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

**Citation: 2017 TMOB 164**

**Date of Decision: 2017-11-30**

**IN THE MATTER OF AN OPPOSITION**

**Institute of Advanced Financial  
Planners**

**Opponent**

**and**

**The Financial Advisors Association of  
Canada**

**Applicant**

**1,489,710 for THE INSTITUTE FOR  
ADVANCED FINANCIAL  
EDUCATION & Design**

**Application**

INTRODUCTION

[1] The Institute of Advanced Financial Planners (the Opponent) awards the professional designation, the R.F.P. (Registered Financial Planner). It promotes the profession of financial planning by setting standards and providing educational offerings in association with its trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS.

[2] In 2010, The Institute of Chartered Life Underwriters of Canada filed an application to register the trade-mark THE INSTITUTE FOR ADVANCED FINANCIAL EDUCATION & Design in association with a variety of goods and services including educational materials and preparing education training programs and membership services in the fields of wealth management and living benefits. The applied-for trade-mark was subsequently assigned to The Financial Advisors Association of Canada (both entities referred to as the Applicant). The

Opponent opposed this application alleging grounds of opposition based on sections 30(i), 16(3)(a) and (c) and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the basis that the applied-for trade-mark was confusing with its trade-mark and trade-name INSTITUTE OF ADVANCED FINANCIAL PLANNERS.

[3] In view of the circumstances discussed below, I find that the Applicant has not met its legal onus of proving that there is no reasonable likelihood of confusion between the applied-for trade-mark and the Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS at the date of filing the application.

#### FILE HISTORY

[4] On July 22, 2010, the Applicant filed an application to register the trade-mark THE INSTITUTE FOR ADVANCED FINANCIAL EDUCATION & Design (the Mark) set out below:



The application is based on the Applicant's proposed use of the Mark in Canada in association with the following Goods and Services (as amended):

#### Goods:

Educational materials relating to professional development, namely brochures, manuals, newsletters, pamphlets, bulletins, reports, reference books, textbooks, leaflets, workbooks, guides, e-books.

#### Services:

Preparing education and training programs and courses for professionals including through podcasts, providing courses and programs to professionals including through podcasts, membership services and advocacy in the field of professional development and professional skills, testing and accreditation of programs and professionals, all in the fields of wealth management and living benefits.

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 19, 2014.

[6] On April 8, 2014, the Opponent opposed the application on the basis of its use of the trade-mark and trade-name INSTITUTE OF ADVANCED FINANCIAL PLANNERS with the Opponent's Services:

Association services for promoting the interests of financial planners, professional membership services in the field of financial planning, educational services, training programs and continuing education services, arranging and conducting conferences, symposiums, and education events, providing financial information, providing educational information, materials and resources and the operation of a website in the field of financial planning including investment, retirement, tax, insurance and estate planning.

[7] The grounds of opposition are summarized below:

- a) The application does not conform to the requirements of section 30(i) of the Act. The Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Goods and Services. The Applicant was aware of the Opponent's earlier use of its trade-mark and trade-name INSTITUTE OF ADVANCED FINANCIAL PLANNERS.
- b) The Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act because at the date of filing the application, the Mark was confusing with the Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS which had been previously used by the Opponent in Canada and had not been abandoned at the date of advertisement of the application.
- c) The Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(c) of the Act because at the date of filing the application, the Mark was confusing with the Opponent's trade-name INSTITUTE OF ADVANCED FINANCIAL PLANNERS which had been previously used by the Opponent in Canada and had not been abandoned at the date of advertisement of the application.

- d) The Mark is not distinctive in view of section 2 of the Act because the Mark does not actually distinguish, nor is adapted to distinguish, the Goods and Services from the Opponent's goods and services which are associated with the trade-mark and trade-name INSTITUTE OF ADVANCED FINANCIAL PLANNERS.

[8] The Applicant filed and served a counter statement.

[9] The Opponent filed the affidavit of Lawrence John Colero as its evidence. The Applicant filed the affidavits of Gregory J. Pollock and Dane Penney. The Opponent filed as its reply evidence the affidavit of Leah Young. Both parties submitted a written argument and the Applicant attended a hearing.

