



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 203

Date of Decision: 2021-09-20

IN THE MATTER OF AN OPPOSITION

Chicago Mercantile Exchange Inc.

Opponent

and

Canadian Mortgage Experts Inc.

Applicant

**1,755,117 for Canadian Mortgage
Experts Logo**

Application

INTRODUCTION

[1] Canadian Mortgage Experts Inc. (the Applicant) has filed application No. 1,755,117 (the Application) to register the trademark Canadian Mortgage Experts Logo (the Mark), depicted below.



[2] The Application is in association with the following services (hereinafter Services (1) and Services (2)):

(1) Home equity lending brokerage services; mortgage rate monitoring services; inflation hedging services;

(2) Mortgage brokerage; mortgage services.

[3] The Application was filed on November 16, 2015 based on proposed use of the Mark in Canada in association with Services (1) and use of the Mark in Canada since at least as early as 2010 in association with Services (2).

[4] The Application was advertised for opposition purposes in the *Trademarks Journal* on December 14, 2016. On May 15, 2017, Chicago Mercantile Exchange Inc. (the Opponent) filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[5] The Opponent raises grounds of opposition based on non-distinctiveness under section 2, non-registrability under section 12(1)(d), non-entitlement under section 16(3)(a), and non-compliance with sections 30(a), (b) and (i) of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies on its use and/or registration of multiple trademarks which include, or are comprised of, the term CME. The Opponent's trademarks are identified at paragraph 2 and Schedule "A" to the statement of opposition, and include registration Nos. TMA301968 and TMA645644, both for the word trademark CME. For ease of reference, I have identified some of the particulars of the Opponent's registration Nos. TMA301968 and TMA645644 in the table below.

Reg. No.	Trademark	Goods/Services
TMA301968	CME	Conducting a security, mercantile, commodity and monetary exchange and providing [<i>sic</i>] services connected therewith.
TMA645644	CME	Goods: Computer hardware and software for use in providing financial exchange services. Services: Providing temporary use of non-downloadable software for use in providing financial exchange services.

[6] The Applicant filed a counter statement denying the grounds of opposition. Both parties filed evidence and written representations. Only the Opponent requested a hearing, but that request was conditional on the Applicant also requesting a hearing which did not occur. Consequently, the matter proceeded to decision without a hearing.

EVIDENCE

[7] Salient aspects of the parties' evidence are summarized below, and the evidence is further discussed in the analysis of the grounds of opposition.

Opponent's Evidence-in-chief

[8] The Opponent filed as its evidence-in-chief the affidavit of Dane Penney sworn August 10, 2018 (the Penney Affidavit), the affidavit of Mathew J. Kelly sworn August 10, 2018 (the Kelly Affidavit) and the supplemental affidavit of Mathew J. Kelly sworn August 22, 2018 (the Supplemental Kelly Affidavit).

Penney Affidavit

[9] Mr. Penney is a trademark search specialist employed by the Opponent's agent. His affidavit includes the results of various searches of the Canadian Intellectual Property Office *Goods and Services Manual*, as well as screenshots and archived screenshots from the website at <http://cmexp.com/>.

Kelly Affidavit

[10] Mr. Kelly is the Managing Director and Chief Intellectual Property Counsel with the Opponent. He states that the Opponent is part of CME Group Inc., one of the world's leading financial institutions, which operates four exchanges: CME or Chicago Mercantile Exchange, CBOT or Chicago Board of Trade, COMEX or Commodity Exchange, and NYMEX or New York Mercantile Exchange (collectively defined in the Kelly affidavit as "CME"). He states that the Opponent and its predecessors have used the trademark CME in Canada for almost 100 years in association with financial exchange and risk management services.

[11] Mr. Kelly states that the CME exchanges provide the world's leading and most diverse international marketplace for the exchange, trading and clearing of financial derivative products, namely, futures and options contracts, swaps and over-the-counter derivative products. At paragraph 23 of his affidavit, Mr. Kelly explains that futures contracts manage risk by allowing sellers of commodities to know with certainty the price they will receive for their products at the market. Individuals can hedge their risk and lock in prices that are critical for business activities.

