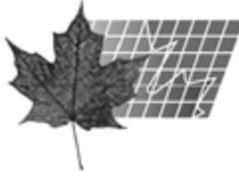


O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 64**

**Date of Decision: 2020-05-29**

**IN THE MATTER OF AN OPPOSITION**

**Navsun Holdings Ltd.**

**Opponent**

**and**

**Sadhu Singh Hamdard Trust**

**Applicant**

**1,762,819 for AJIT**

**Application**

INTRODUCTION

[1] Navsun Holdings Ltd. (the Opponent) opposes registration of the trademark AJIT (the Mark), which is the subject of application No. 1,762,819 (the Application), filed on January 11, 2016 by Sadhu Singh Hamdard Trust (the Applicant).

[2] The Application is in association with the following goods and services (collectively the Goods and Services):

**Goods**

(1) Newspapers and magazines.

**Services**

(1) Advertising the wares and services of others; classified advertising services and display advertising services for third parties.

(2) Provision of news and information, namely, business, financial, political, sports, tourism, travel, lifestyle, weather, community and culture via a global computer network; Operation of a website in the field of the development and progress of Punjabi community, language and culture.

(3) Provision of news and information, namely, business, financial, political, sports, tourism, travel, lifestyle, weather, community and culture via newspapers and magazines.

[3] The Application is based on use of the Mark in Canada since at least as early as 1968 in association with the goods and services (1) and (3), and use of the Mark in Canada since at least as early as July 2002 in association with services (2).

[4] The Application was advertised for opposition purposes in the *Trademarks Journal* on August 17, 2016. On October 17, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that 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 which refer to the Act as it read before it was amended (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 prior to that date).

[5] The Opponent raises grounds of opposition based on non-distinctiveness under section 2; non-entitlement under section 16(1)(a); and non-compliance with sections 30(b) and 30(i) of the Act.

[6] The Applicant filed a counter statement on December 22, 2016 denying the grounds of opposition.

[7] Both parties filed evidence, which is discussed below. Both parties filed written representations and were represented at an oral hearing.

[8] For the reasons that follow, the Application is refused.

#### BACKGROUND OF THE PARTIES

[9] The two parties to this opposition proceeding have an extensive and ongoing history of legal disputes in Canada (and other jurisdictions) relating to the trademark AJIT. Within the past five years, there have been at least seven decisions relating to these disputes, from this Board, the

Federal Court and the Federal Court of Appeal [see *Navsun Holdings Ltd v Sadhu Singh Hamdard Trust*, 2015 TMOB 214, aff'd 2018 FC 42, aff'd 2019 FCA 10 (*Navsun Opposition #1*); *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2014 FC 1139, rev'd by 2016 FCA 69 (*Hamdard Trust Infringement #1*); *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2018 FC 1039, rev'd by 2019 FCA 295 (*Hamdard Trust Infringement #2*)]. Some of these prior decisions will be referred to at various points in this decision.

[10] It is useful to begin with a summary of the nature of the parties' businesses and activities. As these facts have now been canvassed in multiple proceedings (and the evidence in this proceeding is consistent with that in the other decisions referenced above), I will be brief.

[11] Both the Applicant and the Opponent publish Punjabi-language newspapers in association with the trademark AJIT. In Punjabi, the word "Ajit" means "invincible" or "unconquerable." For ease of reference in this decision, I will refer to the Applicant's newspaper as the "*Ajit Daily*" and the Opponent's newspaper as the "*Ajit Weekly*".

[12] The Applicant's *Ajit Daily* newspaper has been published in India since 1955 and is well known among the Punjabi population in India. The *Ajit Daily* has been available via subscription in Canada since 1968, albeit with limited circulation. An online version of the *Ajit Daily* has been available since 2002.

[13] The Opponent's *Ajit Weekly* newspaper is a free weekly newspaper that has been published in Canada since 1993 and is distributed in Vancouver and Toronto. An online version of the *Ajit Weekly* has been available since 1998.

[14] The Applicant was the first to use the trademark AJIT in Canada in association with newspapers, as the *Ajit Daily* was available in Canada since 1968. However, since 1993, the Opponent has been concurrently using the trademark AJIT in Canada association with its *Ajit Weekly* newspaper. While the Applicant asserts that the Opponent's use of AJIT infringes the Applicant's rights, as of the date of this decision the Opponent has not been enjoined by a Canadian Court from continuing to use the trademark AJIT.

