



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 124

Date of Decision: 2022-06-23

IN THE MATTER OF AN OPPOSITION

Legacy Private Trust

Opponent

and

640945 B.C. Ltd.

Applicant

**1,781,474 for LEGACY TAX +
TRUST LAWYERS**

Application

INTRODUCTION

[1] Legacy Private Trust (the Opponent) opposes registration of the trademark LEGACY TAX + TRUST LAWYERS (the Mark), which is the subject of application No. 1,781,474 (the Application), that was filed by 640945 B.C. Ltd. (the Applicant).

[2] The Application was filed on May 9, 2016, on the basis of use in Canada since at least as early as October 2000 in association with the following services (the Services):

- (1) Provision of tax advisory services (Class 35);
- (2) Provision of estate planning services (Class 36); and
- (3) Provision of legal services (Class 45).

[3] The Application was advertised in the *Trademarks Journal* of December 28, 2016.

[4] The Opponent alleges that (i) the Application does not conform to the requirements of section 30(b) of the *Trademarks Act*, RSC 1985, c T-13 (the Act); and (ii) the Mark is not distinctive pursuant to section 2 of the Act.

[5] As a preliminary matter, 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).

[6] For the reasons that follow, I reject the opposition.

THE RECORD

[7] The Opponent filed its statement of opposition on May 29, 2017. The Applicant filed and served its counter statement on August 16, 2017, denying the grounds of opposition.

[8] The Opponent subsequently requested and was granted leave to file an amended statement of opposition dated December 12, 2018. The amendments to the statement of opposition were solely to further particularize the list of third-party entities on which the Opponent relies to support its previously pleaded non-distinctiveness ground of opposition pursuant to section 2 of the Act.

[9] In support of its opposition, the Opponent filed the affidavits of Mary P. Noonan (Noonan affidavit #1), sworn December 18, 2017, and of Jasleen Chahal, sworn December 18, 2017. Neither of the Opponent's affiant's were cross-examined on their affidavits.

[10] Ms. Noonan is a trademark searcher employed by the agents for the Opponent. In her affidavit (Noonan affidavit #1), she provides evidence of certain trademarks and corporate searches she performed together with a number of dictionary definitions. Ms. Chahal is an articling student employed by the Agents for the Opponent. She provides evidence of alleged third-party adoption and use of the word "LEGACY" as or as part of a mark or business name in relation to certain services in Canada.

[11] In support of its Application, the Applicant filed the affidavit of James Shumka, sworn May 1, 2018. Mr. Shumka, one of two shareholders of the Applicant, provides evidence with respect to the history of the ownership of the Mark and use of the Mark. Mr. Shumka was cross-examined on his affidavit and the transcript, exhibits, and answers to undertakings form part of the record.

[12] At the same time as filing its section 42 evidence, the Applicant filed an amended application, to update the Applicant's predecessors information, which was accepted by the Registrar on May 14, 2018. The amendment to the Application regarding the predecessors-in-title will be discussed below.

[13] The Opponent, in reply, filed the affidavit of Mary P. Noonan (Noonan affidavit #2), sworn February 21, 2019; and a certified file history for Canadian trademark registration LEGACY LAWYERS (TMA572,467). The Noonan affidavit #2 includes business registry documents, and an archived copy of a document from the Law Society of Upper Canada regarding law firm names. Ms. Noonan was not cross-examined on her affidavit.

[14] Both parties filed written representations, and made representations at a hearing.

ANALYSIS

Section 30(b) Ground

[15] The Opponent pleads that the Mark has not been used by the Applicant or any named predecessors in title within the meaning of section 4 of the Act, with the Services as of the date of use claimed in the Application, nor continuously since that date. To the knowledge of the Opponent, the Applicant did not exist in October 2000 and no predecessors-in-title are listed in the application. As such, the Opponent submits, the Application is invalid on its face.

[16] I note however, that as previously indicated, the Applicant filed an amended application to include the Applicant's predecessors' information, which was accepted by the Registrar on May 14, 2018.