[12] Mr. Kelly states that the CME trademark has been prominently advertised on the CME website at <*cmegroup.com*> since at least as early as 1998, and that the CME website is accessible to users in Canada and regularly used by customers in Canada to access their CME accounts and CME's financial exchange and risk management services. Representative screenshots of the website bearing the trademark CME, from 2008 through 2018, are included as Exhibit "O" to the Kelly Affidavit.

[13] Mr. Kelly states that CME Group Marketing Inc. is the entity responsible for promoting CME's products and services to the Canadian market, and was incorporated in Canada in November 2009 and operates out of CME's Calgary office.

[14] Mr. Kelly states at paragraph 35 of his affidavit that "[i]nflation hedging services fall squarely within the umbrella of risk management services" and at paragraph 36 that "[c]ustomers come to CME to hedge against risk, specifically to hedge against risks associated with inflation. Due to the interplay between interest rates and inflation, CME's risk management services, including its interest rate futures and options contracts, are substantially identical to inflation hedging services."

[15] At paragraph 38 of his affidavit, Mr. Kelly states "I am not aware of any other similar trademarks in Canada, containing CME, and covering financial exchange and risk management services."

Supplemental Kelly Affidavit

[16] The Supplemental Kelly Affidavit provides additional facts to those in the Kelly Affidavit, discussed above. Mr. Kelly describes that CME has hosted events in the Calgary area

for Canadian customers, including an annual event related to the Calgary Stampede, and attaches as Exhibit FF the invitation to that event.

[17] With respect to CME's website at *www.cmegroup.com*, Mr. Kelly indicates that CME's customers in Canada regularly visit the CME website, and that the CME website received in excess of 5 million page views per year from Canada from 2015 to 2017.

[18] Mr. Kelly also describes CME's sponsorship of the Ladies Professional Golf Association, including the Canadian-Pacific Women's Open event in Saskatchewan. Printouts related to these events bearing the trademark CME are attached as Exhibit GG.

Applicant's Evidence

[19] The Applicant filed the affidavit of Betty Wu sworn December 26, 2018 (the Wu Affidavit). Ms. Wu is a lawyer with the law firm representing the Applicant. Her affidavit includes the results of an online search using the keywords "CME" and "Canada" as well as comments regarding an entity identified as "CME Federal Credit Union" and screenshots from a website at the address *https://cmefcu.org*.

Opponent's Reply Evidence

[20] The Opponent filed as reply evidence the affidavit of Dane Penney sworn February 8, 2019 (the Penney Reply Affidavit). This affidavit includes printouts from various websites relating to credit unions, including the credit union identified in the Wu Affidavit.

ONUS AND MATERIAL DATES

[21] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[22] The material dates for the grounds of opposition are set out below.

- Sections 38(2)(a) / 30 – the filing date of the Application [*Delectable Publications Ltd v Famous Events Ltd*, (1989) 24 CPR (3d) 274 (TMOB); *Tower Conference Management Co v Canadian Exhibition Management Inc*, (1990) 28 CPR (3d) 428 (TMOB)];
- Sections 38(2)(b) / 12(1)(d) of the Act – the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]
- Sections 38(2)(c) / 16(3)(a) – the filing date of the Application; and
- Sections 38(2)(d) / 2 of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Preliminary Issues

Admissibility of the Wu Affidavit

[23] As noted above, Ms. Wu is a lawyer with the law firm representing the Applicant. Her affidavit is comprised of three paragraphs, with paragraphs 2 and 3 each having a related Exhibit “A” and “B” respectively. Paragraph 2 describes an online search conducted by Ms. Wu using the Google search engine and the terms “CME” and “Canada”. Exhibit “A” is a screenshot of the first page of the search results generated by the search engine. Printouts of the webpages that constitute the individual results of the search are not included. In paragraph 2, Ms. Wu states “The results returned indicated that the 8th ranked result is the first result that displays any affiliation with the opponent.”

[24] Paragraph 3 of the Wu Affidavit states that it is “[i]n response to paragraph 38 of Affidavit of Matthew J. Kelly made August 10, 2018”. Paragraph 3 includes the statement that “a Google search provided that CME Federal Credit Union, an American-based credit union, appears to provide services in the provinces of Alberta and Saskatchewan, Canada”. The search parameters and search results that form the basis for that commentary in paragraph 3 of the Wu Affidavit are not included. Exhibit “B” is comprised of screenshots from the website

<https://cmefcu.org> which appears to be a website relating to CME Federal Credit Union. Exhibit “B” identifies the contact address for CME Federal Credit Union as being in Columbus, Ohio. There is no discussion in Exhibit “B” of any services being offered in Canada.

