



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

Citation: 2013 TMOB 61
Date of Decision: 2013-04-04

**IN THE MATTER OF AN OPPOSITION
by Ontario Teachers' Pension Plan Board
to application Nos. 1,333,782 and
1,333,783 for the trade-marks The
Retired Teachers of Ontario and Les
Enseignantes et Enseignants Retraités de
l'Ontario in the name of The Retired
Teachers of Ontario / Les Enseignantes et
Enseignants Retraités de l'Ontario**

[1] On January 26, 2007, The Retired Teachers of Ontario / Les Enseignantes et Enseignants Retraités de l'Ontario (the Applicant) filed applications to register the trade-marks The Retired Teachers of Ontario (1,333,782) and Les Enseignantes et Enseignants Retraités de l'Ontario (1,333,783) (the Marks) based on use in Canada since May 1998 for the following wares and services (the Wares and Services):

Wares:

Clocks; casual clothing, namely shirts, sweatshirts, sweaters, polo shirts, t-shirts, sweatpants, wind-breakers, jackets, ties, scarves; head gear, namely visors, baseball caps, hats; drinking and eating wares, namely mugs, drinking glasses, shot glasses, teacups, saucers, plates; bags, namely tote bags, computer bags, briefcases, backpacks, executive bags, travel bags; umbrellas; jewellery; playing cards; statues; writing instruments.

Services:

(1) Association services in connection with promoting the interests of retired teachers, education administrators and others receiving pensions or allowances under the Teachers' Pension Act, namely: advocating on important issues to retired teachers, such as Canada Pension Plan, Teachers' Pension Plan, government health services and government legislation in connection with the same; monitoring pension legislation and commenting

on and recommending improvements to proposed changes to said legislation; supporting and advocating for active teachers and public education; dissemination of information of specific interest to retired teachers in Ontario via pamphlets and a website; dissemination [*sic*] of a quarterly magazine containing information and updates on areas of interest to retired teachers; conducting workshops and providing information on retirement issues and other issues of interest for retired teachers in Ontario; coordination of travel services for members, namely liaising with travel agency service to coordinate vacations and travel of interest to members.

(2) Insurance services, namely: management and provision of health, dental, hospital, long term care, life, accident, home and automobile insurance plans for members; consulting with independent consultants, the insurance plan administrator and the insurance plan underwriter to ensure responsive and quality insurance benefits; adjudication of complaints of aggrieved insurance plan members.

[2] The Applicant claimed the benefit of section 12(2) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and seeks that the registrations for the Marks be restricted to the Province of Ontario.

[3] The right to the exclusive use of the words RETIRED, TEACHERS, and ONTARIO is disclaimed apart from the trade-mark subject to application No. 1,333,782 and the words ENSEIGNANTES, ENSEIGNANTS, ONTARIO and RETRAITÉS apart from the trade-mark subject to application No. 1,333,783.

[4] The applications were advertised for opposition purposes in the *Trade-marks Journal* of October 8, 2008.

[5] On March 9, 2009, Ontario Teachers' Pension Plan Board (the Opponent) filed a statement of opposition against each application. The Opponent was granted leave on July 18, 2011 to file an amended statement of opposition dated May 11, 2011 in both files. The grounds of opposition are essentially identical with respect to each application and they can be summarized as follows:

- pursuant to sections 38(2)(c) and 16(1)(a), (b) and (c) of the Act, the Applicant is not entitled to registration of the Marks based on confusion with the Opponent, and its predecessor-in-title's trade-names (Ontario Teachers' Pension Plan Board and Ontario Teachers' Plan) as well as the trade-mark TEACHERS' which is subject to application No. 1,144,430 (the Teachers' Mark) which have been previously used by the Opponent and its predecessor-in-title;

- pursuant to sections 38(2)(a) and 30(i), at the date of application for the Marks, the Applicant was well aware of the Opponent's trade-name rights and the Teachers' Mark and therefore the Applicant could not have been satisfied under section 30(i) of the Act, of its entitlement to use the Marks;
- pursuant to sections 38(2)(a) and 30(b), the Applicant has not used the Marks in association with the Wares and Services in accordance with section 30(b) of the Act as of the date of alleged first use, or at any time;
- pursuant to sections 38(2)(d) and 2, the Marks are not distinctive and are not capable of being distinctive of the Wares and Services.

