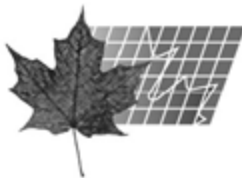


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 147

Date of Decision: 2019-12-31

IN THE MATTER OF AN OPPOSITION

Premiere Home Mortgage Ltd.

Opponent

and

Premier Mortgage Solutions Inc.

Applicant

**1,727,014 for Premier Mortgage
Solutions**

Application

INTRODUCTION

[1] Premiere Home Mortgage Ltd. (the Opponent) opposes registration of the trademark Premier Mortgage Solutions (the Mark), which is the subject of application No. 1,727,014 by Premier Mortgage Solutions Inc. (the Applicant).

[2] The application is based on the Applicant's proposed use of the Mark in association with the services "mortgage brokerage; mortgage refinancing; mortgage services" (the Services).

[3] For the following reasons, I find that the application should be refused.

THE RECORD

[4] The application for the Mark was filed on May 6, 2015 and was advertised for opposition purposes in the *Trademarks Journal* of March 30, 2016.

[5] On August 30, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). On August 31, 2016, the Opponent sought and subsequently obtained leave to file an amended statement of opposition, which was then forwarded to the Applicant. The grounds of opposition are based on sections 30(e), 30(i), 12(1)(d), 16(3)(a), 16(3)(c), and 2 of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[6] On October 25, 2016, the Applicant filed and served a counter statement denying the grounds of opposition. To the extent that the counter statement also contains evidence, it has been disregarded as such evidence was not filed in accordance with rule 42 of the *Trade-marks Regulations* (SOR/96-195) (now section 52 of the *Trademarks Regulations* (SOR/2018-227)).

[7] In support of its opposition, the Opponent filed the affidavits of Giovanni (John) Mercuri and Vilayphet (Sarah) Gallvitz. In support of its application, the Applicant filed the affidavit of Hitendra Darubra (Hiten Nath). None of the affiants were cross-examined on their affidavits.

[8] Both parties filed a written argument. In its written argument, the Opponent withdrew the grounds of opposition based on sections 30(i) and 12(1)(d) of the Act.

[9] Neither party requested a hearing.

ONUS AND MATERIAL DATES

[10] 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 reasonably

be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[11] The material dates that apply to the grounds of opposition pleaded are:

- 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 [16(3) of the Act]; and
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Ground of opposition under section 30(e)

[12] The Opponent has pleaded that the application does not conform to the requirements of section 30(e) of the Act since, contrary to the statement made in the application, the Applicant had no intention, as of the material date, to use the Mark in Canada in association with the Services.

[13] Since the facts concerning the Applicant's intentions are primarily within the knowledge of the Applicant, the burden of proof on the Opponent with respect to this ground is lighter [*Molson Canada v Anheuser-Busch Inc* (2003), 2003 FC 1287 (CanLII), 29 CPR (4th) 315 (FCTD); *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB); and *Green Spot Co v JB Food Industries* (1986), 13 CPR (3d) 206 (TMOB)]. The Opponent may rely on its own evidence and the Applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD)]. However, the Opponent may only rely on the Applicant's evidence if it is clearly inconsistent or puts into issue the claims set forth in the Applicant's application. On this issue, all of the pertinent evidence of record is to be assessed according to the usual criteria, that is, taking into consideration its provenance (including its quality and reliability), the absence of evidence that might reasonably be expected to exist, whether the evidence has been tested on cross-examination and if so, how it fared.

Multiple diverse considerations inform the assessment of evidence [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 (CanLII) at para 37].

[14] In its written argument, the Opponent submits that statements in the affidavit of Hitendra Darubra (sworn June 9, 2017), portions of which are summarized below, clearly indicate that the Applicant had no intention to use the Mark in association with the Services.

Affidavit of Hitendra Darubra

[15] Hitendra Darubra is the sole shareholder of Sunny Homes Mortgage Brokers of Canada Inc. (Sunny Homes) and the Applicant. Mr. Darubra functions as the President and CEO of both companies, and identifies them as related companies under section 2 of the Act (para 1).

[16] Mr. Darubra states that the intent of either company is to provide residential and commercial mortgage brokering and mortgage financing in Ontario only (para 6).

