

**IN THE MATTER OF AN OPPOSITION
by Evergreen Canada-Israel Investments Limited
to application No. 740,609 for the trade-mark
EVERGREEN INVESTMENT SERVICES
filed by The Toronto-Dominion Bank**

On November 3, 1993, the applicant, The Toronto-Dominion Bank, filed an application to register the trade-mark EVERGREEN INVESTMENT SERVICES based on proposed use in Canada. The application covers the following services:

banking, insurance, real estate, securities and computerized data processing services.

The application was amended to include a disclaimer of the words INVESTMENT SERVICES and was subsequently advertised for opposition purposes on July 13, 1994.

The opponent, Evergreen Canada-Israel Investments Limited (“Evergreen Canada”), filed a statement of opposition on December 13, 1994, a copy of which was forwarded to the applicant on February 21, 1995. In its statement of opposition, the opponent relies on the following trade-marks and trade-names:

- (1) EVERGREEN CANADA-ISRAEL INVESTMENTS,**
- (2) EVERGREEN CANADA-ISRAEL INVESTMENTS LIMITED,**
- (3) EVERGREEN CANADA-ISRAEL INVESTMENTS AND COMPANY, LIMITED,**
- (4) EVERGREEN CANADA-ISRAEL INVESTMENTS AND COMPANY, LIMITED / SOCIETE EN COMMANDITE INVESTISSEMENTS EVERGREEN CANADA-ISRAEL ET COMPAGNIE, LIMITEE,**
- (5) EVERGREEN CANADA-ISRAEL MANAGEMENT LIMITED, and**
- (6) EVERGREEN & Design**

used in association with one or more of the following services:

(1) the identification and co-ordination of business and investment opportunities for Canadians in businesses operated by, and security instruments issued by, entities situate in Israel or connected with Israel

(2) the operation and management of an investment pool or funds for the purpose of investing in businesses operated by, and security instruments issued by, entities situate in Israel or connected with Israel

(3) merchant banking services in Israel

(4) the identification and management of foreign investment vehicles for Canadian and Israeli investors.

The opponent's first ground of opposition is that the applicant's application does not comply with Section 30(a) of the Trade-marks Act because it does not contain a statement in ordinary commercial terms of the specific services in association with which the applied for mark is proposed to be used. The second ground of opposition is that the application does not comply with the provisions of Section 30(e) of the Act because the applicant does not use and did not intend to use the applied for mark. The third ground is that the application does not comply with the provisions of Section 30(i) of the Act "...in that the applicant could not have been satisfied that it was entitled to use the trade-mark."

The fourth ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of the character or quality of the services with which it is to be associated or the conditions of or the persons employed in producing those services. The fifth ground is that the applied for trade-mark is not registrable pursuant to Sections 10 and 12(1)(e) of the Act because it is a mark that by ordinary and 'bona fide' commercial usage has become recognized in Canada as designating the kind, quality or value of the services with which it is to be associated or it so nearly resembles that mark as to be likely to be mistaken for it.

The sixth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for mark was confusing with:

- (1) the trade-mark noted above as (1) previously used in Canada by Evergreen Canada for the services noted as (1), (2) and (3) and by its predecessor in title Evergreen Canada-Israel Investments and Company, Limited / Société en Commandite Investissements Evergreen Canada-Israel et Compagnie, Limitée ("the Evergreen Partnership") for the services noted as (1) and (2),**
- (2) the trade-mark noted above as (2) previously used in Canada by Evergreen Canada for the services noted as (1), (2) and (3),**
- (3) the trade-marks noted above as (3) and (4) previously used in Canada by Evergreen**

