



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 050**

**Date of Decision: 2022-03-21**

**IN THE MATTER OF AN OPPOSITION**

**Portland Holdings Inc.**

**Opponent**

**and**

**Orbis Holdings Limited**

**Applicant**

**1,844,963 for ORBIS INVEST**

**Application**

**DIFFERENTLY DESIGN**

OVERVIEW

[1] ORBIS HOLDINGS LIMITED (the Applicant) has filed application No. 1,844,963 (the Application) to register the trademark ORBIS INVEST DIFFERENTLY Design (the Mark), shown below.



The Mark has been applied for in association with the following services:

Financial services, namely financial analysis, financial asset management, financial forecasting, financial investment analysis and security research; financial intermediation, namely, the acquisition of financial instruments namely, securities, commodities and mutual funds for the benefit of managed clients; financial valuation; preparation of financial and investment records depicting the investment performance of managed clients and strategies; provision of loans; brokerage services for capital investment services; funds investment services; management of portfolios of financial assets; investment and hedge fund management and administration; organization and operation of mutual investment funds; purchase and sale of stocks, shares and securities; commodities trading; futures and options trading; investment advisory services; insurance and reinsurance services; insurance brokerage; investment trust services; unit trust services; treasury funding and trading in the money and foreign exchange markets; real estate management and brokerage; executor and trustee services; financial management and analysis services (the Services).

[2] Portland Holdings Inc. opposes the application on a number of different grounds, including on the basis that the Mark is confusing with the registered trademarks TMA938,986 for THE WEALTHY INVEST DIFFERENTLY. ACCESS THROUGH PORTLAND and TMA938,994 for THE WEALTHY INVEST DIFFERENTLY. ACCESS THROUGH MANDEVILLE (the Registered Marks); which have allegedly been used by the Opponent in Canada in association with similar services as those of the Applicant.

[3] For the reasons that follow, the opposition is rejected.

#### FILE RECORD

[4] The Application was filed on June 28, 2017, and is based on proposed use of the Mark in association with the Services in Canada. The application was advertised for opposition purposes in the *Trademarks Journal* on August 1, 2018.

[5] AIC Global Holdings Inc. (AICGHI) opposed the application on December 31, 2018. AIC Global Holdings Inc. was granted leave to amend its statement of opposition to change the name of the opponent to Portland Holdings Inc. (the Opponent or PHI), the owner of the trademark registrations being relied on in this opposition.

[6] The statement of opposition against the application was filed pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (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 which refer to the Act before it was amended [section 70 of the Act].

[7] The Opponent raises grounds of opposition based on non-conformance under sections 30(e) and 30(i), non-registrability under section 12(1)(d), non-entitlement under section 16(3)(a) and 16(3)(b) and non-distinctiveness under section 2 of the Act. Except for the section 30 grounds, each of the grounds of opposition is based on an allegation of confusion with either the Opponent's Registered Marks and or several common law marks.

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

[9] As evidence in support of its opposition, the Opponent filed the affidavit of Lorraine Sullivan, Paralegal/Senior Law Clerk with AICGHI, a company which she states is under common control with the Opponent. In support of its application, the Applicant filed the affidavit of Karen Lau Cardinell, legal secretary with the Applicant's agent. Neither affiant was cross-examined and the Opponent did not file any evidence in reply.

[10] Only the Applicant filed a written argument, and no hearing was conducted.

#### ONUS

[11] 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 Limited v The Molson Companies Limited*, 1990 CanLII 11059 (FC) at 298].

#### SUMMARY OF THE OPPONENT'S EVIDENCE

[23] As noted above, Ms. Sullivan identifies herself as a Paralegal/Senior Law Clerk at AICGHI. She explains that AICGHI is under "common control with" PHI, a company within the Portland Group of Companies (Portland Group). PHI is a privately held investment company

which owns a collection of diversified businesses operating in sectors that include media, tourism and financial services.

[12] Ms. Sullivan then explains that The Mandeville Group of Companies includes Mandeville Private Client Inc., an investment dealer, Mandeville Insurance Services Inc., a life insurance agency and Portland Investment Counsel Inc., a portfolio manager, exempt market dealer, mutual fund dealer and investment fund manager. As Exhibit A to her affidavit she provides copies of webpages from what she describes as the Portland Holdings website, at *www.portlandholdings.com*, and the Mandeville Group of Companies website, at *www.mandevilleinc.com*, which she states provide information confirming the relationship between: (i) AICGHI and PHI; (ii) Mandeville Group of Companies and PHI; (iii) Portland Investment Counsel and PHI; and (iv) Mandeville Private Client Inc. and PHI, as well as other PHI holdings, including Portland Investment Counsel and other companies within the Mandeville Group of Companies. She does not explain who Portland Holdings is.