[17] Furthermore, the Applicant correctly submits that where an application is amended to include the applicant's predecessors-in-title, the amended application is what is considered with respect to compliance with section 30(b) of the Act. This is the case even when the application is amended after advertisement [citing *Empire Comfort Systems, Inc v Onward Multi-corp Inc*, 2010 TMOB 30 at paras 14-19; *Athletic Club Group Inc v Ottawa Athletic Club Inc*, 2012 TMOB 217 at para 16; and *Ubermédia Inc v Uber Publicité*, 2015 TMOB 104 at paras 14-15].

[18] Section 30(b) of the Act requires that there be continuous use of the applied-for trademark in the normal course of trade from the date claimed to the filing date of the application [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[19] While the legal burden is upon an applicant to show that its application complies with section 30 of the Act, there is an initial evidential burden on an opponent to establish the facts relied upon by it in support of its section 30 ground [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 at 329 (TMOB); and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. With respect to section 30(b) of the Act in particular, an opponent's initial burden has been characterized as light due to an opponent's limited access to information regarding use relative to the applicant. While an opponent can meet its initial burden by reference to its own evidence, its burden can in some cases be met with reference to the applicant's evidence, in which case the opponent need only show that the

applicant's evidence puts into issue the claims set forth in the applicant's application, on a balance of probabilities [*Corporativo de Marcas GJB, SA De CV v Bacardi & Company Ltd*, 2014 FC 323, and; *Molson Canada v Anheuser-Busch Inc* 2003, 29 CPR (4th) 315].

[20] If an opponent succeeds in discharging its initial evidential burden, the applicant must then, in response, substantiate its claim of use during the material time. However, while an opponent is entitled to rely on the applicant's evidence, if any, to meet its evidential burden, the applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidential burden [see *Kingsley v Ironclad Games Corporation*, 2016 TMOB 19 at para 63].

[21] In the present case, the Opponent is seeking to rely on the Applicant's own evidence to put into issue the claims set forth in the Application.

[22] The Opponent submits that the amended application filed on May 2, 2018, purporting to list two entities as predecessors-in-title, namely, RS Partnership and Legacy V Partnership, a joint venture; and RS Partnership and Legacy Advisors Law Corporation, a joint venture, was filed in response to the allegation in the statement of opposition that the Applicant did not exist as of the October 2000 date claimed in the original application as the date of first use of the Mark by the Applicant.

[23] The Opponent, however, further submits that at the same time the amended application was filed, the Applicant attempted to clarify the relationship between all of the now named entities and how any such use accrued to the named Applicant through the evidence of Mr. Shumka. I will briefly summarize Mr. Shumka's evidence in this regard.

[24] Mr. Shumka attests that the Mark has been used continuously by the Applicant since at least as early as October 2000 in association with the Services, at first through (i) its predecessor Legacy Joint Venture, originally a joint venture between RS Partnership and Legacy V Partnership, and; (ii) subsequently through the Legacy Joint Venture, as its licensee.

[25] Mr. Shumka attests that the Legacy Joint Venture between RS Partnership and Legacy V Partnership was formed based on the intention of the partners to carry on business in common under the name and trademark, the Mark, providing the Services. He explains that the RS

Partnership and the Legacy V Partnership initially formed the Legacy Joint Venture by entering into a written agreement effective September 1, 2000 (the Legacy Agreement), that they would carry on business in association with each other, offering the Services and using the Mark. He states that the Legacy Agreement continues to operate and contains provisions that govern use of the Mark.

[26] Mr. Shumka explains that the Legacy Joint Venture has operated as a joint venture since October 2000, initially as:

- A joint venture between RS Partnership and Legacy V Partnership;
- Subsequently as between RS Partnership and Legacy Advisors Ltd. (a successor to the assets of Legacy V Partnership, now named Legacy Advisors Law corporation); and
- Currently as between Legacy Law Corporation (a successor to all assets of RS Partnership) and Legacy Advisors Law Corporation.

[27] Mr. Shumka attests that around October 1, 2000, RS Partnership under the Legacy Joint Venture began using the Mark in association with the Services. He states that around November 2000, the Legacy V Partnership, under the Legacy Joint Venture commenced offering the Services under the Mark, together with the RS Partnership pursuant to the Legacy Joint Venture.

[28] Mr. Shumka states that around October 2002, the Applicant, 640945 B.C. Ltd., was incorporated for the purpose of holding the IP assets of the Legacy Joint Venture, and around October 18, 2002, the parties to the Legacy Joint Venture transferred all of their right, title and interest in and to the Mark to the Applicant.

