



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

Citation: 2016 TMOB 175
Date of Decision: 2016-10-28

IN THE MATTER OF AN OPPOSITION

Credit Union Central of Canada **Opponent**

and

CCUEFINANCE Consulting Inc. **Applicant**

1,556,229 for A circle design & **Application**
CCUEFINANCE &
Chinese characters & design

[1] Credit Union Central of Canada opposes registration of the trade-mark A circle design & CCUEFINANCE & Chinese characters & design (the Mark), shown below, that is the subject of application No. 1,556,229 by CCUEFINANCE Consulting Inc.



[2] Filed on December 14, 2011, the subject application is based on use of the Mark in Canada in association with “Financial services, namely financial planning services, wealth management services, securities broker and dealer services; investment advisory services; investment management services; financial investment services, namely investing funds for others; insurance brokerage services; Mortgage brokerage services; tax services, namely tax planning services, tax advice services, tax return preparation services; educational services,

namely workshops, seminars and conferences in the fields of investment, finance, business, financial planning, portfolio management, money management, retirement planning, mortgage, investment strategy and asset allocation” since June 2011.

[3] The subject application contains the following colour claim: “Colour is claimed as a feature of the trade-mark. The colour gold (PANTONE 126C)* is claimed as a feature of the mark. The colour gold (PANTONE 126C)* appears as the circle design. The colour dark blue (PANTONE 7463 PC)* is claimed as a feature of the mark. The colour dark blue (PANTONE 7463 PC)* appears as the letters “CCUEFINANCE”. The colour black is claimed as a feature of the mark. The eight Chinese characters of the mark includes the colour black. *PANTONE is a registered trade-mark.”

[4] The subject application also contains the following description of the foreign characters: “The translation provided by the applicant of the words when read from left to right, the eight Chinese characters transliterate and translate into English as follows: (1) the first and second Chinese characters transliterate from Cantonese phonetic expression as SI SI respectively, from Chinese phonetic expression or PIN YIN as SHI SHI respectively, and translate into English as EVERYTHING; (2) the third and fourth Chinese characters transliterate from Cantonese phonetic expression as YU YI respectively, from Chinese phonetic expression or Pin Yin as RU YI respectively, and translate into English as AS WISH; (3) the fifth and sixth Chinese characters transliterate from Cantonese phonetic expression as KAM YUNG respectively, from Chinese phonetic expression or PIN YIN as JIN RONG respectively, and translate into English as FINANCE; (4) the seventh and eighth Chinese characters transliterate from Cantonese phonetic expression as TAU JI respectively, from Chinese phonetic expression or PIN YIN as TOU ZI respectively, and translate into English as INVESTMENT.”

[5] The Opponent alleges that: (i) the application does not conform to several of the requirements set out in section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act; and (iv) the trade-mark is not distinctive under section 2 of the Act.

[6] For the reasons that follow, I reject the opposition.

The Record

[7] The Opponent filed its statement of opposition on February 8, 2013. The Applicant filed and served its counter statement on May 3, 2013 denying all of the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Sandra Bayley, Manager, Trade-marks & Intellectual Property, of the Opponent, and the affidavit of Jane Buckingham, a trade-mark searcher employed by the Opponent's agent. In support of its application, the Applicant filed the affidavit of Haiying Zhang, the sole shareholder and director of the Applicant. The Opponent further filed the second affidavit of Sandra Bayley as its reply evidence. Only Ms. Zhang was cross-examined; the transcript of her cross-examination, along with her replies to undertakings, has been made of record.

[9] Both parties filed a written argument. Neither party requested a hearing.

The Parties' Respective Burden or Onus

[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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[11] I will now consider each of the grounds of opposition, though not necessarily in the order in which they appear in the statement of opposition.

Is the Mark Confusing with any of the Opponent's CU Registered Marks?

[12] The Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act on the ground that it is confusing with the Opponent's registered trade-marks, including certification marks, that begin with, or incorporate, the letters CU. All the trade-mark applications and registrations alleged by the Opponent in its statement of opposition are identified in Schedule "A" to this decision while those pertaining to its certification mark registrations are identified in Schedule "B" to this decision. I note that all of the cited registered

marks begin with the letters CU. For the purpose of the discussion below, references to the Opponent's registered trade-marks include its certification marks.

