



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

**Citation: 2017 TMOB 57**  
**Date of Decision: 2017-05-31**

**IN THE MATTER OF AN OPPOSITION**

<b>Opus Corporation</b>	<b>Opponent(s)</b>
<b>and</b>	
<b>HomeOpus Inc.</b>	<b>Applicant</b>
<b>1,615,813 for HOMEOPUS</b>	<b>Application</b>

[1] Opus Corporation opposes registration of the trade-mark HOMEOPUS (the Mark), that is the subject of application No. 1,615,813 by HomeOpus Inc.

[2] The application was filed based on proposed use of the Mark in Canada in association with goods that can generally be described as software in the field of residential real estate, and a variety of services also in the field of residential real estate, a complete listing of which is provided under Schedule A to this decision.

[3] The Opponent has opposed the application for the Mark on the basis that: (i) the application does not conform to the requirements of section 30 of the Trade-marks Act, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(b) of the Act; (iii) the Mark is not registrable under section 12(1)(d) of the Act; (iv) the Applicant is not the person

entitled to registration of the Mark under section 16 of the Act; and (v) the Mark is not distinctive under section 2 of the Act.

[4] The last three grounds of opposition turn on the likelihood of confusion between the Mark and the Opponent's prior use and registration of the trade-mark OPUS (registration No. TMA451,117), registered in association with the services, "Building site selection, space planning, interior and exterior design, building construction and property development, building energy analysis, building refrigeration design, and property management and leasing". The Opponent also relies on prior use of its trade-names OPUS BUILDING CORPORATION and/or OPUS CORPORATION in association with such services. The Opponent claims continuous use of its trade-mark and trade-names since at least as early as May 1983.

[5] For the reasons that follow, I refuse the application.

#### The Record, Onus and Material Dates

[6] The application for the Mark was filed on February 26, 2013.

[7] The application was advertised for opposition purposes in the Trade-marks Journal dated May 28, 2014. On June 20, 2014, the Opponent filed a statement of opposition to oppose it under section 38 of the Act. The Applicant then filed and served its counter statement on August 20, 2014.

[8] In support of its opposition, the Opponent filed the affidavit of Hannes Kovac, sworn on December 18, 2014, together with Exhibits 1 through 19. Mr. Kovac was not cross-examined on his affidavit.

[9] In support of its application, the Applicant filed the affidavit of Jason Paul, sworn on July 14, 2015, together with Exhibits A through N, and the affidavit of Heather A. Frydenlund, also sworn on July 14, 2015, together with Exhibits A through I. Neither affiant was cross-examined on their affidavit.

[10] As its reply evidence, the Opponent filed the affidavit of Elaine McGowan, sworn July 30, 2015, together with Exhibits A1, A2, A3, and B1. She was also not cross-examined on her affidavit.

[11] Both parties filed written arguments and were represented at a hearing.

[12] 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 be reasonably concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

[13] With respect to the grounds of opposition, it is the following material dates that apply:

- Sections 38(2)(a)/30(e) – the filing date of the application, namely, February 26, 2013 [see *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 at 94 (TMOB);
- Sections 38(2)(b)/12(1)(b) – the filing date of the application, namely, February 26, 2013 [see *Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021, 28 CPR (4th) 60];
- Sections 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1981), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3)(a) and (c) – the filing date of the application, namely, February 26, 2013 [see section 16(3) of the Act]; and
- Sections 38(2)(d)/2 – the date of filing of the statement of opposition, namely, June 20, 2014 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

### Overview of the Parties' Evidence

[14] Throughout my discussion of the evidence as it applies to the analysis of the grounds of opposition, I will not refer to or place any weight on any statements made by the affiants which

constitute opinions on issues that go to the merit of the opposition [see *British Drug Houses Ltd v Battle Pharmaceuticals* (1944), 4 CPR 48 at 53 and *Les Marchands Deco Inc v Societe Chimique Laurentide Inc* (1984), 2 CPR (3d) 25 (TMOB)].

### *The Opponent's Evidence*

#### *The Kovac Affidavit*

[15] Mr. Kovac is the President and Chief Executive Officer of the Opponent.

[16] The Opponent, Mr. Kovac explains, is a Calgary-based full-service real estate developer that has been operating in Western Canada since 1983, having developed over 20 million square feet of buildings since its inception. He further explains that the Opponent operates from British Columbia to Ontario in the mixed use, commercial, office, industrial and retail real estate fields. In support, he attaches as Exhibit 1 to his affidavit, what he attests are representative pages from the Opponent's "About Us" brochure published on the Opponent's website at [www.opuscorp.ca](http://www.opuscorp.ca).

[17] Mr. Kovac then attests that prior to the filing of the Applicant's application for the Mark, the Opponent used the OPUS mark continuously since at least as early as 1983, a registration for which was obtained in Canada under No. TMA451,117. He attaches a certified copy of the mark as Exhibit 2 to his affidavit.

[18] Mr. Kovac attests that in addition to the registered services, since at least as early as 2009, the Opponent has offered, in association with the OPUS mark, pre-construction services, construction services, and special project services to its clients. These services, Mr. Kovac explains, include an array of services, which I will describe generally as encompassing financial analysis and planning, project management, and renovation-oriented services. In support, Mr. Kovac attaches as Exhibit 4 to his affidavit, a representative copy of the "Construction Services" page of the Opponent's website outlining the above-noted services. Mr. Kovac explains that also since at least as early as 2009, the Opponent has used software to offer property management services to clients. In support, he attaches as Exhibits 5 and 6 to his affidavit respectively, a representative copy of the Property Management Services brochure and a representative copy of the Property Management Services page from the Opponent's website.

[19] Additionally, Mr. Kovac states that since at least as early as 2006, the Opponent has provided educational services in the field of real estate through conference presentations. In support he provides as Exhibit 7, copies of the Calgary Real Estate Forum program for the years 2006, and 2008 through 2012, and a copy of a presentation for the year 2007 where the Opponent provided information and education in the field of real estate. Mr. Kovac refers to all of the above services (including the registered services) as the “OPUS Services”.

[20] With respect to sales, Mr. Kovac states that since May 1983, sales in Canada of some or all of the OPUS Services have never been discontinued. Among the Opponent’s consumers, he attests, are real estate brokers, agents, owner, and developers, institutional investors and their advisors, banks, mortgage companies and individual land owners. He provides a lengthy list “of some of the clients whom have retained Opus for the provision of some or all of the Opus Services”. He states that the recognition and popularity of the OPUS mark is evidenced by the significant and extensive sales in Canada of the OPUS Services over the last several years. In support, he provides general sales figures for the Opponent for the year 2006 (approximately \$180 million) and for 2013 (approximately \$50.4 million), and states that in 2014, annual revenue is expected to be approximately \$46 million. He does not, however, provide a breakdown of sales per service.

