



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 026

**Date of Decision:** 2023-02-16

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Revolution LLC

**Applicant:** RevCap Inc.

**Application:** 1,860,669 for REVOLUTION CAPITAL

### **OVERVIEW**

[1] RevCap Inc. (the Applicant) has applied to register the trademark REVOLUTION CAPITAL (the Mark) in association with the following services: Factoring services, namely assignment of accounts receivable and invoice discounting (the Services).

[2] Revolution LLC (the Opponent) has opposed the application based on an alleged likelihood of confusion with its trademark REVOLUTION which the Opponent has used and registered in Canada in association with the provision of venture capital and related financial services.

[3] For the reasons that follow, the application is refused because the Applicant has failed to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion.

## **THE RECORD**

[4] Application No. 1,860,669 (the Application) was filed on September 26, 2017 and is based on use of the Mark in Canada in association with the Services since August 2017.

[5] The Application was advertised for opposition purposes in the *Trademarks Journal* on December 18, 2019. On February 18, 2020, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. As the Application in this case was advertised after June 17, 2019, the Act as amended applies (see section 69.1 of the Act).

[6] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under section 16(1)(a) and 16(1)(c), distinctiveness under section 2, and non-compliance with sections 38(2)(a.1), 38(2)(e), and 38(2)(f) of the Act.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] Both parties filed evidence and written representations and were represented at a hearing.

## **ONUS**

[9] The legal onus is on the Applicant to show that the Application complies with the provisions of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

## **EVIDENCE**

### ***Opponent's Evidence***

[10] The Opponent filed the affidavit of Song Pak, sworn on August 31, 2020 (the Pak Affidavit). Ms. Pak was not cross-examined. The Opponent also filed a certified copy of the Opponent's registration No. TMA920,628 for the trademark REVOLUTION.

[11] Ms. Pak is Executive Vice President of Operations and Deputy General Counsel of the Opponent. She describes that the Opponent is a venture capital investment firm founded in 2005 in Washington, D.C. by individuals that include Steve Case, Tige Savage and Ted Leonsis, each successful entrepreneurs who remain active in the Opponent's business.

[12] Ms. Pak states that since April 2005 the Opponent has offered services that include financial consulting; providing venture capital, development capital, private equity and investment funding; and management of private equity funds in the United States and Canada. She describes that the Opponent has six investment funds focussed on making investments in the U.S. and Canada in accordance with three principal fund strategies, namely: (a) REVOLUTION GROWTH – introduced in 2011 offers growth-stage venture capital investments to help companies take ideas from niche to mass markets; (b) REVOLUTION VENTURES – introduced in 2010 provides early-stage venture capital investments in technology-enabled businesses; and (c) RISE OF THE REST – introduced in 2017 invests in seed-stage venture capital in companies predominantly located outside of Silicon Valley, New York City, and Boston. In addition, the Opponent has a REVOLUTION PLACES business segment that focusses on making real estate and hospitality capital investments.

[13] Ms. Pak states that the Opponent has offered its services in Canada in association with one or more of the REVOLUTION, REVOLUTION GROWTH, REVOLUTION VENTURES, and REVOLUTION PLACES trademarks and trade names, since the time the Opponent commenced operations in 2005. In this regard, she states that the REVOLUTION trademark and trade name is – and has been since April 2005 – prominently displayed on the Opponent's website at *www.revolution.com* in the

advertising of the Opponent's services. Representative printouts from the Opponent's website are included as Exhibit "B" to the Pak Affidavit. The Opponent's website first became active on or about April 5, 2005, and since that date, the REVOLUTION trademark and trade name has consistently been displayed prominently on the website, and the Opponent has continuously been in a position to perform its services in Canada. Since 2011, the Opponent's website has received more than 35,000 hits from Canada (over 17,000 of which were before August 2017).

[14] Ms. Pak states that in 2014, the Opponent's REVOLUTION VENTURES fund made a capital investment in a Canadian company called Busbud, Inc. Exhibit "D" to the affidavit are sample third-party press releases announcing the investment as well as a copy of the investment announcement from the Opponent's website dated July 9, 2014. Ms. Pak states that in 2016, the Opponent also made a capital investment through Steve Case in the Canadian company Knowledgehook, Inc., and that overall, the Opponent has invested over \$3 million in Canadian companies, and each investment was made before August 2017.