- Canada and its predecessor in title the Evergreen Partnership for the services noted as (1) and (2),
- (4) the trade-marks noted above as (3) and (4) previously used in Canada by Evergreen Canada-Israel Management Limited (“Evergreen Management”) for the services noted as (1) and (2),
- (5) the trade-mark noted above as (5) previously used in Canada by Evergreen Management for the services noted as (1), (2) and (4),
- (6) the trade-mark noted above as (6) previously used in Canada by Evergreen Canada for the services noted as (1), (2) and (3), by its predecessor in title the Evergreen Partnership for the services noted as (1) and (2) and by Evergreen Management for the services noted as (1), (2) and (4),
- (7) the trade-name noted above as (2) previously used in Canada by Evergreen Canada for the services noted as (1), (2) and (3),
- (8) the trade-names noted above as (3) and (4) previously used in Canada by Evergreen Canada for the services noted above as (1) and (2),
- (9) the trade-names noted above as (3) and (4) previously used in Canada by the Evergreen Partnership for the services noted as (1) and (2),
- (10) the trade-names noted above as (3) and (4) previously used in Canada by Evergreen Management for the services noted as (1) and (2),
- (11) the trade-name noted above as (5) previously used in Canada by Evergreen Management for the services noted as (1), (2) and (4), and
- (12) the trade-name TD Evergreen Investment Services Inc. previously used in Canada by TD Evergreen Investment Services Inc. for the provision of investment brokerage and investment counselling services.

The seventh ground of opposition is that the applicant’s trade-mark is not distinctive of its applied for services in view of:

- (1) the trade-names used by Evergreen Canada and its predecessor in title the Evergreen Partnership for various services,
- (2) the trade-names used by Evergreen Management for various services,

- (3) the trade-name of TD Evergreen Investment Services Inc. used for investment brokerage and investment counselling services,
- (4) the fact that it offends Section 10 of the Act, and
- (5) the fact that it offends Section 12(1)(b) of the Act.

The applicant filed and served a counter statement. The opponent's evidence comprises the affidavits of the following individuals:

David Philip Baskin	Deanna Rosenswig
Philip Heitner	Louise Fast
Robert Mark Gould	Tyler R. Preston
Gary Laforet	Lisa Corbeil (2)
Theresa Butcher	

Messrs. Baskin and Heitner and Mss. Rosenswig and Corbeil were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record of this proceeding.

As its evidence, the applicant submitted an affidavit of Jeffrey R. Carney. Mr. Carney was cross-examined on his affidavit and the transcript of that cross-examination forms part of the record of this opposition. A number of questions put to Mr. Carney were taken under advisement and the applicant subsequently refused to provide answers. Both parties filed a written argument and an oral hearing was conducted on August 18, 1998 at which both parties were represented.

THE OPPONENT'S EVIDENCE

The Baskin Affidavit

In his affidavit, Mr. Baskin identifies himself as the Secretary-Treasurer of the opponent Evergreen Canada and a director of its wholly-owned subsidiary Evergreen Management. He describes the nature of his company's business which is to identify investments in Israel for Canadians and then to manage a pool of funds for making such investments.

Mr. Baskin details the history of his company's business. 156065 Canada Inc. was incorporated on October 29, 1987 and changed its name to Evergreen Canada on November 18, 1992. Evergreen Canada is the general partner of the Evergreen Partnership, a limited partnership formed in Quebec on October 27, 1987 and registered in Ontario on January 10, 1991. 1007053 Ontario Limited was incorporated on November 6, 1992 and changed its name to Evergreen Management on May 7, 1993. In November of 1992, the Evergreen Partnership was restructured. The limited partners (except Evergreen Management) exchanged their limited partnership units for shares in Evergreen Canada. The Evergreen Partnership then continued with Evergreen Canada as the general partner and a limited partner and Evergreen Management as a limited partner.

The Evergreen Partnership commenced business by effecting two private placements of securities, the first in November of 1987 and the second in November of 1990. These were aimed at wealthy investors since the minimum investment was \$150,000. The investors became unit holders and limited partners within the limited partnership. The figures from the annual reports of the Evergreen Partnership appended as exhibits to Mr. Baskin's affidavit suggest that the number of investors is very small, perhaps a few dozen or less.

In his affidavit, Mr. Baskin gives the impression that the opponent Evergreen Canada is the successor to the Evergreen Partnership as a consequence of the restructuring in November of 1992. However, there is no evidence of any transfer of trade-mark or trade-name rights from the Evergreen Partnership to Evergreen Canada nor is there any evidence of any trade-mark or trade-name license. Furthermore, on cross-examination, Mr. Baskin agreed that the business of soliciting investors was carried out in the name of the partnership. Annual reports in the name of the Evergreen Partnership have been sent out to the partners and perhaps 25-50 potential investors a year except for the January 31, 1994 report (see page 28 of the Baskin transcript). Mr. Baskin agreed that the partnership is the one using the partnership name and not the opponent. He also agreed that use of the trade-mark EVERGREEN & Design in Exhibit K to his affidavit and the use of the partnership name in

Exhibit L are uses by the Evergreen Partnership and not by the opponent (see page 31 of the Baskin transcript).

