opponent did not file any evidence in support of this ground of opposition. Given the relatively lengthy statement of services, in the absence of any indication in the pleading as to which services allegedly offended section 30(a), in my view the pleading is vague and ambiguous. I therefore conclude that the ground of opposition is not set out in sufficient detail to enable the Applicant to reply thereto.

[28] Having regard to the foregoing, I dismiss the ground of opposition based upon non-conformity to the requirements of section 30(a) of the Act for being insufficiently pleaded.

[29] In the event that I am wrong in so finding, I note that the Opponent’s oral argument was essentially that the application does not conform to the requirements of section 30(a) of the Act because the Services “are too broad in scope”. While an opponent’s initial burden of proof under section 30(a) of the Act may be met through argument [see *McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) at 104], in the



circumstances of this case, I would have found that the Opponent's argument was not sufficient to meet its evidential burden.

#### Section 30(e) of the Act

[30] The ground of opposition alleges that the Applicant, by itself or through a licensee, did not intend to use the Mark, as a trade-mark, in association with the general class of services described in the application.

[31] As I understand the Opponent's oral submissions, it contends that the outcome of this ground of opposition is contingent upon the outcome of the non-distinctiveness ground of opposition. More particularly, the Opponent submits that if it is found that the Mark is not distinctive pursuant to section 2 of the Act, it has to be found that the Applicant did not intend to use the Mark as a trade-mark. I disagree with the Opponent's approach.

[32] As the application contains a statement that the Applicant by itself and/or through a licensee intends to use the Mark in Canada, it formally complies with section 30(e) of the Act. The issue becomes whether or not the Applicant has substantially complied with section 30(e) of the Act, i.e. is the Applicant's statement that it intended to use the Mark true? [See *Home Quarters Warehouse, Inc v Home Dépôt, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB)].

[33] The Opponent did not file any evidence to establish that the Applicant falsely made the statement required by section 30(e) of the Act. Further, this is clearly not a case where the Opponent can meet its relatively light burden under this ground of opposition by reference to the Applicant's evidence [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FC)]. Accordingly, I dismiss the ground of opposition for the Opponent's failure to meet its evidential burden.

#### Section 30(i) of the Act

[34] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with

section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Such circumstances do not exist in the present case and I therefore dismiss the ground of opposition.

#### Non-Distinctiveness

[35] The pleaded ground of opposition reads as follows:

The [Mark] is not distinctive as it cannot actually distinguish the services of the Applicant in association with which it is proposed to be used from the services associated with others, including those services (and wares) associated with other trade-marks, trade-names, slogans and product names featuring the element CLARITY (or variations thereof), including those enumerated therein, nor is it adapted so as to distinguish them.

[36] Given the evidence filed by the Opponent, I am satisfied that the Applicant could understand that the ground of opposition was based on an allegation that traders other than the Applicant have used the word "clarity" in association with their wares or services. In other words, the Applicant could understand that the pleading is not restricted to an allegation that the Mark is not distinctive due to the use of the trade-marks and trade-names specifically identified in the statement of opposition.

[37] The Opponent submits that the evidence introduced by Ms. Carnegie is more than sufficient to discharge its burden of evidencing that the Mark is incapable of distinguishing the Applicant's Services from those of others because the word "clarity" as of October 12, 2010 was generally used by traders in association with similar services. I disagree for the reasons that follow.

[38] The reliability of Internet evidence was discussed by Justice Tremblay-Lamer in *ITV Technologies, Inc v WIC Television Ltd* (2003), 29 CPR (4th) 182 at 192 (FCTD) as follows:

[16] With regard to the reliability of the Internet, I accept that in general, official Web sites, which are developed and maintained by the organization itself, will provide more reliable information than unofficial Web sites, which contain

information about the organization but which are maintained by private persons or businesses.

[17] In my opinion, official Web sites of well-known organizations can provide reliable information that would be admissible as evidence, the same way the Court can rely on Carswell or C.C.C. for the publication of Court decisions without asking for a certified copy of what is published by the editor. For example, it is evident that the official web site of the Supreme Court of Canada will provide an accurate version of the decisions of the Court.

The Court did not provide much further guidance about what constitutes an “official website”.

[39] In the present case, while I am satisfied that the websites referenced in the affidavit of Ms. Carnegie existed at the time she accessed them, very little information was provided to establish that the websites were official websites or that they contain reliable information. Even if there may be no reasons to doubt the reliability of the content of the websites accessed by Ms. Carnegie, there is no evidence that the information on these websites has been brought to the attention of any consumers in the marketplace in Canada at the relevant date. Though it is apparent that some of the websites emanate from, relate to, or could be accessed from Canada, the fact remains that it cannot be concluded on the extent to which the information contained in these websites has become known to Canadians.