[13] The material date for considering this issue is 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)].

[14] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration(s) relied upon is(are) in good standing. In this regard, the Registrar has the discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised the Registrar's discretion, I confirm that with the exception of the trade-mark CUCORP & Design of registration No. TMA493,921 which was expunged on December 12, 2013, all the remaining registered trade-marks set out in the statement of opposition are in good standing (CU Registered Marks). I further note that all the CU Registered Marks have been assigned to Canadian Credit Union Association Cooperative as of December 1, 2015. For the purpose of this decision, nothing turns on this assignment.

[15] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's CU Registered Marks.

[16] For the reasons that follow, I reject this ground of opposition.

[17] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[18] In applying the test for confusion, the Registrar 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 each has been in use; (c) the nature of the goods, 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].

[19] I will now turn to the assessment of the section 6(5) factors.

Section 6(5)(a) - the inherent distinctiveness of the trade-marks and the extent to which they have become known

[20] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks.

[21] When considered in its entirety, I find the Mark to possess a fair degree of inherent distinctiveness. In this regard, although letters of the alphabet with no particular meaning are inherently weak and words such as "finance" and "investment" in English and in Chinese may be descriptive or suggestive of the applied for financial services, I find that the fanciful geometric design along with the expression "Everything As Wish" in Chinese contribute to the inherent distinctiveness of the Mark.

[22] In contrast, the Opponent's CU Registered Marks consist of the letters CU followed by other letters of the alphabet (eg. CUDA, CUETS, CUIC, CUIS, CUPS) or by a term that is descriptive or suggestive of the Opponent's services associated with that mark (eg. CUCREDIT for the provision of a credit union credit card service bureau, CUBOND for credit union services related to term deposit investments and CU-XCHANGE for credit union services and an interactive exchange program). As such, I find that the Opponent's CU Registered Marks possess a relatively lower degree of inherent distinctiveness than that of the Mark.

[23] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. Both parties filed evidence of promotion and use of their respective trade-marks. I shall begin with the review of the Opponent's evidence.

Use of the CU Marks by the Opponent

[24] According to Ms. Bayley, the Opponent is the national trade association of the Canadian credit union system, whose membership at the end of 2012 comprised of 348 credit unions in nine provinces, and six regional Centrals whose roles are to monitor and maintain system liquidity at the provincial level. The Opponent represents credit unions with 1,762 locations across Canada, with over 5.3 million retail customers (or members), \$152.5 billion in assets, \$134.6 billion in deposits, \$127 billion in loans, and 27,600 employees. Ms. Bayley states that the Opponent has been managing trade-marks on behalf of the regionals Centrals and the credit unions since the mid-1980s in that it registers trade-marks for use within the credit union system in Canada, licenses them to users, exercises control over the character and quality of the associated goods and services, and provides guidance regarding proper trade-mark usage.

[25] In terms of use of the Opponent's trade-marks, Ms. Bayley provides a list of the Opponent's 64 registered and common law trade-marks that begin with, or incorporate, the letters CU (CU Marks) [Exhibit 2]; as well as a list of licensees and effective dates of licenses that govern the use of various trade-marks and provide for control by the Opponent over the character and quality of the goods/services associated with the respective trade-marks [Exhibit 3]. Copies of representative licensing agreements with various credit unions are also attached [Exhibits 30, 47, 54, 61, 73 and 77].

[26] As evidence of the Opponent's use of the CU Marks, attached to Ms. Bayley's affidavit as Exhibits 4 to 113 are examples of advertising, promotional, and informational material dated from at least as early as 1995 to 2013 displaying one or more of the Opponent's CU Marks including annual reports, publications called *Financial Highlights*, publications called *Reports to Stakeholders* prepared by the Opponent's wholly owned subsidiary CUSOURCE Credit Union Knowledge Network, press releases, newsletters, website printouts, advertisements, brochures, pamphlets, and others. Sample use shown in the exhibits attached to Ms. Bayley's affidavit include the following CU Registered Marks set out in the statement of opposition: CUSOURCE