[21] With respect to advertising of the OPUS mark, Mr. Kovac defines advertising and promotion of the OPUS mark as referring to promotional literature or publications, print advertisements, promotional merchandise and items, and promotional or advertising gifts. He provides a summary of advertising expenditures in association with the OPUS mark by the Opponent and its affiliated entities for the years 2002 to 2013, ranging from \$157,406 to a peak of \$476,660. He attests that these expenditures include expenditures on promotional events, print and online advertising and marketing materials and sponsorships targeted toward the general public, clients and prospective clients. As examples, Mr. Kovac states that the Opponent markets, advertises and promotes the OPUS Services:

- On the OPUS website and has done so since October 30, 2009. He states that the website, which prominently displays the OPUS mark and is accessible to all Canadians, describes some or all of the OPUS Services offered in Canada;

- Through brochures which prominently display the OPUS mark, which he states are distributed to current clients and the general public in Canada. He provides copies of representative brochures as Exhibit 8;
- In various business and trade magazines and publications throughout Canada, representative advertisements of which are attached as Exhibit 9. Mr. Kovac provides Canadian readership statistics with respect to one such publication [*Business in Calgary*, with a readership of approximately 167,500 per month];
- Through presentations, conferences, and speaking events provided for consumers throughout Canada. Mr. Kovac provides at Exhibit 10, representative copies of one such presentation delivered in 2007 at the Calgary Real Estate Forum, as well as copies of the Calgary Real Estate Forum programs for the years 2008 and 2010;
- Through promotional items distributed to consumers at various events sponsored by the Opponent. In support, Mr. Kovac provides as Exhibit 11, photographs of promotional items such as briefcases, t-shirts, labels, and note pads, together with distribution figures and approximate dates of first use; and
- In all of the Opponent's communications with Canadian clients. As an example, he attaches as Exhibit 12, a copy of the Opponent's letterhead and an envelope, both of which prominently feature the OPUS mark. Mr. Kovac states that in communicating, performing, and advertising the Opponent's services for Canadian clients, he regularly conducts business and promotional e-mail communications with current and prospective clients. He further states that most e-mail communications from himself and the Opponent's 30 Canadian employees with Canadian clients feature the OPUS mark above the signature line where the employee name appears. In support, he provides as Exhibit 13, a copy of one such email sent to a client of the Opponent.

[22] Lastly, Mr. Kovac states that the Opponent's OPUS mark has become well known in the real estate industry over the last 30 years. Further to this, he states that the Opponent has become a well known source of construction, development and real estate services having developed a strong reputation in Canada as demonstrated through:

- Numerous references to the OPUS mark and some or all of the Opponent's services made in various Canadian publications. In support, he provides a list of such publications and

attaches copies of articles from these publications under Exhibit 14. The list includes both electronic and traditional hard copy publications, as well as associated publication dates;

- The Opponent's involvement in many large and well known real estate projects, a listing of which he provides, together with associated dates and locations, as well as pages from the Opponent's website referring to such projects attached as Exhibit 15;
- The Opponent's involvement in charitable, not-for profit and fundraising services for various organizations. In support, he provides a list of 27 such entities to which the Opponent provided financial support and assistance between 2001 and 2014.

Additionally, he provides as Exhibit 16, a copy of an article published in the September 10, 2010 edition of the *Calgary Herald* newspaper regarding the Opponent's participation in the "Easter Seals Rappel Challenge"; and

- Numerous industry awards in the areas of construction development and real estate services, evidence of three such awards in the form of press releases and advertisements he attaches as Exhibits 17, 18, and 19.

### *The Applicant's Evidence*

#### *The Frydenlund Affidavit*

[23] Ms. Frydenlund is an articling student at the agents for the Applicant. She attests that she conducted research of the term "OPUS", and provides the following results of her research:

Exhibit A – a copy of search results obtained from the Canadian Trade-marks Database, from searching the term "OPUS" conducted on July 10, 2015. Ms. Frydenlund states that 151 hits were obtained from this search. She highlights seven results in particular, that are registered, allowed, abandoned, or expunged, all of which she attests "contain the term "OPUS" and relate to services in the realm of real estate"

Exhibit B – copies of the search results for the seven "OPUS" marks Ms. Frydenlund highlighted from the search results under Exhibit A.

Exhibit C – a copy of search results obtained from a NUANS Corporate Name Search in Alberta for the term "OPUS" conducted on July 10, 2015. Ms. Frydenlund states that the search engine returned 100 hits. She then highlights 17 such results which she attests are

Canadian businesses having registered names which contain the term “OPUS” and appear to relate to services in the realm of real estate.

Exhibit D – copies of the online information Ms. Frydenlund located in relation to the 17 search results she highlighted from the Exhibit C NUANS search.

Exhibit E – a copy of the search results obtained from the website *www.yellowpages.ca* conducted on July 13, 2015 with respect to the term “OPUS”. Ms. Frydenlund attests that this search yielded 27 results when searching “ALL REGIONS” and 29 results when searching “ALBERTA”. She states that upon review of the search results, there are five Canadian businesses that contain the term “OPUS”, which were not located through the NUANS search and which appear to provide services in the realm of real estate. She then highlights several such examples.

Exhibit F – copies of the online information Ms. Frydenlund located in relation to the search results she highlighted from the Exhibit E *www.yellowpages.ca* search.

Exhibit G – a copy of the first page of search results obtained from a search for the term “OPUS” on *www.google.ca* that Ms. Frydenlund conducted on July 13, 2015. She states that the search returned more than 92 million results. She states that she reviewed the first ten pages of the search results and other than the multiple businesses highlighted from the other above-noted searches, there is at least one further Canadian company with a name that contains the term “OPUS” and which relates to services in the realm of real estate.

Exhibit H – a copy of the online information concerning the one Canadian company identified from the *www.google.ca* search noted above. Ms. Frydenlund identifies the company as Opus International Consultants, and states that the company appears to be an international multi-disciplinary infrastructure consultancy with clients in Canada, which offers services such as development, planning, detailed design, procurement, construction, commissioning, operation, maintenance, rehabilitation and upgrading.