[15] Prior to filing the Application in issue in this proceeding, the Applicant on June 30, 2010 filed an earlier application No. 1,487,122 for the same trademark AJIT, based on use in Canada

since at least as early as 1968 (the '122 Application). The '122 Application, as amended, was in association with the goods “printed publications and newspapers”. The '122 Application was opposed by the Opponent herein (by statement of opposition dated December 28, 2012), and that proceeding was the subject of *Navsun Opposition #1*, referenced above.

[16] By decision of the Registrar dated August 15, 2015, the Registrar refused the '122 Application on the ground of non-distinctiveness in view of the Opponent's longstanding use and reputation in Canada in the trademark AJIT via the *Ajit Weekly* newspaper. The Registrar held that, despite the fact that the Applicant may have been the first party to use the trademark AJIT in Canada in association with newspapers, by the material date for the distinctiveness ground of opposition, the Opponent had concurrently been using the trademark AJIT in Canada for more than a decade, in a manner that was sufficient to negate the distinctiveness of the Applicant's trademark.

[17] The Registrar's decision refusing the '122 Application on the ground of non-distinctiveness was upheld on appeal by both the Federal Court and the Federal Court of Appeal. Leave to appeal to the Supreme Court of Canada was denied and thus the Federal Court of Appeal's decision in *Navsun Opposition #1* is final. In upholding the Registrar's refusal of the '122 Application, the Federal Court of Appeal made the following assessment of the Opponent's distinctiveness ground of opposition (note that the appellant in *Navsun Opposition #1* was the Applicant herein, and the respondent was the Opponent herein):

[15] Whether or not the appellant was the first to use the mark in Canada and whether or not the respondent's subsequent use was infringing are of no consequence where, as here, the parties have used the mark concurrently for over a decade, and, in that time, the respondent has successfully acquired notoriety in the mark in Canada sufficient to negate the distinctiveness of the appellant's mark. As noted by this Court in *Farside Clothing Ltd. v. Caricline Ventures Ltd.*, 2002 FCA 446 at paragraph 9, 22 C.P.R. (4th) 321 (*Farside Clothing*), infringing prior use may cause a mark to lose its distinctiveness, although the extent or degree to which distinctiveness is eroded by infringing use remains a question of fact to be considered in each case. The allegation of passing off does not preclude a party from relying on the alleged infringing use to challenge distinctiveness.

[16] It is incumbent upon a trader to protect the distinctiveness of its mark, even in the face of infringing use (see *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22 at para. 26, [2006] 1 S.C.R. 772; *Suzanne's* at paras. 6-7; *Farside Clothing* at para. 9). The new evidence of readership in relation to the appellant's newspaper cannot change that fact. It

was open to the appellant to take sufficient steps to protect its rights to the impugned mark, which it did not do.

[17] Before the Federal Court, and in this Court, the appellant argued that there is a legal principle which bars a party from relying on its own confusing use of a trademark to challenge another's right to the mark. The judge dismissed this argument, and was correct to do so. The test is not whether the respondent's mark was distinctive of its own publications; rather the question, as established in *Bojangles'*, is whether at the date of filing of the opposition, the respondent's use of its own mark had negated the distinctiveness of the appellant's mark. The Board found the respondent's mark was sufficiently known to negate the distinctiveness of the appellant's mark, and like the Federal Court judge, I find that this conclusion was reasonable.

[18] As will be discussed in further detail, below, in my view, the above analysis by the Federal Court of Appeal, conducted on facts that were nearly identical to the present proceeding, is sufficient to dispose of the present opposition in the Opponent's favour. While there are some differences in the description of goods and services between the '122 Application and the present Application, and in the Applicant's evidence of the use of its Mark online, in my view, those differences are not a basis on which to distinguish the Federal Court of Appeal's decision in *Navsun Opposition #1*.