(TMA650,543), CUDA (TMA616,639), CUIC (TMA614,942), CUPS (TMA696,906), CUETS (TMA541,660), CU@WORK (TMA845,525), CU@HOME (TMA591,042), CUBOND (TMA570,442), CUBILL (TMA557,248), CUSAVE (TMA689,514), CUINCLUSIVE (TMA615,272), CU STEP (TMA644,578), CU BONUS BUILDER (TMA569,232), CU BONUS BUILDER & Design (TMA569,469), CUCREDIT (TMA549,563), CU CREDIT (TMA556,563), CU TAKEN TEN (TMA557,454), CUSALES (TMA718,619), CUIS (TMA549,587), CUIS & Design (TMA549,588), CU LINE (TMA706,393), CULINE (TMA638,033), CU NET (TMA696,316), CU BY PHONE (TMA577,385), CU BY PHONE & Design (TMA577,824), CU FLEX Design (TMA447,813) and CUE (TMA336,301).

[27] I note that Ms. Bayley's affidavit lacks particulars regarding the extent to which many of the Opponent's CU Registered Marks have been used in Canada. For example, with respect to the Opponent's trade-mark CUE (TMA336,301), while Ms. Bayley states that the mark has been in use in Canada with, *inter alia*, the operation of a credit union and the provision of financial services since as early as 1985, the only documentary evidence in support of such statement is a copy of a letter sent by a third party identified as "CUE DATAWEST LTD" to the Opponent in 1986 referencing unspecified licenses issued to credit unions [Exhibit 112] and a printout dated August 26, 2013 extracted from the website of the Greater Vancouver Community Credit Union mentioning "ATM transactions at any CUE/Exchange machine" [Exhibit 113]. There is no information regarding the extent to which the webpage has been accessed by consumers in Canada; there are no advertising figures associated with the trade-mark CUE; and there are no sales or revenue figures connected to the services associated with the trade-mark CUE. With such limited information, I am unable to determine the extent to which many of the Opponent's CU Registered Marks have become known in association with their respective goods and/or services.

[28] Nevertheless, Ms. Bayley does provide some details regarding the extent to which several of the Opponent's CU Marks have been used throughout the years. Notably:

- in 2012, the net sales of CUSOURCE learning, training and development services were in excess of \$2.9 million;
- by 2007, CUPS payment services were processing in excess of 150 million payment transactions annually;

- the annual revenue of CU Electronic Transaction Services (CUETS) which provides a broad range of electronic payment services was 140 million in 2004;
- ACCULINK enables five million credit union members to withdraw funds, make deposits, transfer balances and make account inquiries at more than 1,800 credit union ATMs at almost 400 credit unions across Canada;
- the total investment portfolio for CUBILL for term deposits, savings plans and RRSP plans for Education Credit Union Limited, a licensee, was over \$34 million as of June 2013;
- the value of deposit in CUSAVE accounts at the Biggar and District Credit Union, a licensee, was approximately \$37.5 million as of May 2013; and
- the value of CU FLEX mortgages with Affinity Credit Union, a licensee, was over \$760 million as of December 2012.

[29] Finally, according to Ms. Bayley, other credit union and financial services that have been provided by the Opponent or its licensees under the trade-marks that begin with, or incorporate, the letters CU, include grassroots advocacy programs, educational and training programs, inter-credit union transactions, credit card services, interactive financial services by way of Internet and Intranet, electronic fund transfer services, point-of-sale payment services, consolidation of financial accounts, automated funds transfers, payroll preparation services, mortgage and investment services, loan services, line of credit services, online system to bid on and purchase products, insurance services, financial investment, management and planning services, provision of business development services including training, consulting, advisory services to credit unions and other financial cooperatives, provision of financial information via Internet, and information database for credit unions.

Use of the Mark by the Applicant

[30] According to Ms. Zhang, the Applicant has been providing customers with various consultation services in the fields of insurance, mortgage, mutual funds, tax, RRSP, RESP and TFSA. Ms. Zhang further states that the Applicant has been regularly conducting seminars and presentations in this regard, and that its main targeted customers are Chinese.