At the oral hearing, the applicant's agent contended that the Evergreen Partnership cannot claim any trade-mark or trade-name use at all because the only services it provided were to its partnership unitholders or, after the November 1992 restructuring, to the shareholders of Evergreen Canada. He drew an analogy to a company soliciting shareholders which activity would not constitute use of an associated trade-mark or trade-name for any services. He further submitted that there was no evidence of the performance of any services by the opponent to Canadian consumers outside the company.

The opponent's agent contended that the opponent has performed services in Canada and that a more appropriate analogy would be to a mutual fund company seeking to sell units in its funds. I agree. Whatever the changing structure of the opponent has been over the years, its Canadian business has included the advertising of an investment service in the form of a fund holding to selected Canadian investors. Thus, I find that the opponent has shown use of at least its trade-name and the trade-mark EVERGREEN & Design for services.

Mr. Baskin evidences one advertisement in the partnership's name which appeared in the February 18, 1988 edition of The Globe and Mail. There are references to the business in articles appearing in two editions of The Financial Post and one edition of The Canadian Jewish News. The first phone listing for the business was in the April 1993-94 Toronto telephone directory.

In his affidavit, Mr. Baskin states that between August and October of 1993, he received twenty to thirty phone calls a month at his Toronto offices asking if Evergreen Canada, Evergreen Management and the Evergreen Partnership were related to or affiliated with TD Evergreen Investment Services Inc. Since that time, he has received about one such call every two weeks. He states that the callers referred to an advertisement that appeared in a Toronto newspaper for a new Evergreen service launched by TD Evergreen Investment

Services Inc. On cross-examination, Mr. Baskin stated that most people were directed to him by the telephone operator, presumably because the Evergreen Partnership was the only listing in the telephone directory including the word “evergreen” for financial services. Furthermore, Mr. Baskin conceded that any confusion was “very surface level.”

In his affidavit, Mr. Baskin also states that the various descriptions in the applicant’s statement of services are too broad. He also provides meanings for the words “evergreen”, “evergreen loan” and “evergreen prospectus” relating to financial services. On cross-examination, however, he conceded that the word “evergreen” by itself doesn’t have a banking meaning and that the general public would have no idea what that word means in relation to banking services. He also agrees that the use of the word “evergreen” by the opponent is not clearly descriptive of investment services. As for the phrases “evergreen loan” and “evergreen prospectus”, it is apparent that they are specialized terms used in commercial banking and in the securities industry.

The Rosenswig Affidavit

In her affidavit, Ms. Rosenswig identifies herself as a Vice-President of the Bank of Montreal and gives her definition of the phrase “evergreen loan.” On cross-examination, she stated that she was unaware of any use of the term “evergreen” ‘per se’ in the banking industry. Furthermore, she stated that the designation TD Evergreen has no particular meaning to her except that it comes from the Toronto-Dominion Bank.

The Heitner Affidavit

In his affidavit, Mr. Heitner identifies himself as President of Bank of Montreal Investment. He provides definitions for the words “evergreen”, “evergreen loan” and “evergreen prospectus.” On cross-examination, he agreed that the nature of the applicant’s services would not be apparent from the use of the word “evergreen” alone. Furthermore, he stated that the designation TD Evergreen does not describe those services.

The Fast Affidavit

The Fast affidavit introduces into evidence copies of the articles from The Financial Post referred to by Mr. Baskin.

The Butcher Affidavit

The Butcher affidavit also evidences the articles from The Financial Post referred to by Mr. Baskin and establishes that the Canadian circulation for the publication was 96,045.

The Gould Affidavit

The Gould affidavit introduces into evidence a copy of the advertisement from The Globe and Mail referred to by Mr. Baskin.

The Preston Affidavit

The Preston affidavit also evidences The Globe and Mail ad.

The Laforet Affidavit

The Laforet affidavit introduces into evidence a copy of the November 24, 1994 issue of The Canadian Jewish News. Mr. Laforet states that the circulation in Ontario for that issue was 28,143.