[17] Sunny Homes was incorporated in 2012 (para 4), and is an Ontario based mortgage brokerage providing residential and commercial mortgage financing exclusively in the province of Ontario (para 8). Sunny Homes is registered with the Financial Services Commission of Ontario (FSCO) and is authorized to provide mortgage brokering services in Ontario (para 2). Sunny Homes promotes itself through its company website; it also uses digital marketing, including Search Engine Optimization (SEO) techniques to market and promote itself (paras 9, 11; Exhibit B). Marketing is also done on social media platforms such as Twitter and Facebook, and in print advertisements (para 12; Exhibit C).

[18] The Applicant was incorporated in 2015 (para 4) but has not yet been registered with the FSCO as a mortgage brokerage firm (para 3). Mr. Darubra states that the Applicant, upon registering with FSCO, will continue to provide residential and commercial mortgage services in Ontario only (para 14).

[19] At paragraph 5 of his affidavit, Mr. Darubra states that “Premier Mortgage Solutions was incorporated as a future strategy to change the legal name of Sunny Homes Mortgage Brokers of Canada to Premier Mortgage Solutions Inc”.

[20] At paragraph 13 of his affidavit, Mr. Darubra states that “Sunny Homes intends to file with FSCO to change its legal name to Premier Mortgage Solutions Inc”.

[21] In its written argument, the Opponent submits that it is clear from the Darubra affidavit, particularly paragraphs 5 and 13 thereof, that the Applicant had no intention to use the Mark in association with the Services. Rather, the Applicant filed the application with the intention of changing the legal name of Sunny Homes. The Opponent submits that the Applicant’s filing of the application is analogous to the facts in *Dollar General Merchandising, Inc. v R Steinberg*, 2009 CanLII 90472 (*Dollar General*) in that:

53. ... While in Dollar General, the applicant was an individual who filed the trademark application on behalf of a corporate entity, Encore Industries, in this case, based on the information from the Darubra Affidavit, the Applicant filed the Application on behalf of Sunny Homes.

54.... Therefore... the Applicant’s evidence clearly shows an inconsistency between the Applicant’s claim that it intends to use with Mark with the Services and its actual intentions, namely to hold the mark for Sunny Homes.

[22] I do not consider the facts in this case to be analogous to those in *Dollar General*. Notwithstanding that the Applicant may have been incorporated to facilitate a future name change, the fact remains that it is the intent of the Applicant company to provide residential and commercial mortgage brokering and mortgage financing in Ontario (para 6, Darubra affidavit). That the Applicant would intend to provide these services in association with the proposed trademark “Premier Mortgage Solutions” is not inconsistent with the evidence of record. Moreover, there would appear to be nothing prohibiting use of the Mark in Canada by Sunny Homes, as a licensee.

[23] Accordingly, this ground of opposition is dismissed.

Ground of opposition under section 16(3)(a)

[24] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because at the date of filing the Mark was confusing with “one or more of the PREMIERE Marks and Names”, which were previously used in Canada by the Opponent, and which had not been abandoned. In its pleading, the Opponent defines the “PREMIERE Marks and Names” as a collective term comprising the registered trademark PHM Premiere Mortgage,

the (unregistered) trademark PREMIERE MORTGAGE, and the trade names PREMIERE CANADIAN MORTGAGE CORPORATION and PREMIERE HOME MORTGAGE LTD. The services associated with the PREMIERE Marks and Names are identified as “mortgage brokering and lending”.

[25] To meet its evidential burden under the section 16(3)(a) ground, the Opponent must show that it had used its trademark PREMIERE MORTGAGE in Canada in association with mortgage brokering and lending services prior to May 6, 2015 [see section 16(3)(a) of the Act]. The Opponent must also show that it had not abandoned its trademark at the date of advertisement of the application for the Mark, namely March 30, 2016 [see section 16(5) of the Act]. To determine whether the Opponent has met its burden, I will now review the Opponent’s evidence.

Review of the Opponent’s evidence

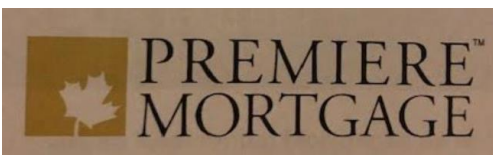
[26] The Opponent filed as its evidence the affidavits of Giovanni (John) Mercuri and Vilayphet (Sarah) Gallvitz, both sworn on February 27, 2017. Pertinent portions of these affidavits are summarized below.

