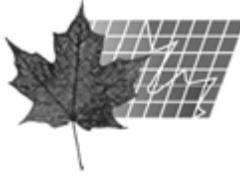


O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 140

Date of Decision: 2019-12-23

IN THE MATTER OF AN OPPOSITION

**Fay G. Weisberg Medicine Professional
Corporation**

Opponent

and

Dr. Marjorie Dixon

Applicant

1,743,791 for FIRST STEPS

Application

INTRODUCTION

[1] Fay G. Weisberg Medicine Professional Corporation (the Opponent) opposes application No. 1,743,791 (the Application) for registration of the trademark FIRST STEPS (the Mark) filed by Dr. Marjorie Dixon (the Applicant).

[2] For the reasons that follow, the opposition is successful in part.

THE RECORD

[3] The Application was filed on August 28, 2015. It has been amended once in response to an office action concerning the description of some of the services. It is based on use of the Mark in Canada since at least as early as February 2008 in association with the following services:

Operation of a fertility clinic; services of fertility enhancement therapy; services of fertility preservation, assisted reproduction therapy; operation of a women's health clinic; ultrasound diagnostic services; medical counselling services in the field of fertility; providing information services on the internet in the field of fertility medicine; research and development services in fertility and embryology; medical laboratory services; reproductive tissue, egg and cell banking services; human egg donation services; third party reproduction services, namely, assisting couples who require a third party to achieve pregnancy whether using an egg donor (known or anonymous), sperm donor (known or anonymous) or a gestational surrogate; acupuncture and naturopathic services, namely, assessing, treating and counselling patients through the application of naturopathic medicine, natural therapy and naturopathic health care; diagnosis and surgical treatment of uterine abnormalities, ectopic pregnancy and missed abortions; management of early pregnancy (the Fertility Services);

and based on proposed use in Canada in association with:

Dispensing of prescription medication (the Prescription Services)

[4] The Application was advertised in the *Trademarks Journal* on December 14, 2016 for the purposes of opposition.

[5] On May 11, 2017, the Opponent filed a statement of opposition. The grounds of opposition pleaded are based on sections 30(b), (e), and (i) (compliance), and 2 (distinctiveness) of the Act as it read immediately before CIF date (as defined later).

[6] Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13, (the Act) came into force on June 17, 2019 (CIF date). In the context of opposition proceedings, the date that determines which version of the Act applies is the date on which the application being opposed was advertised in the *Trademarks Journal* for opposition purposes. In the present case, the Application was advertised prior to the CIF date. Consequently, pursuant to the transitional provisions in section 70 of the Act as amended, the grounds of opposition will be assessed in accordance with the Act as it read immediately before CIF date, with the exception that, in assessing confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[7] All other references to the Act in these reasons are to the Act as amended on CIF date, unless otherwise indicated.

[8] The Applicant filed a counter statement on July 13, 2017, denying each of the grounds of opposition.

[9] The Opponent filed as its evidence the affidavits of Fay G. Weisberg, executed on November 6, 2017 and Amanda Gauthier executed on November 3, 2017. None of these deponents was cross-examined.

[10] The Applicant filed a statement that it would be filing evidence.

[11] Only the Opponent filed written arguments; an oral hearing was not held.

PRELIMINARY REMARKS

[12] It is important to note that Dr. Weisberg's statements contained in her affidavit have not been contradicted by way of affidavit evidence or by cross-examination.

OPPONENT'S EVIDENCE

Affidavit of Fay G. Weisberg

[13] Dr. Weisberg is the Opponent's President and an Ontario physician. She has been certified as a specialist in obstetrics and gynecology since 1991. She is also an Assistant Professor with the Faculty of Medicine at the University of Toronto.

[14] Dr. Weisberg states that in late 2007, she decided to join the Applicant and Dr. Sony Sierra in the establishment and operation of a fertility clinic. As such, on or about December 3, 2007, First Steps Fertility Inc. (FSFI) was incorporated for the purpose of operating a fertility clinic. The officers of FSFI were the Applicant as President, Dr. Sierra as Vice-President and Dr. Weisberg as the Secretary and Treasurer. She attached as Exhibit A a copy of the Corporation Profile Report for FSFI.

[15] Dr. Weisberg explains that FSFI operated a medical clinic under the name First Steps in Toronto (the FSFI Clinic), specializing in the treatment of fertility and reproductive issues, excluding *in vitro* fertilization which was outsourced. She states that the Applicant, Dr. Sierra

and herself set up a joint bank account for the FSFI Clinic and agreed that the income from FSFI Clinic would be pooled together, and profits would be divided equally among them.

