

**IN THE MATTER OF AN OPPOSITION
by Eric Latta to application No. 1274781
for the trade-mark SOLD BY ERIC filed
by Eric Christiansen**

On September 29, 2005, Eric Christiansen, (the “Applicant”) filed an application to register the trade-mark SOLD BY ERIC (“the Mark”) based upon use of the Mark in Canada in association with real estate services, namely the buying and selling of real estate on behalf of third parties since at least as early as January, 1999. The right to the exclusive use of the word SOLD was disclaimed apart from the Mark.

The application was advertised for opposition purposes in the Trade-marks Journal of June 28, 2006.

On August 24, 2006, Eric Latta (the “Opponent”) filed a statement of opposition against the application in which it alleged the following grounds of opposition:

- (a) The application does not comply with the requirements of Section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (“the Act”) in that the Applicant could not have been satisfied that it is entitled to use the alleged trade-mark in Canada in association with the services described in the application, since at the date of filing the application the trade-mark SOLD BY ERIC was not, and is not and cannot be, a “trade-mark” as defined in Section 2 of the Act. The alleged trade-mark is a purely descriptive phrase commonly used by others, including the Opponent, and cannot be the subject of exclusive trade-mark rights;
- (b) The alleged trade-mark SOLD BY ERIC is not registrable, having regard to the provisions of Section 12(1)(a) of the Act, on the ground that the alleged trade-mark is primarily the name of an individual who is living, namely Eric Christiansen;
- (c) The alleged trade-mark is not registrable, having regard to the provisions of Section 12(1)(b) of the Act, on the ground that the alleged trade-mark is clearly descriptive or deceptively misdescriptive in the English language of the nature or character of the services in association with which it is proposed to be used, namely the selling of real estate on behalf of third parties by the Applicant, Eric Christiansen;
- (d) The alleged trade-mark is not registrable, having regard to the provisions of s. 16(1)(a) and/or (c), on the ground that the alleged trade-mark is confusing with the trade-mark and/or trade-name that had been previously used in Canada by the Opponent, namely the words “Sold by Eric”;

- (e) The alleged trade-mark is not registrable, having regard to s.2 (definition of trade-mark), 4(2) and 16(1) of the Act in that the alleged trade-mark has not been used in Canada in association with the services in respect of which it is proposed to be registered, namely the buying and selling of real estate on behalf of third parties, in that the Applicant does not provide, has not provided, and is not licensed to provide, those services in Canada; and
- (f) The alleged trade-mark is not distinctive, within the meaning of Section 2 of the Act because it does not actually distinguish nor is adapted to distinguish the services in association with which it is proposed to be used by the Applicant from the services of others, including the Opponent, namely the provision of real estate services on behalf of third parties.

The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

The Opponent's evidence consists of the affidavits of Eric Latta, Ralph Kennedy and Elaine Uribe. The Applicant elected not to file any evidence and no affiant was cross-examined. No oral hearing was held.

Onus and Material Dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)).

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

- s. 30 - the filing date of the application (see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475);
- s. 12(1)(a) – the date of my decision (see *Lubrication Engineers, Inc. v. Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243 (F.C.A.));
- s. 12(1)(b) – the filing date of the application (see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.));
- s. 16(1) - the Applicant's date of first use (see s. 16(1));
- non-distinctiveness - the date of filing of the opposition (see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)).

Section 30 (i) Ground of Opposition

The requirement under s. 30(i) of the Act is to include, in the application, a statement that the Applicant is satisfied that it is entitled to use the Mark in Canada in association with the services. Such a statement has been provided in the present application. Whether or not the mark is a trade-mark is not one of the enumerated requirements of s. 30 and is therefore not a proper consideration under this ground. This ground is accordingly dismissed.

