

**IN THE MATTER OF AN OPPOSITION  
by Bank of Montreal to application No.  
1,143,700 for the trade-mark THE  
WEALTH MOSAIC filed by 1114871  
Ontario Inc.**

On June 11, 2002, 1114871 Ontario Inc. (the “Applicant”) filed an application to register the trade-mark THE WEALTH MOSAIC (the “Mark”). The application is based upon proposed use of the Mark in Canada in association with the following wares and services:

Wares: Workbooks, questionnaires and manuals, audio and video cassettes and discs, and computer software related to an educational program of financial planning and financial management for individuals and/or companies.

Services: Conducting a program for educating and guiding individuals and/or companies in financial planning and financial management.

The application was advertised for opposition purposes in the Trade-marks Journal of January 14, 2004.

On February 24, 2004, Bank of Montreal (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the allegations contained in the statement of opposition.

The Opponent filed an affidavit of Nancy Marescotti and a certified copy of registration No. TMA571,286 pursuant to r. 41 of the *Trade-marks Regulations (1996)*.

The Applicant filed an affidavit of George J. Primak pursuant to r. 42. Mr. Primak was cross-examined on his affidavit and a copy of the transcript of the cross-examination forms part of the record.

The Opponent also filed an affidavit of Jennifer Galeano and certified copies of three documents

pursuant to r. 43.

Each party filed a written argument. An oral hearing was held in which only the Opponent participated.

#### Preliminary Discussion re Primak Affidavit

Mr. Primak identifies himself as “a trade-mark agent with the firm Primak & Co. which represents the applicant in this opposition.” He discusses how he received instructions to conduct a trade-mark search for the Mark and then proceeded to file the present application. His affidavit discusses the prosecution of the application, including how he dealt with an objection from the Examiner based on the Opponent’s mark. He provides multiple meanings for the word “mosaic”, a Yellow Pages search for businesses in Canada with “mosaic” in their trade-name, a federal corporations data on-line search, information about a number of companies that came from the Internet or some other source, and information concerning his own MOSAIK MASTERCARD credit card.

As argued by the Opponent, there are some admissibility issues with respect to Mr. Primak’s affidavit. First, the Opponent has pointed out that the concerns raised by the Federal Court of Appeal in *Cross-Canada Auto Body Supply v. Hyundai*, 2006 FCA 133 apply here because the Applicant’s sole evidence has been presented through the agent representing it in this proceeding. I recognize that Mr. Primak’s affidavit was filed before the issuance of that decision but the concerns addressed by the Court still apply. I am therefore according reduced weight to Mr. Primak’s evidence due to the potential lack of objectivity and the fact that the majority of Mr. Primak’s evidence relates to contentious issues. Second, the Opponent has pointed out that there are hearsay issues with respect to the information that Mr. Primak obtained from websites. Mr. Primak refers to such information as if the information set out in the websites has been proven, but the exhibits extracted from the Internet can only be relied upon as proof of the existence of the websites, not as proof of the truth of their contents [*Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446; *ITV Technologies Inc. v. WIC Television Ltd.* 2003 FC 1056].

### Onus

An applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”). There is however an initial burden on an opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [*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.)]

### Grounds of Opposition

The Opponent has pleaded six grounds of opposition, each of which turns on the issue of the likelihood of confusion between the Mark and the Opponent’s trade-mark/trade-name MOSAIK. The Opponent has pleaded that it has previously used and registered MOSAIK as a trade-mark in Canada, and in this regard refers to registration No. TMA571,286 which covers banking services.

The grounds of opposition are as follows:

1. non-compliance with s. 30(i) in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied-for wares and services;
2. non-registrability under s. 12(1)(d) based on the Opponent’s registration No. TMA571,286;
3. non-entitlement under s. 16(3)(a) due to confusion with the Opponent’s previously used MOSAIK mark;
4. non-entitlement under s. 16(3)(b) due to confusion with the MOSAIK mark in respect of which an application for registration had been previously filed in Canada by the Opponent;
5. non-entitlement under s. 16(3)(c) due to confusion with the MOSAIK trade-name previously used in Canada by the Opponent;
6. non-distinctiveness, for the reasons set forth above.

### Section 12(1)(d) Ground of Opposition

The material date with respect to this ground of opposition is today's date. [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]

As the Opponent's registration is in good standing, the Opponent has met its initial burden.

#### *the test for confusion*

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion.]

I shall now assess each of the surrounding circumstances.

#### *s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

The Applicant has introduced evidence concerning the use of the word "mosaic" as a reference to Canadian culture, but the word "mosaic", or its phonetic equivalent "mosaik", has no meaning that relates to financial matters. The Opponent's mark is accordingly inherently distinctive.

The Applicant's Mark is slightly less inherently distinctive due to the inclusion of the descriptive word "wealth".

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is no evidence that the Applicant's Mark has been used or promoted to date. In contrast, there is considerable evidence concerning the use and promotion of the Opponent's MOSAIK mark.

Ms. Marescotti, the Opponent's Manager of Brand Marketing and Enhancements, attests that the Opponent has offered banking services in Canada in association with the MOSAIK mark since at least as early as August 2002. Ms. Marescotti provides the number of clients accessing the MOSAIK banking services in each province for each of the fiscal years of 2002, 2003 and 2004; the total across Canada in each of those three years exceeded three million. This equated to more than 42 billion dollars of sales charged to MOSAIK credit cards in Canada during the three years.

During the same three-year period, the Opponent spent more than 40 million dollars advertising and promoting its MOSAIK services in Canada. Examples of the advertising and promotional materials have been provided.