The First Corbeil Affidavit

In her affidavit, Ms. Corbeil identifies herself as a trade-mark researcher with an intellectual property research firm. She conducted a trade-mark search of her firm's computerized version of the Canadian Trade-marks Office records. She did not check the original records and her search did not produce complete particulars for all entries. Thus, her search results must be given diminished weight.

Ms. Corbeil's search revealed about two dozen registrations for trade-marks comprising or including the word EVERGREEN covering various wares and services. It is noteworthy, however, that none of those registrations covers financial services or the like.

Ms. Corbeil also conducted what she called a common law search which covers a wide variety of trade-mark, trade-name and corporate name sources. Not surprisingly, Ms. Corbeil's search revealed a large number of business entities using the word "evergreen" as part of their names. However, there is no evidence as to whether any of these names are in use or if they are used in association with banking services and the like.

Ms. Corbeil also conducted a search of several dictionaries, atlases and telephone directories. The only dictionary definition for the word "evergreen" located by Ms. Corbeil which relates to financial matters appears in a specialty dictionary entitled Barrons Dictionary of Business Terms which gives the following definition: "revolving line of credit with no clean-up requirement."

The Second Corbeil Affidavit

In her second affidavit, Ms. Corbeil states that she conducted the same types of searches as in her first affidavit but in relation to the words "investment" and "service." Her search of the trade-marks register revealed only a handful of registrations for trade-marks for similar services which include those words or similar words. Her common law search suffers from the same deficiencies as noted above. Her final search revealed the ordinary dictionary meanings for these two words which, in any event, have been disclaimed in the present application.

THE APPLICANT'S EVIDENCE

The Carney Affidavit

In his affidavit, Mr. Carney states he is the President and Chief Operating Officer of TD Evergreen Investment Services ("TD Evergreen") which he identifies as a licensee of the applied for trade-mark and a division of TD Securities Inc., a wholly-owned subsidiary of the applicant. TD Evergreen Investment Services Inc. was incorporated on June 9, 1993 and was amalgamated with Greenline Investment Services Inc. on January 1, 1996 to form TD Securities Inc. (see paragraph 2 of the Carney affidavit and page 3 of the Carney transcript).

Mr. Carney states that TD Evergreen is a full service broker providing various investment vehicles to its clients including GICs, mutual funds and bonds. Its first office was opened in Toronto on September 13, 1993 and, as of the date of Mr. Carney's affidavit (July 19, 1996), there were 33 offices across Canada. TD Evergreen's clientele has grown from about 7,000 active accounts in 1993 to about 35,000 in 1995. Prior to June of 1994, the office signs read Evergreen Investment Services and since then they have read TD Evergreen Investment Services. According to Mr. Carney, promotional and advertising expenses since 1993 have totalled in excess of \$3 million.

Mr. Carney appended several brochures and flyers about the services provided by TD Evergreen. Exhibit A is a July, 1993 flyer which refers to Evergreen Investment Services and states that Evergreen is a wholly-owned subsidiary of The Toronto-Dominion Bank. There is no indication that use of the mark EVERGREEN or the applied for mark is under license from The Toronto-Dominion Bank. Exhibit B is similar.

Exhibit C is a brochure which identifies EVERGREEN as a trade-mark of the applicant and Evergreen Investment Services Inc. as a registered user. On cross-examination, Mr. Carney admitted that this notice was in error since there is no entity named Evergreen Investment Services Inc. In any event, the notice did not refer to the applied for trade-mark.

The later brochure appended as Exhibit D to the Carney affidavit features the trade-mark TD EVERGREEN rather than EVERGREEN which, according to Mr. Carney, was a deliberate change by TD Evergreen. That brochure identifies TD Evergreen Investment Services Inc. as a licensed user of the mark TD EVERGREEN and notes that the company will become TD Evergreen Investment Services, a division of TD Securities Inc. effective January 1, 1996. The two newspaper ads appended as Exhibit F to the Carney affidavit also identify TD Evergreen Investment Services Inc. as a licensed user of the mark TD EVERGREEN.

On cross-examination, Mr. Carney was questioned about the existence of a license from the applicant to TD Evergreen Investment Services Inc. covering use of the EVERGREEN

trade-marks. He stated that there was a license and he was asked to provide a copy of it. The matter was taken under advisement and the applicant chose not to comply with the opponent's request. He was asked to provide a copy of any assignment of an existing license agreement that arose as a consequence of the January 1, 1996 amalgamation. Again, the applicant refused to comply. Similarly, Mr. Carney was asked about any quality control procedures the applicant employed in respect of the use of the marks by TD Evergreen Investment Services Inc. The applicant chose not to provide any such information.