[29] Lastly, Mr. Shumka states that the shares of the Applicant were from October 18, 2002, and continue to be, held by him and by Nicholas Smith as nominees and agents for the parties to the Legacy Joint Venture subject to and for the purpose of fulfilling the terms of the Legacy Agreement in respect of the Legacy Joint Venture. Since that time, he states the Applicant has licensed and controlled, through common beneficial ownership and the terms of the Legacy Agreement, all use made of the Mark by the Legacy Joint Venture.

[30] The Opponent submits that Mr. Shumka's evidence regarding the chain of title of the Mark and any licensed use that would have accrued to the Applicant is unclear. This being so, the Opponent submits, given the number of purported predecessors in title involved, the lack of clear evidence as to the dates when transfers of any rights associated with the Mark were made, and since no supporting documentary evidence with respect to any such assignments, etc. were provided. As such, the Opponent submits, it is impossible to conclude whether or not the bare allegations made in Mr. Shumka's affidavit are accurate. Furthermore, the Opponent submits that the explanations and descriptions of the purported chain of title of the Mark stand in contrast to available evidence as to a related mark now owned by the Applicant [per certified file history for Canadian trademark registration LEGACY LAWYERS (TMA572,467), filed as part of the Opponent's reply evidence].

[31] I shall first address the parties' representations concerning the evidence directed to the chain of title.

[32] The Opponent submits that the chain of title to the related mark, LEGACY LAWYERS, is very different as to what is stated in the current application, and Mr. Shumka's own evidence shows use of both of these marks together over the years. Further to this, the Opponent submits that the certified file history for LEGACY LAWYERS indicates that there was a trademark assignment in 2002, where Legacy V Tax & Trust Lawyers, assigns all rights to the Applicant, with no mention of the Legacy Joint Venture. The Opponent submits then, that there is now evidence of two related marks being used contemporaneously pursuant to the terms of the same joint venture, but with a completely different chain of title. The Opponent submits that this suggests that one of the applications is not correct, and there is no way of knowing without hearing from the Applicant as to which is correct.

[33] The second piece of evidence that creates doubt with respect to the chain of title, according to the Opponent, is a sole proprietorship summary document in the province of British Columbia [Exhibit A to the cross examination of Mr. Shumka, and Exhibit 1 to the Noonan affidavit #2]. That document indicates that the proprietor of LEGACY TAX + TRUST LAWYERS is Legacy Advisors Law Corporation, and was registered on July 5, 2002.

[34] As discussed before however, I note that Mr. Shumka's evidence is that the Legacy Advisors Law Corporation was the successor to the Legacy V Partnership, and one of the co-venturers of the Legacy Joint Venture [paragraph 3 of the Shumka affidavit, and response to undertaking request No. 3 on cross examination]. Furthermore, I note that the original applicant in the application for the trademark LEGACY LAWYERS, was Legacy V Tax & Trust Lawyers, a partnership, which was confirmed on the cross examination of Mr. Shumka to be an alternative name to Legacy V Partnership, one of the co-venturers to the original Legacy Joint Venture [see Q173 of cross examination, and answers to undertakings].

[35] The Applicant submits that the certified file history for LEGACY LAWYERS, is not proper reply evidence, and should have been filed at the outset. The Applicant submits that this is a classic splitting of the case as there is no opportunity for the Applicant to provide a further explanation. The Opponent submits that it is proper reply evidence, as questions about the case file were put to Mr. Shumka on cross examination, and some of those questions were refused. I note that the refusals were not with respect to the chain of title, and will be appropriately discussed in the non-distinctiveness ground of opposition. The Opponent also notes that the LEGACY LAWYERS mark was specifically mentioned at paragraph 20 of Mr. Shumka's affidavit, where he attested to efforts to enforce rights in the Mark, as well as other trademarks owned by the Applicant and used by the Legacy Joint Venture, including the trademark LEGACY LAWYERS (TMA572,467).

[36] In any event, I need not address whether the certified copy of the file history for LEGACY LAWYERS is proper reply evidence, as I agree with the Applicant's submission that the file history does not impact the present mark in any way, as both marks are not required to have the same path of ownership.