[15] The Opponent has also participated in the Canadian Innovation Exchange ("CIX") conference, including the 2019 conference which took place on October 16-17, 2019, in Toronto, Ontario. Ms. Pak describes CIX as Canada's largest curated startup investment conference featuring over 1,000 invitees from innovative and growth-stage tech companies and investors.

[16] The Opponent also publishes and distributes in Canada, the U.S., and elsewhere a periodic electronic newsletter that prominently displays the REVOLUTION, REVOLUTION GROWTH, REVOLUTION VENTURES, and REVOLUTION PLACES trademarks and trade names. Ms. Pak states that there are currently over 260 Canadian subscribers to the Opponent's newsletter, many of whom have held subscriptions since well before August 2017. Exhibit "G" to the Pak Affidavit includes sample newsletters showing how the REVOLUTION, REVOLUTION GROWTH, REVOLUTION VENTURES, and REVOLUTION PLACES trademarks and trade names appeared in the newsletters in the advertising of the Opponent's services.

[17] Ms. Pak states that over the years, the Opponent has been the subject of numerous news articles in the Canadian media, including in the following newspapers: Globe and Mail, Toronto Star, Calgary Herald, Vancouver Sun, Montreal Gazette, Edmonton Journal, Ottawa Citizen, and Waterloo Region Record, as well as the Canadian Press and Canada Newswire wire services. Exhibit "K" to the affidavit includes examples of articles from Canadian media featuring discussions about the Opponent and its services and the REVOLUTION, REVOLUTION GROWTH, REVOLUTION VENTURES, and REVOLUTION PLACES trade names.

[18] Ms. Pak states that in the past, the Opponent used the term REVOLUTION CAPITAL as a trademark and trade name in association with one of its principal funds or business segments in association with its services. Exhibit "L" to the Pak Affidavit are screenshots from the Opponent's website obtained from the Wayback Machine showing how the Opponent previously used the REVOLUTION CAPITAL trademark and trade name in the advertising and promotion of its services in 2010 and 2011. I note that none of the Opponent's past use of the trademark REVOLUTION CAPITAL, as described in the Pak Affidavit, appears to have taken place in Canada or to otherwise have been related to Canada.

### ***Applicant's Evidence***

[19] The Applicant's evidence includes the sworn statement of Loren Shifrin dated December 30, 2020 (the Shifrin Affidavit), the affidavit of Brian Benford sworn on December 18, 2020 (the Benford Affidavit), the affidavit of Eli Bordman sworn on December 21, 2020 (the Bordman Affidavit) and the affidavit of Patrick Balzamo sworn on December 22, 2020 (the Balzamo Affidavit). None of these individuals was cross-examined.

#### Shifrin Affidavit

[20] Mr. Shifrin is the Founder and CEO of the Applicant. He describes that the Applicant was formed as an Ontario corporation on April 9, 2009, with a principal office located in Woodbridge, Ontario. The former corporate name of the Applicant was

Revolution Capital Inc. and that name was amended to RevCap Inc. on August 22, 2020.

[21] The Applicant's primary line of business is in the factoring industry. Mr. Shifrin describes that "factoring" is a cash-flow tool, whereby the Applicant provides immediate liquidity to a business by purchasing their accounts receivables at a discount of the face value of said receivables. He states that for all intents and purposes, factoring is a transaction of purchase and sale.

[22] Mr. Shifrin states that the Applicant has established itself as a leader in Canada in the factoring industry and that the Applicant has experienced great growth in its business, having factored in excess of \$1.4 billion (CA) since September 2018. The Applicant has over 600 active clients, and over 6,000 debtors have transacted with the Applicant (I note that the Shifrin Affidavit states "over 60,000 debtors"; however, the Applicant at paragraph 41 of its written representations indicated that was a typographical error and provided a correction).