THE GROUNDS OF OPPOSITION

Non-compliance with Section 30(a)

As for the first ground of opposition based on Section 30(a) of the Act, the former Registrar of Trade-marks stated in Dubiner and National Yo-Yo and Bo-Lo Ltd. v. Heede Int'l Ltd. (1975), 23 C.P.R. (2d) 128 that an applicant in its application “must clearly set forth wares or services as they are customarily referred to in the trade (emphasis added).” In this regard, reference may also be made to the opposition decision in Pro Image Sportswear, Inc. v. Pro Image, Inc. (1992), 42 C.P.R.(3d) 566 at 573.

The opponent's only evidence on point is Mr. Baskin's opinion that the descriptions in the applicant's statement of services are too broad. The descriptions “banking services”, “insurance services” and the like do appear to be fairly broad in that they could encompass a wide variety of specific services. But the breadth of a written description is not the determining factor in respect of a statement of services.

The determining factor is the practice of the relevant trade. It may well be that businesses in the financial trades use broad terms such as “banking services” and “insurance services” to describe their business activities to their customers. It was incumbent on the opponent to adduce at least some evidence to show that such is not the case. Since the opponent failed to submit any such evidence, it has failed to satisfy its evidential burden and the first ground of opposition is unsuccessful.

As for the description “real estate services”, the opponent relied on the opposition decision in Sentinel Aluminum Products Co. Ltd. v. Sentinel Pacific Equities Ltd. (1983), 80 C.P.R.(2d) 201 and Chairman Partington’s opinion (at page 206) that such a description is not in ordinary commercial terms. However, that opinion was ‘obiter’ and it does not appear that any evidence on point was submitted in that case.

Non-compliance with Section 30(e)

The opponent's second ground of opposition is based on the provisions of Section 30(e) of the Act. The material time for assessing the applicant's compliance with Section 30(e) is the filing date of its application. As of that date, Section 30(e) read as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing.....
- (e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada.

The onus or legal burden is on the applicant to show its compliance with Section 30(e): see the opposition decisions in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and Canadian National Railway Co. v. Schwauss (1991), 35 C.P.R.(3d) 90 at 94 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(e) of the Act: see page 95 of the Schwauss decision and the opposition decision in Green Spot Co. v. J.B. Food Industries (1986), 13 C.P.R.(3d) 206 at 210-211.

The applicant's application formally complies with Section 30(e) of the Act since the application contains the statement that the applicant intends to use the applied for mark. The issue then becomes whether or not the applicant has substantially complied with Section 30(e) - i.e. - was the applicant's statement that it intended to use the applied for trade-mark true?

From a review of the Carney affidavit and transcript, any use of the applied for mark has been by TD Evergreen Investment Services Inc. and its successor TD Evergreen. It appears that the applicant's intention from the outset was not to use the applied for mark itself but rather to use it through licensees. Thus, one would have expected that the applicant would have amended its trade-mark application to assert its intention to use the applied for mark through its licensee. The applicant chose not to do so.

At the oral hearing, the applicant's agent contended that any deficiencies in the applicant's application or its licensing arrangements is not fatal at this stage and need not be addressed until such time as the application is allowed and a declaration of use is called for. I disagree. Section 30(e) of the Act is explicit in its requirement, presumably to alert the public as to the applicant's planned manner of use of its trade-mark. Furthermore, this requirement provides three alternatives. This allows for a great deal of flexibility since the application may be amended at any time to accommodate a change in the applicant's planned manner of use.

Notwithstanding the apparent deficiency in the applicant's application, there is some evidence suggesting that the use of the applied for mark has been under license from the applicant. For example, the notices appearing in some of the brochures appended to the Carney affidavit appear to meet the requirements of Section 50(2) of the Act such that use of the applied for mark would be presumed to have been under license from the applicant. However, that presumption only stands where the contrary is not proven. In the present case, Mr. Carney was asked to provide documentation and information concerning the alleged license but refused to do so. Thus, I must draw a negative inference and conclude that no such license (written or oral) exists.