[13] Ms. Sullivan further deposes that PHI is the owner of the Registered Marks, as well as the following common law marks: THE WEALTHY INVEST DIFFERENTLY, LES NANTIS INVESTISSENT AUTREMENT, WOMEN INVEST DIFFERENTLY. ACCESS THROUGH MANDEVILLE and THE WEALTHY INVEST DIFFERENTLY. THEY HAVE ACCESS (the Common Law marks). Portland Investment Counsel uses registration No. TMA938,986, and the Common Law marks “in accordance with license rights granted to it by PHI.” Similarly, Mandeville Group of Companies utilizes registration No. TMA938,994 and the Common Law marks “in accordance with license rights granted to it by PHI”.

[14] Attached as Exhibit C to Ms. Sullivan’s affidavit are what she states to be copies of examples of uses by PHI, or through its licensees, of the Common Law Marks of PHI in various forms of media, including articles published in third party online publications, print advertisements, billboard advertisements, brochures and speaker presentations, each bearing the Common Law marks.

[15] Ms. Sullivan states that use of the Registered Marks, by PHI or through its licensees, started at least as early as May 26, 2016, and that all of the marks (including the registered marks and the Common Law marks) were made known in Canada in association with services in the

financial and investment industries, by PHI or through its licensees, in advance of June 28, 2017, and have been used continuously since then. Examples of such use are attached to her affidavit and include the following:

- (a) An example of a marketing brochure of PHI or its licensees;
- (b) Copies of example print advertisements of PHI or its licensees;
- (c) Copies of examples of online advertisements;
- (d) Copies of social media sites where the marks are advertised;
- (e) Copies of speaker engagement advertisements;
- (f) Copies of photos of billboards of a licensee of PHI; and
- (g) Copies of examples of location and team member advertisements of PHI or its licensees.

HAS THE OPPONENT SHOWN LICENSED USE OF ITS MARKS

[16] It was open to the Applicant to cross-examine Ms. Sullivan on her affidavit if it wished to explore what it perceived as unlicensed use, but it chose not to. Having said that, the Applicant was under no obligation to cross-examine as the Registrar has consistently held that such ambiguities are to be resolved against the party putting forward the evidence in an opposition case [see, for example, *Power Budd, LLP v Beaudry*, 2006 CanLII 80342 (TMOB); *Ben Sherman Group Limited v Knautz*, 2013 TMOB 122 (CanLII); *Hunter Douglas Inc v Blinds To Go Inc*, 2007 CanLII 80854 (TMOB)].

[17] I must therefore assess whether the evidence furnished is sufficient to show licensed use by the Opponent of its Registered Marks and/or its Common Law marks in Canada.

[18] There are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control;

or third, by providing a copy of a license agreement that provides for the requisite control [*Empresa Cubana del Tabaco v Shapiro Cohen*, 2011 FC 102 at para 84].

[19] In this case, the only reference to “control”, is the statement by Ms. Sullivan at the beginning of her affidavit that AICGHI is “under common control with” the Opponent, PHI. There is no further explanation about what “common control” means, or whether it even applies to the control over the character and quality of the services offered in association with the various trademarks.

[20] Further, while the affiant states that PHI has granted license rights to both the Mandeville Group of Companies as well as Portland Investment Counsel, such facts are of themselves insufficient to satisfy section 50 of the Act. There is no evidence that the Opponent has direct or indirect control of the character or quality of the services under the license. In the absence of a clear statement or copy of the license agreement providing for the requisite control, I cannot conclude that the licensee’s use accrued to the benefit of the Opponent pursuant to section 50 [see *Empressa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102; *MCI Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB)].

[21] Finally, I note that any reference to licensees in the footnotes of some of the ads produced by Ms. Sullivan either do not refer to the trademarks at issue in this proceeding (*e.g.*, PORTLAND, PORTLAND INVESTMENT COUNSEL and the Clock Tower Design) or state that the trademarks in the ad are used under license by an entity who is not identified by Ms. Sullivan as a licensor (*i.e.*, Mandeville Holdings Inc.). The Opponent cannot therefore rely on section 50(2) of the Act because there is no evidence that public notice has been given that any use shown of any of the trademarks at issue in this proceeding has been licensed use by Portland Holdings Inc. or Mandeville Group of Companies.