[6] In each case, the Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof. The Applicant also claimed the benefit of section 12(2) of the Act in its counter statements.

[7] In support of its oppositions, the Opponent filed the affidavit of Marlye Monfiston, a trade-mark agent employed by the Opponent's agent.

[8] The Applicant filed the affidavit of Simon Leibovitz, the Director of Administrative and Member Services for the Applicant. Mr. Leibovitz was cross-examined and the transcript and responses to undertakings were filed and form part of the record.

[9] Both parties filed written arguments and an oral hearing was held at which both parties were represented.

Onus and Material Dates

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

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

Conference Management Co v Canadian Exhibition Management Inc (1990), 28 CPR (3d) 428 at 432 (TMOB)].

- sections 38(2)(c)/16(1) - the claimed date of first use [see section 16(1) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 30 Grounds of Opposition

Non-compliance with section 30(b) of the Act

[12] The initial burden on the Opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. Section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing the application [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[13] The Opponent may rely on the Applicant's evidence and the cross-examination of the Applicant's affiant to meet its initial burden in relation to this ground [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD); *York Barbell Holdings Ltd v ICON Health and Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB); *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230; *Coca-Cola Ltd v Compagnie Francaise de Commerce International Cofci, SA* (1991), 35 CPR (3d) 406 (TMOB); *Credit Union Central of Canada v Community Credit Union Ltd* (2005), 48 CPR (4th) 226 (TMOB)].

[14] The Applicant submits that where an opponent relies on the applicant's evidence in order to meet its evidential burden, it must establish that the evidence is "clearly inconsistent" with the applicant's claims as set forth in its application [see *Ivy Lea Shirt Co v I227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), *aff'd* 11 CPR (4th) 489 (FCTD)].

[15] At the oral hearing, the Opponent submitted that it need not establish that the evidence was clearly inconsistent with the claimed use date; rather it would be sufficient to identify

contradictions and inconsistencies in the evidence [see *Credit Union, supra* and *Muscle Tech Research & Development Inc v Petrillo* (2008), 70 CPR (4th) 385 (TMOB)]. The Opponent submitted that in the present case, where the Applicant's affiant has been cross-examined, and where the cross-examination had as its purpose to address the accuracy of the claimed use date, the Opponent need not meet the higher standard of "clearly inconsistent" in order to meet its evidential burden.

[16] The Opponent submits that it appears that the Applicant selected a date of first use on the basis that on May 27, 1998 the Applicant passed a resolution to adopt a new corporate name comprised of the Marks, namely The Retired Teachers of Ontario / Les Enseignantes et Enseignants Retraités de l'Ontario. The evidence shows that the Applicant did not adopt its new name until July 1, 1998 (see Leibovitz affidavit paragraph 2 and Exhibit A).

[17] The Opponent submits that the Applicant would have been prohibited from using the new name until the business name registration was completed (which occurred on July 1, 1998) pursuant to section 2(1) of the *Business Names Act*, RSO 1990, c B-17. The Applicant submits that, as a not-for-profit organization, it is not required to comply with the *Business Names Act* as it is not considered a "business" as defined therein [see *Business Names Act*, section 1]. I note that in response to an undertaking given on cross-examination the Applicant specified that it is a "non-share capital corporation incorporated pursuant to the *Ontario Corporations Act, Part 2*".

[18] At paragraph 5 of his affidavit, Mr. Leibovitz makes a bald assertion that the Applicant has used the Marks in Canada since at least as early as May 1998. At the oral hearing, the Applicant submitted that Mr. Leibovitz's statement regarding use of the Marks since May 1998 was not a legal conclusion but rather a statement of fact. I do not agree; rather I am of the view that given the technical meaning of the word "use" in the context of trade-mark opposition proceedings Mr. Leibovitz's statement is necessarily a legal conclusion regarding the issue of use of the Marks in accordance with section 4 of the Act.

[19] The Opponent then proceeded to review the evidence in order to identify the earliest documentary evidence which displays the Marks. The Applicant agreed that the specified documents were the earliest documents in the evidence of record displaying the Marks; however,

the Applicant did not agree that the evidence was clearly inconsistent with the claimed first use date. I will now summarize the Opponent's submissions regarding these documents.