[25] The Applicant’s written representations do not explain why the Wu Affidavit supports the Applicant’s position on any issue in the proceeding, though presumably it was filed in part to try to demonstrate that there are other entities operating in Canada in association with the term “CME”, which would potentially narrow the scope of protection afforded to the Opponent’s trademarks.

[26] The Opponent contends that the Wu Affidavit is inadmissible as it constitutes evidence on a contentious issue in the proceeding from an employee of the law firm representing one of the parties, contrary to the principles set out in the leading decision *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2006 FCA 133, 53 CPR (4th) 286 (*Cross-Canada*). The Applicant argues that the affidavit consists of online searches that are readily reproducible by any other party, are not contentious in nature, and therefore that there is no reason to exclude such evidence.

[27] Starting with paragraph 2 of the Wu Affidavit and the related Exhibit “A”, even if this evidence is admissible, it is of no probative value to any issue in this proceeding. A printout of the first page of online search results, without anything further, in my view, does not provide any meaningful insight into the state of the marketplace in Canada with respect to the Opponent’s use of its trademark or the use of third party trademarks.

[28] With respect to paragraph 3 of the Wu Affidavit, wherein the affiant provides commentary regarding where and what services are provided by a third party business under a particular trademark, in my view, that evidence is not admissible under the principles set out in *Cross-Canada*. However, regardless of the question of admissibility based on *Cross-Canada*, the evidence contained in paragraph 3 is also hearsay which ought not be admitted for the truth of its contents, as it is neither necessary nor reliable. Indeed, the affidavit does not provide the online search results which purport to be the basis for the commentary included in paragraph 3. The related Exhibit “B”, to the extent it is admissible, relates solely to the activities of a third party business in the United States, and thus is irrelevant to this proceeding.

[29] For the reasons above, I have not attributed any weight in this proceeding to any aspect of the Wu Affidavit.

Ambiguities in the Kelly Affidavit

[30] The Kelly Affidavit includes definitive statements that the Opponent and its predecessors have used the trademark CME for almost 100 years in association with financial exchange and risk management services, including in Canada (see paragraphs 3 and 18 of the Kelly Affidavit), and the Kelly Affidavit is replete with examples of use of the trademark. That evidence was not challenged by the Applicant via cross-examination, nor did the Applicant file any contrary evidence. Consequently, I am satisfied that the Kelly Affidavit demonstrates use by the Opponent of the trademark CME in Canada in association with financial exchange and risk management services since prior to all of the material dates in this proceeding.

[31] However, when it comes to the question of the full scope of the Opponent's use of its trademark CME in Canada, and the extent of reputation and goodwill which the Opponent has acquired, there are ambiguities in the Kelly Affidavit (and similarly in the Supplemental Kelly Affidavit) which in my view prevent me from assessing that issue. In particular, the Kelly Affidavit differentiates in its defined terms between a variety of entities, including the Opponent (defined as "My Company") the four exchanges operated by CME Group Inc. (defined collectively as "CME") and an additional entity operating in Canada named "CME Group Marketing Canada Inc." Each of these entities is at various points in the Kelly Affidavit and Supplemental Kelly Affidavit presented as using the trademark CME. However, the Kelly Affidavit fails to clarify the relationship between those entities in a way that would allow me to conclude that all use of the trademark CME by entities other than the Opponent accrues to the Opponent pursuant to sections 50(1) and/or (2) of the Act. This has a bearing on the consideration of certain aspects of the grounds of opposition, discussed further below.

Section 30(a) Ground of Opposition

[32] With this ground of opposition, the Opponent asserts that the following services in the Application are not described in ordinary commercial terms in compliance with section 30(a) of

the Act: “Home equity lending brokerage services; mortgage rate monitoring services; inflation hedging services”.

[33] In support of this ground, the Opponent relies on the Penney Affidavit, particularly paragraph 2 of that affidavit and the related Exhibit “A”, wherein Mr. Penney provides the results of a search of the Canadian Intellectual Property Office *Goods and Services Manual* for the following terms: Home equity lending brokerage services; home equity; equity lending; lending brokerage; mortgage rate monitoring services; mortgage rate; inflation hedging services; inflation hedging; and hedging services. No results were obtained from that search of the *Goods and Services Manual*.