[16] Dr. Weisberg affirms that on or about December 12, 2007 she took steps to register the domain name <firststepsfertility.ca> on behalf of FSFI and advised both the Applicant and Dr. Sierra. She attached as Exhibit B a copy of the Domain Tools Domain Report on <firststepsfertility.ca> dated October 3, 2017. However, it is unclear from a reading of that documentation who registered that domain name. In the earliest report dated January 23, 2008 there is no reference to the “registrant” of that domain name. As mentioned earlier, Dr. Weisberg has not been cross-examined and therefore her statements remain unchallenged.

[17] Dr. Weisberg states that in or around November or December 2011, Dr. Sierra left FSFI Clinic to continue practice elsewhere. Despite the fact that her name remains as a director and officer of FSFI she has had no continuing involvement with FSFI since that time.

[18] Dr. Weisberg explains that in view of Dr. Sierra’s departure from FSFI, on or about November 9, 2011, Dr. Weisberg formed a new company (2305151 Ontario Inc.) and the business name First Steps Fertility was registered under that company. She attached as Exhibits C and D respectively, a copy of the Corporation Profile Report for 2305151 Ontario Inc. and a copy of the Business Names Report for First Steps Fertility. Her intention was that 2305151 Ontario Inc. would continue the business of FSFI on behalf of both the Applicant and herself. She informed the Applicant at the time that this new company was available for them to continue their business together, but ultimately they decided to continue their business under FSFI.

[19] Dr. Weisberg affirms that on or about December 5, 2014 (two days before it was due to expire), the domain name registration for <firststepsfertility.ca> was updated to change the name of the registrant to Dr. Marjorie Dixon Medicine Professional Corporation and the administrative contact was changed to Tara McAteer, who was at the time the office manager at the FSFI Clinic. Exhibit B to her affidavit supports that contention.

[20] Dr. Weisberg states that, despite regular meetings with the Applicant and Ms. McAteer to discuss various matters pertaining to the FSFI Clinic, she was never informed of those changes.

[21] Dr. Weisberg affirms that on or about the Spring of 2015, the Applicant informed her that she was planning to start a new business at a different location. Her understanding at the time was that the new business was meant to be complementary to the work being done at the FSFI Clinic in that it would perform IVF procedures, which were traditionally outsourced.

[22] Dr. Weisberg states that the Applicant told her that IVF procedures would be done through the new business, and that they would continue carrying on their existing business at the FSFI Clinic under the name “First Steps” through their respective professional corporations. The Applicant offered Dr. Weisberg to purchase a minority stake in the new business but on August 21, 2015, she advised the Applicant that she was not interested in joining her new business as a minority shareholder.

[23] Dr. Weisberg states that on or about January 20, 2016 the Applicant provided her with draft documents entitled “Trademark Assignment” and “Trademark License Agreement” and she attached those documents as Exhibits E and F respectively. She states that they were prepared unilaterally by or on behalf of the Applicant without Ms. Weisberg’s input. She did not sign either of these documents.

[24] Dr. Weisberg affirms that in or around February 2016, the Applicant posted messages online, including on the FSFI Clinic’s website and social media accounts indicating that “First Steps Fertility” was moving. Dr. Weisberg was concerned that patients could misinterpret this to mean that she was moving her practice when in fact she was not.

[25] Dr. Weisberg states that she called the web hosting company for the FSFI Clinic to ask them to remove the message from the clinic’s website. She was then informed that the domain name registration for <firststepsfertility.ca> had been changed to list the Applicant’s professional corporation as the registrant, and Ms. McAteer as the administrative contact. This fact is confirmed by the content of the Whois Record report attached as Exhibit B to the Weisberg affidavit.

[26] Dr. Weisberg affirms that in or around the Spring of 2016, she discovered that the domain name <firststepsfertility.ca> was being redirected to Anova Fertility & Reproductive Health (Anova), which was done without her knowledge. She attached as Exhibit G a copy of a

screen shot from her phone that she took on or around March 13, 2016 showing that the first hit for a Google search for “first steps fertility” led to Anova. She attached as Exhibit H a copy of the screen shot of the website for Anova, which is the website that a user is taken to when the domain name <firststepsfertility.ca> is entered into the search box on Google.

[27] Dr. Weisberg affirms that on or about April 22, 2016 she received a letter from the Ontario Ministry of Finance, attached as Exhibit I to her affidavit, seeking her consent to dissolve FSFI. She states that she did not participate in that request, nor did she provide her consent to the dissolution.