[37] Furthermore, the Applicant submits in response, that any differences in the chain of title between the Mark and the LEGACY LAWYERS trademark fail to cast doubt on the named predecessors-in-title in the present application, as evidenced in the Shumka affidavit. The Applicant submits that the fact that the parties to the Legacy Joint Venture may have changed over time, or the fact that the ownership chain of a different trademark [TMA572,467] now owned by the Applicant may have been different does not cast doubt on the validity or the

veracity of the predecessors-in-title information set out in the Application. Once again, I agree with the Applicant. Furthermore, I accept Mr. Shumka's uncontroverted sworn statements regarding the Applicant's chain of title, and find that the Opponent has failed to cast doubt that the named predecessors-in-title used the Mark since at least as early as the date claimed, or cast doubt that such the Applicant and the named predecessors-in-title used the Mark continuously since that date.

[38] I now turn to the parties' representations regarding the licensed use of the Mark by the Legacy Joint Venture.

[39] The Applicant submits in response to the Opponent's argument that there is no evidence to support the fact that the Applicant exercises care and control pursuant to section 50(1) of the Act, over the use of the Mark by the Legacy Joint Venture, are not grounds for opposition under sections 38(2)(a) and 30(b) of the Act. Thus, the Applicant submits that the Opponent is not able to and has not raised any grounds of opposition with respect to the failure to comply with section 50, and therefore, this allegation should be summarily dismissed. While it is true that a lack of control over the quality and character of the services may affect the distinctiveness of a trademark, it is also relevant when assessing a section 30(b) ground of opposition. This being so, in that the Applicant must have control over the character and quality of the services associated with the Mark in order to benefit from any use of the Mark by the licensee.

[40] In any event, the Applicant submits, the Shumka affidavit provides uncontroverted evidence that the Applicant exercises care and control over the use of the Mark by the Legacy Joint Venture. I agree. Indeed, I find that control over the character and quality of the services can be inferred to be exercised through Mr. Shumka himself, being both the President of Legacy Law Corporation and a principal of the joint venture between Legacy Law Corporation and Legacy Advisors Law Corporation [see *Petro-Canada v 2946661 Canada Inc.* (1998), 83 CPR (3d) 129 (FCTD); and *Lindy v Canada (Registrar of Trade-Marks)* (1999), 241 NR 362 (FCA)].

[41] Accordingly, as the Opponent has failed to meet its burden, the section 30(b) ground of opposition is rejected.

Section 2 Ground of Opposition

[42] The Opponent pleads that the applied-for trademark is not distinctive of the Applicant, within the meaning of section 2, by reason of the fact that the trademark does not actually distinguish the Applicant's services recited in the Application from the tax, estate, legal and other services of a similar nature of purpose of others, nor is it adapted so to distinguish them in light of the following:

- The word LEGACY is common in the industry, being used and otherwise adopted as or as part of a trademark by others, namely those entities listed in the table attached as Schedule "A" to the statement of opposition (reproduced as Schedule A to this decision), in relation to tax, estate, legal, and other services of a similar nature or purpose, and the element TAX + TRUST LAWYERS is descriptive or clearly descriptive of the character or quality of the applied for services; and
- In the event that the Applicant may take a position either in this proceeding or otherwise that the Opponent's LEGACY PRIVATE TRUST formative marks, which the Opponent has consistently used for over 15 years throughout the province of Ontario, are individually or collectively confusing with the applied for trademark, and this position is found to be correct (which is not admitted), it follows that the applied for trademark cannot be distinctive throughout Canada of the Applicant.

[43] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)]. That is, in order for the Opponent to meet its initial burden in support of the first prong of the non-distinctiveness ground of opposition, it is sufficient for the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support the non-distinctiveness ground of opposition exist.

[44] The material date under this ground of opposition is the date of filing of the statement of opposition, namely, May 29, 2017 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[45] In support of the first prong of this ground of opposition, the Opponent submits that the “TAX + TRUST LAWYERS” portion of the Mark is plainly descriptive of the legal services which the Applicant offers. The Opponent further submits that the “LEGACY” portion of the Mark is also descriptive of the services offered by the Applicant (in that they relate to wills, estates, and similar ideas) as established by the dictionary definitions which are of record as set out in the evidence of Ms. Noonan [Noonan affidavit #1].