Affidavit of Giovanni (John) Mercuri

[27] Mr. Mercuri is the President and CEO of the Opponent and has held this position since 2011. He has been employed by the Opponent since 2000, became a director in December 2005, and became the sole owner in 2013 (para 1).

[28] The Opponent was incorporated in 1985. In July 2005, the Opponent’s legal name was changed to Premiere Home Mortgage Ltd. (para 2).

[29] Mr. Mercuri states that the Opponent has provided mortgage brokering, mortgage refinancing, and mortgage administration services (the “Mortgage Services”) under the trademark PREMIERE MORTGAGE since at least as early as July 2005; the trademark PREMIERE MORTGAGE & Leaf Design since at least as early as December 2012, depicted below; and the trade name PREMIERE HOME MORTGAGE LTD. since at least as early as July 2005 (defined collectively in the Mercuri affidavit as the Brokerage Marks and Name) (para 2).



[30] The Opponent specializes in equity based, residential mortgage financings on urban and small town/rural properties throughout the provinces of British Columbia, Alberta, and Manitoba (para 3).

[31] Mr. Mercuri states that the Opponent's licensee, Premiere Canadian Mortgage Corp. ("Mortgage Corp") provides lending services (the "Lending Services", and with the Mortgage Services, collectively, the "Services") under the trademark PREMIERE CANADIAN and the trade name PREMIERE CANADIAN MORTGAGE CORPORATION (collectively defined in the Mercuri affidavit, along with the trademarks PREMIERE MORTGAGE and PREMIERE MORTGAGE & Leaf Design, and the trade name PREMIERE HOME MORTGAGE LTD., as the "PREMIERE Marks and Names"). However, I note that there is no statement by Mr. Mercuri of the requisite control by the Opponent that would allow it to benefit from the deeming provision in section 50(1) of the Act [see *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102 (CanLII) at para 84].

[32] Mr. Mercuri states that since July 2005, the Opponent has provided the Mortgage Services to at least 3,000 customers, as it brokered and arranged for approximately 3,300 mortgages valued at \$550 million. Since June 2008, the Opponent has provided the Mortgage Services to at least 2,600 customers, as it brokered and arranged for approximately 2,600 mortgages valued at \$407 million (para 6).

[33] Mr. Mercuri states that the Opponent has been registered to provide the Mortgage Services in British Columbia since April 1985 and has been extra-provincially registered in Alberta since September 1996 and in Manitoba since November 2005.

[34] Mr. Mercuri states that on average, the Opponent receives approximately 100 to 200 mortgage applications or enquiries regarding the Services per month. These mortgage applications and enquiries originate through the website, by email, by facsimile, and by telephone (para 9).

[35] Mr. Mercuri states that the Opponent and its licensee market and promote the Services under the PREMIERE Marks and Names in various channels, including through different websites; email marketing; banner advertisements and social media; print advertising; and through attendance at trade shows (para 10). The evidence of promotion through these channels is briefly discussed below.

Websites

[36] Mr. Mercuri states that the Opponent operates its website at the domain name *www.mortgagescanada.net* (the Premiere Mortgage Website) and Mortgage Corp's website at the domain name *www.premierecanadian.ca* (collectively, the Websites). The Opponent markets and advertises the Services on the Websites under one or more of the PREMIERE Marks and Names (para 11).

[37] Exhibit A1 is described as a copy of a screenshot from the Premiere Mortgage Website dated February 23, 2017, bearing one or more of the PREMIERE Marks and Names. I confirm that the trademark PREMIERE MORTGAGE & Leaf Design prominently appears on the Premiere Mortgage Website printouts, and advertises the Opponent's mortgage services, though there is no indication of the number of visits to this website at any time.

[38] Mr. Mercuri states that potential customers can make mortgage applications directly to the Opponent by using the forms available on the Premiere Mortgage Website. Exhibit B is described as true copies of screenshots from the Premiere Mortgage Website dated February 23, 2017 bearing one or more of the PREMIERE Marks and Names. I confirm that the trademark PREMIERE MORTGAGE & Leaf Design is prominently displayed on the top and bottom of the screenshots. Mr. Mercuri states that similar forms have been provided under one or more of the PREMIERE Marks and Names on the Premiere Mortgage Website since at least as early as January 2006 (para 12).