In view of the above, I find that the opponent has met its evidential burden respecting the second ground. It was therefore incumbent on the applicant to adduce evidence showing that it intended to use the applied for mark. Alternatively, if it was the applicant's intention to use its mark through a licensee, it was incumbent on the applicant to rectify any defects in its trade-mark application and positively evidence the existence of a licensing arrangement that qualifies under Section 50(1) of the Act. Since the applicant has not done either, it has failed

to satisfy the legal burden on it to show its compliance with Section 30(e) of the Act. The second ground of opposition is therefore successful.

Non-compliance with Section 30(i)

As for the third ground, it does not raise a proper ground of opposition of non-compliance with Section 30(i) of the Act. The opponent did not provide any supporting allegations of fact. The ground is not adequately pleaded, is not in compliance with Section 38(3)(a) of the Act and is therefore unsuccessful.

Non-registrability pursuant to Section 12(1)(b)

As for the opponent's fourth ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). Furthermore, the issue is to be determined from the point of view of an everyday user of the services. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

The fourth ground does not raise a proper ground of opposition and is contrary to Section 38(3)(a) of the Act. The opponent failed to set forth any allegations of fact in support of its assertion that the applied for mark contravenes the provisions of Section 12(1)(b) of the Act. Thus, the fourth ground is unsuccessful.

Based on the opponent's evidence, presumably it wished to allege that the applied for mark offends Section 12(1)(b) of the Act because the word "evergreen" has a known meaning in the context of financial services. Although three of the opponent's affiants state that the word "evergreen" alone has a known meaning in the context of financial services, each affiant conceded on cross-examination that such is not the case. The phrases "evergreen loan" and "evergreen prospectus" do have meanings within the financial community but they are

specialized terms known only to a few. As noted by the applicant, even the staff reporter for The Canadian Jewish News who wrote the article about the opponent which appeared in the “Business & Finance” section of the paper (see page 41 of Exhibit A to the Laforet affidavit) assumed that the word “evergreen” was adopted by the opponent as part of its name because of its meaning in relation to a type of tree and not because of a possible financial meaning. The cross-examinations support the contention that the everyday user of the applicant’s services would not, as a matter of first impression, give any meaning to the word “evergreen” relating to financial services when viewing the applicant’s trade-mark. Furthermore, even if the word “evergreen” was found to offend Section 12(1)(b) of the Act, the applied for trade-mark as a whole does not. Thus, even if the fourth ground had been adequately pleaded, it would have been unsuccessful.

Non-registrability pursuant to Sections 10 and 12(1)(e)

As for the fifth ground of opposition, the opponent asserts that the applied for trade-mark is not registrable pursuant to Section 12(1)(e) because it contravenes Section 10 of the Act which reads as follows:

Where any mark has by ordinary and 'bona fide' commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trademark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

The relevant date for determining the “ordinary and *bona fide* commercial usage” of the mark for the purposes of Section 10 would appear to be the date of my decision: see Olympus Optical Company Ltd. v. Canadian Olympic Association (1991), 38 C.P.R. (3d) 1 at 3-4 (F.C.A.).

The fifth ground does not raise a proper ground of opposition and is contrary to Section 38(3)(a) of the Act. The opponent did not identify the prohibited mark. More importantly, it did not include any supporting allegations of fact. Thus, the fifth ground is unsuccessful.

Presumably, the opponent intended to identify the prohibited mark as EVERGREEN and to allege that it has come to be recognized in Canada as designating a certain kind of financial services. As discussed, the opponent’s evidence does not support such a contention.

Thus, even if adequately pleaded, the fifth ground would have been unsuccessful.

Prior entitlement pursuant to Section 16(3)

There are twelve sub-headings under the opponent's sixth ground of opposition. Sub-headings (4), (9) through (12) and the second aspect of (6) are all unsuccessful in view of the provisions of Section 17(1) of the Act. An opponent cannot assert a ground of prior entitlement pursuant to Section 16(3) of the Act based on prior use of a trade-mark or trade-name by an entity other than itself or its predecessor in title.

As for sub-headings (1) through (3) and (5), the evidence does not show use of any of the alleged trade-marks by anyone much less the opponent. The alleged marks do appear in various materials but always as trade-names and not as trade-marks. Thus, sub-headings (1) through (3) and (5) are unsuccessful.