MATERIAL DATES AND ONUS

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(c)/16(3) - the filing date of the application [see section 16(3) of the Act];  
and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)].

[11] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[12] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an

applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

#### GROUND OF OPPOSITION

##### **Section 30(i) Ground of Opposition**

[13] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd. v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no evidence of bad faith or other exceptional circumstances underlying the allegations in this pleading, the section 30(i) ground is rejected.

##### **Section 16(3)(a) Ground of Opposition**

[14] This ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act in view of confusion with the Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS alleged to have been previously used in Canada by the Opponent.

[15] In order to meet its evidential burden, the Opponent must show that it had used its trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS in Canada prior to July 22, 2010 [see section 16(3)(a) of the Act]. Further, the Opponent must show that it had not abandoned its trade-mark at the date of advertisement of the application for the Mark, namely February 19, 2014 [see section 16(5) of the Act].

#### The Opponent Meets Its Evidential Burden

[16] The Opponent filed as its evidence the affidavit of Lawrence John Colero, a Policy Advisor for the Opponent and its former Executive Director (para 1). Mr. Colero's evidence set out below is sufficient to meet the Opponent's evidential burden:

- a) The Opponent is a member-driven, not-for-profit organization established in 2002 to administer the Registered Financial Planner (R.F.P.) designation (Colero affidavit, paras 2-4). The Opponent's website, printouts of which are attached as Exhibit 8, provides that its mission is to promote the profession of financial planning by setting a standard of excellence in the competency and practice of personal financial planning. The Opponent is also committed to providing symposia and other educational offerings on subjects related to advanced financial planning.
- b) The Opponent has awarded over 400 memberships from 2004-2010 and its yearly membership revenues have exceeded \$130,000 each year between 2007-2010 (paras 14, 19).
- c) While the trade-mark below, with bolded letters R.F.P. above INSTITUTE OF ADVANCED FINANCIAL PLANNERS in smaller text, appears throughout Mr. Colero's evidence, I find that this design constitutes use of the trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS. It is well-established that two trade-marks may be used at the same time so long as they are not combined in a way to render the individual marks indistinguishable [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD) at 272; *Philip Morris Products SA v Marlboro Canada Ltd* (2010), 90 CPR (4th) 1 (FC) at para 217]. Such is the case here.



- d) The Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS is used with professional membership services as follows: it appears on the professional standards of practice for R.F.P.'s (Exhibit 3); on certificates (Exhibit 13); and on brochures which promote its association services and educate others on the benefit of membership (Exhibit 14).

- e) The Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS appears on its website *www.iafp.ca* and archived versions of this website before and after the material date (Exhibits 5-6,8-10). The hits to the Opponent's website are significant and in the months leading up to the material date totalled more than 20,000 per month (Exhibit 11).
- f) The Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS is used with arranging and conducting conferences, symposia, and education events as it appears on its website promoting its symposiums and on agendas for symposiums including the symposiums held yearly between 2007-2010 (Exhibit 21).

[17] As such, I am satisfied that the Opponent has met its evidential burden under this ground of opposition. I must now determine whether the Applicant has met its onus of proving that there is no reasonable likelihood of confusion on a balance of probabilities.

#### The Test for Confusion

[18] 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 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.

[19] 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 enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22 , (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

### The Applicant Does Not Meet its Legal Onus

[20] Considering all of the surrounding circumstances discussed below, I find that the Applicant has not satisfied its legal onus of establishing on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark.

#### *Inherent Distinctiveness*

[21] With respect to the inherent distinctiveness of the trade-marks at issue, neither the Mark, nor the Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS possess much inherent distinctiveness as both are highly suggestive of their associated services. That being said the Mark possesses a slightly higher degree of inherent distinctiveness by virtue of its additional design features.

#### *Length of Time in Use and Extent Known*

[22] This factor favours the Opponent who has provided evidence of use of its trade-mark as of July 22, 2010, the filing date of the application (see paragraph 16 of this decision). In contrast, the application is filed on the basis of proposed use.