[22] For the reasons stated above I am unable to conclude that any use shown enures to the benefit of the Opponent pursuant to section 50 of the Act. I will discuss the impact of this finding in more detail in my confusion analysis below.

## GROUNDINGS THAT CAN BE SUMMARILY DISMISSED

### **Sections 30(e) and 30(i) – Non-compliance with section 30 of the Act**

[23] The Opponent has pleaded that the Applicant could not have been satisfied that it was entitled to use or register the Mark, having regard to the prior and continuous use of the registered trademarks TMA938,986 and TMA938,994 for similar services, knowledge of which the Applicant had or should have had when it filed its application. In addition, the Opponent has pleaded that the Applicant did not intend to use the Mark as alleged in the application or at all.

[24] The Opponent has failed to file any evidence to support a section 30(e) ground of opposition.

[25] With respect to the section 30(i) ground of opposition, it has been held that a ground of opposition based upon this section should only succeed in exceptional cases [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is nothing in the Opponent's pleading or evidence to suggest that this is an exceptional case. Further, mere awareness of prior rights alleged by an opponent, does not preclude an applicant from truthfully making the statement required by section 30(i) of the Act [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197].

[26] Accordingly, both of these grounds of opposition are dismissed.

### **Section 16(3)(b) – Non-entitlement**

[27] The Opponent alleges that the Applicant is not the person entitled to registration pursuant to section 16(3)(b) of the Act, because the Mark is confusing with the Opponent's two previously filed trademark applications for its Registered Marks.

[28] To meet its initial evidential burden with respect to its section 16(3)(b) ground of opposition, the Opponent must show that it had applied-for at least one of its trademarks prior to the Applicant's filing date (*i.e.*, June 28, 2017). Any applications filed before this date must also have been pending as of the advertisement of the Application on August 1, 2018 [section 16(4) of the Act].

[29] Both of the Opponent's trademark applications were registered May 26, 2016, which was prior to the Applicant's advertisement date. The Opponent therefore fails to meet its evidential burden under this ground [*Governor and Co of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co v Kmart Canada Ltd* (1997), 76 CPR (3d) 526 (TMOB) at 528].

[30] Accordingly this ground is also dismissed.

#### REMAINING GROUNDS OF OPPOSITION

##### **Section 12(1)(d) – Non-Registrability**

[31] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks*, 1991 CanLII 11769 (FCA), *Simmons Ltd v A to Z Comfort Beddings Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[32] As noted above, the Opponent has pleaded that the Mark is not registrable because it is confusing with its registered trademark Nos. TMA938,986, for THE WEALTHY INVEST DIFFERENTLY. ACCESS THROUGH PORTLAND and TMA938,994 for THE WEALTHY INVEST DIFFERENTLY THROUGH MANDEVILLE. Both marks are registered in association with the following services:

Sales, brokerage, distribution and investment services in the fields of investment funds, mutual funds, pooled funds, wrap account products, segregated funds, and securities-based investment products; investment counselling and financial planning; and providing investment management services, customized investment services, and customized investment portfolios to private clients (including high net worth individuals, family trusts and holding companies).

[33] I have exercised my discretion and checked the Register and can confirm that both of these registrations are in good standing [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].



[34] The Applicant now has the legal onus of proving on a balance of probabilities that there is not a reasonable likelihood of confusion between the Mark and either of the Opponent's registered trademarks.

When are trademarks confusing?

[35] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

The 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 . . . 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 . . . .

[36] Thus, the issue is not confusion between the trademarks themselves, but confusion of services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's financial and investment services sold with the Mark would believe that they were authorized or licensed by the Opponent.

[37] In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin c Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trademarks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[38] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc.*, 2011 SCC 27 (SCC)

[*Masterpiece*] 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.

#### Analysis of the Section 6(5) Factors

##### *Inherent Distinctiveness and Extent Known*

[39] The section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trademarks. The strength of a trademark may be increased by means of it becoming known in Canada through promotion or use.

[40] The Mark consists of the coined word ORBIS (which has a stylized letter O design) along with the words INVEST DIFFERENTLY.

[41] The Opponent's marks are comprised of what appear to be slogans - THE WEALTHY INVEST DIFFERENTLY. ACCESS THROUGH PORTLAND and THE WEALTHY INVEST DIFFERENTLY. ACCESS THROUGH MANDEVILLE.