[31] In terms of use of the Mark, Ms. Zhang states that the Applicant has been using the Mark since June 2011. Attached as Exhibit A to Ms. Zhang's affidavit is a single page printout extracted from the Applicant's website on December 17, 2013 at *ccuefinance.com*. I note that the Mark appears at the top left corner of the printout. The webpage is set out almost entirely in Chinese. During her cross-examination, Ms. Zhang explained that the printout discusses mortgage, insurance, mutual fund and tax knowledge [answers to Qs 88 to 90 of the Zhang cross-examination]. Also attached as Exhibit A are copies of pamphlets distributed by the Applicant to its customers since 2012 [answers to Qs 93 and 94 of the Zhang cross-examination]. The Mark appears prominently in these pamphlets that are set out almost entirely in Chinese, with the terms "Insurance", "Mortgage", "Mutual Fund" and "Tax" in English at the top right corner of each page. Other English references in the pamphlets include "RESP", "Registered Education Savings Plans", "Canada Education Savings Grant", "Canada Learning Bond", "RRSP", "TFSA", and the name of various funds in English.

[32] During her cross-examination, Ms. Zhang explained that 90 to 99 percent of the Applicant's clients are Chinese and that the Applicant communicates with them in Chinese, though many also speak English [answers to Qs 85 to 87 and Qs 97 to 99 of the Zhang cross-examination]. Ms. Zhang further stated that the Applicant's revenue for 2013 was between \$100,000 and \$150,000, and less for each of 2012, 2011, 2010 and 2009 [answers to Qs 114 to 125 of the Zhang cross-examination].

Conclusion

[33] When the evidence is viewed in its entirety, while Ms. Bayley's affidavit lacks particulars regarding the extent to which many of the Opponent's CU Registered Marks have been used in Canada, taking into account the sample use of each party's trade-marks, the length of time of such use, as well as the revenues associated, I am satisfied that at least some of the Opponent's CU Registered Marks, including CUSOURCE, CUPS, CUETS, CUBILL, CUSAVE and CU FLEX, have become known in Canada in association with a variety of financial and credit union services to a much greater extent than that of the Mark used in association with financial services.

[34] In assessing the 6(5)(a) factor, the Federal Court explained in *London Drugs Limited v International Clothiers Inc* 2014 FC 223 that “the inherent distinctiveness of a mark must be considered and cannot be ignored in the analysis of the likelihood of confusion even in those cases where an originally weak mark has subsequently acquired a significant reputation” [para 53].

[35] In the present case, I am of the view that the section 6(5)(a) factor favours the Applicant to the extent that it involves the inherent distinctiveness of the Mark, but favours the Opponent to the extent that it involves the acquired distinctiveness of some of the CU Registered Marks.

Section 6(5)(b) - the length of time the trade-marks have been in use

[36] The length of time that each mark has been in use favours the Opponent as the Opponent has shown evidence of use of many of its trade-marks that predates that of the Mark.

Sections 6(5)(c) and (d) - the nature of the goods, services, trade and business

[37] Sections 6(5)(c) and (d) factors involve the nature of the goods, services, trade and business.

[38] When considering sections 6(5)(c) and (d) of the Act, it is the statements of goods and services as defined in the application for the Mark and in the Opponent’s 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)]. Even so, the statements of goods and/or services must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful [see *McDonald’s Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[39] The parties’ goods and services belong to the general category of financial and related services.

[40] In *Cheung Kong (Holdings) Limited v Living Realty Inc* (1999), 4 CPR (4th) 71 (FCTD), the Court found that there was confusion between a mark made up of Chinese characters and one that was the English equivalent thereof. In order to determine whether a mark is likely to cause confusion, Justice Evans reasoned that the question should be asked in respect of the particular market in which the goods are offered, which would make up the appropriate average consumer. In the present case, the evidence suggests that the market consists of consumers who would understand English, Chinese or both.

