IN THE MATER OF AN OPPOSITION
by Hume Publishing Company Limited to
application No. 640,265 for the trade-mark
SUCCESSFUL MONEY STRATEGIES SEMINARS
filed by Successful Money Management Seminars, Inc.

On September 12, 1989, Successful Money Management Seminars, Inc. filed an application to register the mark SUCCESSFUL MONEY STRATEGIES SEMINARS, based on use in Canada since at least as early as June 17, 1989, with the wares

workbooks concerning financial planning

and with

educational services namely, financial planing seminars.

The application was subsequently amended to disclaim the right to the exclusive use of the words MONEY, STRATEGIES and SEMINARS apart from the mark as a whole. The application was advertised for opposition purposes in the Trade-marks Journal issue dated August 29, 1990 and opposed by Hume Publishing Company Limited on September 21, 1990. A copy of the statement of opposition was forwarded to the applicant on November 5, 1990. The applicant responded by filing and serving a counter statement.

The first ground of opposition is that the application is not in compliance with Section 30 of the Trade-marks Act because the applicant has not used its mark since the date of first use alleged in the application namely June 17, 1989 or alternatively, that the mark has not been used continuously since the alleged date of first use. The second ground, also pursuant to Section 30, is that the applicant could not have been satisfied that it was entitled to use the mark in Canada.

The third ground of opposition is that the applied for mark is not registrable because it is confusing with the opponent's registered marks namely, SUCCESSFUL BUSINESS MANAGEMENT, REUSSIR EN AFFAIRES, SUCCESS OVER 50, and SUCCESSFUL REAL ESTATE INVESTING. The first two marks cover the services of "conducting an individual study course" and related wares namely, the course material. The second and third marks cover similar services and wares specifically focused on financial planning and real estate investment, respectively.

The fourth and fifth grounds of opposition are that the applicant is not entitled to registration because, at the alleged date of first use namely June 17, 1989, the applied for mark was confusing with (i) the opponent's above-mentioned marks previously used or made known in Canada by the opponent or its predecessors in title, (ii) the opponent's marks GERER ET INVESTIR VOTRE ARGENT AVEC SUCCES and SUCCESSFUL INVESTING & MONEY MANAGEMENT, covering the services "counselling and advising concerning personal financial planning . . . and money management" and related course material previously used or made known in Canada by the opponent and previously applied for by the opponent on April 19, 1989 under application Nos. 630,193 and 630,194, respectively.

The sixth ground of opposition is that the applicant is not entitled to registration because at the alleged date of first use of the applied for mark it was confusing with the opponent's mark ADVANCED STRATEGIES FOR SUCCESSFUL INVESTING previously used by the opponent in association with "written communications dealing with financial planning . . ." The seventh ground of opposition alleges that the applied for mark is not distinctive of the applicant's services and wares presumably in view of the facts alleged in the statement of opposition.

The opponent's evidence consists, in part, of the affidavit of Michael Keerma, Editorial Director of the opponent company. The applicant's evidence consists of the affidavit of Gordon C. Root, Vice President of the applicant company. An order for the cross-examination of Mr. Root issued at the opponent's request and was conducted on September 29, 1992. The transcript of the cross-examination, exhibits thereto and replies to questions taken under advisement form part of the evidence of record.

On October 19, 1992, that is, shortly after Mr. Root's cross-examination, the opponent requested leave to amend the statement of opposition to add the following ground of opposition:

The following reason was submitted in support of the request:

The applicant was accorded but declined an opportunity to comment of the opponent's request: see the Board letter of November 12, 1992. In the circumstances, the opponent was granted leave to amend on February 5, 1993. The applicant subsequently requested and was granted leave to file and serve an amended counter statement: see the Board ruling dated February 11, 1994.

During Mr. Root's cross-examination the applicant requested about twelve undertakings each of which the applicant took under advisement. The opponent communicated with the Board on January 18, 1993 concerning the requested undertakings:

In view of the opponent's submissions, the Board issued the following ruling on March 19,1993:

Shortly thereafter, the applicant answered two of the requested undertakings and submitted that answers could not be provided for the remaining undertakings because "the opponent has requested material and documents which are no longer available" or because the material "is confidential in nature." The applicant did not differentiate between which materials it considered confidential and which materials were no longer available nor did the applicant provide any further elaboration as to its position with respect to the requested undertakings.