[46] I note however, that the Opponent has not made any allegation that the Mark *as a whole* is clearly descriptive. The fact that individual elements may be descriptive, does not render the mark as a whole to necessarily be clearly descriptive of the character or quality of the services [*Molson Companies Ltd v John Labatt Ltd* (1981), 58 CPR (2d) 157 at 161 (FCTD)]. I do not consider the Mark to be clearly descriptive as a whole. Therefore, I do not consider the Mark to be non-distinctive by virtue of the Mark being clearly descriptive of the character or quality of the applied-for services.

[47] The Applicant submits that it is not to be assumed that something which is descriptive cannot also be distinctive. In *Molson Breweries, A Partnership v John Labatt Ltd* (2000), 5 CPR (4th) at para 32, the Federal Court of Appeal cited with approval the statement from the English Court of Appeal:

Much of the argument before us on the part of the Opponents and the Board of Trade was based on an assumption that there is a natural and innate antagonism between distinctive and descriptive as applied to words, and that if you can show that a word is descriptive you have proved that it cannot be distinctive. To my mind this is a fallacy. Descriptive names may be distinctive, and vice versa.

[48] The Applicant submits that section 38(d) allows a basis of objection to registration of trademarks that have no inherent distinctiveness – *i.e.* – a mark that “is not distinctive” – as opposed to trademarks that may have low inherent distinctiveness. The Applicant submits that while a mark that contains elements that are common in the marketplace will have less inherent distinctiveness, that does not mean that such a mark has no inherent distinctiveness [*CompuLife Software Inc v Compuoffice Software Inc*, 2001 FCT 559 at para 21].

[49] A trademark can be held to be non-distinctive on other bases aside from matters of confusion and being purely descriptive or deceptively misdescriptive. Indeed, Mr. Justice

Denault stated in *Clarco Communications Ltd v Sassy Publishers Inc* (1994), 54 CPR (3d) 418 (FCTD) at 428:

While distinctiveness is quite often determined as part of an evaluation of whether the proposed trade mark is confusing with another trade mark within the meaning of s. 6 of the Act, it is possible to refuse an application for registration on the basis of non-distinctiveness independent of the issue of confusion, provided the ground is raised in opposition... The quality of distinctiveness is a fundamental and essential requirement of a trade mark and the ground of lack of distinctiveness may be raised in opposition by any person and may be based on a failure to distinguish or to adapt to distinguish the proposed trade mark from the wares of any others. (emphasis mine)

[50] Furthermore, in *Canadian Council of Professional Engineers v APA - The Engineered Wood Association* (2000), 7 CPR (4th) 239 at 253, Mr. Justice O'Keefe said:

While it is true that a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive, it is not correct to hold that merely because a mark is adjudged *not* to be either purely descriptive or deceptively misdescriptive, it is therefore distinctive.

[51] In the present case, the Opponent is alleging that the Mark is not distinguishable or adapted so as to be distinguishable from the trademarks of others, due to a combination of the common usage of the word LEGACY together with clearly descriptive words. In this regard, the Opponent submits that the evidence demonstrates widespread use, advertising, and promotion of LEGACY-formative trademarks by others offering legal services and similar services in Canada. In this regard, the Opponent submits that the Noonan affidavit #1 contains evidence of 28 active trademark applications and registrations containing the term “LEGACY” of record with tax, estate, and legal related services, many of which were of record as of the material date. Further to this, the Opponent submits that this state of the register evidence is further supported by the marketplace searches conducted by Ms. Chahal, which shows both current and archived versions (pre-dating the material date) of websites of some 30 third-party businesses using LEGACY-formative marks and names in these fields. The Opponent submits that this widespread use destroys the ability of the applied-for trademark to distinguish the legal services offered by the Applicant from those of any other party.

[52] With respect to the state of the register evidence however, the Applicant submits that: (i) only two of the located trademarks include legal services as part of the list of services, both of

which are owned by the Applicant; (ii) only 11 of the identified trademarks contain the word LEGACY as the first portion of the mark, two of which are owned by the Applicant; and (iii) only 11 are associated with tax services, two of which are owned by the Applicant. Lastly, the Applicant submits, the Noonan affidavit #1 does not interpret the results or explain what factual inferences may be drawn from the applications/registrations.