[39] Mr. Mercuri states that potential customers of the Services are also able to obtain information about the Services provided by the Opponent under one or more of the PREMIERE Marks and Names, such as mortgage rates, mortgage term, types of mortgages available, and contact information, from the Websites. Exhibit C is described as exemplary fact sheets about the

Services bearing one or more of the PREMIERE Marks and Names available on the Websites (para 13). I confirm that the trademark PREMIERE MORTGAGE & Leaf appears on some of the fact sheets. While some of these sheets are undated, others refer to interest rates and terms etc... effective July 20, 2015.

Email Marketing

[40] Mr. Mercuri states that the Opponent's primary method of marketing and advertising the Services under one or more of the PREMIERE Marks and Names is through electronic mail to mortgage brokers, and that the Opponent has an active database of licensed mortgage brokers in British Columbia, Alberta, Manitoba, and Ontario, totaling at least 7,000 contacts. Mr. Mercuri states that since at least as early as January 2006, the Opponent has sent, and continues to send, electronic email to the contacts on its electronic mail distribution list twice weekly to market and advertise the Services under one or more of the PREMIERE Marks and Names.

[41] Exhibit D is described as "true copies of exemplary emails sent by the Opponent to mortgage brokers since at least as early as September 2006". I confirm that the trademarks PREMIERE MORTGAGE and/or PREMIERE MORTGAGE & Leaf Design appear in various emails advertising the mortgage services, including on emails sent in 2006, 2007, 2008, 2011, 2012, 2016 and 2017.

Banner advertisements and social media

[42] Mr. Mercuri states that since at least as early as January 2006, the Opponent has marketed and promoted the Services under one or more of the PREMIERE Marks and Names using banner advertisements. Mr. Mercuri explains that banner advertisements are delivered by an ad server to different websites, and users of those sites can click the advertisement to access one of the Websites (para 15). However, I note that no information on any of these different websites (and the number of resultant 'clicks' to the Opponent's websites) is provided. Exhibit E is described as a sample banner advertisement bearing one or more of the PREMIERE Marks and Names as used by the Opponent in 2015. I confirm that the sample banner displays the trademark PREMIERE MORTGAGE & Leaf Design.

[43] Mr. Mercuri states that the Opponent also markets the Services under one or more of the PREMIERE Marks and Names through social media, namely Twitter (since 2010), and Facebook (since August 2011) (para 15). However, no exhibits showing the manner of use are provided. Further, the number of subscribers to these social media sites is not provided.

Print advertising

[44] Mr. Mercuri states that the Opponent has placed advertisements in magazines, such as the magazines of the Alberta Mortgage Brokers Association and the Mortgage Brokers Association of British Columbia (*Canadian Mortgage Broker*), to market the Services under one or more of the PREMIERE Marks and Names (para 16). Exhibit F includes an advertisement for the Opponent's mortgage services from the September 2015 issue of *Canadian Mortgage Broker* magazine bearing the trademark PREMIERE MORTGAGE & Leaf Design.

[45] Mr. Mercuri states that since at least as early as January 2006, the Opponent has also distributed printed advertisements, including brochures and coupons, to potential customers through direct mail (para 16). Various of these materials are attached as Exhibit F; I confirm that the trademarks PREMIERE MORTGAGE and/or PREMIERE MORTGAGE & Leaf Design appear on these materials.

Affidavit of Vilayphet (Sarah) Gallvitz

[46] Ms. Gallvitz is a trademark agent employed with the agent for the Opponent (para 1). Ms. Gallvitz visited the website at <https://archive.org> and accessed the site's 'waybackmachine' tool. Ms. Gallvitz used this tool to obtain and print archived versions of the Opponent's Websites. Exhibit B1 to B11 consists of printouts of the home page of the Premiere Mortgage Website. I note that the trademark PREMIERE MORTGAGE & Leaf Design appears prominently on the pages dated January 26, 2015 and January 23, 2016 (Exhibits B10, B11), and that these pages advertise the Opponent's mortgage services.