[42] Both of the Opponent's marks possess some degree of inherent distinctiveness, but neither mark is inherently strong as each is somewhat suggestive of the character of the associated services. While the Mark is also suggestive of the character of the Services associated with it, I consider it inherently stronger than both of the Opponent's marks because the first element of this Mark is a unique coined word with a stylized design component.

[43] With respect to the extent known of the parties' marks, the Application for the Mark is based upon proposed use. Ms. Lau provides screenshots of representative webpages from the Applicant's website at <https://www.orbis.com/calinstitutional/home> that display the Applicant's Mark. In the absence of more information regarding the date the Applicant began offering its Services on its website in Canada in association with the Mark, as well as an indication about the number of Canadians who have viewed this website, it is not possible to determine to what extent, if any, the Mark has become known in Canada.

[44] The Opponent, on the other hand, has produced the affidavit of Ms. Sullivan to demonstrate the extent known of its marks. While Ms. Sullivan does provide a number of

exhibits which display the Opponent's trademarks, there is very little information regarding where and when most of these ads appeared, or how many people may have seen them. Further, Ms. Sullivan does not provide any invoices or sales figures for any services that have been provided in association with the marks. Finally, as indicated above, I am unable to conclude to what extent, if any, the use shown of the Opponent's registered marks enures to the Opponent. I am therefore unable to determine the extent to which the Opponent's marks have become known in Canada in the hands of the Opponent [*Boehringer Ingelheim Pharma KG v Braintree Laboratories Inc*, 2004 CarswellNat 4704].

[45] In view of the above, I find that, overall, this factor favours the Applicant.

#### *Length of Time in Use*

[46] As noted above, from the evidence furnished it is not possible to determine the length of time the Mark may have been in use in Canada. While there is use shown of the Opponent's registered marks, it is not clear that the use which occurred was in accordance with section 50 of the Act. I am therefore not satisfied that this use would have enured to the benefit of the Opponent.

[47] As a result, this factor does not favour either party.

#### *Nature of the Goods, Services or Business and Trade*

[48] When considering sections 6(5)(c) and (d) of the Act, it is the statement of services as defined in the registrations relied upon by the Opponent and the statement of Services in the Application for the Mark that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[49] The parties both offer financial/investment services and there is no reason to expect that their services would not travel through similar channels of trade.

[50] The Applicant submitted that it is not clear from the evidence what services the Opponent's marks have been used in association with. However, it is evident that the Opponent's marks have been used with services that qualify as financial/investment services and the Opponent acts as an advisor. I will not discuss the Opponent's specific services further but note that services are generally granted a generous or broad interpretation [*Aird & Berlis v Virgin Enterprises Ltd* (2009), 78 CPR (4th) 306 (TMOB)].

[51] This factor therefore favours the Opponent.

#### *Degree of Resemblance*

[52] When considering the degree of resemblance between trademarks, the trademarks must be considered in their totality; it is not correct to lay the trademarks side by side and compare and observe similarities or differences among the elements or components of the trademarks [*Veuve Clicquot Ponsardin c Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20]. In *Masterpiece*, at para 64, the Supreme Court further advises that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trademarks that is particularly striking or unique.

[53] The parties' marks differ primarily because the Applicant's Mark begins with the distinctive word ORBIS, which also has a unique letter O design, while the Opponent's marks begin with the words THE WEALTHY, and then end with the words ACCESS THROUGH along with either the words PORTLAND or MANDEVILLE.

[54] While both the Mark and the Opponent's Registered Marks contain the words INVEST DIFFERENTLY, I consider these words to be suggestive of the parties' services. Therefore, when the marks are considered in their entirety, I do not find much resemblance in appearance or sound between them. The ideas suggested are also more different than similar as the Mark suggests investing differently through Orbis while the Opponent's marks suggest that wealthy people invest differently and need access through PORTLAND or MANDEVILLE in order to do so.

[55] This factor therefore favours the Applicant.

*Surrounding circumstance - Co-existence on the Register of the Trademarks ORBIS INVEST DIFFERENTLY and ORBIS INVEST DIFFERENTLY & Design and the Opponent's marks*

[56] In its written representations, the Applicant identifies its use and ownership of the ORBIS INVEST DIFFERENTLY trademark, registration No. TMA1,017,429 and the ORBIS INVEST DIFFERENTLY & Design, registration No. 1,040,312, shown below, as a relevant surrounding circumstance.