Exhibit I – a copy of the first ten pages of search results Ms. Frydenlund conducted on *www.google.ca* for the term “HOMEOPUS” on July 13, 2015. She states that she reviewed these pages and found no reference to Opus Corporation.



*The Paul Affidavit*

[24] Mr. Paul is the President and sole shareholder and director of the Applicant. He states that since 2008, he has worked as a successful residential real estate agent in Edmonton, and that a big contributor to his success has been the implementation of an online residential real estate search system for consumers.

[25] Mr. Paul then describes the history of the creation of the Mark, attesting that after being inspired in late 2008 by specified real estate websites, he started working on a business idea for a “finely-tuned search parameter online residential real estate search system”. He states that after much brainstorming, Google and domain name searches to rule out potentially conflicting trademarks, and through the use of a thesaurus, he came up with the name HOMEOPUS for his planned business. He explains that he had never heard of the Opponent until these proceedings were commenced, thus, the Opponent’s existence, name and reputation played no role in his selection of the HOMEOPUS name.

[26] Mr. Paul attests that on March 22, 2009, he purchased the domain name “*homeopus.com*”, along with other similar domain names with different extensions for use by his business. As confirmation of the “*homeopus.com*” domain registration, he provides as Exhibit A, a printout from *whois.net*. He states that pending development of the HOMEOPUS website, visitors to this website were redirected to his personal website, *jasonpaul.com*, from which he advertises and promotes his real estate agent business in Edmonton.

[27] Mr. Paul explains that in developing his business plan in 2009, he decided that HOMEOPUS would involve a website platform, software programs and smartphone/tablet applications to provide searchable real estate information, referrals to those involved in residential real estate, online appraisals and mortgage calculators, and advertising and marketing for residential real estate listings. He further explain that in March 2009, he and his business partner sought out the services of a website designer for the HOMEOPUS business, and completed a business plan and pricing strategy with respect to HOMEOPUS products and services. He states that on July 29, 2009, they incorporated HOMEOPUS REAL ESTATE SERVICES LTD. (see Exhibit C for copy of the certificate of incorporation and related documents).

[28] Following incorporation, Mr. Paul attests that on April 22, 2010, he created a HOMEOPUS Twitter account (see Exhibit D for a screenshot of the account page taken on July 9, 2015). However, he explains that due to the passing of his business partner on September 26, 2010, the HOMEOPUS business plans were derailed for a period of time, until he arranged to have HOMEOPUS Inc. incorporated as an Alberta corporation on October 24, 2012 (see Exhibit E for the certificate of incorporation). He attests that since that time, he has worked on the HOMEOPUS logo concept and hired a designer who completed the HOMEOPUS logo in April 2015, a copy of which he attaches under Exhibit G. He attests that in June 2015, the HOMEOPUS logo was prominently displayed on the exterior of his residential real estate agency office, a recent photograph of which he provides under Exhibit H. He states that he has told those who have visited his office and have been exposed to the HOMEOPUS logo about what HomeOpus Inc. will offer in terms of goods and services.

[29] Mr. Paul states that he has no intention for the Applicant to enter the commercial real estate field, and provides a copy of an email sent to the Opponent in this regard under Exhibit I, as well as a copy of a revised application (Exhibit J) submitted to the Registrar amending the statement of goods and services in the application to reflect that they are related to residential real estate. He further attests that he has reviewed Mr. Kovac's affidavit as well as the Opponent's website (excerpts of which he attaches as Exhibits K through N) and provides comments in response, essentially and generally arguing that the Opponent's evidence shows that the Opponent is in the "commercial" real estate field, not the "residential" real estate field. Among other comments, he states that from his experience as a residential real estate agent that "almost no realtors and very few brokerages simultaneously work in both the residential and commercial real estate markets". He further attests that the Opponent's website indicates that its services "will more often than not be in the range of millions of dollars when developing commercial-scale buildings", and that the Opponent's services cannot be obtained online.

[30] Mr. Paul attests that he believes based on a review of the search results under the Frydenlund affidavit, that the term "OPUS" is used by numerous businesses related to real estate. He provides a list of more than a dozen such entities from the Frydenlund affidavit search results in this regard.

[31] Lastly, Mr. Paul concludes his affidavit by providing comments with respect to confusion between the parties' marks, including differences with respect to goods and services, channels of trade, etc. He states that "despite my years promoting HOMEOPUS through word of mouth and other methods mentioned in this Affidavit to multiple individuals, no one has ever expressed any confusion to me as to whether HOMEOPUS and Opus are related in any way".

*The Opponent's Reply Evidence*

*The McGowan Affidavit*

[32] Ms. McGowan is a legal assistant employed by the agents for the Opponent.

[33] Ms. McGowan states that on July 30, 2015, she searched the domain *www.homeopus.com* on the Wayback Machine Internet archive. She attaches the following documents located in her search:

Exhibit A1 – a printout from the homepage of the Wayback Machine Internet archive.

Exhibit A2 – a printout of the calendar view on the Wayback Machine Internet archive identifying specific dates of archived versions of the HOMEOPUS website (*http://www.homeopus.com*).

Exhibit A3 – a printout of the archived version of the HOMEOPUS website dated February 7, 2011 identifying the redirection to *http://www.jasonpaul.ca* and a printout of the archived version of such website.

[34] Lastly, Ms. McGowan attests that she conducted a search of *www.homeopus.com* through the Internet Explorer web browser. She attaches the results of this search under Exhibit B1.

## Grounds of Opposition

### Section 30(e)

[35] The Opponent has pleaded that the Applicant's application is contrary to section 30(e) of the Act, in that at the time of filing of the application, namely February 26, 2013, the Applicant did not intend to use the Mark in Canada in association with the goods and services.

[36] In its submissions, the Opponent further specified that at the time of filing of the application, the Applicant did not intend to use the Mark in Canada in association with the goods and services, but rather had already used the Mark in Canada as of that date. The Opponent submits that both the Applicant's own evidence, as well as the McGowan affidavit support that such use predated the filing date. The Opponent submits that a series of decisions support the proposition that a proposed use application will be refused where the evidence points to use of the applied-for-mark in advance of the filing date [citing *Tone-Craft Paints Ltd v Du-Chem Paint Co* (1969), 62 CPR 283 (TMOB); *Airwick Industries Inc v Metzner* (1982), 74 CPR (2d) 55 (TMOB); *Société Nationale Elf Acquitaine v Spex Design Inc* (1988), 22 CPR (3d) 189 (TMOB); *Frisco-Findus SA v Diners Delite Foods Ltd* (1989), 26 CPR (3d) 556 (TMOB); *Canada Post Corporation v IBAX Inc* (2001), 12 CPR (4th) 562 (TMOB); and *Nabisco Brands Ltd – Nabisco Brands Ltée v Cuda Consolidated Inc* (1997), 81 CPR (3d) 537 (TMOB)].

