

TRADUCTION/TRANSLATION

**IN THE MATTER OF THE OPPOSITION
BY Desjardins Sécurité financière, Compagnie
d'assurance-vie to application No. 1,045,420
filed by Ing Canada Inc. for the registration of
the trade-mark EVOLUPLAN**

Ing Canada Inc. (the “Applicant”), on February 3, 2000, filed an application for the registration of the trade-mark EVOLUPLAN (the “Trade-mark”). The application, based on proposed use, covers the following services: “Financial planning, namely, portfolio and estate management services, securities brokering, group savings brokering, brokering of investment contracts, personal insurance brokerage services”.

The application was published in the *Trade-Marks Journal* dated April 2, 2003 and was the subject of two objections. The opponent in this case, Desjardins Sécurité financière, Compagnie d'assurance-vie (the “Opponent”), filed its statement of objection on May 7, 2003. The Applicant filed a counter statement. The parties have filed no evidence. Only the Applicant filed a written argument and no hearing has been held.

For the purposes herein, I think it is appropriate to reproduce below paragraphs 2 and 3 of the opposition.

[Translation]

2. *The Opponent bases its opposition on the grounds in the Trade-marks Act (the “Act”):*

- (a) Under section 38(2)(a) of the Act, the applicant does not satisfy the requirements of section 30 of the Act in that the applicant could not validly state that it was satisfied that it is entitled to use the trade-mark **EVOLUPLAN** in Canada in association with the services described in the application, having regard to the reasons hereinafter recited;*
- (b) Under section 38(2)(d) of the Act, the trade-mark **EVOLUPLAN** is not distinctive within the meaning of section 2 of the Act and does not distinguish or is not adapted to really distinguish the Applicant’s services from the services of others;*

3. *More particularly, the Applicant's application is not distinctive and is confusing with the trade-mark EVOLUVIE DESJARDINS (TMA329081) used by the Opponent since at least June 19, 1987, the date when it was registered."*

I note that the Opponent explicitly cites sections 38(2)(a) and 38(2)(d) in paragraph 2 of the statement reporting the grounds of opposition. Although paragraph 3 refers to the registered trade-mark EVOLUVIE DESJARDINS, the Opponent has not cited sections 38(2)(b) and 12(1)(d) of the Act. I am aware of the decision in *Sun Squeeze Juices Inc. v. Shenkman* (1990), 34 C.P.R. (3d) 467 (T.M.O.B.), in which it was held that the failure to refer to a section of the Act was inconsequential because it was a somewhat technical point. However, I am of the opinion that this case is distinguishable from *Sun Squeeze*. On the one hand, in that decision the opposition did not refer to any section of the Act while in the present case sections 38(2)(a) and 38(2)(d) were explicitly cited in the opposition. On the other hand, the opposition does not state anywhere that the Trade-mark is not registrable. In my opinion, the grounds of objection are pleaded in paragraph 2 of the opposition and paragraph 3 simply supports the grounds of objection as pleaded. I conclude, therefore, that the Opponent has not raised any ground of opposition based on section 12(1)(d) of the Act and I do not intend to rule on a ground of opposition that has not been raised [see *Imperial Developments Ltd. v. Imperial Oil Limited* (1984), 79 C.P.R. (2d) 12 (F.C.T.D.)].

For whatever purpose it may serve, I note that if a ground of opposition based on section 12(1)(d) of the Act had been raised, it would have been necessary for me to confirm the existence of a registration for the Opponent's trade-mark. It would then have been necessary to examine the relevant circumstances, such as those enumerated in section 6(5) of the Act, to determine whether on a balance of probabilities the Applicant had discharged its onus of demonstrating that there is no risk of confusion between the trade-marks at the date of my decision.

The relevant date for considering the first ground of opposition based on non-compliance with section 30 is the date of filing of the application for registration [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)]. But the Opponent essentially argues that the

Applicant could not validly make the statement required by section 30(i) of the Act because of the risk of confusion with the Opponent's trade-mark. However, the Opponent failed to allege that the Applicant had knowledge of the Opponent's trade-mark. The first ground of opposition is consequently dismissed. I would add that even if knowledge of the Opponent's trade-mark had been pleaded, the ground of opposition would have been dismissed, as the Opponent has not discharged its initial onus to prove that the Applicant knew of its trade-mark at the date of the application. I would also add, and more importantly still, that proof of knowledge of the Opponent's mark by the Applicant would not have been sufficient to conclude that the Applicant could not validly state that it was satisfied it had the right to use the Trade-mark.

It is generally acknowledged that the material date with respect to the lack of distinctiveness was the date of the filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]. Although the onus is on the Applicant to demonstrate that the Trade-mark is distinctive throughout Canada, the Opponent must establish that the trade-mark it cites had become sufficiently known to negate the distinctiveness of the Trade-mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44]. Given that there is no evidence to suggest that the Opponent's trade-mark EVOLUVIE DESJARDINS has acquired a reputation as a result of its use or the promotional activities devoted to it, I find that the Opponent has not discharged its initial onus. Consequently, the ground of opposition based on the lack of distinctiveness is likewise dismissed.

By virtue of the powers delegated to me by the Registrar of Trade-marks under section 63(3) of the Act, I reject the opposition of Desjardins Sécurité financière, Compagnie d'assurance-vie to the application for registration of the Trade-mark, the whole in accordance with the provisions of section 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, MARCH 17, 2006.

Céline Tremblay

Member
Trade Marks Opposition Board.