It is clear that a consideration of the extent to which each mark has become known favours the Opponent.

*s. 6(5)(b) - the length of time each trade-mark has been in use*

This factor favours the Opponent as it claims use of its mark in Canada since at least as early as August 2002, whereas the Applicant does not claim to have used its Mark to date.

*s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade*

The Opponent's registration covers "banking services" whereas the Applicant's application covers the services of "conducting a program for educating and guiding individuals and/or

companies in financial planning and financial management” and the wares of “workbooks, questionnaires and manuals, audio and video cassettes and discs, and computer software related to an educational program of financial planning and financial management for individuals and/or companies”.

According to the evidence, the Opponent is “a full service banking institution offering personal finance, business banking and corporate and institutional services inclusive of financial planning and financial management for both individual and business clients.” Ms. Marescotti describes the banking services that are associated with the Opponent’s MOSAIK mark as including “customized credit card services offering reward programs, selective interest rate plans, personal choice of card design and a full range of travel protection and emergency medical financial assistance services together with extended warranty insurance and purchase protection.” The Applicant’s agent/affiant has agreed that credit card services are part of banking services. (Question 97, Primak cross-examination)

There is no direct evidence of the nature of the Applicant’s business and so it is best determined by reference to the statement of wares and services set out in the Applicant’s application.

During cross-examination, the Applicant’s agent/affiant agreed that financial planning might be an element of service offered by a bank and that banks would offer their clients, whether individuals or companies, financial management services to help them manage their finances. (Question 46) He also agreed that it would be reasonable to assume that banks in the context of providing financial planning or financial management services might also provide products, such as brochures or booklets, to assist their clients in financial planning and financial management, to provide them with information. (Question 47)

Overall it appears that the Applicant’s proposed wares and services are closer in nature to parts of the Opponent’s general banking business, rather than to the specific banking service with which the Opponent presently uses its MOSAIK mark, *i.e.* credit card services. Nevertheless, when considering the wares, services and trades of the parties, it is the statement of wares or services in the parties’ trade-mark application or registration that govern in respect of the issue of

confusion arising under s. 12(1)(d). [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

*s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

The two marks differ primarily as a result of the Applicant's Mark including the leading words THE WEALTH. Although the first component of a mark is often considered more important for the purpose of distinction, when a word is a common, descriptive or suggestive word (as is the case here), the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4<sup>th</sup>) 109 (T.M.O.B.)].

I therefore find that the degree of resemblance between the two marks is fairly high in all respects. The different spelling of MOSAIC and MOSAIK does not serve to distinguish THE WEALTH MOSAIC from MOSAIK.

*other surrounding circumstances*

The Applicant relies on the state of the register and state of the marketplace evidence in support of its argument that confusion between the two marks is unlikely. I shall therefore assess such evidence.

Mr. Primak conducted a Google search of the Internet directed to the word "mosaic"; hundreds of thousands of hits were shown but those search results are meaningless as Mr. Primak did not provide a copy of the full results and it is impossible to know if any of the "hits" relate to services being offered in Canada in the field of the Opponent or the Applicant. The search instead merely confirms that the word "mosaic" is a common, dictionary word.

Mr. Primak has also provided the results of an Internet search of YellowPages.ca, which revealed 62 businesses having the word “mosaic” in their trade-name. However, even if I disregarded any hearsay issues with respect to this evidence, it would still be of no assistance to the Applicant because not one of those businesses is identified as being in the financial field (the majority seem to be concerned with ceramic tiles).

Mr. Primak has provided Internet pages concerning one Mosaic business that he says is a venture capital fund firm, but it appears that he has derived his information about this company from the Internet and, as indicated earlier, information located on the Internet can only be introduced as evidence of its appearance on the Internet, not as evidence of its truth.

Mr. Primak has also provided the results of a Federal Corporations Data On-line search, which list 21 companies with the word MOSAIC in their name. However, a good number of these companies are listed as “dissolved” and regarding the remainder, there is no evidence that they are in fields related to those of the present parties, or that they have acquired any reputation in Canada, or even that they are presently carrying on business.

Overall, I find that the evidence introduced by Mr. Primak on the topic of third party users of marks or names incorporating the word “mosaic” is insufficient to enable me to conclude that Canadians are used to distinguishing between one MOSAIC/K mark and another with respect to services that relate to financial matters.

Regarding the state of the register, Mr. Primak provides a copy of the report that he gave to his client in 2002, prior to filing the present application. There is a reference in that report to him having located 19 trade-mark applications or registrations for marks that include the word MOSAIC, but details of those 19 marks have not been provided. I therefore am unable to assess their relevancy.



*conclusion re likelihood of confusion*

“If there is doubt whether the registration of a trademark would cause confusion with a prior mark the doubt must be resolved against the newcomer.” [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]

In the present case, the Applicant has essentially taken the Opponent’s mark in its entirety and added non-distinctive words to it. Both parties are in the financial field and the evidence does not support a conclusion that MOSAIC/MOSAIK has been commonly used by others in this field. Although the Opponent may have only used MOSAIK to date with banking services in the form of credit card services, its registration gives it the exclusive right to use MOSAIK in association with any type of banking service, and banking services include services similar to those proposed by the Applicant. Moreover, there is evidence of significant use and promotion of the Opponent’s mark as opposed to no evidence of use or promotion of the Applicant’s Mark.

I therefore conclude that the Applicant has not satisfied its burden under s. 12(1)(d). Accordingly, this ground of opposition succeeds.

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 TORONTO, ONTARIO, THIS 20th DAY OF DECEMBER 2007.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board