[37] Section 30(e) of the Act requires an applicant to make a statement that it, either by itself or through a licensee intends to use the applied-for trade-mark in Canada. In the present case, the application contains such a statement. The application therefore formally complies with section 30(e) of the Act. The question then becomes whether the Applicant has substantively complied with section 30(e) of the Act; i.e. was the statement true?

[38] Since it is difficult to prove a negative, and certainly more so in a case of a proposed use application, the initial burden upon an opponent with respect to a ground of opposition based upon non-compliance with section 30(e) is a relatively light one [see *Molson Canada v Anheuser-Busch Inc*, 2003 FC 1287, 29 CPR (4th) 315]. Further, an opponent may rely upon the applicant's evidence to meet its initial burden, but the opponent must show that the applicant's

evidence is clearly inconsistent with the applicant's claim [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc.*, (2001), 13 CPR (4th) 156 (TMOB)].

[39] In the present case, as previously indicated, the Opponent is relying upon both the Applicant's own evidence, as well as the McGowan affidavit as evidence that the Applicant had commenced use of the applied-for-mark prior to the date of filing of the application. In this regard, the Opponent submits that the Applicant's own evidence shows that the Mark was used prior to the filing date through the incorporation of the Mark into the domain name *www.homeopus.com*. The Opponent notes that Mr. Paul himself attests that the *homeopus.com* domain was purchased on March 22, 2009, wherein visitors to this site were redirected to Mr. Paul's personal website *jasonpaul.com* through which he advertised, promoted and offered the services. Further to this, the Opponent submits that the McGowan affidavit clearly shows that the *homeopus.com* website redirect was available since at least as early as February 7, 2011; that is, visitors to the *homeopus.com* site were redirected to Mr. Paul's personal website used to advertise and promote his business as a residential real estate agent more than two years prior to the date of filing of the application. The Opponent submits that the incorporation of a trade-mark into a domain name constitutes use in association with services if immediately linked to substantial information about the services, as in the present case [citing *Salam Toronto Publications v Salam Toronto Inc.*, 2009 FC 24]. Thus, the Opponent submits, the use of the Mark as part of the domain name *www.homeopus.com* amounts to use of the Mark prior to the filing date.

[40] The Applicant submits that its evidence only suggests that there is an intention to use the Mark. The Applicant submits that it was not incorporated until 2012 and it is clear that it did not offer any of the services. The Applicant submits that the evidence of website redirection is all before the Applicant was incorporated and, in any event, the Mark neither appears on the *jasonpaul.com* website itself nor in the domain name *jasonpaul.com*. The Applicant submits that any reasonable consumer would see this as promotion of the *jasonpaul* name or RE/MAX, the real estate agency where he works. The Applicant submits that the evidence is clear that HomeOpus Inc. is only going to be in a position to offer the services after the proceedings are dealt with, and the *jasonpaul.com* website mentions nothing about mortgage services, advertising and referral services. To the extent that the website touches on brokerage or searching systems,

the Applicant submits that the evidence is clear that these services themselves are offered by Jason Paul or RE/MAX and not HomeOpus Inc.

[41] With respect to the case law relied upon by the Opponent, the Applicant submits that prior use has to be use by the Applicant itself and that the evidence is clear that HomeOpus Inc. was not in a position to offer any of the services. Further to this, the Applicant submits, and I agree, that *Salam, supra* is distinguishable in that the evidence showed that the trade-mark at issue was presented prominently on the website, both in the domain name *and* in the website content itself, which was *directly* linked to the services in question and redirected to a site where once again the trade-mark was displayed prominently in the website content. The Applicant submits that the redirection to *jasonpaul.com* has no mention of the Mark on this site nor does it include information as to any goods or services offered by the Applicant. The Applicant also relies on *AM Ford Sales Ltd v 7268769 Canada Inc*, 2010 TMOB 154, where it was held that use of a trade-mark within a domain name which redirects to another website was not enough to show previous use of a trade-mark. In particular, in this case, I note there was no direct connection between the trade-mark and the services pleaded, and it was held that the domain name was not being used in print advertisements as a trade-mark with respect to these services, but rather would be perceived as contact information or a business name with respect to other services.

[42] I note further that in *McMillan LLP v SportsLine.com, Inc*, 2014 TMOB 51, a case wherein the trade-mark at issue was incorporated into several domain names which then resolved to a different URL, it was held not to constitute use of the mark. In particular, as in the present case, the trade-mark at issue, as part of the original URL, was not displayed in association with the services accessible via the registrant's website after the redirect. Furthermore, the Registrar has previously found that the mere registration of a domain name does not constitute use of a trade-mark for purposes of section 4 of the Act [see *Sun Media Corporation v The Montreal Sun (Journal Anglophone) Inc*, 2011 CarswellNat 940 (TMOB); and *4358376 Canada Inc v 770879 Ontario Ltd*, 2012 CarswellNat 5263 (TMOB)].

[43] Having regard to the foregoing, I agree with the Applicant and do not consider that the mere appearance of the Mark within a domain name constitutes use of the Mark pursuant to

section 4(2) of the Act. Not only does the Mark itself not stand out apart from the domain name, as previously mentioned, it does not appear anywhere on the redirected website itself in connection with any particular service.

[44] The Applicant submits that as the Opponent has not filed any evidence whatsoever in support of this ground of opposition, it has accordingly failed to meet its initial evidential burden. In any event, the Applicant submits and I agree, the application as filed contains a statement that the Applicant by itself or through a licensee, or by itself and through a licensee intends to use the Mark in Canada and there is no evidence that the Applicant had any other intention at the filing date. Further, there is evidence that the Applicant started planning its HOMEOPUS business, through which the Mark would be used, in 2008, and took steps to implement this plan through hiring a consultant to design a website, creating a HOMEOPUS twitter account, creating HOMEOPUS companies in 2009 and 2012, developing a logo and prominently displaying the logo and otherwise promoting the HOMEOPUS business concept to the present time. Accordingly, there is clear evidence of an ongoing intention to use the Mark in association with the Applicant's goods and services.

[45] Accordingly, the section 30(e) ground is dismissed for the Opponent's failure to meet its burden.