[23] Mr. Shifrin states that the Applicant has continually used the Mark in Canada in promoting its factoring services. The Applicant has an Ontario Business Name Registration for REVOLUTION CAPITAL (I note that the Applicant included a certified copy of this business name registration as part of its evidence), and in the normal course of dealing with clients, the Applicant has presented the Mark to its clients. Mr. Shifrin states that as part of the Applicant's promotion of its factoring services, the Applicant has a website at *revolutioncapital.ca* which has been in constant use and availability since the domain name was registered and Applicant's website went live in 2015. Exhibit A to the Shifrin Affidavit is a printout of extracts from Applicant's website that were obtained on December 21, 2020, which display the Mark.

[24] Exhibit B to the Shifrin Affidavit is a copy of the Applicant's factoring brochure that the Applicant has provided to clients and potential clients since 2018, which displays the Mark. Exhibit C is a copy of the Applicant's broker brochure that the Applicant has provided to brokers and potential brokers since 2018, which also displays the Mark.

[25] Mr. Shifrin states that the Applicant is not aware of any instance where a client, potential client, or any other stakeholder of the Applicant has confused the Applicant's Mark as being owned by the Opponent. The Applicant is not aware of any instance where a client, potential client, or any other stakeholder of the Applicant has confused the Applicant's Mark as being the Opponent's trademark REVOLUTION (registration No. TMA 920,628).

[26] Mr. Shifrin states that the Applicant has not and does not intend to provide "Financial consulting; providing venture capital, development capital, private equity and investment funding; management of private equity funds."

#### Benford Affidavit

[27] Mr. Benford is an articling student with the Applicant's agent. His affidavit includes printouts of archived pages from the Applicant's websites as well as the results of various online searches.

#### Bordman Affidavit

[28] Mr. Bordman is also an articling student with the Applicant's agent. His affidavit includes printouts of the results of searches of the Canadian Intellectual Property Office trademark database as well as printouts of pages from the websites *revolutioncapital.net* and *RevolutionCapital.com*.

#### Balzamo Affidavit

[29] Mr. Balzamo is a research analyst with CompuMark, an intellectual property research firm. His affidavit includes the results of a "Full Dilution Search" and "Web Common Law Search" for the term "REVOLUTION" in association with "Financial services, specifically factoring services (namely accounts receivable funding services) and accounts receivable and accounts payable services, namely accounting services" in International Class 36. The results include printouts from the Canadian trademarks Register as well as various other online searches.

## **ANALYSIS**

### ***Section 12(1)(d) ground of opposition***

[30] The material date for the section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[31] The Opponent pleads that the Mark is not registrable because it is confusing with its registered trademark REVOLUTION (TMA920,628). I have exercised my discretion to check the Register and confirm that registration remains extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden with respect to this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's registered trademark.

### **Test for confusion**

[32] 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, including in appearance or sound or in the ideas suggested by them.

[33] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *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.

[34] 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 they have no more than an imperfect recollection of the opponent's trademark, and do 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].

[35] Also, where it is likely the public will assume an applicant's goods are approved, licensed, or sponsored by the opponent so that a state of doubt and uncertainty exists in the minds of the purchasing public, it follows that the trademarks are confusing [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at para 21].

#### *Degree of resemblance*

[36] I will begin with a consideration of this factor given that, as noted in *Masterpiece*, the degree of resemblance will often be the most important factor in the confusion analysis. In considering the degree of resemblance, it is preferable to determine whether there is an aspect of each trademark that is "particularly striking or unique" [*Masterpiece* at para 64].

[37] The striking aspect (indeed the only aspect) of the Opponent's registered trademark is the word "REVOLUTION".

[38] The striking aspect of the Applicant's Mark is also the word "REVOLUTION". I do not consider the word "CAPITAL" in the Mark to be particularly striking or unique given its descriptive connotation in the context of financial services. In this regard, I note that the definition of "capital" in the *Canadian Oxford Dictionary, 2nd Ed.* includes the following: "**3a** the money or other assets with which a company starts in business. **b.**

accumulated wealth, esp. as used in further production. c money invested or lent at interest.” [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 at para 29 which provides that the Registrar can take judicial notice of dictionary definitions].

