



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

Citation: 2011 TMOB 259
Date of Decision: 2011-12-19

**IN THE MATTER OF AN OPPOSITION by
Desjardins Gestion Internationale D'Actifs
Inc./Desjardins Global Asset Management
Inc. to application No. 1,210,827 for the
trade-mark DGAM & Design in the name of
Diversified Global Asset Management, Inc.**

[1] On March 24, 2004, Diversified Global Asset Management, Inc. (the Applicant) filed an application to register the trade-mark DGAM & Design (the Mark) in association with the following services on the basis of proposed use:

Financial services, namely portfolio management, namely the creation, management, monitoring, and rebalancing of investment portfolios; strategic asset allocation services, namely, devising and recommending allocation of assets among various investment classes; principal and agency investing, namely investing as principal and/or agent in various investment classes; and investment banking, namely acting as principal, agent and/or advisor on the issuance of equity, equity-related, fixed income and other securities, and as principal, agent and/or advisor in respect of strategic transaction (the Services).

[2] The Mark is shown below:



[3] The Mark was advertised for opposition purposes in the *Trade-marks Journal* of November 9, 2005.

[4] On March 10, 2008 Desjardins Gestion Internationale D'Actifs (the Opponent) filed a statement of opposition pleading the grounds set out in s. 38(2)(c)/s. 16(3)(a), and s. 38(2)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), namely:

- (a) That contrary to s. 16(3)(a) the Applicant is not the person entitled to registration of the Mark since at the date of application, the Mark was confusing with the Opponent's previously used trade-mark DGAM in Canada in association with: "investment management services, portfolio management services, portfolio performance review services, portfolio asset allocation services, and development of investment products for third parties."
- (b) That contrary to s. 2 of the Act, the Mark is not distinctive and is not adapted to distinguish the services of the Applicant from the wares and services of others, including the business and services of the Opponent; in view of the use, advertising and making known in Canada of the DGAM and DeGAM trade-marks by the Opponent, and the use of similar trade-marks and trade-names of others.

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

[6] The Opponent filed the affidavit of Ms. Caroline Thomassin on December 8, 2008; this affidavit was subsequently returned to the Opponent pursuant to r. 44(5) of the *Trade-Marks Regulations*, as Ms. Thomassin failed to attend for cross-examination. The Applicant did not file any evidence. Both parties filed written arguments and were represented at an oral hearing.

Discussion

[7] The material dates with respect to the grounds of opposition are as follows:

- (a) Section 38(2)(c)/16(3)(a) of the Act - the filing date of the application;
- (b) Section 38(2)(d)/2 of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

[8] 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[9] In particular, in order for the Opponent to meet its burden under the s. 16(3)(a) ground it must show evidence of use of its mark in Canada with its wares or services prior to the date of filing the subject application. Section 16(3)(a) of the Act reads as follows:

(3) Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the wares or services specified in the application, *unless at the date of filing of the application* it was confusing with:

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person; (emphasis added)

[10] The s. 16(3)(a) grounds are dismissed as the Opponent has not met its initial burden to evidence that its marks were used or made known in Canada at the date of filing of the subject application. In its written argument the Opponent relied on the use statement in its application No. 1,218,638 for the trade-mark DGAM wherein a date of first use is claimed of November 1, 2003. Even if I was prepared to exercise the Registrar's discretion to check the trade-marks register to confirm that this application was extant as of the Applicant's filing date, I cannot accept that a claimed date of first use is *evidence* of use. In this regard, I refer to the reasoning of Member Herzig in *Dimo's Tool & Die Ltd. v. Quantum Electronics Inc.* (2009), 72 C.P.R. (4th) 209 wherein Mr. Herzig dealt with a similar situation as follows:

In particular, the opponent has not evidenced any use of its marks. At the oral hearing, counsel for the opponent requested that I take judicial notice of its two trade-mark applications for the marks MODEL 919 and 919 pleaded in the statement of opposition. I indicated that I would exercise the Registrar's discretion to check the trade-marks register

to confirm that the applications were extant: see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (TMOB) at 529. However, counsel for the opponent also requested that I accept as fact that its marks MODEL 919 and 919 have been used in Canada since 1952 and 1977, respectively, as claimed in the opponent's trade-mark applications. I decline to do so because the Registrar's discretion does not extend so far. Rather, it is the responsibility of the opponent to establish that it has in fact used its marks and to establish the time period of such use. In other words, while the Registrar's discretion may be exercised to take cognizance of the filing of a trade-mark application to support a ground of opposition pursuant to Section 16(3)(b), the Registrar will not take cognizance, on the basis of the application, that a party has in fact been using the mark which is the subject of the application.

[11] I note that this reasoning has also been followed in the recent decision of Member Folz in *Artic Jungle Media v. HTC Corporation*, 2011 TMOB 47.

[12] With respect to the ground of non-distinctiveness, the Opponent must establish that its trade-marks were known sufficiently to negate the distinctiveness of the Applicant's Mark. In the absence of evidence of use, the Opponent has not met this initial burden. This ground is also dismissed.

Disposition

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

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office