The opponent filed the affidavit of Terrylynn Edwards, trade-mark agent, as its evidence in reply. Both parties filed written arguments and both were represented at an oral hearing.

I will begin by considering the final ground in the amended statement of opposition namely, that the applied for mark is not distinctive of the applicant because of use of the phrases SUCCESSFUL MONEY STRATEGIES SEMINARS or SUCCESSFUL MONEY STRATEGY or SUCCESSFUL MONEY STRATEGY as trade-marks or as business names by third parties. The onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see *Muffin Houses Inc. v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of a legal burden means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against that the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). The opponent submits that the material date to consider the final ground of opposition is the date of filing the amended statement of opposition namely, October 19, 1992, rather than the date of filing of the original statement of opposition namely, September 21, 1990. However, the opponent was unable to cite any relevant precedent on point and the applicant made no submissions on the matter. Nevertheless, the facts supporting the added ground did not come into existence until after September 21, 1990. I have therefore accepted the later material date as

urged by the opponent because to do otherwise would effectively preclude the opponent from supporting the added ground of opposition (Of course, if I have taken the wrong material date to decide the issue of distinctiveness, then an interested party may apply to the Federal Court to expunge a mark once it is registered. The issue of distinctiveness would be considered at the time that the plaintiff brings the motion to expunge: see Sections 57 and Section 18(b) of the Trade-marks Act.). Further, in considering the issue of distinctiveness I am permitted to take into account evidence of all the surrounding circumstances up to the material date: see *Castle & Cooke, Inc. v. Popsicle Industries Ltd.* (1990), 30 C.P.R.(3d) 158 (TMOB).

Mr. Root's affidavit evidence is rather sparse but does provide an overall impression of the applicant's business. The applicant is engaged in producing and marketing educational seminars generally concentrating on financial planning. Seminar topics covered include mutual funds, planning for educational funding, retirement planning, and various types of life insurance. A personal financial planning consultation is optional but apparently included in the registration fee. The course materials are only available to persons who attend a seminar. The applicant has offered financial planning courses since about 1976 in the United States. The affidavit is silent as to when the applicant first began to market its wares and services in Canada, however, Exhibit C to Mr. Root's affidavit is a workbook for a seminar in Canada dated 1991 bearing the applied for mark. Exhibit B to Mr. Root's affidavit is entitled A Proven Marketing System Available for Canadian Financial Planners; at the top right corner of the document is a notice which reads: "Available for Delivery October 1, 1990." Mr. Root's affidavit testimony is that "To date [April 22, 1992] over seventy (70) seminars have been presented in Canada to over twenty-six hundred (2600) people."

Mr. Root's testimony on cross-examination is somewhat more informative than is his affidavit evidence. The applicant permits some 85 licensees to use the applied for mark in Canada. The licensees are Canadian financial planners who are not related to the opponent nor are they controlled by the applicant other than through licence agreements. The applicant supplies its licensees with "a turn key seminar marketing system" (see Exhibit B to the cross-

examination) that includes, among other things, an operations manual, speaker's reference notes, written script, workbooks for the participants, audio tapes, video tapes, transparencies, advertising and promotional materials, welcome registration signs, a podium and a podium wrap. In other words, the package provided by the opponent enables Canadian financial planners to put on their own seminars: see Q 48 of the transcript of cross-examination.

Mr. Root's testimony on cross-examination is that the applicant company first conducted a seminar in Canada at the date of first use claimed in the subject application [see pages 22-23 of the transcript of cross-examination] and that both the applicant and its licensees have conducted seminars in Canada from 1990 on [see pages 63-64 of the transcript of cross-examination]. The applicant did not apply to appoint any of its licensees as registered users of the applied for mark as of the date of cross-examination namely, September 29, 1992 [see page 9 of the transcript of cross-examination] although the registered user provisions of the Act were not repealed until June 9, 1993. The first and second undertakings requested by the opponent appear on page 8 of the transcript of cross-examination and relate to licensed use of the mark:

At cross-examination, Mr. Root was shown pages taken from Metro Vancouver telephone directories dated July 1990. 1991, and 1992 (Exhibits 3, 2 and 1 respectively). There was no listing for Successful Money Strategies Seminars, or a variation of it, in the 1990 listings. However, the 1991 and 1992 listings included the following: Successful Money Strategies at 608-650 W 41 St; Successful Money Strategies at 404-999 Canada Pl; Successful Money Strategies Seminars at 1400-1500 W Georgia. Mr. Root was unable to confirm whether the above-mentioned businesses were licensees of the applicant: see Q 94; Q 100-105; Q 111-114.

