IN THE MATTER OF AN OPPOSITION by Insight Holdings Ltd. to application No. 851,874 for the trade-mark REAL INSITE filed by Insite Real Estate Information Systems Inc.

On July 28, 1997, the applicant, Insite Real Estate Information Systems Inc., filed an application to register the trade-mark REAL INSITE based on use of the trade-mark in Canada since at least as early as March 31, 1997. The applicant disclaimed the right to the exclusive use of the word REAL apart from its trade-mark. Further, the applicant amended its application at the examination stage in response to an objection raised by the examiner that its statement of wares was not in compliance with subsection 30(a) of the ***Trade-marks Act***. As a result, when advertised for opposition purposes in the ***Trade-marks Journal***, the present application covered the following wares:

> "Printed matter; namely, magazines, brochures, and periodicals, relating to the advertisement, listing, valuation, and analysis of the financial performance as an investment, of commercial real estate"

as well as the following services:

> "Providing information, facility performance, and advertising services relating to commercial real estate for others; namely, providing online databases of commercial real estate inventory and space availability and building information; providing online searching and retrieval of information relating to commercial real estate inventory, space availability and building information; providing online commercial real estate listing services; providing online advertising services; and rating the performance of commercial real estate facilities".

The present application was advertised in the ***Trade-marks Journal*** of September 2, 1998 and the opponent, Insight Holdings Ltd., filed a statement of opposition on November 2, 1998, a copy of which was forwarded to the applicant on November 20, 1998. The applicant served and filed a counter statement in response to the statement of opposition on January 19, 1999. The opponent filed as its evidence the affidavit of Charles Koo while the applicant elected not to file any evidence. The opponent requested and was granted leave on two occasions to amend its statement of opposition pursuant to Rule 40 of the ***Trade-marks Regulations***. Furthermore, the opponent requested and was granted leave pursuant to Rule 44(1) of the ***Trade-marks Regulations*** to submit a certified copy of registration No. 515,594 for the trade-mark INSIGHT standing in the name of the opponent as further evidence in this opposition. Neither party filed a written argument and neither party requested an oral hearing.

The following are the grounds of opposition asserted by the opponent in the second of its amended statements of opposition:

a) Contrary to paragraph 38(2)(a) and subsection 30(b) of the ***Trade-marks Act***, at the date of filing of the present application, the applicant had not used the trade-mark REAL INSITE as alleged, or at all, or had subsequently abandoned the trade-mark.

b) Contrary to paragraph 38(2)(a) and subsection 30(i) of the ***Trade-marks Act***, at the date of filing of the present application, the applicant could not properly have been satisfied that it was entitled to use the trade-mark in Canada in association with the wares or services described in the application since it was aware of the facts set out in the remaining grounds of opposition.

c) The applicant is not the person entitled to registration of the trade-mark REAL INSITE in view of paragraphs 38(2)(c) and 16(1)(a) of the ***Trade-marks Act*** because, at the date on which the applicant or its predecessor-in-title allegedly first used the trade-mark, the applied for mark was confusing with the trade-mark INSIGHT which the opponent had previously used or made known in Canada in association with developing, designing, planning, constructing, marketing, selling and managing of residential and commercial properties, real estate projects and/or real estate developments, and which was not abandoned at the date of advertisement of the present application.

d) The applicant is not the person entitled to registration of the trade-mark REAL INSITE in view of paragraphs 38(2)(c) and 16(1)(c) of the ***Trade-marks Act*** because, at the date on which the applicant or its predecessor-in-title allegedly first used the trade-mark, the applied for mark was confusing with the trade-names INSIGHT, INSIGHT GROUP, INSIGHT GROUP DEVELOPMENT CORPORATION, INSIGHT HOLDINGS and INSIGHT HOLDINGS LTD. which the opponent had previously used in Canada in association with developing, designing, planning, constructing, marketing, selling and managing of residential and commercial properties, real estate projects and/or real estate developments, and which were not abandoned at the date of advertisement of the present application.

e) The applied for trade-mark is not distinctive, having regard to the provisions of paragraph 38(2)(d) and section 2 of the ***Trade-marks Act*** because it is not capable of distinguishing the applicant's wares or services from the wares and services of others, particularly real estate related services performed by the opponent under the trade-mark INSIGHT and the trade-names INSIGHT, INSIGHT GROUP, INSIGHT GROUP DEVELOPMENT CORPORATION, INSIGHT HOLDINGS and INSIGHT HOLDINGS LTD., referred to in the two previous grounds, nor is it adapted to so distinguish them.

f) The applied for trade-mark is not distinctive, having regard to the provisions of paragraph 38(2)(d) and section 2 of the ***Trade-marks Act*** because the trade-mark has not been used by the applicant for the purpose of distinguishing the applicant's wares from the wares and services of others in the marketplace.

g) The applied for trade-mark is not registrable in view of paragraphs 38(2)(d) and 12(1)(d) of the ***Trade-marks Act*** because it is confusing with a registered trade-mark, namely, registration No. 515,594 for the trade-mark INSIGHT which is owned by the opponent in association with "developing, designing, planning, constructing, marketing, selling and managing of residential and commercial properties, real estate projects and/or real estate developments".