As for the first aspect of sub-heading (6), there is evidence of use of the trade-mark EVERGREEN & Design in association with the offering of securities prior to the applicant's filing date. However, that use was by the Evergreen Partnership rather than the opponent Evergreen Canada. The opponent contends that the opponent can rely on the use by the Evergreen Partnership as its predecessor in title. As previously discussed, however, the evidence does not support the opponent's position. There is no evidence of a transfer or assignment of rights to the trade-mark EVERGREEN & Design from the Evergreen Partnership to Evergreen Canada. Furthermore, there is no evidence of use of the mark by the Evergreen Partnership under license from Evergreen Canada. Thus, the first aspect of sub-heading (6) is also unsuccessful.

The opponent contended that it should succeed, in any event, because it is one of the partners of the Evergreen Partnership and all partners benefit from the actions of the partnership. While this may be true of many aspects of a partnership arrangement, it is not true with respect to trade-mark use and ownership. A partnership qualifies as a person under the Trade-marks Act: see Mayborn Products Ltd. v. Registrar of Trade Marks (1983), 70 C.P.R.(2d) 1 at 10 (F.C.T.D.). Alternatively, it qualifies as a person pursuant to Section 2 of the Act as being a "lawful association engaged in trade or business." Furthermore, use of a trade-mark or trade-name by a partnership does not constitute use of the mark or name by any of the individual partners: see Garant v. Abba Fashions Inc. (1984), 1 C.P.R.(3d) 550 at 553 (T.M.O.B.). To hold otherwise would mean that any trade-mark or trade-name used by

a partnership would be rendered non-distinctive by the common use of the mark or name by all of the partners.

As for sub-headings (7) and (8), the opponent has failed to establish that it has acquired successor rights to the trade-names relied on. Alternatively, it has failed to evidence use by others of those names under license from it prior to the applicant's filing date. Thus, sub-headings (7) and (8) are also unsuccessful.

Non-distinctiveness

As for the seventh ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - December 13, 1994): see 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.).

As of the material time, the Evergreen Partnership, Evergreen Canada and Evergreen Management had made only minor use of the trade-names relied on. As previously noted, there are only a small number of investors in the Evergreen Partnership. There has only been one newspaper advertisement in The Globe and Mail and several mentions of the partnership in articles in two other periodicals. Promotion of the business appears to have been primarily through the distribution of annual reports, brochures and the like to a limited number of potential investors. Thus, as of the material time, only a handful of Canadians were aware of the Evergreen Partnership, Evergreen Canada or Evergreen Management.

The applicant has failed to evidence a reputation for its applied for mark in its own hands. Rather, as discussed, the trade-mark has been used by TD Evergreen Investment Services Inc. and the applicant has failed to establish that such use was under license from it. There was fairly significant use of the applied for mark prior to the material time due to the rapid expansion of the business across Canada. Thus, the trade-mark EVERGREEN

INVESTMENT SERVICES was known to some extent as of that date but in the hands of TD Evergreen Investment Services Inc. rather than The Toronto-Dominion Bank.

I have given little weight to the opponent's evidence of actual mistake or confusion as between the marks at issue. As noted by the applicant's agent, this is far from the best evidence since Mr. Baskin did not know what was in the minds of the callers. As discussed, it appears that the incidents evidenced by Mr. Baskin arose primarily due to the fact that the trade-marks EVERGREEN, TD EVERGREEN and the like were being heavily advertised in the Toronto area in the latter part of 1993 and the only Toronto telephone listing for a financial enterprise using the word Evergreen was for the Evergreen Partnership. As also discussed, it appears that most of the callers were directed to the opponent by a telephone operator. Finally, as conceded by Mr. Baskin, any confusion that arose was superficial.

In view of the fact that there was at least a minor reputation for the trade-names used by the Evergreen Partnership, Evergreen Canada and Evergreen Management among a handful of investors and in view of the fact that there was a significant reputation for the trade-marks EVERGREEN, TDEVERGREEN and the like used by TD Evergreen Investment Services Inc. in the investment community, I find that the applicant's applied for mark EVERGREEN INVESTMENT SERVICES was not adapted to distinguish its services from those of others. The seventh ground is therefore successful. Had the applicant been able to rely on the use of the various EVERGREEN marks by TD Evergreen Investment Services Inc. as its own pursuant to Section 50(1), my conclusion respecting this ground may well have been different.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 11th DAY OF SEPTEMBER, 1998.

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