[28] Dr. Weisberg states that in or around July or August 2016, she saw a post on First Steps Fertility’s Facebook page stating that “First Steps Fertility is no longer” and she attached as Exhibit J a copy of a screen shot that she took from this posting.

[29] Dr. Weisberg concludes her affidavit by stating that she has continued to operate a fertility and reproductive health clinic in Toronto. That clinic is being run through her professional corporation, but Dr. Weisberg does not state the name of that corporation. Is it the Opponent or another corporation? She adds that the Applicant has had no involvement whatsoever with the clinic since approximately early 2016 and she attached as Exhibit K a copy of a screen shot from the home page of her clinic’s website.

Affidavit of Amanda Gauthier

[30] Ms. Gauthier is a legal assistant with the Opponent’s agent firm. The main purpose of her affidavit is to file in the record certain documents and the results of various searches as detailed below:

- Exhibit A is a certified copy of the file history of the Application;
- Exhibit B is a copy of a print out of the results of a search on the website of the Canadian Intellectual Property Office of the Canadian Trademarks Database, where she inserted “marjorie dixon” in the search field “Current owner name” and Exhibit C are the copies of printouts of each search result after clicking on each link appearing on the results Exhibit B;
- Exhibit E is a copy of a print out of the result of a search conducted on the website Wayback Machine after entering the domain name <firststepfertility.ca>;

- Exhibit F-3, F-5, F-7 and F-8 are the web pages attributed to various dates namely, March 24, 2010, December 5, 2014, August 11, 2015 and September 10, 2015 respectively.

EVIDENTIARY BURDEN

[31] The legal onus is on the applicant to show that its application complies with the provisions 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. Once this initial burden is met, the applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155].

GROUND OF OPPOSITION BASED ON SECTION 30(B) OF THE ACT

[32] The Opponent pleads that the Application does not conform to the requirements of section 30(b) of the Act in that the Applicant has not used the Mark since the date of first use claimed in the Application, namely since February 2008 in association with the Fertility Services.

[33] In this respect, compliance with section 30(b) requires that a trademark be used continuously in the normal course of trade from the date of first use claimed to the filing date of the application [see *Benson & Hedges (Canada) Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD); *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co*, 2001 FCT 253, 11 CPR (4th) 489]. Compliance is assessed at the filing date [*Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[34] An opponent's initial burden with respect to section 30(b) is a lighter one, given that the relevant information regarding use is more readily available to the applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. If an opponent succeeds in discharging its initial evidential burden, then the applicant must, in response, substantiate its use claim. However, the applicant is under no obligation to do so if the date of first use is not

first put into issue by an opponent meeting its initial evidential burden [see *Kingsley v Ironclad Games Corp*, 2016 TMOB 19, 2016 CarswellNat 644].

[35] If the Applicant intends to rely on the use of the trademark applied for by a predecessor-in-title, that entity must be identified in the application [see *ServiceMaster Co v 385 MKE Ltd* 2015 TMOB 188].

[36] The Opponent's evidence establishes the following un-contradicted facts:

- A corporation was created (FSFI) in late 2007 by three individuals including the Applicant;
- A fertility clinic (FSFI Clinic) was operated under the tradename Firsts Steps by FSFI in late 2007 or early 2008;
- In December 2014, the domain name registrant for <firststepsfertility.ca> was changed to the Applicant's professional corporation without the knowledge of the Opponent or Dr. Weisberg;
- In the spring of 2015, the Applicant left the FSFI Clinic to start a new business;
- In January 2016 the Applicant submitted draft documents to Dr. Weisberg pertaining to the transfer of the Mark;
- In March 2016 the Applicant filed application 1770377 (Exhibit A to the Gauthier affidavit) for the registration of the trademark ANOVA for services almost identical to the Fertility Services.

[37] Those facts raise serious questions on the alleged date of first use of the Mark by the Applicant. The FSFI Clinic was operated by FSFI and not the Applicant alone as FSFI was a corporation formed by three doctors including the Applicant and Dr. Weisberg. Moreover, the application does not allege any use of the Mark by a predecessor in title. The application is based on use of the Mark by the Applicant alone.

[38] There is no transfer in ownership of the Mark from FSFI to the Applicant. To the contrary, the Applicant acknowledged that it was not the sole owner of the Mark as it submitted to the Opponent a document entitled "TRADEMARK ASSIGNMENT" (Exhibit E to Dr. Weisberg's affidavit) in which we find the following statements:

AND WHEREAS, the [Opponent] and [Dr. Marjorie E. Dixon Professional Medicine Corporation (the Assignee)] are co-founders of the First Steps Fertility Clinic...;

AND WHEREAS, the [Opponent] has used and continues to use the trade-marks [including the Mark] set out in Schedule A...in association with the [Fertility Services];

AND WHEREAS, the [Opponent] and the Assignee are co-creators of the [Mark].