[53] With respect to the state of the marketplace evidence, the Applicant submits that there is no evidence when any of the alleged businesses identified commenced use of the word LEGACY, when they started offering the alleged tax, estate and/or legal services in association with the word LEGACY, whether such use constitutes use as a trademark pursuant to the Act in association with the alleged tax, estate, and/or legal services, the extent to which the use has become known in Canada (if at all), or even whether any alleged tax, estate and/or legal services have been provided or purchased.

[54] Further to this, the Applicant submits that with respect to each of the conversations with purported representatives of the businesses identified, that each were after the material date, and do not provide any particulars regarding the nature of the goods or services offered other than a vague allegation they are related to tax, estate and/or legal services. With respect to each of the websites identified by Ms. Chahal, the Applicant submits that there is no evidence Canadian consumers visited any of those websites, and for six of the alleged businesses, there is no *Wayback Machine* archived website evidence that the websites existed before the material date. The Applicant makes the following further submissions with respect to the websites identified by Ms. Chahal:

- Only six businesses are allegedly using the word LEGACY in relation to advertised legal services;
- Of these six, only four are using the word LEGACY as the first portion of the business name;
- Of these six, none have a trademark registration incorporating the word LEGACY as can be seen from the Noonan affidavit; and

- Of these six, the Applicant has sent cease and desist letters at least four of the identified businesses, at least three of whom have agreed to change their business name [per Shumka affidavit].

[55] The Applicant further submits, and I agree, that exclusive use is not a requirement of distinctiveness [per *Molson Breweries, supra*, paras 47-48].

[56] Insofar as the evidence provided by Ms. Chalal is concerned, I accept that pages of the LEGACY websites are admissible to establish the existence of the websites (rather than the accuracy of their content). However, I disregard Ms. Chalal's statements about third party use of LEGACY which consist of opinion evidence of the type that ought to be excluded from consideration [*Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada* (2005), 43 CPR (4th) 21 (FC); aff'd (2006), 53 CPR (4th) 286 (FCA)]. Further, I agree with the Applicant that Ms. Chalal's evidence regarding telephone conversations with various "Legacy" entities constitutes hearsay. Generally speaking, I note that there are other deficiencies in Ms. Chalal's evidence as identified by the Applicant.

[57] In any event, even if I were to accept that LEGACY had been commonly adopted in the marketplace, the Mark at issue is not LEGACY on its own, but LEGACY TAX + TRUST LAWYERS. As evidenced by the Opponent, the word LEGACY is descriptive of the associated services, and thus, is not an inherently strong component of a trademark. Furthermore, at the very least, common adoption in the marketplace would support that consumers are accustomed to distinguishing amongst the various LEGACY marks in association with such services. The trademarks listed by the Opponent, are either for the word LEGACY alone, or are used in combination with additional matter. In the end, I find that when the Mark is considered as a whole, it is distinguishable from those marks [*General Motors Corp v Bellows* (1949), 10 CPR 101 at 115-6 (SCC)].

[58] Consequently, I conclude that the Opponent has failed to meet its burden with respect to the first prong of this ground of opposition to show that the Mark is not distinguishable from the trademarks of others.

[59] With respect to the second prong of the Opponent's section 2 ground of opposition, the Opponent must show that as of May 29, 2017, or one or more of the Opponent's LEGACY PRIVATE TRUST formative marks was known to some extent at least and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[60] The Opponent has failed to meet its burden under this prong, as the Opponent has not filed any evidence that any of its LEGACY PRIVATE TRUST formative marks were used, let alone known to any extent in Canada. Consequently, the second prong of the Opponent's non-distinctiveness ground is dismissed.

[61] Having regard to the aforementioned, the ground of opposition based on non-distinctiveness is dismissed, as the Opponent has failed to meet its burden.