[34] However, the mere absence of those descriptions in the *Goods and Services Manual* is not sufficient for the Applicant to meet its initial burden for the section 30(a) ground. The *Goods and Services Manual* provides descriptions which will be accepted by the Office as complying with section 30(a), but does not purport to be an exhaustive collection of all descriptions which so comply. In addition, in my view, the Opponent has not otherwise met its initial evidential burden under section 30(a) via argument.

[35] Consequently, the section 30(a) ground of opposition is rejected.

Section 30(b) Ground of Opposition

[36] With a ground of opposition based on section 30(b) of the Act, it is well established that if the date of use claimed in the application is earlier than the applicant’s actual date of first use of the trademark in Canada, the section 30(b) ground of opposition is successful [*Scenic Holidays (Vancouver) Ltd v Royal Scenic Holidays Ltd*, 2010 TMOB 63].

[37] An opponent’s initial burden under section 30(b) is light [*Tune Masters v Mr P’s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89] and can be met by reference not only to the opponent’s evidence but also to the applicant’s evidence [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230].

[38] In the present case, the Application claims use of the Mark in Canada in association with Services (2) since at least as early as 2010. It is only Services (2) that are in issue for the section

30(b) ground of opposition, since the Application is based on proposed use of the Mark in association with Services (1).

[39] The Opponent relies on paragraph 3 of the Penney Affidavit and the related Exhibit “B”, which indicates that, while the Mark was displayed on the Applicant’s website in 2018, the Mark was not displayed on certain pages of the Applicant’s website in 2010 and 2011. On the facts of the present case, I do not consider that evidence sufficient to meet the Opponent’s initial evidential burden. The absence of an applicant’s trademark on a website, alone, has been held to be insufficient to meet an opponent’s initial evidential burden under section 30(b) if the goods or services concerned would not necessarily be offered online [see *Littlewoods Ltd v Grabish*, 2013 TMOB 34, 111 CPR (4th) 438 at para 14]. Services (2) in the Application are services which are not necessarily offered online, and thus I do not consider the Mark’s absence from the Applicant’s website in 2010 and 2011 to be sufficient for the Opponent to meet its initial evidential burden. There is no evidence from the Applicant regarding the date of use claimed in the Application on which the Opponent can rely.

[40] Consequently, the Opponent has not met its initial evidential burden and the section 30(b) ground of opposition is rejected.

Section 30(i) Ground of Opposition

[41] In the present case, the Opponent has plead two aspects to its section 30(i) ground of opposition. First, it asserts that the Applicant could not have been satisfied it was entitled to use the Mark in Canada because the Applicant was aware or should have been aware of the prior rights of the Opponent in its CME trademarks. Second, the Opponent alleges that the Application does not comply with section 30(i) of the Act because the Applicant’s use of the Mark will depreciate the goodwill in the Opponent’s trademarks, contrary to section 22 of the Act.

[42] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant’s statement untrue, such as evidence of bad faith or non-compliance with a Federal

statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *McDonald's Corporation and McDonald's Restaurants of Canada Limited v Hi-Star Franchise Systems, Inc*, 2020 TMOB 111, 178 CPR (4th) 179 at para 27].

[43] With respect to the first aspect of the Opponent's section 30(i) ground of opposition, it is well established that mere knowledge of the existence of an opponent's trademark is not sufficient to support a section 30(i) ground of opposition [*Woot Inc v WootRestaurants Inc*, 2012 TMOB 197]. Further, there is no evidence to suggest that this is a case involving bad faith. The first aspect of the Opponent's section 30(i) ground is therefore rejected.

[44] With respect to the second aspect of the Opponent's section 30(i) ground, in *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401 at para 46, the Supreme Court of Canada identified the following four elements required to demonstrate a depreciation of goodwill under section 22: (1) use of the trademark, (2) sufficient goodwill in the trademark, (3) likely connection or linkage in the consumer's mind, and (4) likelihood of depreciation. In the present case, neither parties' written representations address section 22 or any of these four elements. In any event, I am not satisfied that the evidence demonstrates a *prima facie* case of a violation of section 22 of the Act sufficient to meet the Opponent's initial evidential burden for the section 30(i) ground of opposition. In particular, I am not satisfied that the Opponent has demonstrated that it has acquired sufficient goodwill in the trademark CME in Canada, in view of the ambiguities in the Kelly Affidavit, discussed at paragraph 31 of this decision, above. Accordingly, the second aspect of the section 30(i) ground of opposition is also rejected.