[39] The Opponent has met its initial burden by filing evidence that seriously questions the Applicant's allegation contained in the Application that it began by itself to use the Mark in association with the Fertility Services in February 2008. Therefore, it was up to the Applicant to file evidence of its use of the Mark as of the claimed date of first use.

[40] In the absence of that evidence, I conclude in favour of the Opponent and I therefore maintain this ground of opposition.

GROUND OF OPPOSITION BASED ON SECTION 30(I) OF THE ACT

[41] The Opponent pleads that the Application does not conform to the requirements of section 30(i) of the Act because the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the Services.

[42] Section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use its trademark in Canada in association with the goods and services described in the application. Accordingly, where, as here, the required statement is included in the application, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud on the part of the applicant is alleged, or where federal legislation arguably prevents the registration of the mark [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)].

[43] One must read a statement of opposition in conjunction with the evidence filed. Despite the fact that the ground of opposition as pleaded does not clearly allege bad faith or fraud, there are facts set out in the statement of opposition that imply at least bad faith on the part of the Applicant. In particular, I refer to paragraph 4 of the material facts described in the statement of opposition, which reads:

The application for FIRST STEPS was filed without the knowledge or consent of the other shareholders of FSFI. At no time, did FSFI assign the FIRST STEPS trade-mark or the *First Steps Fertility* trade-name to the Applicant, and the Applicant is not a successor in title to FSFI of the FIRST STEPS trade-mark or the *First Steps Fertility* trade-name.

[44] In the present case, I consider the un-contradicted description by Dr. Weisberg of the actions taken by the Applicant, and detailed above, to be evidence of bad faith on her part. It can be infer that she knew that the Mark had been used by at least FSFI and not herself personally. That is the reason why she tried to obtain an assignment of the Mark from Dr. Weisberg. Prior business relationship between the parties can lead to a conclusion of bad faith [see *Levis v Golubev* 2019 TMOB 100].

[45] However, there is no evidence of prior use by FSFI of the Mark in association with the Prescription Services. Accordingly, the Applicant was at liberty, at the filing date of the application, to apply for the registration of the Mark in association with those services.

[46] Therefore, I maintain this ground of opposition only for the Fertility Services.

GROUND OF OPPOSITION BASED ON SECTION 30(E) OF THE ACT

[47] The Opponent alleges that the Application does not comply with the requirements of section 30(e) of the Act in that the Applicant did not, and does not intend to use the Mark in Canada, either by herself or through a licensee, or by herself and through a licensee. Given that the application was filed on the basis of proposed use in association with the Prescription Services only, this ground of opposition is limited to those services.

[48] The Opponent's burden is lighter with respect to the issue of non-compliance with section 30(e) because the facts supporting no intention to use the Mark are particularly within the knowledge of the Applicant [*Molson Canada v. Anhauser-Busch Inc* (2003), 29 CPR (4th) 315, *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216].

[49] The material date for assessing compliance with section 30(e) is the filing date of the Application (August 28, 2015). However, consideration could be given to facts that took place subsequent to the filing date [see *Bacardi & Co Ltd v Jack Spratt Mfg Inc* (1984), 1 CPR (3d) 122 (TMOB)].

[50] The Opponent takes the position that the following sequence of events demonstrates that the Applicant did not intend to use the Mark at the relevant date, namely:

- In the spring 2015, the Applicant advised Dr. Weisberg of the former's plans to start a new business. Dr. Weisberg's understanding was that this new business was meant to be complementary to the work being done at the First Steps Clinic. The Applicant offered Dr. Weisberg an opportunity to purchase a minority stake in the new business;
- On or about August 21, 2015 (7 days prior to the filing date of the Application) Dr. Weisberg advised the Applicant that she was not interested in joining the new business as a minority shareholder;
- The Applicant filed on August 28, 2015 the present application;
- On September 22, 2015 The Applicant filed application No.1,747,173 for the



trademark based on proposed use in association with services virtually identical to the Fertility Services and the Prescription Services (see Exhibit C to the Gauthier Affidavit);

- On or about January 20, 2016, the Applicant presented Dr. Weisberg with a Trademark and a Trademark License Agreement pertaining to the Mark which Dr. Weisberg refused to sign;
- On or about March 2, 2016, the Applicant filed application No. 1,770,377 for the trademark ANOVA based on proposed use in association with services virtually identical to the Fertility Services and the Prescription Services (see Exhibit C to the Gauthier Affidavit).