DISPOSITION

[62] In view 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.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-07-06

APPEARANCES

Natalie Rizkalla-Kamel	For the Opponent
Karen MacDonald	For the Applicant

AGENTS OF RECORD

Gowling WLG (Canada) LLP	For the Opponent
Norton Rose Fulbright Canada	For the Applicant

SCHEDULE A

The Opponent has alleged in its statement of opposition that the word LEGACY is common in the industry, being used and otherwise adopted as or as part of a trade-mark by others, namely, those listed in the following table:

	<u>Entity</u>	<u>Mark</u>
1.	Thomas P. Crean	THE LEGACY ASSURANCE PLAN
2.	The Newcastle Group of Companies Ltd.	THE LEGACY DIRECTORY
3.	The Newcastle Group of Companies Ltd.	THE LEGACY FOUNDATION
4.	Donald S. Kelly, trading as The Legacy Group	THE LEGACY GROUP
5.	Donald S. Kelly, trading as The Legacy Group	LEGACY LIFESTYLE PROGRAM
6.	Legacy Family Enterprise Advisors Ltd.	LEGACY FAMILY ENTERPRISE ADVISORS
7.	Legacy Family Enterprise Advisors Ltd.	LEGACY FAMILY OFFICE
8.	Legacy Wealth Management Inc.	LEGACY WEALTH MANAGEMENT
9.	Legacy Wealth Management Inc.	LEGACY
10.	Katherine Downey	LEGACY MATTERS
11.	Melanie Reidy	LEGACY QUEST
12.	Strategic Legacies Inc.	THE STRATEGIC LEGACY
13.	Cory Litzenberger	HELPING YOUR LEGACY LIVE ON
14.	The Bank of Nova Scotia	SCOTIA FARM LEGACY
15.	The Bank of Nova Scotia	FARM LEGACY SERVICES & DESIGN
16.	Gillian Stovel Rivers	FAMILY LEGACY CENTRE
17.	Strategic Philanthropy Inc.	LEGACYPRO & DESIGN
18.	Gregory Barnsdalev	THE LIVING LEGACY PROGRAM
19.	Life & Legacy Advisory Group Ltd.	LIFE & LEGACY & DESIGN
20.	Donvito O'Neill Financial Inc.	LIFE, TIME, LEGACY
21.	Haunn Financial Services Inc.	WEALTH, HEALTH & LEGACY WITH YOUR VALUES
22.	Haunn Financial Services Inc.	LIFESTYLE AND LEGACY PLANNING
23.	First Affiliated Holdings Inc.	EMPOWERING PROSPERITY, BUILDING LEGACIES

24.	Journey Partners International Corporation	MY JOURNEY LEGACY ROAD MAP
25.	Robert Senft, trading as Wealth and Legacy Planning	RISE WEALTH AND LEGACY PLANNING
26.	Robert Senft, trading as Wealth and Legacy Planning	YOUR WEALTH, YOUR LEGACY
27.	Legacy Law Group	LEGACY LAW GROUP
28.	Legacy Personal Injury Legal Services	LEGACY
29.	Walsh Legacy Law Firm	WALSH LEGACY
30.	Legacy Law	LEGACY
31.	VR Legacy Law Professional Corp.	VR LEGACY LAW
32.	Legacy Consulting	LEGACY CONSULTING
33.	Legacy Capital Partners Inc.	LEGACY
34.	Legacy Wealth Advisors Inc.	LEGACY
35.	Canaccord Genuity Corp.	LEGACY WEALTH PARTNERS
36.	Legacy Financial	LEGACY FINANCIAL
37.	Legacy Insurance and Financial Services Agency Inc.	LEGACY
38.	Legacy Financial Canada Inc.	LEGACY FINANCIAL
39.	Legacy Financial Canada Inc.	BUILD YOUR LEGACY. PROTECT YOUR LEGACY. LEAVE A LEGACY.
40.	Legacy Financial Canada Inc.	LEGACY FINANCIAL & DESIGN
41.	Legacies Financial Group Inc.	LEGACIES FINANCIAL GROUP
42.	Legacy Capital Group Inc.	LEGACY
43.	Legacy Capital Group Inc.	LEGACY CAPITAL GROUP
44.	Quiet Legacy Planning Group Ltd.	QUIET LEGACY
45.	The Legacy Group	THE LEGACY GROUP
46.	REAL Legacy Law	REAL LEGACY
47.	Raymond James Ltd., trading as Johnson	JOHNSON LEGACY

	Legacy Wealth Management	
48.	Investment Planning Counsel	LEGACY WEALTH MANAGEMENT
49.	Baptist Union Development Foundation	LEGACY FOR MINISTRY
50.	Alexander Tettmar	LIFESTYLE AND LEGACY
51.	iA Investment Counsel Inc.	YOUR LIFE. YOUR LEGACY.