[20] The Opponent identifies the earliest documentary evidence as being a copy of the June 1998 edition of the Applicant's publication *District Updater* (Exhibit D). The Opponent submits that the only display of the Marks in this document is the announcement on the first page "It's official – as of July 1st our organization's name is The Retired Teachers of Ontario / Les Enseignantes et enseignants retraités de l'Ontario (RTO/ERO)". The Opponent submits that this announcement is not trade-mark use in the meaning of section 4 of the Act; specifically it is not use as a source identifier or use in association with any particular wares or services. I agree. Furthermore, the Opponent submits that the words of the Marks do not stand out in any respect from the other words that comprise the name of the Applicant and as such they would not be perceived to be a trade-mark. I agree. Mr. Leibovitz states that this document was distributed to approximately 800 executive members of the Applicant's organization. The Opponent submits that as a result this is not a communication to the public that could be considered advertising. I agree. Finally, the Opponent submits that the Applicant's evidence shows that the June 1998 issue of *District Updater* was distributed on or after June 30, 1998 since it includes the statement "As of June 30, 1998, our membership count stands at 38,615 (regular and associate members" (page 4 of Exhibit D). I agree.

[21] Based on the foregoing, I agree with the Opponent that the June 1998 issue of *District Updater* is contradictory with the claimed first use date of May 1998.

[22] The Opponent submits that the next earliest documentary evidence filed by the Applicant that features the words making up the Marks is a copy of the June 1999 issue of a publication entitled *RTO/ERO Newsletter* (Exhibit E). The words of the Marks appear two times in the publication – (1) the masthead on page 2 includes the statement that the newsletter is "published regularly by The Retired Teachers of Ontario / Les Enseignantes et enseignants retraités de l'Ontario" and (2) an advertisement on page 15 for RTO/ERO promotional items. The Opponent submits that in the first instance the words are being used as part of a trade-name and do not in any way stand out from the rest of the corporate name. I agree. In the second instance the words are displayed as part of an advertisement for wares. The Opponent submits that display of the

Marks in advertising does not constitute use in association with the Wares. I agree. I note as well that the images of the promotional items in the advertisement are so small that it is not possible to see whether or not the Marks appear on these items. Furthermore, on cross-examination Mr. Leibovitz admitted that several of these promotional items do not display the Marks (Q54-55). The Opponent submits that the display of the Marks in this publication do not constitute use in accordance with section 4 of the Act. I agree. Finally, the Opponent submits that even if any of these instances were sufficient to qualify as use of the Marks in accordance with section 4 of the Act, any such use would be more than a year after the claimed date of first use. I agree.

[23] The Opponent submits that the Applicant has failed to explain the discrepancy between the claimed date of first use and the earliest evidence of display of the Marks in association with the wares and services. The Applicant's only explanation for this discrepancy is an admission made by Mr. Leibovitz during cross-examination that the Applicant does not retain documents for more than ten years. The Applicant submits that as a result, once the opposition was commenced the earliest documents it would have had access to would have been from March 1999. The Opponent submits that the Applicant was given notice of the potential for an opposition when the extension of time was requested prior to December 2008 and thus documentary evidence from the relevant period should have been available at that time.

[24] The Opponent submits that the Applicant's own evidence casts serious doubt on the accuracy of the claimed first use date such that the Opponent has succeeded in meeting its evidential burden. I agree. The Applicant is thus under an onus to establish continuous use of the Marks in association with the Wares and Services since the claimed date (May 1998) until the date of filing the applications (January 26, 2007).

[25] The Opponent submits that the Applicant has not shown that it has used the Mark with any of the Wares covered in the application at any time. Specifically, the Opponent points out that the Applicant has not filed any documentary evidence of the sale of those wares. Furthermore, the Opponent submits that on cross-examination Mr. Leibovitz admitted that there was no evidence of any such sales that would constitute use in accordance with section 4 of the Act (cross-examination Q121-146). On cross-examination, Mr. Leibovitz admitted that the two invoices from a supplier to the Applicant dated May 11 and 17, 2000 (Exhibits X and Y) are the

only evidence regarding sales of promotional items (Q116-119). Based on the foregoing, I find that the Applicant has failed to provide evidence that there was any transfer of the property in or possession of the Wares in the normal course of trade at the claimed date of first use.