Grounds of Opposition based on Alleged Confusion – Sections 12(1)(d), 16(3)(a) and 2

[45] With respect to the grounds of opposition that are based on an alleged likelihood of confusion, the statement of opposition suggests that the Opponent's primary objection is to the services identified in the Application as "inflation hedging services".

[46] In particular, paragraph 4 of the statement of opposition states as follows: "The Opponent objects to use and registration of the Trademark in association with the following services that are listed in the Application: 'inflation hedging services', which are a form of risk management

services.” In addition, the Opponent asserts a non-entitlement ground of opposition under section 16(3)(a) of the Act - which addresses Services (1) including inflation hedging services - but the Opponent noticeably does not assert a ground of opposition under section 16(1)(a) to address Services (2). Also, at paragraphs 93 to 112 of the Opponent’s written representations, the Opponent focusses on the “inflation hedging services” when arguing that there is a likelihood of confusion between the parties’ trademarks.

[47] However, since the Opponent has not expressly limited its confusion allegations in other paragraphs of the statement of opposition (see, for example, paragraphs 6(a), (b), (c), and (g) of the statement of opposition), out of an abundance of caution, I will address all of the services in the Application when considering the issue of confusion (keeping in mind the limitation that the section 16(3)(a) ground of opposition only applies to Services (1)).

[48] As noted above, the material dates for the sections 12(1)(d), 16(3)(a) and 2 grounds of opposition differ. However, in my view, the different material dates have no impact on the outcome of the confusion analysis in this case.

[49] In considering the issue of confusion, I will focus on the Opponent’s registered trademark CME that is the subject of registration Nos. TMA301968 and TMA645644, as I consider this to represent the Opponent’s best case. If there is no likelihood of confusion with the Opponent’s registered trademark CME, there will be no likelihood of confusion with the Opponent’s other trademarks, as the Opponent’s other trademarks include additional word and design matter that reduce the degree of resemblance with the Applicant’s Mark.

[50] I am satisfied that the Opponent has met its initial evidential burden with respect to each of the section 12(1)(d) and section 16(3)(a) grounds of opposition. With respect to section 12(1)(d), I have exercised my discretion to check the register and confirm that the Opponent’s registration Nos. TMA301968 and TMA645644 remain extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. With respect to the section 16(3)(a) ground of opposition, I am satisfied that the Opponent has demonstrated use of the trademark CME in Canada since prior to the Application filing date.

[51] With respect to the section 2 ground of opposition, I am not satisfied that the Opponent has met its initial evidential burden to demonstrate that it had acquired a substantial, significant or sufficient reputation in its trademark CME in Canada as of the date of the opposition, for the reasons set out in paragraph 31 of this decision, above [for a discussion of the initial evidential burden under section 2, see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at paras 33-34]. The section 2 ground of opposition is therefore dismissed on that basis. However, in the event that I am wrong on the question of whether the Opponent has met its initial evidential burden for the section 2 ground, then the outcome of that ground would be identical to that for the section 12(1)(d) and section 16(3)(a) grounds, based on the confusion analysis below.

Test for Confusion

[52] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and 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 *Veuve Clicquot, supra*; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 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.

[54] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

The inherent distinctiveness of the trademarks and the extent to which they have become known

[55] While not devoid of inherent distinctiveness, both parties' trademarks possess a low degree of inherent distinctiveness. The Opponent's trademark is comprised solely of the acronym CME, and it is well established that acronyms and abbreviations have a low degree of inherent distinctiveness and are generally entitled to a narrow scope of protection [*GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) at para 51; and *Gemological Institute of America Inc v Gemology Headquarter International LLC*, 2014 FC 1153, 127 CPR (4th) 163]. With respect to the extent to which the Opponent's trademark has become known, as discussed above, I am satisfied that the Opponent has used its trademark in Canada for many years, though I am not satisfied that the scope of the Opponent's use of its trademark been especially significant (given the ambiguities in the Kelly Affidavit discussed in paragraph 31, above). Consequently, I am prepared to accept only that the Opponent's trademark has become known to a limited extent in Canada in the field of financial exchange and risk management services

[56] The Applicant's trademark similarly has a low degree of inherent distinctiveness, given that the most striking aspect of the Mark is the acronym CME. I do not consider the maple leaf design element or the phrase "Canadian Mortgage Experts" to lend any significant inherent distinctiveness, as they are both essentially descriptive features. I have no evidence regarding the scope of the Applicant's use of the Mark in Canada. Therefore, I cannot conclude that the Mark has become known to any extent.