Conclusion – the Opponent meets its initial evidential burden

[47] Based on the foregoing, I am satisfied that the Opponent's trademark PREMIERE MORTGAGE was in use as of the material date (May 6, 2015) and had not been abandoned as of the date of advertisement of the Mark.

[48] In making this finding, I have considered the display of the PREMIERE MORTGAGE & Leaf Design (shown above at paragraph 29) to constitute the display of the Opponent's trademark PREMIERE MORTGAGE. In my view, the words PREMIERE MORTGAGE stand out from the design element of the mark, such that the public would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[49] As 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.

Test for confusion

[50] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[51] Thus the issue is not confusion between the trademarks themselves, but of confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the Services provided in association with the Mark would believe that those Services were produced, authorized or licensed by the Opponent.

[52] 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 trademarks 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 trademarks in appearance or sound or in the ideas suggested by them.

[53] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

Inherent distinctiveness and extent known

[54] The applied for trademark is a combination of ordinary dictionary words. I consider PREMIER to be laudatory given it holds the meaning (as an adjective) “first in importance, order, or time”; the word originates from the Old French word meaning “first” [*The Canadian Oxford Dictionary*, 2 ed; see *Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65 (CanLII) at para 29 which provides that the Registrar can take judicial notice of dictionary definitions]. The remaining elements MORTGAGE SOLUTIONS are highly suggestive if not descriptive of the Services. Accordingly, when considered overall, I find that the Mark possesses very little inherent distinctiveness.

[55] The Opponent’s trademark PREMIERE MORTGAGE is also a combination of dictionary words. The word PREMIERE is similarly laudatory in nature (it is defined, as an adjective, as equivalent to the word “premier” in *The Canadian Oxford Dictionary*, 2 ed), and the word MORTGAGE is descriptive of the Opponent’s services, with the result that the trademark, when considered overall, possesses very little, if any, inherent distinctiveness.

[56] The strength of a trademark may be increased by means of it becoming known through promotion or use.

[57] The Opponent’s evidence of use and promotion of the trademark PREMIERE MORTGAGE, as summarized above, is not without deficiencies, most notably in that there is no indication of the number of Canadian visitors to the Opponent’s websites at any of the material dates, and only collective reference to sales figures, and no information on advertising

expenditures. However, considering the evidence as a whole, including the Opponent's long history of use of the trademark PREMIERE MORTGAGE through various promotional channels (including through email and annual attendance at industry trade shows and conferences) with representative examples, I am satisfied that the Opponent's trademark has become known to at least some extent in Canada.

[58] In contrast, the Applicant has filed no evidence of use of the Mark.

[59] Accordingly, I find that overall, this factor, which involves an assessment of a combination of the inherent and acquired distinctiveness of the parties' trademarks, slightly favours the Opponent.

Length of time in use

[60] This factor favours the Opponent who has provided evidence of prior use (summarized above), whereas the Applicant's application is filed on the basis of proposed use.

Nature of the goods and trade

[61] To the extent that the services of the parties both relate to mortgages, including mortgage brokering, there is a clear and significant overlap in the nature of the parties' services.

[62] In its written argument, the Applicant notes that the Opponent's mortgage brokering services are in British Columbia whereas the Applicant's (proposed) use of the Mark for mortgage solutions is solely in Ontario. The Opponent, its written argument, cites paragraph 30 of the *Masterpiece* decision which indicates that the test for confusion is based on the hypothetical assumption that both marks are used "in the same area", irrespective of whether this is actually the case. I agree that the geographical separation of the parties' services is not determinative in assessing this factor. In any event, there is nothing in the application restricting the Applicant's Services to Ontario. Moreover, if the Applicant were to obtain registration of the Mark, this would grant it the exclusive right to use of the Mark across Canada.

Degree of resemblance

[63] When considering the degree of resemblance, the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent's trademark [*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltee* (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 at para 20].

[64] The Applicant, in its written argument, emphasizes there are significant differences between the words PREMIER and PREMIERE in the parties' trademarks, arguing that they are distinguishable in spelling, pronunciation and dictionary meaning. In particular, the Applicant notes that the plain meaning definition of the word "Premier" is "first in importance, order of position; leading", whereas the plain meaning definition of the word "Premiere" is "first performance of a musical or theatrical work or the first showing of a film or "first showing". I note that the Applicant has not filed any evidence in this regard - while the Darubra affidavit (at para 15) refers to information contained in its counter statement, evidence filed in or as part of a counter statement is not admissible.