#### Section 12(1)(b)

[46] The Opponent has pleaded that the Mark is not registrable having regard to section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the Applicant's goods and services.

[47] The test under section 12(1)(b) of the Act considers whether the trade-mark as a whole is clearly descriptive or deceptively misdescriptive of the character or quality of the goods or services in association with which it is used or proposed to be used. The trade-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 CPR (2d) 25 (FCTD) at 27-8; and *Atlantic Promotions Inc v Registrar of Trade-marks*, 2 CPR (3d) 183 (FCTD) at 186], from the point of view of the average purchaser

of those goods or services, and in context with the goods and services with which the trade-mark is associated. “Character” means a feature, trait or characteristic of the goods or services and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 34]. To be found to be deceptively misdescriptive, a mark must first be found to be descriptive [see *Oshawa Group Ltd v Canada (Registrar of Trade-marks)*, (1980) 46 CPR (2d) 145 at 148 (FCTD)]. Lastly, if only part of a trade-mark is objectionable, the trade-mark as a whole may still be registrable provided that the objectionable part does not so dominate the applied-for trade-mark as a whole such that the trade-mark would thereby be precluded from registration [see *Canadian Council of Professional Engineers v John Brooks Co* (2004), 2004 FC 586 (CanLII), 35 CPR (4th) 507].

[48] In the present case, the Opponent’s pleading merely reproduces the language of section 12(1)(b) of the Act and therefore merely pleads a conclusion of law and is insufficient for not providing any supporting allegations of fact [see *Faber-Castell Canada Inc v Binney & Smith Inc* (1991), 36 CPR (3d) 388]. Moreover, the Opponent has not led any argument or evidence in this regard.

[49] In any event, I am permitted to apply common sense when assessing the trade-mark with respect to registrability under section 12(1)(b) of the Act, including having resort to dictionary definitions. However, in the present case, I agree with the Applicant that while the word “home” itself suggests a relationship with residential real estate, when combined with “opus”, forms a coined mark that when viewed as a whole, does not describe the types of goods or services associated with the Mark.

[50] Having regard to the foregoing, the section 12(1)(b) ground of opposition is dismissed due to the Opponent’s failure to meet its evidential burden.

#### Section 12(1)(d)

[51] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with its OPUS registration No. TMA451,117.



[52] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which as previously indicated is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp, supra*].

[53] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark OPUS.

*The test for confusion*

[54] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[55] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 (SCC) at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

*Section 6(5)(a) – the inherent distinctiveness and the extent to which the marks have become known*

[56] The overall consideration of the section 6(5)(a) factor, involves a combination of inherent and acquired distinctiveness of the parties' marks.

[57] The Applicant submits that the Mark is a coined word and therefore has high inherent distinctiveness, especially as compared to the Opponent's trade-mark, which is simply a known

English word. Further to this, the Applicant submits, that as per the evidence submitted, the term “OPUS” has been fairly commonly used in the real estate industry, such that, by itself, it is not overly distinctive, and it would be inappropriate to apply a strict monopoly to the use of the term in this realm.

[58] The Mark is a coined word, albeit a combination of two ordinary words in the English language. Although the word HOME is related to the goods and services in the sense that they are directed at the *residential* market, it is the Mark as a whole that must be considered, and the word OPUS does not have any direct connotation with respect to any of the associated goods or services. To illustrate, the definition of the word OPUS as found in *The Canadian Oxford Dictionary*, 2<sup>nd</sup> edition is as follows:

1 Music a separate musical composition or set of compositions of any kind . ■ used before a number given to a composer's work, usu. indicating the order of publication . ( Abbr.: Op. ) 2 any artistic or creative work (compare magnum opus) . – origin Latin, = work...

[59] As such, I consider both parties’ marks have a measure of inherent distinctiveness, with the Applicant’s Mark having a higher degree of inherent distinctiveness by virtue of the inclusion of the word HOME in forming a coined term. However, I consider the addition of the word HOME only marginally increases the inherent distinctiveness of the Mark, as I agree with the Opponent that the word HOME is arguably descriptive, particularly in the field of real estate.

[60] With respect to the Applicant’s submissions regarding common use of the term OPUS in the real estate industry, I will address this evidence under additional surrounding circumstances.

[61] The Opponent on the other hand, focusses its submissions on acquired distinctiveness, and submits insofar as the section 12(1)(d) ground is concerned, that its OPUS mark has acquired distinctiveness through use and promotion in Canada by the Opponent in association with the registered services since at least as early as May, 1983. In this regard, it relies on evidence of advertising expenditures totalling more than \$3.5 million between the years 2002 and 2013. In addition, the Opponent submits that it has clearly established that it has maintained significant market share in the real estate industry and especially as it relates to the number of significant

real estate projects which have been designed, developed and constructed by the Opponent, going back to 1996.

[62] The Applicant challenges this evidence, submitting that there is no corroborating evidence as to use of the Opponent's mark until 2002, when advertising expenses were apparently incurred. Further to this, the Applicant submits that the evidence provided by the Opponent is lacking in several key areas, which mitigate strongly against any finding of its trade-mark having established a significant reputation. For example, aside from the evidence being limited predominantly to Alberta, the Applicant submits that the evidence does not indicate how many individuals would have been reached by or exposed to the Opponent's mark through the advertising and promotion mechanisms shown in the evidence. Furthermore, the Applicant submits that the relevance of the list of projects in Mr. Kovac's Affidavit is ambiguous. In this regard, the Applicant submits that being "involved" with real estate projects, primarily Calgary and with only one outside of Alberta is not evidence of having developed "a strong reputation throughout Canada" as claimed by the Opponent.

[63] To counter, the Opponent submits that Mr. Kovac attests to use of its mark with the services and the proper approach is to consider the evidence in its entirety. The Opponent refers to readership statistics provided by Mr. Kovac of over 100,000 (*Business in Calgary* publication), which it submits is substantial. Further to this, the Opponent submits that there can be no question as to the Opponent's use and display of its mark in Canada; this is evidenced by real estate projects in Richmond, BC and in Edmonton and Calgary, Alberta. The Opponent submits that there is no need to go back further than 2002 as it has provided 11 years of advertising expenditures to demonstrate use and reputation. Lastly the Opponent submits that there is no data from the Applicant regarding its advertising expenditures. Accordingly, the Opponent submits that this factor favours the Opponent.