[41] With respect to the Applicant's business, as per my review of Ms. Zhang's affidavit and the transcript of her cross-examination, the Applicant has produced evidence to the effect that the Chinese community is its targeted clientele and that its documentation is predominantly written in Chinese. Even so, attached as Exhibit O to Ms. Bayley's second affidavit, produced by the Opponent as its reply evidence, are printouts extracted from the Applicant's website at *ccuefinance.com*. The Mark appears at the top left corner of the printouts and information about mortgage, insurance, investment banking and tax accounting, is shown in these webpages in English. Moreover, Ms. Bayley's second affidavit also includes documents from Canadian credit unions who are part of the Opponent's overall organization that offer their services in languages other than English, including Chinese [Exhibits A to N of Ms. Bayley's second affidavit].

[42] In view of the foregoing and considering that neither the Opponent's registrations nor the subject application contains any restriction on the parties' channels of trade, I am of the view that there is potential for overlap between the parties' channels of trade.

[43] In view of the foregoing, for the purpose of assessing confusion, I conclude that the 6(5)(c) and 6(5)(d) factors favour the Opponent.

Section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[44] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd.* (1980), 47 CPR (2) 145, affirmed (1982), 60 CPR (2d) 70 (FCA)].

[45] When considering the degree of resemblance, the trade-marks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks. It is nevertheless possible to focus on particular features of a mark that may have a determinative influence on the public's perception of it [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)]. Moreover, while the first component of a trade-mark is often considered more important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)], the preferable approach when comparing trade-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].

[46] As the Opponent has pointed out in its written argument, the letters CU appear as the prefix in the Opponent's CU Marks, which I find to be the relatively more striking element of the Opponent's CU Registered Marks where the second component of the mark is either descriptive or suggestive of the Opponent's financial or credit union services. In those cases, the CU prefix is the more important element of the Opponent's marks for purposes of distinction. As I mentioned above under the 6(5)(a) analysis, there are also several CU Registered Marks which consist of a combination of letters, also commencing with the letters CU, with no apparent meaning (e.g. CUDA, CUETS, CUIC, CUIS). In those cases, there is not one aspect of the trade-mark that is particularly striking or unique. In any event, it is well established that letters *per se* lack inherent distinctiveness and are not entitled to a wide ambit of protection [see *GSW Ltd v Great West Steel Industries Ltd*, *supra*].

[47] In the case of the Mark, I am of the view that the fanciful geometric design is its most striking or unique component.

[48] When the parties' marks are viewed in their entirety, there are little similarities between the Opponent's CU Registered Marks and the Mark.

[49] In its written argument, the Opponent submits that the letters CU contained in the geometric design of the Mark are identical to the CU prefix found in the Opponent's CU Registered Marks. I will add that the letters CU can also be found in the term "CCUE" of the

Mark. If one were to dissect the marks into their respective components, I agree with the Opponent. However, this is not the proper test of confusion considering that the letters CU represent but one of the many elements of the geometric design, and of the Mark overall.

[50] In this regard, I do not consider the letters CU to be the most striking or unique component of the Mark. Moreover, I do not find there to be any resemblance between the overall geometric design of the Mark and any of the Opponent's trade-marks. There are also little to no similarities between the English and Chinese characters of the Mark and any of the Opponent's trade-marks. In the end, the overall appearance of the Opponent's CU Registered Marks is different from that of the Mark.

[51] In terms of sound, I am of the view that English component of the Mark would be sounded as "C-C-U-E finance". According to Ms. Zhang, the first four Chinese characters would be sounded as "Shi Shi Ru Yi" when read in the Mandarin Dialect of the Chinese language, and "Si Si Yu Yi" when read in the Cantonese Dialect of the Chinese language, in which case would be similar to the pronunciation of the letters "C-C-U-E".

[52] In its written argument, the Opponent submits that the average Canadian consumer would sound the letters CU of the Opponent's trade-marks as the letter "Q" rather than the letters "C-U". In my view, the average Canadian consumer could equally pronounce the CU component of the Opponent's trade-marks as the letters "C-U" and as the letter "Q". Either way, when the trade-marks are considered in their entirety, I find very little resemblance between the parties' marks when sounded.

[53] In terms of ideas suggested, I am mindful of the differences in the ideas suggested by the striking components of the parties' marks. In this regard, the Opponent submits in its written argument that the idea suggested by the CU prefix in the Opponent's marks is that the services are associated with credit unions. In comparison, there is no readily apparent meaning the geometric design of the Mark. Moreover, I do not find there to be any resemblance between the ideas suggested by the letters "CCUE" or the Chinese characters and the Opponent's trade-marks. To the extent that the average consumer of the parties' goods and services would understand Chinese, according to Ms. Zhang, the meaning of the four Chinese characters in the Mark is "Everything As Wish".