[51] Based on this sequence of events, the Opponent contends that the Applicant intended to open her new business using the ANOVA trademark, if she was unable to obtain Dr. Weisberg's cooperation regarding the use of the Mark, and in fact the Applicant ultimately opened a fertility



clinic under the trademarks and ANOVA as per Exhibits G and H to the Weisberg affidavit. The Opponent adds that therefore the Applicant had no intention to use the Mark as a trademark in her individual capacity. Consequently, the application filed by the Applicant as an individual, does not comply with section 30(e) of the Act.

[52] I note that the Applicant states in her application that she intended to use the Mark "by itself or through a licensee, or by itself and through a licensee". Consequently, the application was not limited to a proposed use of the Mark by the Applicant herself. It is still open for an individual to file an application to register a trademark in his (her) personal capacity, and thereafter license the trademark applied for to a corporate entity[see *Alltemp Products Co v Bit Holder Inc* 2007 CarswellNat 3738 (TMOB)].

[53] Additionally, the fact that the evidence shows that the Applicant is operating a fertility clinic under a different trademark does not necessarily prove that the Applicant, did not have the intention to use the Mark at the filing date of the application in association with the Prescription Services. Indeed, as explained above, the services in issue concerning this ground of opposition are not the Fertility Services but the Prescription Services. I fail to see how this sequence of events would establish that the Applicant did not intend to use the Mark in association with the Prescription Services at the material date.

[54] For all these reasons, I dismiss this ground of opposition.

GROUND OF OPPOSITION BASED ON SECTION 2 OF THE ACT (LACK OF DISTINCTIVENESS)

[55] The Opponent pleads that:

Contrary to Section 2 of the Act, [the Mark] is not distinctive of the Applicant in that it does not and cannot distinguish, nor can it be adapted to distinguish the services of the Applicant from the services provided by others, including, but not limited to the Opponent.

[56] The relevant date for this ground of opposition is the filing date of the statement of opposition (May 11, 2017) [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed 2006 FC 657].

[57] Reading the statement of opposition as a whole, in conjunction with the Opponent's evidence, it is clear that the Opponent is relying on the alleged prior use of the trademark FIRST STEPS by the Opponent and/or FSFI and/or any other corporate professional entities associated with Dr. Weisberg but not clearly identified in her affidavit other to state "...through our respective professional corporations". Given the evidence in the record and described above, I conclude that the Opponent has not met its initial burden of proof under this ground of opposition for the following reasons.

[58] The Opponent had to establish that the trademark FIRST STEPS has been made known in Canada to some extent as of the filing date of the statement of opposition (May 11, 2017) or has become well known in a particular area of Canada (in this case the Toronto area) so as to negate

the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed 2006 FC 657].

[59] Dr. Weisberg makes reference to the use of the trademark FIRST STEPS by FSFI starting in December 2007 without filing any evidence establishing use of the Mark by FSFI or any other entity, within the meaning of section 4(2) of the Act.

[60] Given that FSFI operated a fertility clinic in Toronto only, according to the evidence in the file, the Opponent had the initial burden to prove that FSFI and/or the Opponent used the trademark FIRST STEP quite extensively in the Toronto area such that it became well known in that area at the material date [see *Bojangles, supra*]. There is no evidence in the record that could lead to that conclusion.

[61] Accordingly, I dismiss this ground of opposition.

DISPOSITION:

[62] In view of all the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application for the following services:

Operation of a fertility clinic; services of fertility enhancement therapy; services of fertility preservation, assisted reproduction therapy; operation of a women's health clinic; ultrasound diagnostic services; medical counselling services in the field of fertility; providing information services on the internet in the field of fertility medicine; research and development services in fertility and embryology; medical laboratory services; reproductive tissue, egg and cell banking services; human egg donation services; third party reproduction services, namely, assisting couples who require a third party to achieve pregnancy whether using an egg donor (known or anonymous), sperm donor (known or anonymous) or a gestational surrogate; acupuncture and naturopathic services, namely, assessing, treating and counselling patients through the application of naturopathic medicine, natural therapy and naturopathic health care; diagnosis and surgical treatment of uterine abnormalities, ectopic pregnancy and missed abortions; management of early pregnancy

and reject the opposition for the services of dispensing of prescription medication.

The whole pursuant to section 38(12) of the Act.

Jean Carrière
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

Hoffer Adler LLP

FOR THE OPPONENT

Ridout & Maybee

FOR THE APPLICANT