[64] I agree with the Opponent that it is the evidence as a whole that must be considered, and despite the Applicant's submissions, it is clear that the Opponent's OPUS mark has been used for a number of years. Although the Opponent has only provided advertising expenditures going back to 2002, and use appears to be geographically centered in a few population centres (albeit predominantly Calgary), it is clear that the Opponent has advertised, offered and performed the

registered services in association with the OPUS mark. Further to this, significant sales figures with regard to the OPUS services have been provided. As such, I conclude that the Opponent's OPUS mark has acquired at least some measure of distinctiveness, if not well-known, in Calgary.

[65] Having regard to the foregoing, the Applicant's Mark has only a marginally greater degree of inherent distinctiveness, whereas by contrast, the Opponent's Mark has become known to a significant extent in the above-noted geographic areas and thus has acquired distinctiveness. Consequently, I find this factor favours the Opponent.

*Section 6(5)(b) – the length of time of use*

[66] As per my review of the Kovac affidavit and having regard to my analysis under section 6(5)(a) of the Act, I conclude that the Opponent has shown use of its OPUS trade-mark in association with the registered services over a lengthy period of time.

[67] Accordingly, I find that this factor strongly favours the Opponent.

*Sections 6(5)(c) and (d) – the nature of the services and business or trade*

[68] It is the Applicant's statement of services as defined in its application versus the Opponent's registered goods and services that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. These statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. However, evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[69] The Opponent submits that there is no question that both parties offer real estate and ancillary real estate goods and services. The Opponent submits that its OPUS mark is used in association with, among other things, property management and leasing services, building construction and property development and is recognized as a full-service real estate developer. The Opponent submits that when comparing the goods and services and trade, the proper focus is the terms of application, since what is at issue is what the registration would authorize the

Applicant to do [see *Mattel, supra* at para 53, and *Masterpiece, supra* at paras 51-59].

Accordingly, the goods and services listed in the Application include, among other things, real estate brokerage services and mortgage brokerage services, computer software and software applications which are targeted to real estate professionals and the general public. The Opponent submits that the nature of the goods and services of the parties fall squarely within the same general class, namely, real estate and ancillary real estate services and given the Opponent's extensive use of the OPUS mark, there is a high likelihood that consumers will assume the Applicant's residential real estate goods and services are approved, licensed or sponsored by the Opponent.

[70] The Applicant on the other hand submits that the parties' goods and services are completely different. Furthermore, the Applicant submits that it is in the field of *residential* real estate, which is in contrast to the Opponent, a builder and property manager, who deals with *commercial* properties. The Applicant submits that someone who is looking for a house and one who is looking for commercial development opportunities would be more discerning, even on first impression. That is, the Applicant's goods and services relate to finding other goods and services that are likely of substantial personal importance and potential expense to customers – the purchase or improvement of one's home. Similarly, the Applicant submits, the Opponent's services relate to matters of great commercial importance and expense to businesses; thus, consumers who would be confronting the Applicant's Mark and the Opponent's mark will likely be highly discerning as to what they are purchasing and from whom and as a result, any small differences between the trade-marks at issue would be enough to distinguish them in the mind of the reasonable consumer at issue. In addition, the Applicant submits, these stark differences carry over to the very different channels of trade of the parties. Specifically, the Applicant submits, the parties' goods and services are available through different means; one accessible to anyone online and free of charge and the other through direct consultation and negotiation of detailed contracts and pricing structures that, even for small and mid-sized projects, cost in the millions of dollars.

[71] The Opponent submits that despite the Applicant's aforementioned submissions, Exhibits A3 and B1 (printouts from *homeopus.com*) of the McGowan affidavit are examples of how *residential* and *commercial* real estate services are likely to overlap, as this evidence

demonstrates that Mr. Paul's own website lists both industrial and residential properties. However, contrary to the Opponent's submission, I do not see anything on these printouts which clearly relates to commercial real estate.

[72] In any event, the Opponent submits that while it is primarily involved in commercial real estate, it does offer its services to a wide-range of consumers as evidenced by its offering of educational services at forums (see Exhibits 7 and 10 of the Kovac affidavit) which provide information and education to the residential and commercial real estate markets as a whole. Lastly, the Opponent submits, arguably many of the professionals targeted by the parties (*i.e.* – brokers, agents, etc.) cater to both the residential and commercial markets and, as such, the parties are likely to offer their respective goods and services to identical consumers.

[73] While there is nothing in the evidence to support this latter submission, and educational services are not included in the Opponent's registration relied upon, I consider that this evidence at the very least demonstrates, whether residential or commercial, there is potential for overlap. The fact remains that both parties' goods and services pertain to the field of real estate and ancillary services, and it is conceivable that the Applicant's services, could be viewed as an extension from the Opponent's commercial market into the residential forum. Furthermore, I find that the differences in the nature and channels of trade of the parties do not detract from this conclusion.

[74] Accordingly, I find this factor favours the Opponent.

*Section 6(5)(e) – degree of resemblance in appearance, when sounded, or in idea suggested*

[75] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totalities; it is not the correct approach to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks. The Supreme Court of Canada in *Masterpiece, supra* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[76] The Applicant submits that it is clear that the first portion of the Mark, “HOME”, causes there to be very little similarity between the marks at issue, both visually and when sounded. Furthermore, the Applicant submits, that the parties’ marks suggest different ideas; the Applicant’s Mark suggesting goods or services related to a person’s house, while the Opponent’s mark evokes the idea of a musical composition.

[77] The Opponent submits that while the first word may be most important in some cases, per *Masterpiece, supra*, the most striking or unique portion of both parties’ marks in this case is the word OPUS. I agree. In this regard, the word OPUS bears no clear meaning in association with the parties’ goods or services, and given the descriptive nature of the word HOME as discussed in the analysis under section 6(5)(a) of the Act, I do not find the addition of the word HOME serves to diminish the resemblance between the parties’ marks [see *Reno-Dépôt Inc v Homer TLC Inc* (2009), 2010 TMOB 11 (CanLII), 84 CPR (4th) 58 (TMOB) at para 58].

[78] Accordingly, having regard to the foregoing, this factor favours the Opponent.

#### *Additional Surrounding Circumstances*

##### *Lack of Actual Confusion*

[79] In his affidavit, Mr. Paul states “despite the fact that I have promoted HOMEOPUS Inc. (and the previous HOMEOPUS company) and the related Mark for years with multiple individuals, no one has ever expressed any confusion to me as to whether the HOMEOPUS business and brand are in any way related to Opus”.

[80] However, an adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the opponent [see *Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA)]. In the present case, there is no evidence that the Applicant has used the Mark. Furthermore, any promotion of the Mark in association with yet to be offered goods and services has been quite minimal.