[40] For all intents and purposes, I note that the Applicant rightly pointed out that it appears that none of the exhibits to the affidavit of Ms. Carnegie references the words “clarity” and “defined” in combination. Hearsay deficiencies aside, even if I was to infer from Ms. Carnegie’s affidavit as a whole that the term “clarity” was commonly used by third parties in fields related to that of the Applicant as of October 12, 2010 this would not be sufficient to negate the distinctiveness of the Mark. Rather, I would agree with the Applicant that the only reasonable conclusion would be that as of October 12, 2010 consumers were accustomed to distinguishing among competing marks or business names that share the word “clarity”. Thus, the differences between the Mark and the third party CLARITY trade-marks or business names would be sufficient to preclude a likelihood of confusion.

[41] Having regard to the foregoing, I dismiss the non-distinctiveness ground of opposition.

Registrability Pursuant to Section 12(1)(d) of the Act

[42] Having exercised the Registrar's discretion, I confirm that all of the registrations alleged in the statement of opposition are extant. Since the Opponent's initial burden under section 12(1)(d) of the Act has been met, the Applicant has the legal onus to show that, as of today's date, the Mark is not reasonably likely to cause confusion with any of the alleged registered trade-marks.

[43] Here also the Opponent did not expand on the ground of opposition in its written argument, but did so at the oral hearing. The Opponent started its submissions by referencing the mark CLARITY FOR WOMEN of application No. 1,108,749, stating that it had proceeded to registration. Aside from the fact that Exhibit E to the Giugno affidavit shows that application No. 1,108,749 was abandoned on May 14, 2003, I indicated to the Opponent that it did not allege any registration for the mark CLARITY FOR WOMEN in support of the ground of opposition; if the Opponent intended to rely upon other registrations than those pleaded at paragraph 8 of the statement of opposition, it should have filed an amended statement of opposition with leave of the Registrar.

[44] In the end, the Opponent acknowledged that the registrability ground of opposition is restricted to the registered trade-marks pleaded in the statement of opposition; the Opponent went on to focus its submissions on the likelihood of confusion between the Mark and the trade-marks CLARITY THROUGH DIALOGUE (TMA555,288) and CLARITY AND COMMITMENT (TMA656,967). In fact, the Opponent did not make any submissions on the likelihood of confusion between the Mark and the mark THERE'S A LOT TO BE SAID FOR CLARITY (TMA582,428) or between the Mark and the Cantonese and Mandarin versions for the mark THERE'S A LOT TO BE SAID FOR CLARITY (TMA582,145 and TMA582,146), shown below:

TMA582,145

有明白至有信任

(Cantonese)

TMA582,146

有明白才有信任

(Mandarin)

[45] The Opponent also did not make any submissions on the likelihood of confusion between the Mark and the marks CLARICA/CHINESE CHARACTERS & Design (TMA552,966) and CLARICA/CHINESE CHARACTERS & Design (No. 2) (TMA552,975), shown below (collectively the CLARICA marks):

TMA552,966



TMA552,975



[46] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[47] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion.]

[48] In *Masterpiece, supra*, the Supreme Court of Canada discussed the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion at paragraph 49:

[...] the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that

even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start [...].

[49] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totality; it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks.

[50] In my opinion, it can fairly be concluded that there is no degree of resemblance whatsoever between the Mark and the Cantonese and Mandarin versions for the mark THERE'S A LOT TO BE SAID FOR CLARITY. It can also fairly be concluded that there is no degree of resemblance between the Mark and the CLARICA marks. Thus, I deem it not necessary to consider the sections 6(5)(a) through (d) factors to find that the Applicant has discharged its legal onus to show that confusion between the Mark and each of the trade-marks of registration Nos. TMA582,145, TMA582,146, TMA552,966 and TMA552,975 is not likely.

[51] Insofar as the remaining alleged registrations are concerned, I deem it not necessary to discuss the likelihood of confusion between the Mark and the trade-mark THERE'S A LOT TO BE SAID FOR CLARITY (TMA582,428) at length. For one thing, the Opponent chose to focus its submissions on the likelihood of confusion between the Mark and the trade-marks CLARITY THROUGH DIALOGUE (TMA555,288) and CLARITY AND COMMITMENT (TMA656,967). In addition, given the evidence of record, in my view comparing the Mark and the trade-marks CLARITY THROUGH DIALOGUE and CLARITY AND COMMITMENT will effectively decide the ground of opposition based upon the trade-mark THERE'S A LOT TO BE SAID FOR CLARITY. In other words, if confusion is not likely between the Mark and the mark CLARITY THROUGH DIALOGUE or the mark CLARITY AND COMMITMENT, then it would not be likely between the Mark and the mark THERE'S A LOT TO BE SAID FOR CLARITY.