[57] The Applicant submits that the Lau Affidavit conclusively demonstrates that the Applicant's word mark and a similar design mark are already coexisting on the Register with the Opponent's registrations, without issue. Ms. Lau also attaches as an exhibit to her affidavit a screenshot of webpages from the Applicant's website that allegedly displays the Applicant's ORBIS INVEST DIFFERENTLY trademark.

[58] The Applicant further submits that neither of these two marks were opposed by the Opponent despite being advertised in the *Trademarks Journal* in or about late 2018 and early 2019.

[59] It is well established that an applicant's ownership of one or more trademarks does not confer an automatic right to obtain a further registration [*Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc* (1984), 4 CPR (3d) 108 at 115 (TMOB)].

[60] Further, there is insufficient evidence to show that the parties have ever used their marks in the marketplace concurrently without any evidence of confusion.

[61] Based on the foregoing, I do not consider this factor to assist the Applicant.

Conclusion

[62] Having regard to all of the surrounding circumstances, I conclude that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of

confusion between the Mark and the Opponent's THE WEALTHY INVEST DIFFERENTLY. ACCESS THROUGH PORTLAND or THE WEALTHY INVEST DIFFERENTLY. ACCESS THROUGH MANDEVILLE trademarks. Despite the fact that the parties' services are related and that their channels of trade would likely be similar, given that I cannot draw any meaningful conclusion with respect to the acquired distinctiveness of the Opponent's marks, I find that the inherent distinctiveness of the Mark, combined with the differences in the parties' trademarks in appearance and sound, sufficient for me to rule in favour of the Applicant. The section 12(1)(d) ground of opposition is therefore rejected.

### **Section 16(3)(a) – Non-entitlement**

[63] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in that at the date the Application was filed, the Mark was confusing with the INVEST DIFFERENTLY marks, each of which has been previously used in Canada in association with the same or similar services. These marks comprise the Opponent's registered trademarks noted above as well as the following Common Law marks of the Opponent: THE WEALTHY INVEST DIFFERENTLY; LES NANTIS INVESTISSENT AUTREMENT; WOMEN INVEST DIFFERENTLY. ACCESS THROUGH MANDEVILLE; THE WEALTHY INVEST DIFFERENTLY. THEY HAVE ACCESS.

[64] This ground of opposition fails because the Opponent has not met his initial burden to evidence any prior use of any of these trademarks that enures to its benefit. As discussed above, while Ms. Sullivan deposes that both the Registered Marks and the Common Law marks have been used in Canada prior to June 28, 2017, her evidence does not corroborate this assertion. As previously noted, there is very little information regarding where or when the exhibits she provided as evidence were advertised. Further, any evidence of use shows that the trademarks were used by the entities Portland Investment Counsel or Mandeville Private Client Inc., among others. There is no evidence of a license between the Opponent and any of these entities such that use by any of these entities of the Registered Marks or the Common Law marks would enure to the benefit of the Opponent. Section 17(1) of the Act prevents an entitlement ground from succeeding based on use by a party whose use does not qualify as that of the opponent pursuant

to section 50. As the Opponent has not met its burden under this ground, this ground of opposition is rejected.

[65] I would like to add here that even if the Opponent had met its burden under this ground, the differences in material dates between this ground and the section 12(1)(d) ground would not have had a significant impact on the determination of the issue of confusion between the trademarks of the parties. This ground would therefore have been rejected regardless.

## **Section 2 – Non-distinctiveness**

[66] The Opponent has also pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's services from the services of the Opponent, namely those in association with the INVEST DIFFERENTLY marks.

[67] The material date for assessing distinctiveness is the date of filing of the opposition, which is December 31, 2018 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 (FCTD)].

[68] To meet its initial burden with respect to the non-distinctiveness ground of opposition, the Opponent was required to show that at least one of its trademarks had become known sufficiently in Canada to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185; *Motel 6, Inc v No 6 Motel Ltd*, 1981 CanLII 2834 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. Given the evidence summarized above, I am not satisfied that the Opponent has met its burden under this ground. This ground is therefore rejected.

[69] Again, even if the Opponent had met its burden under this ground, the differences in material dates between this ground and the section 12(1)(d) ground would not have had a significant impact on the determination of the issue of confusion between the trademarks of the parties. This ground would therefore have been rejected regardless.

DISPOSITION

[70] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Cindy R. Folz  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



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

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Miller Thomson LLP

For the Opponent

Osler, Hoskin & Harcourt LLP

For the Applicant