*State of the Register and Marketplace*

[81] As previously indicated, the Applicant submits that as per the evidence submitted, the term “OPUS” has been fairly commonly used in the real estate industry to the extent that it would be inappropriate to apply a strict monopoly to the use of the term in this realm. In this regard, the Applicant’s evidence consists of search results for the term OPUS attached under Exhibits A through I of the Frydenlund affidavit. As summarized above, these searches include searches of the Canadian Trade-marks Database, NUANS Corporate Name Search in Alberta, *yellowpages.ca*, and *Google.ca*.

[82] With respect to the search results obtained through the Canadian Trade-marks Database, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); and *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[83] In the present case, although 151 results were obtained per the Frydenlund affidavit, I note that particulars of only seven of those results have been provided with respect to marks which Ms. Frydenlund attests “contain the term “OPUS” and relate to services in the realm of real estate”. Of these seven results however, I note that one has been abandoned, and two others are, in fact, owned by the Opponent (notwithstanding, one of which, is expunged).

[84] The Opponent submits, and I agree, that these results should be given little weight. There are simply too few relevant marks to draw any inferences concerning the state of the marketplace from the state of the register evidence filed.

[85] I am also of the view that the remaining search results (NUANS, *yellowpages.ca* and *Google.ca*) are of little assistance to the Applicant. In this regard, with respect to the 100 NUANS search results attached under Exhibit C to the Frydenlund affidavit, I agree with the Opponent that there is no evidence that many of the businesses located are active, that such names are in use in Canada or being used as trade-marks, or of the nature of the goods or services connected with these businesses. Furthermore, upon review of the 17 NUANS search



results under Exhibit D to the Frydenlund affidavit, which she specifically identified as relating to the realm of real estate, many of the results relate to businesses that offer goods and/or services that I consider are sufficiently distinct from the Opponent, such as flooring, wood working, custom glass products, and landscaping services. The same holds true with respect to the *yellowpages.ca* and *Google.ca* searches. In the end, there are simply too few *potentially* relevant examples. As such, absent further particulars, I am not prepared to conclude that the foregoing evidence demonstrates widespread use of the term OPUS in the realm of real estate.

### *Conclusion*

[86] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In the present case, I have concluded that the parties' marks share a high degree of resemblance, given that the Applicant has taken the Opponent's mark in its entirety and merely added a word that is clearly descriptive of the goods and services to which it is associated. Furthermore, the parties' goods and services are related, the state of the register evidence is simply insufficient to draw any meaningful inferences regarding the state of the marketplace, and the marketplace evidence is insufficient to demonstrate widespread use of the term OPUS with respect to real estate. Having regard to the foregoing, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark. Accordingly, the ground of opposition based on 12(1)(d) of the Act is successful.

### Sections 16(3)(a) and (c)

[87] With respect to these grounds of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark and trade-names prior to the Applicant's filing date and non-abandonment of its trade-mark and trade-names as of the date of advertisement of the Applicant's application [section 16(5) of the Act].

[88] The difference in material dates under the section 12(1)(d) ground of opposition does not impact my analysis under these grounds. More particularly, with respect to the section 16(3)(a) ground of opposition, notwithstanding the inclusion of additional unregistered services in the Opponent's evidence and submissions, this ground of opposition is successful for the same

reasons as those identified above in the analysis of the section 12(1)(d) ground of opposition. In any event, I will add that I accept that the Opponent's evidence also demonstrates use of its OPUS trade-mark in association with the additional unregistered services (*i.e.* – pre-construction, construction, property management and educational services in the field of real estate). As I find these services are an extension of or related to the registered services and therefore, also fall within the real estate realm, I consider there to be overlap once again with the Applicant's goods and services. Thus, for the same reasons as those identified above in the analysis of the section 12(1)(d) ground of opposition, this ground of opposition is also successful with regards to these additional unregistered services.

[89] With respect to the section 16(3)(c) ground of opposition, as previously indicated, the Opponent relies on prior use of its trade-names OPUS BUILDING CORPORATION and/or OPUS CORPORATION.

[90] The Applicant submits that the Opponent has not met its evidential burden, particularly with respect to the trade-name "OPUS BUILDING CORPORATION". In this regard, the Applicant notes that Mr. Kovac states in his affidavit that Opus Building Corporation assigned the Opponent's trade-mark to the Opponent in 2009, who then licensed the use of the mark back to Opus Building Corporation. This attestation, the Applicant submits, indicates that Opus Building Corporation and the Opponent are two separate legal entities, as opposed to one legal entity that owns a trade-name. Further to this, the Applicant submits that there is no evidence of use of "OPUS BUILDING CORPORATION" in any respect after 2009, indicating that this trade-name was abandoned before the date of advertisement of the Mark. In any event, the Applicant submits, the trade-names relied upon by the Opponent are not confusing with the Mark, for similar reasons as given with respect to the section 12(1)(d) ground.

[91] The Opponent has made no submissions with respect to its trade-name use. I note however, that the trade-name OPUS BUILDING CORPORATION does not appear in the evidence beyond examples in an archived 2006 Calgary Real Estate Forum program attached under Exhibit 7 to the Kovac affidavit. Following this, Mr. Kovac instead appears to be the President and CEO of Opus Building Canada Inc. according to archived 2008, 2009, and 2010 Calgary Real Estate Forum programs, and then of OPUS Corporation, according to an archived

2012 Calgary Real Estate Forum program, all of which are also attached under Exhibit 7 to his affidavit. In any event, the trade-name OPUS Corporation does appear in the 2012 Calgary Real Estate Forum program, as well as on advertisements attached under Exhibit 9 to the Kovac affidavit, which pre-date the filing date of the application for the Mark. Consequently, I accept that the Opponent has shown use of its trade-name OPUS Corporation prior to the filing date of the application for the Mark and has thus satisfied its initial burden under this ground. As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the date of filing of the Applicant's application, namely, February 26, 2013, there was not a reasonable likelihood of confusion between its Mark and the Opponent's trade-name OPUS Corporation.

[92] As previously mentioned, the difference in material date under the section 12(1)(d) ground of opposition does not impact my analysis under this ground, and my findings under the ground of opposition based on section 12(1)(d) of the Act are once again equally applicable. Indeed, while the Applicant has argued that the differences between the Mark and the Opponent's trade-name in appearance, ideas, and when sounded are more pronounced, I am still of the view that the term OPUS is the most striking portion of the Mark and the Opponent's trade-name.