[65] Notwithstanding that the Applicant has not properly filed any evidence of the meaning and pronunciation of these words, and while it may well be that the word PREMIERE holds a specific meaning, as a noun, relating to the first performance of a musical or theatrical work (see *The Canadian Oxford Dictionary*, 2ed), I am of the view that this word, when viewed in the context of the Opponent's trademark PREMIERE MORTGAGE, would instead, as a matter of first impression, simply be seen as a variation of the word 'PREMIER' applied as an adjective, therefore suggesting being 'first in importance' (as defined in the *Canadian Oxford Dictionary* (2ed)). I consider that the differences between the words cited by the Applicant go beyond what would give the first impression, and is effectively a detailed side by side comparison, which is not the appropriate approach.

[66] Accordingly, I consider that the applied for trademark PREMIER MORTGAGE SOLUTIONS would effectively be seen to incorporate the entirety of the Opponent's trademark PREMIERE MORTGAGE.

[67] It has been established that confusion will be unlikely in situations where marks share common features but also feature dominant differences [*Chalet Bar B-Q (Canada) Inc. et al. v Foodcorp Ltd.* (1982), 66 CPR (2d) 56 at 73 (FCA)]. However, in the instant case the word

SOLUTIONS when viewed in the context of the overall Mark is highly suggestive of the Services and therefore does not serve to diminish the degree of resemblance in any significant manner [*Reno-Dépôt Inc. v Homer TLC Inc.* (2009), 2010 TMOB 11 at para 58].

[68] Accordingly, this factor favours the Opponent.

Conclusion on the likelihood of confusion

[69] 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 applied for trademark Premier Mortgage Solutions with the Services at a time when he or she has no more than an imperfect recollection of the Opponent's trademark PREMIERE MORTGAGE, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 2006 SCC 23 (CanLII) at para 20].

[70] I find that the Applicant has failed to establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's trademark PREMIERE MORTGAGE as of the material date. I reach this conclusion considering the significant degree of resemblance between the marks, the overlap in the parties' services, and the extent known and length of time in use of the Opponent's trademark. In reaching my finding, I have also considered that only a very narrow scope of protection can be attributed to the Opponent's trademark, as it is a weak mark. However, the Mark falls within this narrow scope.

[71] Accordingly, this ground of opposition is successful.

Ground of opposition under section 2

[72] The Opponent has pleaded that the Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the services in association with which it is proposed to be used from the services provided by the Opponent under one or more of the Opponent's PREMIERE Marks and Names.

[73] To meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the filing of the statement of opposition, one or more of the Opponent's

PREMIERE Marks and Names had become sufficiently known to negate the distinctiveness of the Mark and its reputation in Canada is substantial, significant or sufficient [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 (CanLII) at para 34].

[74] I find the Opponent's evidence, in particular the Opponent's sales (Mercuri affidavit, para 6) in combination with the broad range of advertising by the Opponent, including through its websites (Mercuri affidavit, para 11; Gallvitz affidavit, paras 2,3, and Exhibits B10, B11), direct email (Mercuri affidavit, para 14), print advertising (Mercuri affidavit, para 16), and attendance at trade shows (Mercuri affidavit, para 17) to be sufficient to meet its burden with respect to the Opponent's trademark PREMIERE MORTGAGE. The Applicant is therefore required to show that its Mark is adapted to distinguish or actually distinguishes its Services from the services of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)].

[75] I consider that the difference in material dates does not materially affect my conclusion under the section 16(3)(a) ground of opposition discussed above. Accordingly, for reasons similar to those expressed in the above analysis, I reach the same conclusion regarding the likelihood of confusion as under the section 16(3)(a) ground of opposition. Accordingly, this ground of opposition is also successful.

Ground of opposition under section 16(3)(c)

[76] Having already refused the application under two grounds, I will not discuss the remaining ground of opposition with respect to this application.

DISPOSITION

[77] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENT(S) OF RECORD

McCarthy Tétrault LLP

FOR THE OPPONENT

No agent of record

FOR THE APPLICANT