[19] In addition to the earlier opposition proceeding involving the '122 Application, in 2010 the Applicant also commenced an action against the Opponent in the Federal Court alleging, *inter alia*, passing-off and copyright infringement (a claim for trademark infringement relating to a registered design trademark owned by the Applicant was later added). That action has twice been considered by both the Federal Court and Federal Court of Appeal, with the Federal Court of Appeal most recently sending the matter back to the Federal Court for redetermination [see *Hamdard Trust Infringement #1* and *Hamdard Trust Infringement #2, supra*]. As of the date of this decision, the action in the Federal Court remains unresolved on its merits.

## EVIDENCE

### **Opponent's Evidence**

[20] In support of its opposition, the Opponent filed the affidavit of Kanwar (Sunny) Bains sworn April 19, 2017 (the Bains Affidavit). Mr. Bains is the shareholder and Director of the Opponent. Some of the more relevant facts from his affidavit are summarized below.

[21] Since 1993, the Opponent and its predecessors in title and licensees have published a weekly newspaper in Canada called the *Ajit Weekly*. The *Ajit Weekly* is a weekly, free newspaper that generates all of its revenue from the sale of advertising in the newspaper and on the related website *ajitweekly.com*. The *Ajit Weekly* is printed in the Punjabi language and is targeted to the Punjabi community in Canada and the United States.

[22] Each week, the *Ajit Weekly* newspaper gets delivered in bundles to newspaper boxes in various locations in the Greater Toronto and Vancouver Areas, including grocery stores, supermarkets and newspaper stands. There are rarely any copies of the *Ajit Weekly* newspapers left in the newspaper boxes at the end of the week. The volume of *Ajit Weekly* newspapers that are circulated each week has remained steady over the years, with 12,000 newspapers per week printed from the Opponent's Vancouver-based printer and 11,000-12,000 newspapers per week printed from its Toronto-based printer.

[23] The *Ajit Weekly* newspaper bears the trademark AJIT on its front page, and the newspaper boxes also bear the trademark AJIT.

[24] In 1998, through a licensee, the Opponent began operating a website at the domain *ajitweekly.com*. The website displays the trademark AJIT. The website publishes electronic versions of the *Ajit Weekly* newspaper as well as offering other information, entertainment and communication services to the Punjabi community.

[25] Mr. Bains was cross-examined on his affidavit and the transcript from that cross-examination forms part of the record.

### **Applicant's Evidence**

[26] In support of the Application, the Applicant filed three affidavits discussed below. As this evidence is extensive and there is some overlap in the content of the three affidavits, I have briefly summarized some of the more pertinent facts, and the evidence is further discussed in the analysis of the grounds of opposition. None of the Applicant's affiants were cross-examined.

*Affidavit of Dr. Barjinder Singh Hamdard dated August 17, 2017 (the Hamdard Affidavit)*

[27] Mr. Hamdard is the Editor-in-Chief of the *Ajit Daily* newspaper and has held that position since 1984. He states that the *Ajit Daily* newspaper was started in Jalandhar, a city in the Punjab state of India, on November 1, 1955. The *Ajit Daily* is published by the Applicant, which is a public charity that works for the progress of Punjabis, Punjabi language and culture.

[28] The contents of the *Ajit Daily* are typical of a daily newspaper, and include local, national and international news, weather forecasts, sports, advertisements by businesses and classified advertisements. Mr. Hamdard indicates that the *Ajit Daily* is the largest Punjabi language newspaper in the world, with an average daily circulation in excess of 400,000 copies recorded during the period from July to December 2017.

[29] Mr. Hamdard states that since the *Ajit Daily* is a daily newspaper, its circulation on paper beyond India is thin due to the factor of later delivery and because of large geographic distances. Thus, not many daily subscriptions are sold outside of India and the paper is instead read on the Internet at the Applicant's website *ajitjalandhar.com*, and also using an online mobile application.

[30] Nevertheless, the *Ajit Daily* has had subscribers in Canada since at least 1968, and Mr. Hamdard provides data regarding the annual number of subscribers to the *Ajit Daily* in Canada during the period from 1990 to 2016. These figures vary from a high of forty three (43) Canadian subscribers in 1991 to a low of one (1) Canadian subscriber in 2013.