The first two grounds of opposition are based on subsections 30(b) and 30(i) of the ***Trade-***

marks Act. While the legal burden is on the applicant to show that its application complies with section 30 of the ***Trade-marks Act***, there is an initial evidential burden on the opponent to establish the facts relied on by it in support of its section 30 grounds [see ***Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.***, 3 C.P.R. (3d) 325, at pp. 329-330; and ***John Labatt Ltd. v. Molson Companies Ltd.***, 30 C.P.R.(3d) 293]. The material time for considering the circumstances respecting the issues of non-compliance with section 30 of the ***Act*** is the filing date of the application [see ***Georgia-Pacific Corp. v. Scott Paper Ltd.***, 3 C.P.R.(3d) 469, at p. 475].

The opponent has not furnished any evidence in support of its allegation that the applicant has not used its trade-mark REAL INSITE as alleged in its application, or at all, or had subsequently abandoned the trade-mark in Canada. As a result, the opponent has failed to meet its evidential burden in relation to the first ground. I have therefore dismissed the subsection 30(b) ground of opposition. Likewise, the opponent has not furnished any evidence to show that the applicant could not have been satisfied that it was entitled to use its trade-mark REAL INSITE in Canada. Moreover, to the extent that the subsection 30(i) ground is founded upon allegations set forth in the remaining grounds of opposition, the success of this ground is contingent upon a finding that the trade-mark REAL INSITE is not registrable or not distinctive, or that the applicant is not the person entitled to its registration, as alleged in those grounds [see ***Consumer Distributing Co. Ltd. v. Toy World Ltd.***, 30 C.P.R. (3d) 191, at p.195; and ***Sapodilla Co. Ltd. v. Bristol-Myers Co.***, 15 C.P.R.(2d) 152, at p.155]. I will therefore consider the remaining grounds of opposition.

The opponent has also alleged that the applicant's trade-mark REAL INSITE is not registrable in view of paragraph 12(1)(d) of the ***Trade-marks Act*** in that the applicant's mark is confusing with its registered trade-mark INSIGHT, registration No. 515,594. In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark REAL INSITE and the registered trade-mark INSIGHT, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the ***Trade-marks Act***. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark REAL INSITE and the opponent's registered trade-mark as of the date of my decision, the material date for

assessing a paragraph 12(1)(d) ground [see ***Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks***, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering initially the inherent distinctiveness of the trade-marks at issue [para.6(5)(a)], the applicant's trade-mark REAL INSITE when considered in its entirety as applied to the wares and services covered in the present application possesses some measure of inherent distinctiveness even though the mark may suggest to some consumers that the applicant is providing insight or information in relation to real estate. Likewise, the opponent's registered trade-mark INSIGHT as applied to the services covered in the opponent's registration possesses some measure of inherent distinctiveness.

With respect to the extent to which the trade-marks at issue have become known [para.6(5)(a)] and the length of time the marks have been in use [para.6(5)(b)], the applicant has not submitted any evidence in this opposition and its trade-mark REAL INSITE must be considered as not having become known to any extent in Canada. On the other hand, the opponent's evidence establishes that its registered trade-mark INSIGHT has become known to some extent on Vancouver Island through the design, planning, construction and marketing of LONGWOOD and LONGWOOD STATION real estate development projects in the vicinity of Nanaimo, British Columbia. In his affidavit, Charles Koo, President and Chief Executive Officer of the opponent and of its related company, Insight Group Development Corporation, states that Insight Group Development Corporation, which operated under license from the opponent and its predecessor, commenced using the trade-mark INSIGHT about January 12, 1996 in association with the design and planning of the LONGWOOD and LONGWOOD STATION projects. Further, according to Mr. Koo, Insight Group Development Corporation has used the trade-mark INSIGHT since early to mid-1996 on its office signage, its stationery and its business cards, as well as in its advertising for its services, specimens of which are annexed to his affidavit. Thus, both the extent to which the trade-marks at issue have become known and the length of time the marks have been in use weigh in the opponent's favour.