[54] When the marks are assessed in their totality, bearing in mind the particularly striking or unique feature of each party's marks rather than their individual components, as a matter of first impression and imperfect recollection, I consider the parties' marks to be sufficiently different visually, when sounded and in ideas suggested to outweigh any similarities of a particular component.

[55] Accordingly, this factor favours the Applicant.

Additional surrounding circumstances

Opponent's Family of CU Marks

[56] As an additional surrounding circumstance, I have considered the Opponent's family or series of marks. As discussed above, the Opponent has evidenced some use of many of its CU prefixed trade-marks in the marketplace, including CUSOURCE, CUBOND, CUSAVE, CUBILL, CULINE, CUCREDIT, CULEASE and CUSALES [see *McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)]. I am therefore satisfied that the Opponent has established the existence of a family of trade-marks that include the prefix CU for use in association with financial and related services.

Applicant's Survey Evidence

[57] Attached as Exhibit C to Ms. Zhang's affidavit are copies of 18 signed survey questionnaires conducted by the Applicant early 2013 regarding third parties' perception of the relationship between the Opponent and the Applicant, and their respective trade-marks. I note that the survey contains questions regarding the meaning of "CCUE" in the Mark, confusion with other CU trade-marks, and whether the Opponent and its trade-marks are "famous". In particular, in reference to a table in which a list of the Opponent's CU trade-marks are reproduced, the survey includes the question: "Will the mark 'CCUEFINANCE' make you confuse with such other marks as 'CUE', 'CCUA', 'CULEAS3E' or 'CU...?'"

[58] During her cross-examination, Ms. Zhang explained that the survey was designed by a friend who does not appear to have any particular qualification for conducting survey or opinion polling [answers to Qs 175 to 182 of the Zhang cross-examination]. The affiant also explained

that the survey was conducted in the Chinese community in Markham, Ontario, and was carried out by the Applicant's employees [answers to Qs 186 to 190 of the Zhang cross-examination]. Ms. Zhang was unable to provide details as to how the respondents were selected by the employees [answers to Qs 191 to 202 of the Zhang cross-examination].

[59] In its written argument, the Opponent submits that the survey evidence is not admissible for numerous reasons, including the fact that the questions were devised by a friend who has no experience in conducting surveys, that the surveys were not administered by independent skilled persons, that the sampling was inadequate and arbitrary as only 18 people who happened to be in Markham were questioned, and that there was no expert verification of the suitability of the questions. In support, the Opponent cites *McDonalds Corp v Coffee Hut Stores Ltd* (1994) 55 CPR (3d) 465 (FCTD).

[60] The Applicant did not address the admissibility or the reliability of the survey in its written argument. I note however that Ms. Zhang indicated during re-examination that she believed that it was a simple questionnaire and that the word "confuse" is a simple word that would be understood by anyone [answers to Qs 329 to 353 of the Zhang cross-examination].

[61] The concept of relevance in survey evidence, as described by the Supreme Court in *Mattel, Inc v 3894207 Canada Inc*, supra at 45, includes the following issues: 1) reliability (in the sense of producing the same results if repeated); and 2) validity (in the sense of asking the right questions to the right pool of respondents in the correct circumstances to provide the information sought).

[62] In the present case, having reviewed the questions in the survey, and taking into account Ms. Zhang's answers during cross-examination regarding the methodology employed, the small number of the sampling size, and the nature of the questions in the survey, I agree with the Opponent that the survey questionnaire does not meet proper standards of relevance and reliability. As such, I am not prepared to afford the survey questionnaire any weight.

Conclusion in the likelihood of confusion

[63] 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 as follows [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.

[64] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, despite the acquired distinctiveness of some of the Opponent's CU Registered Marks, the length of time for which they have been in use, the clear overlap in the nature of the parties' services and the potential for overlap in their channels of trade, as well as evidence of a family of the Opponent's trade-marks with the prefix CU, I am of the view that the overall dissimilarity of the parties' marks in appearance, sound, and ideas suggested, are significant enough to shift to balance of probabilities in favour of the Applicant.