[31] Included in the Hamdard Affidavit as Exhibit 3 are the particulars for the Applicant's Canadian registration No. TMA914,925 for the trademark Ajit Design, depicted below:



[32] The above design trademark (which the registration particulars indicate is comprised of the word "Ajit" written in Punjabi characters) is displayed as part of the masthead of the *Ajit*

*Daily* newspaper. I note that TMA914,925 is the trademark registration being asserted by the Applicant against the Opponent in the Federal Court litigation, referenced above.

*Affidavit of Sukhvinder Singh dated August 17, 2017 (the Singh Affidavit)*

[33] Mr. Singh is employed by the Applicant as the Marketing Manager for the *Ajit Daily* newspaper. He describes that the Applicant has published the *Ajit Daily* newspaper online at the website *ajitjalandhar.com* continuously since 2002. The content and layout of the newspaper on the website are the same as the printed, paper version, and the online content is available on the same day the paper version is published. Since May 2008, the servers on which the website operates have been located in Montreal, Canada. Using various online analytics tools, Mr. Singh indicates that during the period from May 11, 2008 to August 31, 2008, there were 909,405 visits to this website from Canadian IP addresses.

[34] Mr. Singh indicates that since 2013, the readership figures for the website declined, which coincides with the release of an online application in December 2012 that permits readers to access the *Ajit Daily* newspaper using cell phones and tablets. Mr. Singh indicates that approximately 72,000 people in Canada have downloaded the application.

*Affidavit of Satpaul Singh Johal dated August 17, 2017 (the Johal Affidavit)*

[35] Mr. Johal is a Staff Correspondent in Canada employed by the Applicant to write for the *Ajit Daily* newspaper. He has had this position since 2001, and indicates that there are seven other correspondents who work for the *Ajit Daily* newspaper in Canada. He and the other correspondents in Canada publish stories in the *Ajit Daily* about events in Canada of interest to Punjabis in Canada, including political, social, cultural and sporting news. Mr. Johal indicates that the *Ajit Daily* publishes approximately 50-70 classified advertisements each day relating to Canada and Canadians.

ONUS AND MATERIAL DATES

[36] The Applicant bears the legal onus of establishing, on a balance of probabilities that the application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the

evidence, then the issue must be decided against the Applicant. 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[37] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a)/30 of the Act - the filing date of the Application, namely, January 11, 2016 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(c)/16(1)(a) - the claimed date of use of the Mark, namely, 1968 for goods and services (1) and (3), and July 2002 for services (2);
- Sections 38(2)(d) of the Act - the filing date of the opposition, namely, October 17, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

## ANALYSIS

### **Distinctiveness Ground of Opposition – Section 2**

[38] With this ground of opposition, the Opponent alleges that the Mark is not distinctive of the Applicant in accordance with section 2 of the Act, in view of the Opponent's longstanding use in Canada of the trademark AJIT in association with the same goods and services. This same ground of opposition was raised by the Opponent against the '122 Application in *Navsun Opposition #1*.

[39] "Distinctiveness" is defined in section 2 of the Act as follows:

*distinctive*, in relation to a trade-mark, means a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them;

[40] It is well established that in order to meet its initial evidential burden under this ground, an opponent must show that its trademark had a substantial, significant or sufficient reputation in

Canada in association with relevant goods and/or services [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FC) at para 34 (*Bojangles*)]. In the present case, the Opponent has met that initial evidential burden. The Opponent has demonstrated continuous use of the trademark AJIT in association with newspapers in Canada since 1993 via its *Ajit Weekly* newspaper, and in association with the online version of that newspaper since 1998.

[41] The Opponent having met its initial evidential burden, the question then becomes whether the Applicant has demonstrated, on a balance of probabilities, that the Mark is distinctive of the Applicant in Canada pursuant to section 2, despite the Opponent's use of the trademark AJIT. In my view, the Applicant has not satisfied that legal burden. As was held in *Navsun Opposition #1*, in this case the Opponent's evidence of its use of the trademark AJIT in Canada since 1993 is sufficient to negate the distinctiveness of the Applicant's Mark in association with the Goods and Services. In this regard, I adopt the Federal Court of Appeal's analysis at paragraphs 15 to 17 of *Navsun Opposition #1*, cited above, which was in respect of the same ground of opposition against the same trademark, involving the same parties on nearly identical facts to this proceeding.