[93] Having regard to the foregoing, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's OPUS Corporation trade-name as of the filing date of the application. Accordingly, the ground of opposition based on section 16(3)(c) of the Act is also successful.

#### Non-distinctiveness Ground of Opposition

[94] The Opponent has pleaded that the Mark is not distinctive of the Applicant in that it is not adapted to distinguish and does not actually distinguish the goods and services of the Applicant from the services the Opponent, having regard to the use and advertisement by the Opponent of the Opponent's OPUS trade-mark and trade-names.

[95] There is an initial evidential burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground. Once the burden has been met, there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods and services from those of others [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 298; *Muffin Houses Incorporated v The Muffin House Bakery Ltd*, (1985) 4 CPR (3d) 272 (TMOB); *Imperial Tobacco Canada Limited v Philip Morris Products SA*, 2013 TMOB 175 (TMOB) para 24, aff'd 2014 FC 1237 para 15-16 and 68; and *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2013 FC 608 para 55].

[96] In order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, June 20, 2014, the Opponent's OPUS trade-marks and/or trade-name had become known to such an extent that it could negate the distinctiveness of the Mark. In *Bojangles' International, LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC) at para 33, the Federal Court provided that a mark could negate another mark's distinctiveness if it was known to some extent in Canada or alternatively, if it is well known in a specific area of Canada. In doing so, it is not necessary that the Opponent show that its OPUS marks and/or trade-name had become well known in Canada in the technical sense of Section 5 of the Act. Indeed, the Opponent may rely on evidence of knowledge or reputation of its mark and/or trade-name(s) spread by means of word of mouth and evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles as opposed to advertising [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58-59].

[97] In the present case, I accept that the Opponent has provided evidence of use of its OPUS trade-mark and OPUS Corporation trade-name. Furthermore, as per my analysis under the section 12(1)(d) and non-entitlement grounds of opposition, I accept that the Opponent's OPUS trade-mark and the OPUS Corporation trade-name have become well known in association with the real estate associated services in at least Calgary, Alberta. This is supported by evidence of substantial sales and advertising expenditures, multiple references in various publications, as well as the Opponent's numerous real estate development projects over the years, which are predominantly Calgary-based. Thus, I accept that the Opponent has met its evidential burden under this ground of opposition.

[98] Since I am satisfied that the Opponent's evidence establishes that its OPUS trade-mark and trade-name had become sufficiently known as of June 20, 2014 to negate the distinctiveness of the Mark, the issue becomes whether the Applicant has satisfied its legal onus to show that the Mark was not reasonably likely to cause confusion with the Opponent's trade-mark and/or trade-name.

[99] Once again, the difference in material dates is not significant, and as a result, my findings under the grounds of opposition based on sections 12(1)(d) and 16(3)(a) and (c) are equally applicable here. Accordingly, the ground of opposition based on non-distinctiveness is successful.

### Disposition

[100] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Kathryn Barnett  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**SCHEDULE A**

<u>Application No.</u>	<u>Trade-mark</u>	<u>Goods and Services</u>
1,615,813	HOMEOPUS	<p><u>Goods:</u></p> <p>(1) Software applications (apps) for mobile phones, e-readers, tablets, lap top and personal computers and other hand held electronic devices to provide information, tools, and resources, in the field of residential real estate, namely residential real estate listings, display of residential property information, and searching for residential real estate professionals and the public.</p> <p>(2) Search engine software for residential real estate, namely residential real estate listings, display of residential property information, and residential real estate professionals.</p> <p>(3) Computer software for residential real estate that performs the following functions: a) online referral management system for: residential real estate mortgage brokerages, residential real estate brokerages, and residential real estate professionals such as residential real estate mortgage brokers, residential real estate lawyers, residential real estate insurance brokers, residential real estate property inspectors, residential real estate contractors, residential real estate realtors, residential real estate property managers, residential real estate builders, residential real estate home improvement, and residential real estate developers; b) online appraisal and market estimate system for residential real estate; c) residential real estate mortgage calculators; d) professional process guide and template system for residential real estate referral services and residential real estate professionals such as residential real estate mortgage brokers, residential real estate brokers, residential real estate lawyers, residential real estate insurance brokers, residential real estate property inspectors, residential real estate contractors, residential real estate realtors, residential real estate brokers, residential real estate property managers, residential real estate builders, residential real estate home improvement, and residential real estate developers; e) creates residential real estate related website templates and designs with integrated data for residential real estate referral services, such as residential real estate mortgage broker referral and residential real estate broker referral, and other residential real estate related services such as residential real estate lawyers, residential real estate insurance brokers, residential real estate property</p>

	<p>inspectors, residential real estate contractors, residential real estate realtors, residential real estate brokers, residential real estate property managers, residential real estate builders, residential real estate home improvement, and residential real estate developers.</p> <p><u>Services:</u></p> <p>(1) Residential real estate brokerage.</p> <p>(2) Residential real estate mortgage brokerage.</p> <p>(3) Residential real estate referral services, namely residential real estate insurance referral, residential real estate mortgage broker referral, residential real estate broker referral and referrals for other residential real estate related services such as residential real estate lawyers, residential real estate insurance brokers, residential real estate property inspectors, residential real estate contractors, residential real estate realtors, residential real estate brokers, residential real estate property managers, residential real estate builders, residential real estate home improvement, and residential real estate developers.</p> <p>(4) Searching and listing service for residential real estate listings such as: residential real estate sales, residential real estate foreclosures, new residential real estate home sales, and residential real estate rental listings, and for residential real estate related services such as residential real estate lawyers, residential real estate insurance brokers, residential real estate property inspectors, residential real estate contractors, residential real estate realtors, residential real estate brokers, residential real estate property managers, residential real estate builders, residential real estate developers, and residential real estate home improvement.</p> <p>(5) Advertising and marketing service for residential real estate listings such as: residential real estate sales, residential real estate foreclosures, new residential real estate home sales, and residential real estate rental listings and for residential real estate related services such as residential real estate lawyers, residential real estate insurance brokers, residential real estate property inspectors, residential real estate contractors, residential real estate realtors, residential real estate brokers, residential real estate property managers, residential real estate builders, residential real estate developers, and residential real estate home improvement.</p>
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Hearing Date: 2016-09-27

Appearances

Elizabeth Williams

For the Opponent

Chris B. Zelyas

For the Applicant

Agents of Record

Norton Rose Fulbright Canada

For the Opponent

N/A

For the Applicant