As for the nature of the wares and services of the parties [para.6(5)(c)] and the nature of the trade associated with those wares and services [para.6(5)(d)], it is the applicant's statements of wares

and services and the statement of services covered in the opponent's registration for the trade-mark INSIGHT which must be considered in assessing the likelihood of confusion in relation to the paragraph 12(1)(d) ground [see ***Mr. Submarine Ltd. v. Amandista Investments Ltd.***, 19 C.P.R.(3d) 3, at pp.10-11 (F.C.A.); ***Henkel Kommanditgesellschaft v. Super Dragon***, 12 C.P.R.(3d) 110, at p.112 (F.C.A.); and ***Miss Universe, Inc. v. Dale Bohna***, 58 C.P.R.(3d) 38,1 at pp.390-392 (F.C.A.)]. However, those statements must be read with a view to determining 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 may be useful [see ***McDonald's Corporation v. Coffee Hut Stores Ltd.***, 68 C.P.R.(3d) 168, at p.169 (F.C.A.)].

Registration No. 515,594 covers services described as "Developing, designing, planning, constructing, marketing, selling and managing of residential and commercial properties, real estate projects and/or real estate developments" which are related to the applicant's "magazines, brochures, and periodicals, relating to the advertisement, listing, valuation, and analysis of the financial performance as an investment, of commercial real estate", as well as being related to the applicant's services which are identified as: "Providing information, facility performance, and advertising services relating to commercial real estate for others; namely, providing online databases of commercial real estate inventory and space availability and building information; providing online searching and retrieval of information relating to commercial real estate inventory, space availability and building information; providing online commercial real estate listing services; providing online advertising services; and rating the performance of commercial real estate facilities". Moreover, in the absence of any evidence to the contrary, I would expect that there could be a potential overlap in the respective wares and services of the parties.

With respect to the degree of resemblance between the trade-marks at issue, the applicant's trade-mark REAL INSITE and the opponent's registered trade-mark INSIGHT bear little similarity in appearance although there is a fair degree of similarity in sounding and in the ideas suggested by these marks, the word INSITE being the phonetic equivalent of the registered trade-mark INSIGHT.

Having regard to the degree of resemblance in sounding and in the ideas suggested by the

trade-marks at issue as applied to related wares and services which could travel though the same channels of trade, and bearing in mind that the applicant has filed no evidence or written argument in support of its application, I find that the applicant has failed to meet the legal burden on it of satisfying the Registrar that there would be no reasonable likelihood of confusion between the trade-marks at issue in relation to the paragraph 12(1)(d) ground. Consequently, the applicant's trade-mark is not registrable in view of the provisions of paragraph 12(1)(d) of the ***Trade-marks Act***.

The opponent also challenged the applicant's entitlement to registration of the trade-mark REAL INSITE in view of *inter alia* its prior use in Canada of its trade-mark INSIGHT in association with "Developing, designing, planning, constructing, marketing, selling and managing of residential and commercial properties, real estate projects and/or real estate developments". The Koo affidavit establishes that the opponent had used its trade-mark INSIGHT in association with the developing, designing, planning, constructing, marketing, selling and managing of residential and commercial real estate projects in Canada prior to the applicant's claimed date of first use [March 31, 1997], and that the opponent had not abandoned its trade-mark as of the date of advertisement of the present application [September 2, 1998]. As a result, the opponent has met the burden on it under subsections 16(5) and 17(1) of the ***Trade-marks Act*** in relation to the non-entitlement ground. Thus, the legal burden is upon the applicant to show that there would have been no reasonable likelihood of confusion between its trade-mark REAL INSITE and the opponent's trade-mark INSIGHT as of the applicant's claimed date of first use. My previous comments concerning the surrounding circumstances in assessing the likelihood of confusion between the trade-marks at issue in relation to the paragraph 12(1)(d) ground likewise apply to the determination of the issue of confusion as of the applicant's claimed date of first use. Consequently, the paragraph 16(1)(a) ground of opposition is also successful.

Having concluded that the applicant's trade-mark is not registrable and that the applicant is not the person entitled to registration of the trade-mark REAL INSITE as applied to the wares and services covered in the present application, it follows that the applicant's trade-mark is not distinctive. In view of the foregoing, it is unnecessary to consider the remaining grounds of opposition which are based on the opponent's prior use of the various trade-names identified in the

fourth ground including the trade-name INSIGHT. However, having concluded that the applicant's trade-mark REAL INSITE and the opponent's trade-mark INSIGHT are confusing, I would expect that the non-entitlement and non-distinctiveness grounds which are founded on the opponent's use of the trade-name INSIGHT would also be successful.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the ***Trade-marks Act***, I refuse the applicant's application pursuant to subsection 38(8) of the ***Trade-marks Act.***

DATED AT HULL, QUEBEC, THIS DAY 4th OF DECEMBER, 2000.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.