[39] I am reinforced in the view that “REVOLUTION” is the dominant and striking aspect of the Mark, with “CAPITAL” being largely descriptive, by the Applicant’s evidence of how it depicts the Mark and advertises its services in the marketplace. For example, Exhibits “B” and “C” to the Shifrin Affidavit include promotional brochures in which the Mark is depicted with the word “REVOLUTION” in larger font above the word “CAPITAL” in smaller font. Further, the brochure in Exhibit “B” advertises the Applicant’s services as providing businesses with “Access to Capital”.

[40] With the above in mind, I consider there to be a high degree of resemblance between the parties’ trademarks.

*Inherent distinctiveness of the trademarks and the extent to which they have become known*

[41] The Opponent’s trademark REVOLUTION has at least a modicum of inherent distinctiveness. While the trademark is comprised of an English dictionary word, it does not directly describe the Opponent’s venture capital and related financial services. The Applicant’s Mark has a similar degree of inherent distinctiveness for essentially the same reasons, owing to the presence of the word “REVOLUTION” in the Mark. As discussed above, I do not consider the word “CAPITAL” in the Mark to contribute to its inherent distinctiveness, given that “CAPITAL” in the financial field will likely be understood to be descriptive.

[42] With respect to the extent to which the parties’ trademarks have become known, in my view this element does not strongly favour either party. The Opponent has made two capital investments in Canadian companies since 2014, has in the order of 260 Canadian subscribers to its newsletter, and has been discussed in Canadian news publications. The Applicant has been using its Mark in Canada since 2017 and has in the order of 600 active clients. I note that the Shifrin Affidavit describes that the Applicant has factored in excess of \$1.4 billion since September 2018; however, without

additional context from the Applicant as to the nature of the factoring industry and its client base, it is difficult to assess to what degree that has resulted in the Mark becoming known. The Shifrin Affidavit also includes examples of advertising in association with the Mark via a website and brochures, but provides no evidence from which to assess the impact of that advertising, such as the number of website visits or volume of distribution of its brochures.

[43] Overall, when considering the inherent distinctiveness of the parties' trademarks and the extent to which they have become known, I do not consider this factor to favour either party to a significant extent.

*Length of time the trademarks have been in use*

[44] The Opponent submits that its trademark REVOLUTION has been in use in Canada since 2005. This appears to be based on the fact that the Opponent's business and website bearing the trademark commenced in 2005 and since that point the Opponent has been willing and able to offer its venture capital services in Canada. The evidence indicates that the first capital investment made by the Opponent in a Canadian company took place in 2014.

[45] With respect to the Applicant's Mark, there is some ambiguity as to the duration of its use. The Application itself claims use of the Mark in Canada since August 2017. However, paragraphs 4, 7 and 8 of the Shifrin Affidavit discuss the Applicant's activities in association with the Mark since 2018. I note that paragraph 6 of the Shifrin Affidavit discusses the Applicant's website going live in 2015; however, there is no evidence of the depiction of the Mark on the website as of that date so as to constitute use in accordance with section 4(2) of the Act. Paragraphs 3, 5 and 108 of the Applicant's written representations discuss the Applicant's use of the Mark in Canada "since July 2018", though I suspect that may have simply been a typographical error in the written representations. When I questioned the Applicant's counsel on this point at the hearing, he confirmed that the Applicant's position is that it has been using the Mark in Canada since August 2017 as claimed in the Application. As I do not consider there to be any

evidence of record that is clearly inconsistent with the August 2017 claimed date, I will accept that date for the purpose of considering this factor.

[46] With respect to the comparative durations of use of the two parties' trademarks, regardless of whether I consider the date of first use of the Opponent's trademark in Canada to be 2005 or 2014, either date is earlier than the Applicant's date of first use of August 2017. Therefore, this factor favours the Opponent.

*Nature of the services or business; and nature of the trade*

[47] Given the other statutory factors which weigh in the Opponent's favour, and in particular the high degree of resemblance between the parties' trademarks, the confusion analysis in this case turns largely on a consideration of the nature of the parties' services and likely channels of trade.

[48] When considering the nature of the services, it is the statement of services in the parties' application and registration that govern the analysis [*Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. Those 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)].

[49] The Opponent's registration No. TMA920,628 for the trademark REVOLUTION covers the following services: "Financial consulting; providing venture capital, development capital, private equity and investment funding; management of private equity funds." The Opponent's evidence of its use of the trademark is consistent with that description of services.