Mr. Root's testimony on cross-examination, his inability to identify the applicant's licensees, and the negative inferences that I have drawn from the applicant's apparent reluctance to provide any information regarding contracts with Canadian financial planners involved with seminars given in Canada under the applied for mark [see the undertaking requested, but not answered, at Q 148 of the transcript of cross-examination] suffice to meet the opponent's evidential burden regarding the issue of distinctiveness as pleaded in the final ground of opposition. In other words, in my view the opponent has raised serious doubts about whether the applicant has direct or indirect control over licensees of the applied for mark as required by Section 50 of the Trade-marks Act and has also raised serious doubts concerning unlicensed use of the applied for mark (or variations of it) by third parties unknown to the applicant.

Accordingly, I find for the applicant on its final ground of opposition because all of the evidence, including the opponent's evidence filed in reply after Mr. Root's cross-examination, points to non-distinctiveness of the applied for mark as of the material date October 19, 1992.

In the event that I was wrong in choosing October 19, 1992, as the material date, I will next consider the first ground of opposition, pursuant to Section 30(b), which alleges that "the applicant has not used the trade-mark in Canada in association with [its wares and services] since the date of first use alleged in the application namely, June 17, 1989 . . ."

Section 30(b) of the Trade-marks Act requires the application to contain the date from which the applicant has used its mark in association with the wares and services specified in the application. As always, the legal burden or onus is on the applicant to show that its application complies with Section 30(b). That is, the applicant must show that the date of first use alleged is factually correct. The applicant may allege a date of first use later than the actual date of first use, but may not allege a date earlier than the actual date of first use. There is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to establish the facts inherent in its allegation that the applicant's date of first use is incorrect. The presence of an evidential burden on a party with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. The evidential burden on the opponent with respect to Section 30(b) is lighter than in the ordinary case: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at pp. 298-300 (F.C.T.D.). As noted earlier, the presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of non-compliance with Section 30(b) is the filing date of the application: see *Thomas J. Lipton Inc. v. Primo Foods Ltd. (1992)*, 44 C.P.R.(3d) 556 at p. 560 (TMOB); *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 468 at p. 475 (TMOB).

While I do not doubt the reliability or credibility of Mr. Root's testimony based on his own recollection of events, it is nevertheless clear from the transcript of cross-examination that Mr. Root was not thoroughly acquainted with all the relevant facts and had relied on business records for the statement in the trade-mark application that the date of first use of the mark was June 17, 1989: see Q 121-123 of the transcript of cross-examination:

Later in cross-examination Mr. Root identified three Canadians namely, Michael Olsen, Scott Hespin, and Andy Dukta as having participated in the June seminar and went on to describe some of the promotion leading to the seminar:

In my view, several of the undertakings requested by the opponent were relevant to determining the date of first of the applied for mark in Canada, and whether such use was by the opponent or by a licensee. It is no answer to a question on cross-examination for the witness to say that he does not have a specific recollection of a date of first use alleged in a trade-mark application and then for the witness to fail to provide documents which might answer the question. Consequently, I find that the opponent has met the evidential onus on it to put the date of first use of the mark by the applicant in issue and I find that the applicant has not met the legal onus on it to show that, on the balance of probabilities, it used the applied for mark in Canada on June 17, 1995. At best the applicant's evidence shows first use of the applied for mark on June 30, 1989.

Thus, the opponent also succeeds on its first ground of opposition and it is not necessary for me to consider the remaining grounds.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 30th DAY OF OCTOBER, 1995.

Myer Herzig,
Member,
Trade-marks Opposition Board