#### *Nature of the Goods and Services*

[23] There is a clear overlap in the nature of the Goods and Services and the Opponent's Services. Both involve services provided to an association of members in the finance field (described in the Services as providing membership services and accreditation of programs and professionals and described in the Opponent's Services as association services for promoting the interests of financial planners, professional membership services in the field of financial planning). Further, it appears that both parties have the same target audience – financial services practitioners.

[24] In this regard, the evidence of Gregory J. Pollock, the President and CEO of the Applicant, is that The Institute of Chartered Life Underwriters of Canada was created to grant professional designations and set standards for professionals engaged in financial planning and related services (para 7). In 2010, it was rebranded The Institute of Advanced Financial



Education (para 9). The Institute of Advanced Financial Education offers two designations: the Chartered Life Underwriter (CLU) and Certified Health Insurance Specialist (CHS). The CLU designation builds competencies and provides knowledge with respect to wealth transfer and estate planning advice. The CHS designation provides knowledge and expertise in income replacement, disability, critical illness, long-term care and group benefits (Exhibit B-2). The target audience for the Applicant is financial services practitioners in the specialty areas of advanced estate-planning, wealth transfer, living benefits and life insurance (para 7).

[25] At para 66 of its written argument and at the hearing, the Opponent pointed to *Venngo Inc. v Concierge Connection Inc.* 2015 FC 1338 at paras 125-128 to support its submissions that where, like in this opposition, consumers are relatively sophisticated professionals, who take significant time and due diligence in the purchase decision, the likelihood of confusion is reduced. I accept that the parties' average consumers are sophisticated professionals. However, the test for confusion is one of first impression and any subsequent steps taken by sophisticated consumers in an attempt remedy a potential instance of confusion when they are exercising time and due diligence in the purchasing decision are irrelevant [by analogy see paragraphs 68-74 of *Masterpiece, supra*].

#### *Degree of Resemblance*

[26] When considering the degree of resemblance between two trade-marks, the law is clear that they must be considered in their totality. Further, in assessing the degree of resemblance I am cognizant that the words appearing in each party's trade-marks are highly suggestive of the services.

[27] When considered in appearance, the dominant portion of the Mark is THE INSTITUTE as this is the part of the Mark that attracts a viewer's attention. When considered as sounded, however, the dominant portion of the Mark is THE INSTITUTE FOR ADVANCED FINANCIAL EDUCATION in its entirety. When sounded and in the ideas suggested, there is a high degree of resemblance with the Opponent's trade-mark. It is when the trade-marks are considered visually that the trade-marks resemble each other to a lesser extent but even then there is a considerable degree of resemblance.

[28] At para 70 of its written argument, the Applicant submits:

The Opposed Mark includes prominent, unique design elements (e.g.) the stylized lower-case letter “i” and the Sun Design) that create distinctiveness, and make the mark easily distinguishable from the Opponent’s trade-mark and trade name.

[29] While a greater degree of discrimination is expected from the public where a trade-mark consists of wholly or in part descriptive words [see Applicant’s written argument para 62 citing *Weetabix of Canada Ltd v Kellogg of Canada Inc*, 2002 FCT 724 at para 42], the test of confusion considers the first impression of an average consumer having a vague recollection of the Opponent’s trade-mark. Even given a greater degree of discrimination, I do not find that the design elements including the i in the circle dotted with a sun placed beside INSTITUTE in large prominent lettering and the other differences between the trade-marks, to find that the trade-marks do not resemble each other to a significant extent.