[50] The Application lists the following services: Factoring services, namely assignment of accounts receivable and invoice discounting. The Shifrin Affidavit describes "factoring" as a cash-flow tool, whereby the Applicant provides immediate

liquidity to a business by purchasing their accounts receivables at a discount of the face value of said receivables.

[51] The Applicant's position regarding the nature of the parties' services and channels of trade are summarized at paragraphs 129 and 138 of its written representations:

129. Revolution Capital and Revolution LLC both operate in the financial services industry, however, they offer distinct and separate financial services. While Revolution Capital offers invoice factoring, Revolution LLC's services are quite different and distinct as they relate to venture capital investments, with a focus in start-up tech companies.

[...]

138. The consumer base for the Applicant comprises companies in various industries who cannot operate without invoice factoring while they wait for their clients to pay. While the Opponent services focus on investments in fast-growing companies, the Applicant's services help companies stay financially afloat in day-to-day operations. The financial services associated with the Applicant and the Opponent have separate natures of trade and are thus it is not likely that a consumer of Applicant's services would confuse Applicant's Trademark as being owned by the Opponent.

[52] In my view, it is apparent from the evidence that the services of the parties do not overlap precisely. However, I agree with the Opponent that the parties' services and channels of trade are not so disparate as to necessarily avoid a finding of confusion.

[53] Fundamentally, both the Opponent and the Applicant provide capital to businesses and advertise themselves as providing this service. The Opponent provides venture capital services (*i.e.* investment of money in exchange for shares of a business) and the Applicant provides capital via a different mechanism, namely, factoring. As noted by the Opponent, the Applicant's own advertising material is consistent with the fundamental relatedness of the parties' businesses in terms of the provision of capital. For example, the promotional brochure for the Applicant's services included in Exhibit B to the Shifrin Affidavit states as follows:

#### **Access to Capital**

The real secret to any successful business venture is access to capital. As your company continues to scale expenses will rise, payment terms will slow, and your financial needs will increase. Revolution Capital is here to help!

[54] With respect to channels of trade, I note that that Applicant's advertising material suggests that its services can be used in a wide variety of industries. The Applicant's promotional brochure in Exhibit B to the Shifrin Affidavit states: "We believe that factoring is the most flexible form of cash flow financing for companies in almost any industry."

[55] To summarize, while the parties' services and channels of trade do not directly overlap, in my view, they are sufficiently related that these factors still favour the Opponent, albeit only to slight degree.

*Surrounding circumstance – state of the Register and marketplace*

[56] For this surrounding circumstance, the Applicant relies primarily on the Balzamo Affidavit which the Applicant says demonstrates that the term "REVOLUTION" is commonly used and therefore that the Opponent's trademark should be afforded a narrow scope of protection.

[57] Evidence concerning the state of the Register is relevant to the extent that inferences may be drawn regarding the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FC)]. Inferences regarding the state of the market may be drawn from such evidence only if a large number of relevant trademarks are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at paras 41-46]. Relevant trademarks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the marks at issue, and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197 at para 38].

[58] In the present case, the Balzamo Affidavit identifies twenty six (26) third-party trademark applications and registrations which include the term "REVOLUTION" in Nice Class 36. The four third-party references from the Balzamo Affidavit which the Applicant

considers the most relevant are included in Exhibit A-1 to the Applicant's written representations (and are addressed, below, among others).

[59] I do not consider the state of the Register evidence to assist the Applicant to any meaningful degree. Many of the third-party applications and registrations in the Balzamo Affidavit relate to very different services from those in issue in this case (e.g. TMA984,828 for REVOLUTION in association with various waste management services; TMA744,048 for REVOLUTION HEALTH in association with various health care related goods and services; and application No. 2028955 for REVOLUTION RIDE in association with various charitable fundraising services). Most of the remaining references contain elements which significantly distinguish the third-party trademark from those in issue in the present proceeding (e.g. TMA723,996 for TSX QUANTUM REVOLUTION and TMA894,063 for STATPRO REVOLUTION), or incorporate the term "revolution" only as part of a different word in a manner that renders the reference irrelevant (e.g. TMA706,720 for AGF ELEMENTS ADVANTAGE: OUR REVOLUTIONARY COMMITMENT). Finally, one reference identified as being in association with potentially relevant services is application No. 1,929,311 for the trademark WEALTHCARE REVOLUTION in association with, *inter alia*, financial investment brokerage; however, that application has not been allowed and indeed is presently being opposed.