[65] In this regard, I do not think that the Opponent's claim to a monopoly over the particular combination of the letters CU as a prefix can be extended to cover all trade-marks that contain the same letters of the alphabet used in association with financial services, irrespective of the overall dissimilarities of the trade-marks as a whole. In the end, I find that the ordinary consumer would not, as a matter of first impression, think that financial and related goods and services used in association with the parties' trade-marks emanate from a common source.

[66] Consequently, the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Marks and any of the registered trade-marks relied up on by the Opponent in the present proceeding.

[67] In view of the foregoing, I reject the section 12(1)(d) ground of opposition.

Non-entitlement under section 16(1)(a) of the Act

[68] The Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(1)(a) of the Act, on the ground that it is confusing with the

Opponent's trade-marks, including certification marks, that begin with the letters CU, identified in Schedules "A" and "B" to this decision.

[69] The material date for considering this ground of opposition is the claimed date of first use of the subject application, namely June 2011.

[70] As per my review of Ms. Bayley's affidavit under the section 12(1)(d) analysis, I am satisfied that a number of the Opponent's CU trade-marks have been used in association with financial and credit union services in Canada prior to June 2011, and that it has not been abandoned as of January 16, 2013. Further, assessing each of the section 6(5) factors as of June 2011 rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case.

[71] As in the case of the non-registrability ground, I conclude that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and any of the Opponent's CU trade-marks as of June 2011. Accordingly, the section 16(1)(a) ground of opposition is dismissed.

Was the Mark distinctive of the Applicant's services at the filing date of the statement of opposition?

[72] In order to meet its initial burden with respect to the non-distinctiveness ground of opposition, the Opponent is required to show that one or more of its trade-marks had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Applicant's Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[73] The material date to assess the ground of opposition is the filing date of the statement of opposition, namely February 8, 2013 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[74] Based on my review of the Opponent's evidence, I am satisfied that the Opponent has provided sufficient evidence to support a finding that one or more of its trade-marks had become

known sufficiently to negate the distinctiveness of Mark at the filing date of the statement of opposition.

[75] As I came to the conclusion that, based on the evidence of record, there is no likelihood of confusion between the Mark and any of the Opponent's CU trade-marks which had become known sufficiently, and because the considerations are essentially the same under and the difference in relevant dates does not affect my analysis, I am satisfied that the Applicant has met its legal onus to show that the Mark does distinguish, and is adapted to distinguish, its services from those of the Opponent.

[76] The section 2 ground is therefore also dismissed.

Does the Application Conform to the Requirements of Section 30 of the Act?

[77] The Opponent pleads that the application does not conform to sections 30(a), 30(b) and 30(i) of the Act. The material date for assessing a section 30 ground is the filing date of the application, namely December 14, 2011 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

Section 30(a) of the Act

[78] The Opponent alleges that the application does not comply with section 30(a) of the Act in that the services contained in the application are not described in ordinary commercial terms. The Opponent did not identify the services in question, nor did it provide or refer to any evidence or make any submissions with respect to this ground of opposition. The section 30(a) ground is therefore summarily dismissed for the Opponent's failure to satisfy its initial evidential burden.

Section 30(b) of the Act

[79] The Opponent alleges that contrary to section 30(b) of the Act, the Applicant has not used the Mark, as a trade-mark within the meaning of the Act, in Canada since the claimed date of first use, in association with the services contained in the application.

[80] There is an initial evidential burden on the Opponent to adduce sufficient evidence to support its allegation of the application's non-conformity to section 30(b) of the Act, bearing in mind that 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* (1996), 10 CPR (3d) 84 (TMOB) at 89 and *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323]. If the Opponent succeeds in discharging its initial evidential burden, the Applicant must then, in response, substantiate its claim of use during the material time.

[81] The Court has noted that an opponent's initial burden under section 30(b) can be met by reference not only to its own evidence but also that of the Applicant [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230].