*Surrounding Circumstance: Applicant’s Use of the Mark After the Material Date*

[30] Mr. Pollock provides the following evidence regarding the Applicant and its use of the Mark:

- a) The Institute for Advanced Financial Education was established in 1929 as “The Institute of Chartered Life Underwriters” (para 8). After more than 80 years, it was re-branded in October 2010 as “The Institute for Advanced Financial Education” (para 9). Following a trade-mark assignment to the Applicant dated June 20, 2011, The Institute for Advanced Financial Education’s use of the Mark has been made under license (para 19) and the Applicant has exercised and continues to exercise, direct or indirect control over the character and quality of all goods and services offered (para 20).
- b) The Applicant is the leading designation body in Canada for financial services practitioners in the specialty areas of advanced estate-planning, wealth transfer, living benefits, and life insurance (para 7). It has 40 chapters and 11,000 members across Canada (para 1).
- c) The Mark appears on brochures, flyers, postcard advertisements, course catalogues and program enrolments for the CLU and CHS designations (see, for example, paras 24, 26,

33; 36; Exhibits B-2, J, N). Since 2011, over 17,000 financial professionals have enrolled in such programs and courses. Since 2011 the certificates provided to candidates upon successful completion of their programs have displayed the Mark (para 25, Exhibit F). Since January 1, 2011, the sale of educational materials relating to professional development has generated revenues in excess of \$4.5 Million (para 23). There are over 5000 CLU and CHS designates in good standing across Canada (paras 15-16).

- d) The Mark has appeared on the Applicant's website *advocis.ca* (paras 31-32; Exhibit I) and The Institute for Advanced Financial Education's website at *www.iafe.ca* (para 34; Exhibit K) since 2010. The Mark is also advertised through social media including Linked In (para 35; Exhibit L). The Mark is prominently displayed in advertisements and announcements placed in the Applicant's FORUM magazine which is published four times a year and circulated to 40,000 recipients in Canada (para 37; Exhibit O).
- e) The Applicant has spent in excess of \$177,000 on advertising prominently displaying the Mark since January 1, 2011 (para 30).
- f) Mr. Pollock, nor The Institute for Advanced Financial Education, nor the Applicant is aware of any instances of actual confusion between the Opponent and the Applicant due to use of the Mark (para 40).

[31] I am not able, however, to consider the evidence of use of the Mark detailed above with respect to this ground of opposition or make inferences about a potential lack of confusion between the Opponent's use of its trade-mark and the Applicant's use of its Mark, as all of this evidence postdates the material date and is not intrinsically connected with facts occurring at the material date [see *Servicemaster Co v 385229 Ontario Ltd* 2015 FCA 114 at paras 21-22].

*Surrounding Circumstance – Parties are Distinguishable in the Financial Field*

[32] The Applicant suggests in its written argument that the fact that the parties are readily distinguishable within the relevant financial field is a surrounding circumstance which favours it (paras 73-74). The Applicant points to examples of articles in trade publications which discuss the differences between the parties (citing Colero affidavit, Exhibit 22) and letters that the

Opponent has received discussing the Applicant and its rebranding (citing Colero affidavit, Exhibit 9); and the Opponent's statement that it doesn't see itself as competition for the Applicant (citing Colero affidavit, Exhibit 22). I do not find that this is a surrounding circumstance which favours the Applicant as the evidence relied upon is not extensive enough for me to conclude that there would be an impact on the first impression of an average consumer.

*Surrounding Circumstance – State of the Register and State of the Marketplace Evidence*

[33] The Applicant filed as its evidence the affidavit of Dane Penney, a Trade-mark Search Specialist employed by its agent who performed various corporate, trade-mark and internet searches.

[34] Mr. Penney's evidence is that he used the NUANS Pre-Search system to search for a list of Canadian companies containing the words "Financ\*" and "Institu\*" (para 2). While the NUANS search revealed several company names including the Applicant's and Opponent's, because these searches do not confirm whether these business are operating or the nature of their businesses beyond what can be surmised from the names, the results of the search are not particularly relevant. Mr. Penney then performed an Internet search to locate active websites from the companies identified in the Nuans search. He attaches printouts of the websites of 13 different companies. Relevant companies located which appear to operate in the same or related fields to that of the Opponent and Applicant include the American Finance Institute Corporation (Exhibit A-2); Canadian Institute of Finance and Management who offers professional certificate programs (Exhibit A-4); Financial Career Institute (Exhibit A-7); Institute of Trading and Finance (Exhibit A-12); The Canadian Institute of Financial Planning (Exhibit A-13); and The Financial Education Institute of Canada (Exhibit A-14).