[60] With respect to evidence of the state of the Canadian marketplace, I am similarly not persuaded that it assists the Applicant. While the Balzamo Affidavit identifies a variety of business names in Canada that include the term "REVOLUTION", only three of these business names suggest that the entities operate in the financial field (REVOLUTION PAYROLL SERVICES LTD. in Mississauga, Ontario; REVOLUTION ACCOUNTING in Prince George, B.C.; and REVOLUTION INVESTMENTS in Edmonton, Alberta), and beyond the mere existence of these business names, the Applicant has not filed any evidence regarding the specific nature of these businesses or the manner, duration or extent of use of these names.

[61] Finally, I note that Exhibit “C1” to the Bordman Affidavit includes printouts from the website *www.revolutioncapital.net* relating to an investment advisory business that appears to operate under the name Revolution Capital; however, the website indicates that business is located in Massachusetts, U.S.A., and so has no relevance to the assessment of the state of the Canadian marketplace.

[62] Ultimately, the state of the Register and marketplace evidence does not assist the Applicant to any meaningful degree.

*Surrounding circumstances – absence of evidence of actual confusion*

[63] The Applicant submits that the co-existence of the parties’ trademarks without any evidence of actual confusion is a surrounding circumstance which weighs in its favour.

[64] Evidence of instances of actual confusion is not required in order to demonstrate a likelihood of confusion. However, concurrent use of two trademarks without such instances of actual confusion is a surrounding circumstance which can suggest an absence of a likelihood of confusion, depending on the specific nature and duration of that concurrent use [see *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155 (FCA) at para 19; see also *Maple Leaf Consumer Foods Inc v Kelbro Enterprises Inc*, 2012 TMOB 28, 99 CPR (4th) 424].

[65] While the absence of evidence of actual confusion does weigh in the Applicant’s favour, I do not attribute a great deal of weight to this factor in this case, given the limited duration of use of the Applicant’s Mark and the limited evidence regarding the scope of use of both parties’ trademarks in Canada [see *Alpha Sportswear Ltd v Alpha Industries Inc* 2004, 39 CPR (4th) 87 (TMOB) at para 31].

Conclusion regarding the section 12(1)(d) ground

[66] Having regard to all of the surrounding circumstances discussed above, and in particular the high degree of resemblance between the parties’ trademarks, I conclude that at best for the Applicant, the probability of confusion between the Mark and the Opponent’s trademark 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 between the trademarks, I must therefore find against the Applicant.

[67] Consequently, the section 12(1)(d) ground of opposition succeeds.

***Section 16(1)(a) ground of opposition***

[68] The material date for the section 16(1)(a) ground of opposition is the date of first use of the Mark, namely, August 2017. The Opponent has met its initial evidential burden under this ground of opposition by virtue of its evidence of use of its trademark REVOLUTION in Canada since at least 2014. Further, there is no evidence to suggest that the Opponent had abandoned its trademark as of the date the Application was advertised, namely, December 18, 2019.

[69] In these circumstances, the analysis of the likelihood of confusion under this ground is essentially the same as for the section 12(1)(d) ground. Indeed, the Opponent's case under section 16(1)(a) is arguably stronger than under section 12(1)(d), since the earlier material date for the non-entitlement ground reduces the significance of the coextensive use of the parties' trademarks.

[70] Therefore, the section 16(1)(a) ground of opposition also succeeds.

***Remaining grounds of opposition***

[71] As I have found that the Opponent succeeds with its grounds of opposition under sections 12(1)(d) and 16(1)(a) of the Act, I do not consider it necessary to address the remaining grounds of opposition.

**DISPOSITION**

[72] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act.

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Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2022-11-10

## **APPEARANCES**

**For the Opponent:** Reed Taubner

**For the Applicant:** Robert H. Nakano

## **AGENTS OF RECORD**

**For the Opponent:** Gowling WLG (Canada) LLP

**For the Applicant:** Gardiner Roberts LLP