[26] With respect to the Services, the Opponent submits that none of the evidence shows that the Marks were displayed in the performance or advertising of any services before July 1999 at the earliest. The Opponent also pointed to various admissions made by Mr. Leibovitz on cross-examination regarding the lack of evidence of use of the Marks in association with various services at the material date, as follows:

- the Applicant filed no evidence showing advertising or promotion of the services “supporting and advocating for active teachers and public education” (Q156);
- the Applicant did not advertise in external magazines until approximately 2000 (Q61);
- Mr. Leibovitz was not aware of invoices or other documentation evidencing sales of the Wares and Services (Q121-146);
- the Applicant has filed no evidence showing advertising/promotion of the Services “supporting and advocating for public education” (Q156);
- the Applicant did not offer the services “conducting workshops and providing information on retirement issues and other issues of interest for retired teachers in Ontario” until 2002 (Q163-166).

[27] In support of its applications, the Applicant relied on the audited financial statement of December 31, 1998 which includes advertising expenditures for the year 1998 (Exhibit R) and which it submitted supports a finding that the Wares and Services were being advertised in 1998. The documents feature expenses for “newsletters” and “promotional items”. While I am satisfied that this suggests that the Applicant was promoting its Wares and Services during the year 1998, I am not satisfied that the audited financial statements are sufficient to support a finding that the Marks were in use in association with these Wares and Services at the claimed date of first use.

[28] Based on the foregoing, I find that the Applicant has failed to satisfy its legal onus of establishing continuous use of the Marks from the claimed date of first use (May 1998) to the date of filing of the application for the Marks (January 26, 2007). As a result, the ground of opposition based on section 30(b) of the Act is successful.

Non-compliance with section 30(i) of the Act

[29] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

Non-entitlement Ground of Opposition

Sections 16(1)(a) and (c) of the Act

[30] The Opponent has not filed any evidence showing use of its TEACHERS' Mark or its trade-names, Ontario Teachers' Pension Plan Board and Ontario Teachers' Plan, at any time. Based on the foregoing, the Opponent has failed to meet its evidential burden under section 16(1)(a) and (c) of the Act and these grounds of opposition are dismissed accordingly.

Section 16(1)(b) of the Act

[31] In light of the success of the section 30(b) ground of opposition, the relevant date for this ground of opposition shifts from the claimed date of first use to the date of filing the application. Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's claimed TEACHERS' trade-mark, the Opponent has the initial onus of proving that the application for the trade-mark alleged in support of the section 16(1)(b) ground was pending at the filing date (January 26, 2007) and remained pending at the date of advertisement of the application for the Mark, October 8, 2008 [section 16(5) of the Act].

[32] The Opponent's application for the TEACHERS' mark was filed prior to the filing date and remained pending as of the date of advertisement for the Mark. As a result, the Opponent has met its evidential burden with respect to this ground of opposition.

[33] I note that the Opponent did not make any submissions in support of this ground of opposition.

[34] Recently, in *Masterpiece*, the Supreme Court of Canada discussed the importance of the section 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with section 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in section 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.

[35] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

[36] The only similarity between the parties' marks results from the inclusion of the word TEACHERS in application No. 1,333,782 and the French translation thereof (ENSEIGNANTES et ENSEIGNANTS) in application No. 1,333,783. The word TEACHERS is descriptive and completely lacking any inherent distinctiveness with respect to the parties' wares and services. Thus the inclusion of this non-distinctive word is not sufficient to create any significant similarity between the parties' marks.

[37] I am not satisfied that any of the remaining surrounding circumstances are significant enough to find a likelihood of confusion [see *Masterpiece, supra* at para 49].

[38] Based on the foregoing, I dismiss the ground of opposition based on section 16(1)(b) of the Act.

Non-distinctiveness Ground of Opposition – Section 38(2)(d) of the Act

[39] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares and Services from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[40] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing date of the statement of opposition, one or more of the TEACHERS' mark and the Opponent's trade-names had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[41] As the Opponent has failed to provide any evidence of use or reputation for the TEACHERS' Mark or for its trade-names, Ontario Teachers' Pension Plan Board and Ontario Teachers' Plan, the Opponent has failed to meet its evidential burden and this ground of opposition is dismissed.

Disposition

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

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office