[35] Mr. Penney also provides evidence of a trade-mark search for "finance\*" and "institu\*" in the trade-mark field which located 13 results. After discounting official marks, trade-mark applications which were not yet allowed, did not include finance\* and institu\* in the trade-mark and marks owned by the parties to the opposition, the following relevant trade-marks were identified: FMI IGF FINANCIAL MANAGEMENT INSTITUTE OF CANADA INSTITUT DE LA GESTION FINANCIERE DU CANADA (reg No. TMA795,630); CAFII CANADIAN ASSOCIATION OF FINANCIAL INSTITUTIONS IN INSURANCE (reg No. TMA540,092);

LA FINANCE POUR TOUS INSTITUT L'EDUCATION FINANCIERE DE PUBLIC (reg No. TMA795,606) and for FORAN FINANCIAL INSTITUTE & Design (reg No. TMA473,642).

[36] Mr. Penney also includes printouts of seven websites which include a trade-mark with both FINANCE and INSTITUTE and an archived version of the same website prior to the material date from the Internet Archive [www.archive.org](http://www.archive.org), including, for example:

- a) The Financial Education Institute of Canada's website and the archived version of this website from May 5, 2008 (Exhibit N) both of which display the trade-mark The Financial Education Institute of Canada;
- b) The Institute of Financial Consultants' website and the archived version of this website from February 8, 2005 (Exhibit R) both of which display the trade-mark Institute of Financial Consultants;
- c) Financial Management Institute of Canada's website and the archived version of this website from December 1, 1998 both of which display the trade-mark Financial Management Institute of Canada (Exhibit T);

[37] As its reply evidence, the Opponent filed the affidavit of Leah Young, a Trade-mark Searcher employed by its agent. Ms. Young performed a search of the Trade-marks Database for trade-marks including INSTIT\*, ADVANC\* and FINANC\*. Her searches only located trade-marks owned by either the Opponent or the Applicant. I am not prepared to accord any weight to Ms. Young's evidence. I do not believe that I can infer that the Applicant and the Opponent are the only parties using a trade-mark including the components INSTITUTE, ADVANCED and FINANCIAL because no other parties have applied to register one [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB) which discusses that state of the Register evidence is only useful to the extent that one can make an inference about the state of the marketplace].

[38] I am prepared to accord some weight to Mr. Penney's evidence as it seems clear that third parties have been active under trade-marks and trade-names that incorporate the words FINANCE and INSTITUTE (or variants of these words) in the general field that the parties operate within. As such, this factor favours the Applicant to some extent with the following

caveats. First, there is no evidence that any of these third party trade-marks or trade-names has acquired a significant reputation in the marketplace. Second, none of the other entries located in the search are as similar to the Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS as the Mark is.

*Surrounding Circumstances: Jurisprudence Concerning Weak Trade-marks*

[39] The jurisprudence on weak trade-marks supports the Applicant's position. It is well settled that that comparatively small differences will suffice to distinguish between weak marks [*Prince Edward Island Mutual Insurance Co. v. Insurance Co. of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD) at paras 32-34]. In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 46 CPR (4th) 112 at para 31 (FCTD), de Montigny J. explained:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used

...

[40] A party adopting a weak trade-mark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115-116 (SCC)]. It is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian*, (1984), CPR (3d) 238 at 240], however, while the Opponent has clearly evidenced use of its trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS given that the Opponent awarded only 400 memberships in 2010, had membership revenues of approximately \$140,000 and spent \$10,000 on advertising (Colero affidavit, paras 14, 19, and 21), even in the face of significant website hits (Exhibit 11) and revenue from registrations at its symposia (para 44), this is not extensive evidence of use as required to increase the narrow scope of protection afforded to the Opponent's trade-mark.

*Conclusion re likelihood of confusion*

[41] The test to be applied is a matter of first impression in the mind of an average consumer somewhat in a hurry who sees the Mark with the Goods and Services at a time when he or she has no more than an imperfect recollection of the Opponent's trade-mark INSTITUTE OF

ADVANCED FINANCIAL PLANNERS, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 2006 SCC 23 at para 20].