Section 12(1)(a) Ground of Opposition

The second ground of opposition fails because the mark as a whole is quite clearly not "a word that is primarily merely the name or the surname of an individual" (see *Breck's Sporting Goods Co. v. Douglas Slater* (1982), 70 C.P.R. (2d) 265 (T.M.O.B.); *Molson Companies Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157 (F.C.T.D.)).

Section 12(1)(b) Ground of Opposition

The issue as to whether the Applicant's Mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated services. Further, the Mark must not be dissected into its component elements and carefully analyzed but

must be considered in its entirety as a matter of immediate impression (see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 (F.C.T.D.) at 186). Character means a feature, trait or characteristic of the services and "clearly" means "easy to understand, self-evident or plain". (see *Drackett Co. of Canada Ltd v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34.)

The Opponent submits that the Applicant should not be permitted to monopolize the use of the words "sold" or "Sold By Eric" because it has shown that real estate representatives in British Columbia use the terms "sold" and "sold by" extensively, if not universally, to advertise and promote their services. In this regard, the Opponent's evidence shows that where a representative has provided real estate services to a seller, and the property in question has been sold, the representative almost invariably will then announce to the world that he or she has "sold" the property in question. The term "sold by" is understood to mean that a licensed representative such as the Applicant has acted as the "listing agent" or "selling agent" in respect of a real estate transaction that has been completed (in the sense that a house has been sold by a principal to a third party). Therefore, to the extent that the alleged Mark merely describes what the Applicant does (or what the general public understand he does), the Opponent submits that it should not be registrable on the ground of clear descriptiveness.

In considering this ground of opposition, I had regard to the following comments of my colleague, Mr. David Martin, in the decision *Procter & Gamble Inc. v. Nabisco Brands Ltd.* (1988), 22 C.P.R. (3d) 303 at 306:

"With respect to the second and third grounds of opposition (which were based on s. 12(1)(a) of the Act), the MacKendrick affidavit establishes that Christie is a common surname in Canada. Furthermore, that affidavit establishes that many males have the surname Christie. Thus, the possessive form Mr. Christie's is a name or surname. And given the numbers of individuals having the surname Christie and the absence of any other common meaning for the word, Mr. Christie's would be perceived by the average Canadian as primarily merely the name or surname of a living individual. However, in accordance with the decision in *Molson Cos. Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157 (F.C.T.D.), the trade-mark MR. CHRISTIE'S CRISP 'N CHEWY is not, as a whole, primarily the name or surname of a living individual. Thus, the second and third grounds are unsuccessful.

Likewise, I find that the words "crisp 'n chewy" are either clearly descriptive or deceptively misdescriptive of the character or quality of the applied for wares. The disclaimer of those words in the application reinforces that finding. However, in accordance with the *Molson Cos.* decision, the foregoing does not preclude the registration of the trade mark as a whole pursuant to the provisions of s. 12(1)(b) of the Act.”

In the present case, a descriptive word (“sold”) is followed by a first name (“Eric”). As in the *Procter & Gamble* case, the word “sold” in the present case is clearly descriptive or deceptively misdescriptive of the applied for services. When the word is followed by a first name, however, the resultant phrase SOLD BY ERIC **as a whole** is not clearly descriptive of the character or quality of the applied for services. In any event, in view of the Applicant’s disclaimer to the exclusive use of the word “sold” apart from the trade-mark as a whole, a registration for SOLD BY ERIC would not prevent someone else from using “sold” in a descriptive sense in association with their real estate services. As a result, I do not consider the Mark SOLD BY ERIC, as applied to the services covered in the Applicant’s application, to offend the provisions of s. 12(1)(b).