[42] I will note that one potentially material difference in the factual matrix between the present opposition proceeding and *Navsun Opposition #1* is the specific Goods and Services identified in the Application as compared to the '122 Application. Recall that in *Navsun Opposition #1* the goods in issue in the '122 Application, as amended, were "printed publications and newspapers". With the present Application, the Goods and Services are as follows:

**Goods**

(1) Newspapers and magazines.

**Services**

(1) Advertising the wares and services of others; classified advertising services and display advertising services for third parties.

(2) Provision of news and information, namely, business, financial, political, sports, tourism, travel, lifestyle, weather, community and culture via a global computer network; Operation of a website in the field of the development and progress of Punjabi community, language and culture.

(3) Provision of news and information, namely, business, financial, political, sports, tourism, travel, lifestyle, weather, community and culture via newspapers and magazines.

[43] In my view, the difference in the goods and services between the '122 Application and the present Application (and the Applicant's evidence in this case of use of the Mark in association with services (1), (2) and (3)) is not sufficient to distinguish the present case from *Navsun Opposition #1*. The goods in the '122 Application and the present Application are effectively identical. With respect to the services listed in the Application (which were not present in the '122 Application, as amended), each of these services are simply an integral aspect of the Applicant's provision of its newspaper.

[44] For example, services (2) in the Application include the “[p]rovision of news and information [...] via a global computer network” and “[o]peration of a website in the field of the development and progress of Punjabi community, language and culture”. The Applicant's evidence suggests that these services are part of its provision of the *Ajit Daily* newspaper online at *ajitjalandhar.com*. If the Opponent's evidence of use of the trademark AJIT in Canada is sufficient to negate the distinctiveness of the Mark in association with newspapers (as I find in this case and as was found in *Navsun Opposition #1*), in my view, it is also sufficient to negate the distinctiveness of the Mark in association with the provision of online newspapers. I am reinforced in this view by paragraph 35 of the Johal Affidavit, filed by the Applicant, which states as follows:

Most of the world's newspapers are now published online, sometimes to the exclusion of printed copies. The public has no difficulty finding or recognizing their newspapers online. It is consumer demand to read newspapers online which has caused the change.

[45] Further, at paragraph 97 of its written representations, the Applicant takes the position that: “Newspaper readers understand the word ‘newspaper’ to include online editions.”

[46] In short, I do not consider there to be any factual basis to distinguish this case from the Federal Court of Appeal's decision in *Navsun Opposition #1*.

[47] At paragraphs 101 to 118 of its written representations, and at the hearing, the Applicant made a legal argument that a trademark can only be found to be non-distinctive if the mark is descriptive or has become generic, and that concurrent use of a confusing trademark cannot be a

source of non-distinctiveness. I respectfully disagree with the Applicant's position on this point. In my view, that argument has been implicitly rejected by paragraphs 15 to 17 of the Federal Court of Appeal's decision in *Navsun Opposition #1*, where the same trademark AJIT was found to be non-distinctive in view of the Opponent's longstanding use of its mark, despite there being no suggestion that the trademark was descriptive or generic.

[48] It is worth noting that with a ground of opposition under section 2, the issue is not simply which party was first to use the trademark AJIT in Canada, nor whether the Opponent is entitled to continue using its trademark. The issue under section 2 in this proceeding is whether the Applicant is entitled to registered exclusive rights in Canada in the word trademark AJIT, despite the fact that the Opponent has continuously used that same trademark in Canada since 1993. In those factual circumstances, is the trademark AJIT distinctive of the Applicant in Canada for the purposes of section 2? For the reasons set out above, I must answer that question in the negative and therefore the Opponent's section 2 ground of opposition succeeds.

### **Remaining Grounds of Opposition**

[49] As I have found in favour of the Opponent with respect to the section 2 ground of opposition, which is sufficient to dispose of this opposition proceeding, I will refrain from addressing the remaining grounds of opposition.

### DISPOSITION

[50] In view of the above, 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.

---

Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

---

**HEARING DATE** 2020-02-25

**APPEARANCES**

Tamara Ramsey For the Opponent

David Allsebrook For the Applicant

**AGENTS OF RECORD**

Dale & Lessmann LLP For the Opponent

LudlowLaw For the Applicant