[42] I find that the Applicant has failed to establish, on a balance of probabilities, that confusion is not likely between the Mark and the Opponent's trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS as of the material date. I reach this conclusion because of the high degree of similarity between the trade-marks and the overlap in the nature of the parties' goods and services. In so finding, I have only afforded the Opponent's trade-mark a very narrow scope of protection. That being said, a narrow scope of protection is not the same as having no protection at all. In conclusion, I do not consider that as a matter of first impression that an average consumer would be able to distinguish the trade-marks based on the (i) very small differences between them and (ii) differences in the precise fields of interest of the parties. This ground of opposition therefore succeeds.

### **Section 16(3)(c) Ground of Opposition**

[43] While the Opponent's evidence of use of its trade-name Institute of Advanced Financial Planners is sufficient to meet its evidential burden (see, for example, the use of the trade-name on the copyright notice of archived versions of the website), the Applicant meets its legal onus with respect to this ground of opposition. This is because based on Mr. Colero's evidence, I am unable to conclude that the trade-name has become known to some extent as it appears that almost all of the evidence of use of INSTITUTE OF ADVANCED FINANCIAL PLANNERS is evidence of use of the trade-mark as opposed to the trade-name. As such, this ground of opposition is rejected.

### **Section 2 Ground of Opposition**

[44] Regarding the ground of opposition based on lack of distinctiveness pursuant to section 2 of the Act, the Opponent needs to show that its trade-mark INSTITUTE OF ADVANCED FINANCIAL PLANNERS has become known sufficiently to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657] as of April 8, 2014. To

do so, the Opponent must establish that its trade-mark is either known to some extent in Canada or is well known in a specific area of Canada [*Bojangles, supra* at paras 33-34].

#### The Opponent Meets Its Evidential Burden

[45] Mr. Colero's evidence set out below is sufficient to show that its trade-mark was known in sufficient detail as of the material date of April 8, 2014 in association with professional membership services in the field of financial planning and education services, arranging and conducting conferences, symposiums, and education events.

- a) The Opponent's trade-mark appears on professional standards of practice for R.F.P.'s, on certificates, on brochures, on its website and on agendas for its symposiums (Colero affidavit, Exhibits 3, 5-6; 8-10; 13-14, 21). At the material date, the Opponent's website received around 13,000 hits per month (Exhibit 11).
- b) In each of 2013 and 2014, over 350 memberships were awarded by the Opponent and membership revenues in 2013 were approximately \$140,000 with a similar amount anticipated in 2014 (Colero affidavit, paras 14, 19).
- c) In 2013, the Opponent spent approximately \$30,000 on advertising with a similar amount anticipated for 2014 (Colero affidavit, para 21).
- d) The Opponent has held an annual national symposium and conference each year since 2003 for its membership and non-members. The 2013 conference was held in Ottawa and the 2014 conference was held in Calgary (para 42). The revenue for registrations was over \$80,000 for the 2013 conference and a similar revenue was anticipated in 2014 (para 44). The Opponent's trade-mark appeared on its website pages promoting its symposia (Exhibit 21).

#### The Applicant Meets Its Legal Onus

[46] With respect to the distinctiveness ground of opposition, an evaluation of the surrounding circumstances favours the Applicant to a greater extent than the section 16(3)(a) ground of opposition. Not only was the Applicant using its mark by this date, but the



Applicant's use of the Mark as detailed in paragraph 30 of this decision appears to have exceeded that of the Opponent. Further, the apparent lack of evidence of any confusion as to source despite four years of coexistence in the same field supports the finding that there is no reasonable likelihood of confusion. As such, the Applicant has met its legal onus. Accordingly, this ground of opposition is rejected.

DISPOSITION

[47] 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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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2017-07-13

**APPEARANCES**

No one appearing

FOR THE OPPONENT

Mark L. Robbins

FOR THE APPLICANT

**AGENT(S) OF RECORD**

Richards Buell Sutton LLP

FOR THE OPPONENT

Bereskin & Parr LLP S.E.N.C.R.L.,  
S.R.L.

FOR THE APPLICANT