[52] The trade-marks CLARITY THROUGH DIALOGUE and CLARITY AND COMMITMENT are owned by distinct entities and registered in association with the following wares or services:

- CLARITY THROUGH DIALOGUE (TMA555,288), owned by Sun Life Assurance Company of Canada, is registered in association with “printed publications, namely newsletters and brochures dealing with financial matters; electronic magazine” and “financial services, namely insurance services including life insurance, health insurance, annuities, and reinsurance; tax sheltered plans, pension plans, retirement savings plans, RRSP's, registered education savings plans, employee benefit plans, employee benefit plan administration, pension plan administration, disability consulting, savings plans, segregated funds, mutual funds, investment funds, securities brokerage, financial counselling, estate planning, investment counselling, trust company services, fiduciary services, investment certificates, property management services, mortgage lending, mortgage origination, mortgage servicing, consumer and corporate lending, equipment leasing, namely, lease financing services for equipment, computerized data processing, electronic communication of financial transactions, insurance and financial sales support services”.
- CLARITY AND COMMITMENT (TMA656,967), owned by Keith M.J. Anderson Professional Corporation, is registered in association with for the trade-marks for “financial services namely financial accounting, income tax, information technology, business management, financial statement preparation, income tax preparation, financial planning, income tax planning, financial audit engagements, financial review engagements, corporate tax reorganizations, financial projections, business valuations, business plan preparation”.

[53] I will now consider the section 6(5) factors by referring to the trade-marks CLARITY THROUGH DIALOGUE and CLARITY AND COMMITMENT collectively as the Cited Marks and distinguish them where I consider it necessary to do so.

[54] Though the Mark and the Cited Marks are composed of dictionary words, each possesses some measure of inherent distinctiveness in the context of the services at issue. Further, I assess their inherent distinctiveness as about the same. While the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, there is no evidence directed to the use or promotion of the Mark and of the Cited Marks in Canada. Also, the mere existence of the registrations for the Cited Marks can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of the Cited Marks [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Accordingly the section 6(5)(a) factor, which involves a combination of the inherent and acquired distinctiveness of the marks, does not favour either party.

[55] The Mark has been applied for registration on the basis of proposed use. Registration No. TMA555,288 shows that a declaration of use of the mark CLARITY THROUGH DIALOGUE was filed on November 29, 2001 and registration No. TMA656,967 claims use of the mark CLARITY AND COMMITMENT since October 1, 2003. Even if one accepts that the Cited Marks have been used in Canada as stated in the registrations, there is no evidence directed to their use, which as a result is assumed to be only *de minimis*. Accordingly I find that the section 6(5)(b) factor is of no significance in this case.

[56] It is the statement of services in the application for the Mark and the statement of wares and services in the alleged registrations that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[57] To the extent that the Applicant submits at paragraph 47 of its written argument that “there is no relevant similarity in wares or channels of trade given the absence of evidence in that regard”, it seems to me that the Applicant does not debate the similarity, overlap or relationship between the Services and the registered services associated with the Cited Marks. Further, in the circumstances of this case, I disagree with the Applicant that the absence of evidence must lead to a conclusion that there is no similarity in the channels of trade. Since there is no evidence as to the nature of trade, given the similarity, overlap and relationship between the Services and the services associated with the Cited Marks, it seems reasonable to conclude that the channels of trade associated with the trade-marks could be identical or overlapping. Hence, the sections 6(5)(c) and (d) factors favour the Opponent.

[58] In the instant cases, the word CLARITY may be considered as the dominant first portion of each of the marks in issue. Ordinarily it is the first portion of a mark that is the most important for the purpose of distinguishing between marks when considering their degree of resemblance in appearance, sound and in the ideas suggested by them. However, the Supreme Court in *Masterpiece, supra*, advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para. 64]. I am not prepared to conclude that the word CLARITY is



particularly “striking” since it invokes the state or quality of being clear. I wish to add that the Opponent’s own submissions as to the evidentiary value of the affidavit of Ms. Carnegie would lend support to my view that the word “clarity” is not the most distinctive portion of the marks in the context of the services at issue. Of course, the last word of the Mark, i.e. “defined” bears no phonetic and visual resemblance to the last words of the Cited Marks, i.e. “dialogue” and “commitment”. Further, these words have distinct meanings and refer to different concepts and ideas.

[59] In my opinion, the differences between the Mark and each of the Cited Marks when considered as a whole are significant enough to outweigh any similarity owing to the term CLARITY and so the section 6(5)(e) factor favours the Applicant.

[60] While the Applicant’s submissions advance the coexistence of the Cited Marks on the register as a relevant additional surrounding circumstance, I deem it not necessary to address its submissions to find in the Applicant’s favour. Indeed, even though I conclude that the sections 6(5)(c) and (d) factors favour the Opponent, in the absence of any evidence directed to the use of the Cited Marks, I find that the differences between the Mark and each of the Cited Marks in appearance, sound and in the ideas suggested by them are significant enough to shift the balance of probabilities in favour of the Applicant.

[61] Having regard to the foregoing, I conclude that the Applicant has discharged its legal onus to show that confusion between the Mark and each of the Cited Marks (TMA555,288 and TMA656,967) is not likely. Further, I recall that I have previously indicated that comparing the Mark with the Cited Marks effectively decides the outcome of the ground of opposition based upon the mark THERE’S A LOT TO BE SAID FOR CLARITY (TMA582,428).

[62] Having regard to the foregoing, the section 12(1)(d) ground of opposition is dismissed in its entirety.

Disposition

[63] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office