

IN THE MATTER OF AN OPPOSITION
by Realestate World Services
(1978) Ltd. to application No.
631,216 for the trade-mark
REALSAVERS & Design filed by
G.A. Marton Enterprises Ltd.

On May 4, 1989, the applicant, G.A. Marton Enterprises Ltd., filed an application to register the trade-mark REALSAVERS & Design (illustrated below) based on use in Canada since April 10, 1989 with the following services:

home marketing consulting, designing, printing and distribution of material dealing with real estate marketing techniques and methods, especially for the sale by owner real estate market, workshops, lectures, seminars on home marketing, advertising and promotional advice and services, publishing of real estate related statistical data and manuals dealing with home marketing procedures.

The application was advertised for opposition purposes on February 28, 1990.

The opponent, Realestate World Services (1978) Ltd., filed a statement of opposition on June 28, 1990, a copy of which was forwarded to the applicant on August 1, 1990. The first ground of opposition is that the applicant's application does not comply with the provisions of Section 30(i) of the Trade-marks Act because the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in view of the prior use of the opponent's trade-marks and the reputation associated with those marks.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the following registered trade-marks of the opponent:

<u>Trade-mark</u>	<u>Reg. No.</u>	<u>Wares/Services</u>
REALSCOPE	206,126	(1) services of real estate marketing display, namely photographing and developing, and mounting in a particular manner displays of real estate and all brochures and materials in relation thereto (2) services of promotion and advertising for sale, lease and investment generally of agricultural properties owned by others (3) services of audiovisual presentation of real estate listings by VHF recorder
REALFAX	349,060	real estate services
REALINE	349,061	services or [sic] providing information and advice to the public with respect to real estate services
REALOAN	309,178	computer based network for mortgage selection, application and

origination

The first three trade-marks listed above are certification marks.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the trade-marks REALSAFE and REALNEWS and the four trade-marks noted above previously used in Canada by the opponent and for which applications had previously been filed. The fourth ground is that the applied for trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Harold L. Waddell. The applicant did not file any evidence. Both parties submitted a written argument and an oral hearing was conducted at which both parties were represented.

The opponent's first ground does not raise a proper ground of opposition. The mere fact that the opponent has previously used its trade-marks and each of those marks has acquired a reputation does not preclude the applicant from making the statement required by Section 30(i) of the Act. The opponent did not even allege that the applicant was aware of the opponent's marks. Thus, the first ground is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The first of the opponent's trade-marks listed above is registration No. 206,126 for the certification mark REALSCOPE. That mark and the applicant's mark are inherently distinctive since they are both coined words. However, neither mark is inherently strong since the component REAL is suggestive of the associated real estate services.

The applicant has not evidenced any use of its mark REALSAVERS & Design. Thus, I must conclude that the applicant's mark has not become known at all in Canada.

The opponent, on the other hand, has evidenced fairly extensive use of its certification mark REALSCOPE in association with the registered services marked (1) by its network of licensees operating as real estate brokers under the opponent's trade-mark REALTY WORLD. I am therefore able to conclude that the opponent's certification mark has become known to some extent in Canada.

The length of time the marks have been in use favors the opponent. The services of the parties are similar, both qualifying as real estate services. Presumably, the trades of the parties would be similar.

As for Section 6(5) (e) of the Act, I consider that the marks of the parties bear a fair degree of visual and phonetic resemblance. Each mark comprises or is dominated by a two syllable word comprised of nine or ten letters commencing with the word REAL followed by a second component commencing with the letter S. To the extent that the prefix REAL suggests real estate services, there is also some resemblance between the ideas suggested by the marks.

The applicant contends that a surrounding circumstance in the present case which lessens the effect of any degree of resemblance between the marks is the fact that there are hundreds of real estate companies which use trade-marks or trade-names with the prefix REAL. However, there is no evidence on point.

As a surrounding circumstance, I have, however, considered the use of the opponent's two other certification marks (i.e - REALFAX and REALINE) by its licensees in association with real estate- related services. The opponent has evidenced continuous use of those two marks for a number of years throughout Canada. Thus, I am able to conclude, at least to some extent, that a number of Canadians have been conditioned to associating REAL-prefixed marks for real estate services with the opponent's licensees. This, in my view, increases the likelihood of confusion between the marks at issue in the present case.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the services, trades and marks of the parties and the use of two other REAL-prefixed marks by the opponent's licensees, I find that the applicant has failed to satisfy the onus on it to show that its trade-mark REALSAVERS & Design is not confusing with the opponent's certification mark REALSCOPE. The first aspect of the second ground of opposition is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 29th DAY OF October, 1993.

David J. Martin,
Member,
Trade Marks Opposition Board.