[57] On balance, taking into account the inherent distinctiveness of the trademarks and the extent to which they have become known, this factor favours the Opponent but only slightly.

The length of time the trademarks have been in use

[58] The evidence indicates that the Opponent's trademark has been used in Canada for decades. There is no evidence of the Applicant's use of the Mark, other than a printout from the Applicant's website from 2018 that was filed as part of the Opponent's evidence. Consequently, this factor favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[59] It is the statement of services in the parties' trademark application and registrations that govern the confusion analysis [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, these statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties can be useful, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB)].

[60] All of the services listed in the Application are financial in nature, and all but one of those services appear to specifically relate to the real estate field – i.e. in my view, the services “Home equity lending brokerage services; mortgage rate monitoring services; Mortgage brokerage; mortgage services” would be reasonably understood to relate to the field of real estate. The one exception is the service “inflation hedging services”. In the absence of evidence to the contrary, I do not consider “inflation hedging services” to be tied specifically to the real estate field.

[61] The services listed in the Opponent's registrations are also financial in nature, and relate specifically to financial exchange services, such as security, mercantile and commodity exchange services, and provision of related software. The Opponent's evidence of its use of the trademark CME in Canada appears to be consistent with the description of services in its registrations. There is nothing in the description of services in the Opponent's registrations or in the evidence to suggest that the Opponent is engaged in services similar to the real estate related services in

the Application. However, the Opponent's evidence does indicate that some of its services fall within the field of "inflation hedging services".

[62] The Applicant has not filed any evidence to suggest that the "inflation hedging services" in its Application are different, or would be offered through different trade channels, than the Opponent's services.

[63] In view of the above, I consider this factor to favour the Applicant for all of the services listed in the Application, with the exception of "inflation hedging services" for which I consider this factor to favour the Opponent.

Degree of resemblance

[64] As indicated by the Supreme Court of Canada in *Masterpiece*, the preferable approach when considering the degree of resemblance is to begin by determining whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece, supra*, at paragraph 64].

[65] The striking or unique aspect of the Opponent's trademark is obviously CME. In my view, the striking or unique aspect of the Applicant's Mark is also CME. I do not consider the maple leaf design element or the descriptive words "Canadian Mortgage Experts" to constitute the striking or unique aspect of the Mark. While the words "Canadian Mortgage Experts" in the Applicant's Mark convey an idea that is absent from the Opponent's trademark, I do not consider that to be dispositive given the degree of resemblance the trademarks otherwise share in appearance and sound.

[66] Overall, there is a fair degree of resemblance between the parties' trademarks.

Conclusion regarding confusion

[67] Having considered all of the surrounding circumstances, I conclude that the Applicant has met its legal burden to demonstrate no reasonable likelihood of confusion in respect of the following services: Home equity lending brokerage services; mortgage rate monitoring services; Mortgage brokerage; mortgage services. The Opponent's trademark CME is a weak mark, and

given the narrow scope of protection to which it is entitled, in my view, these services are sufficiently different from the Opponent's services that there is no likelihood of confusion.

[68] However, for the "inflation hedging services", I find that at best for the Applicant the probability of confusion between the Mark and the Opponent's trademarks is evenly balanced between a finding of confusion and no confusion. As the onus is on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion, I must therefore find against the Applicant with respect to the "inflation hedging services".

[69] In view of the above, the section 12(1)(d) and section 16(3)(a) grounds of opposition each succeed with respect to the services "inflation hedging services", and those grounds of opposition are each rejected with respect to the remainder of the services.

DISPOSITION

[70] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the services "inflation hedging services" and I reject the opposition with respect to the remainder of the services 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 No Hearing Held

AGENTS OF RECORD

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For the Applicant