Section 16(1)(a) Ground of Opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(1)(a) and/or s. 16(1)(c) of the Act on the basis that the Mark is confusing with the trade-mark and/or trade name that had been previously used in Canada by the Opponent, namely the words “Sold by Eric”. With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark or trade-name prior to the Applicant’s claimed date of first use and non-abandonment of its mark as of the date of advertisement of the Applicant’s application (s. 16). Although Mr. Latta has attested that he has “used the slogan Sold by Eric” in promotional materials since at least the mid-1990’s, he did not provide any evidence to corroborate use of “Sold by Eric” prior to the Applicant’s alleged date of first use (i.e. January, 1999). In this regard, the pamphlet attached as Exhibit E to his affidavit includes the phrase “Sold by Eric Latta” and, while it may have been printed in 1999, there is no indication that it was distributed by mail prior to the end of January, 1999. I am also not satisfied that the pamphlet shows the phrase “Sold by Eric Latta” being used as a trade-mark in association with

the Opponent's real estate services. As the Opponent must show that use of its trade-mark or trade-name occurred in accordance with s. 4(2) of the Act prior to the Applicant's date of first use, not merely state that it has occurred, this ground is dismissed on the basis that the Opponent has not satisfied its initial burden.

Section 38(2)(d) Ground of Opposition

The Opponent has also pleaded that the Mark is not capable of being distinctive of the Applicant, nor was it adapted to distinguish the services of the Applicant from those of others, including the Opponent.

In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition its trade-mark or trade-name SOLD BY ERIC had become known sufficiently to negate the distinctiveness of the Mark (*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)). A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient; it need not be well known in Canada. (*Bojangles' International, LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.); *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58; *Andres Wines Ltd. v. E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at 130; and *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.) at 424).

The evidence relevant to the Opponent's initial burden can be summarized as follows. Mr. Latta has been a licensed realtor in British Columbia since 1992. In that time, he states that he has been one of the highest producing realtors in what is known as the "North Shore" area of Greater Vancouver, comprising the City of West Vancouver and the City and District of North Vancouver. Information on Mr. Latta's website states that Mr. Latta has over \$250,000,000 in real estate sold.

He asserts that he has used his given name, Eric, in connection with his promotional materials in West Vancouver and North Vancouver for approximately the past 15 years, and that most or all of those materials have contained headings like “Listed by Eric” or “Sold by Eric” or “Recently Sold by Eric” or variations of those words. He further states that in addition to pamphlets, flyers and postcards and his website, he has regularly published advertisements in newspapers, including the North Shore News and the Real Estate Weekly.

From his own experience, Mr. Latta states that he knows the Applicant has been in business as a realtor in West Vancouver for roughly the same amount of time that he has. He further asserts that the Applicant’s office is located at 1555 Marine Drive, West Vancouver, which is only a few doors away from Mr. Latta’s office at 1575 Marine Drive, West Vancouver.

While much of Mr. Latta’s evidence shows use of variations of the Mark SOLD BY ERIC, attached as Exhibit C to his affidavit is a promotional flyer bearing the heading “Sold by Eric” which Mr. Latta states was distributed by bulk mail to residents of West Vancouver, based on their postal codes in the Spring of 2000.

Based on the Opponent’s evidence, I am satisfied that the mark SOLD BY ERIC had acquired some reputation in the West Vancouver area in association with real estate services in the hands of someone other than the Applicant prior to August 24, 2006. I am therefore satisfied that the Opponent has satisfied its initial burden with respect to the distinctiveness ground.

Although the Applicant claims use of its Mark since January, 1999, the Applicant has not provided any evidence showing use of the Mark. The Opponent’s evidence, on the other hand, has shown use of the identical mark by at least one other real estate representative prior to the filing date of the opposition in association with identical services to those of the Applicant. I therefore consider that, at the filing date of the opposition, the Applicant’s Mark was incapable of distinguishing the Applicant’s real estate services from the real estate services of the Opponent. This ground of opposition therefore succeeds.

Opponent's Fifth Ground of Opposition

The Opponent's fifth ground of opposition has been dismissed on the basis that it has been improperly pleaded.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT Gatineau, Quebec, THIS 20th DAY OF May, 2009.

Cindy Folz
Member
Trade-marks Opposition Board