[82] Relying on Ms. Zhang's affidavit, the Opponent submits that "none of the exhibits of the Zhang affidavit are dated and no invoices or sales data were provided". When Ms. Zhang's affidavit is viewed in its entirety, along with the transcript of her cross-examination, I am not satisfied that the Opponent has met its initial evidential burden with respect to its 30(b) ground, even if it has been characterized as a light burden. In particular, the Opponent failed to put into question the veracity of the alleged date of first use of the Mark in association with the applied for services.

[83] In her affidavit, Ms. Zhang states that the Applicant has been using the Mark since June 2011. During her cross-examination, Ms. Zhang explained that pamphlets bearing the Mark, attached as Exhibit A to her affidavit, have been distributed by the Applicant to its customers since 2012 [answers to Qs 93 and 94 of the Zhang cross-examination]. The affiant also provided an idea of the Applicant's revenues since its corporation in 2009.

[84] While Ms. Zhang's affidavit might not have provided documentary evidence of use of the Mark as of June 2011, this does not in itself put into question the alleged date of first use. In the end, I am of the view that Ms. Zhang's affidavit does not cast serious doubt, nor does it put into question, the date of first use of the Mark in association with the applied for services.

[85] The section 30(b) ground is therefore dismissed for the Opponent's failure to satisfy its initial evidential burden.

Section 30(i) of the Act

[86] The Opponent pleads that the Applicant could not have been satisfied that it is entitled to use the trade-mark in Canada, contrary to section 30(i) of the Act, as the Mark was confusing with one or more of the Opponent's CU trade-marks and/or certification marks of which the Applicant was aware in view of the Opponent's prior filing for registration, use/or making known of its marks by itself or its licensees.

[87] Section 30(i) of the Act requires an applicant to declare in the application that it 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 [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Opponent has not done so.

[88] The mere fact that the Opponent has alleged confusion between the Mark and the prior use, making known, filing and/or registration of its trade-marks in association with the same or the same type of goods and services as those of the Applicant in Canada is not by itself sufficient to put into question section 30(i) of the Act. Likewise, the mere fact that the Applicant might have been aware of the Opponent's use and registration of its trade-marks in Canada, which has not been shown, is also not sufficient by itself to suggest bad faith and to put into question section 30(i) of the Act [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[89] Consequently, I dismiss the section 30(i) ground of opposition for the Opponent's failure to meet its initial evidential burden.

Disposition

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

Pik-Ki Fung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD








Gowling WLG (Canada) LLP





For the Opponent

No Agent Appointed



For the Applicant

Schedule "A"

Opponent's Trade-mark	Application/Registration No.
CCUA	1,555,046 (Abandoned as of January 15, 2013)
 	TMA569,469
CU BONUS BUILDER	TMA569,232
CU BY PHONE	TMA577,385
	TMA577,824
CU CREDIT	TMA556,563
	TMA447,813
CU LINE	TMA706,393
CU NET	TMA696,316
CU SOLUTIONS	TMA571,870
CU STEP	TMA644,578
	TMA557,357
CU TAKE TEN	TMA557,454
CU-XCHANGE	TMA680,281
	TMA680,282
CU@HOME	TMA591,042
CU@WORK	TMA845,525
CUANYTIME.COM	TMA516,332
	TMA543,475
CUBILL	TMA557,248
CUBOND	TMA570,442
CUCARDSONLINE.COM	TMA567,980
CUCORP	TMA487,559

	TMA493,921 (Expunged on December 12, 2013)
CUCREDIT	TMA549,563
CUDA	TMA616,639
CUETS	TMA541,660
CUIC	TMA614,942
CUINCLUSIVE	TMA615,272
	TMA549,588
CUIS	TMA549,587
CULEASE	TMA555,067
	TMA537,810
CULINE	TMA638,033
CULINK	1,528,858 (Abandoned as of June 11, 2014)
CUPS	TMA696,906
CUSALES	TMA718,619
CUSAVE	TMA689,514
	TMA650,731
CUSOURCE	TMA650,543

Schedule "B"

Opponent's Certification Mark	Registration No.
CU 55 PLAN	TMA517,147
CU CARD	TMA354,942
	TMA343,626
CU-CHEK	TMA169,645
CUDATA	TMA364,743
	TMA334,088
CUE	TMA336,301