



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 110

**Date of Decision:** 2023-06-30

## **IN THE MATTER OF OPPOSITION**

**Opponent:** Navsun Holdings Ltd

**Applicant:** Sadhu Singh Hamdard Trust

**Application:** 1,847,983 for AJIT WEB TV

## **INTRODUCTION**

[1] Sadhu Singh Hamdard Trust (the Applicant) has applied to register the trademark AJIT WEB TV (the Mark) in association with the following Services on the basis of its use in Canada since at least as early as January 10, 2014.

Class 38 - (1) Television broadcasting, television programming and broadcasting via video on demand transmissions;

[2] The application for the Mark was opposed by Navsun Holdings Ltd (the Opponent) on the basis of the use of its AJIT WEEKLY Logo trademark shown below in association with a newspaper, a website providing news and entertainment, as well as television and radio programming.



[3] The parties have been involved in a number of proceedings before the Registrar, Federal Court and Federal Court of Appeal primarily concerning the use of the trademark AJIT in association with two Punjabi-language newspapers in Canada: the *Ajit Weekly*, a free Canadian weekly newspaper published by the Opponent and the *Daily Ajit*, an Indian newspaper published by the Applicant.

[4] In this case, the Opponent provides evidence of the use of the AJIT WEEKLY Logo trademark on its website and newspaper distributed in Canada. In a departure from the earlier cases before the Federal Court and the Registrar, the Applicant's evidence is restricted to the use of the Mark on its Youtube channel along with statistical information showing that this website has significant views in Canada.

[5] For the reasons that follow, I refuse the application on the basis that the Applicant has not shown that it is the person entitled to registration of the Mark, nor that the Mark is distinctive.

### **BACKGROUND**

[6] The application was filed on July 18, 2017 and advertised for opposition in the *Trademarks Journal* issue dated February 12, 2020. The Opponent opposed the application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on August 31, 2020.

[7] The grounds of opposition are set out below:

- (a) The application was filed in bad faith.
- (b) The Applicant is not the person entitled to register the Mark as it is confusing with the Opponent's trademark [AJIT WEEKLY Logo] used in association with:
  - i. the *Ajit Weekly* newspaper, in both paper and electronic formats;

- ii. *ajitweekly.com*, a website that provides news and entertainment services;
- iii. *Ajit Broadcasting Corporation* and *ABC Radio*, radio/audio services that provide news and entertainment;
- iv. *Ajit Television Network* and *Ajit Weekly presents Darshan TV*, television services that provide news and entertainment; and
- v. the Admitted Confusion with the Opponent's Mark which existed as at the actual date of first use of the Mark by the Applicant for the Services.

(c) The Mark is not distinctive of the Applicant. ...

(d) The Applicant was not using and did not propose to use the Mark in Canada.

[8] The Opponent filed as its evidence the affidavit of Kanwar (Sunny) Bains, one of its shareholders and directors. The Applicant filed as its evidence the affidavit of Sukhvinder Singh, a Marketing Manager for the Ajit newspaper published by the Applicant. Both parties filed written arguments and attended a hearing.

### **EVIDENTIAL BURDEN AND LEGAL ONUS**

[9] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[10] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited*, 30 CPR (3d) 293 (FCTD) at 298. An evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). A legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

### **PRELIMINARY ISSUE: SCOPE OF STATEMENT OF OPPOSITION**

[11] In this case, the Opponent has submitted evidence and referenced in its written argument several AJIT formative trademarks. The Applicant submits that only the use of the AJIT WEEKLY Logo was pleaded in the statement of opposition and as such the Opponent is precluded from relying on any additional trademarks.

[12] The statement of opposition is precise in relying only on the AJIT WEEKLY Logo trademark in support of the section 16(1)(a) confusion ground of opposition. With respect to this ground of opposition, its scope has been clearly defined. It is therefore inappropriate to consider the pleading to have been expanded by the evidence; if the Opponent wished to expand this pleading to add additional trademarks, it should have requested leave to file an amended statement of opposition.

[13] I reach a different conclusion with respect to the section 2 ground of opposition as this ground of opposition is pleaded in two paragraphs in the statement of opposition, including one that does not limit the Opponent to any particular trademark or trademarks:

Under Section 38(2)(d), the Trademark is not distinctive, within the meaning of Section 2, as the Trademark does not actually distinguish the wares and services of the Applicant from the like wares and services of others, and is not adapted so to distinguish them.

### **PRELIMINARY ISSUE: PRIOR DECISIONS CONCERNING THE PARTIES**

[14] In their written submissions and at the hearing, the parties refer to the decisions of the Registrar, Federal Court and Federal Court of Appeal concerning the parties' use of their respective AJIT trademarks. While I refer to these decisions throughout my decision, the conclusions and findings in them are not binding on me to the extent that the evidence differs from that before me [*Vibe Ventures LLC v CTV Limited*, 2010 TMOB 166 paras 59-60]. While Mr. Bains attaches to his affidavit the decisions released up to the time he swore his affidavit, these exhibits are simply evidence of the decisions themselves, they are not evidence of the facts cited therein.

## **PRELIMINARY ISSUE: FIRST USER OF A TRADEMARK**

[15] The Applicant submits in its written argument at para 51 that who was the first user of the AJIT trademark in Canada is significant:

- a. The Opponent argues it commenced use of the word AJIT in association with i) its newspapers, ii) its website and iii) radio services several years before the Applicant began to use AJIT WEB TV in association with the Applicant's IPTV services in 2014.
- b. However, the Opponent was not the first user of AJIT for newspapers in Canada. The Applicant was. The issue was decided by the Trademarks Opposition Board [*Navsun Holdings Ltd v Sadhu Singh Hamard Trust*, 2015 TMOB 214 at para 33] and no appeal was taken from this finding. It cannot be challenged now by this collateral attack.

[16] First, there is no evidence in this case on which I could determine that the Applicant was the first user of the trademark AJIT in Canada in association with newspapers and the provision of news, information and entertainment. Even if I could, the trademark at issue in this case is AJIT WEB TV and who was the first user of the AJIT trademark in the face of concurrent use would not be determinative as to whether the Applicant was entitled to register the trademark AJIT WEB TV, nor its distinctiveness. While restricted to distinctiveness, the Federal Court of Appeal's comments upholding the 2015 TMOB 214 case are also instructive [*Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10]:

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

[16] It is incumbent upon a trader to protect the distinctiveness of its mark, even in the face of infringing use (see *Mattel, Inc v 3894207*

*Canada Inc*, 2006 SCC 22 at para 26, [2006] 1 SCR 772; *Suzanne's* at paras 6-7; *Farside Clothing* at para 9). The new evidence of readership in relation to the appellant's newspaper cannot change that fact. It was open to the appellant to take sufficient steps to protect its rights to the impugned mark, which it did not do.

## **GROUND OF OPPOSITION**

### ***Section 16 Ground of Opposition***

[17] The Opponent pleads that the Mark is confusing with the use of its trademark AJIT WEEKLY Logo in association with a newspaper (in paper and electronic formats), a website that provides news and entertainment, radio and audio services and television services as particularized in paragraph 7(b) of this decision.

[18] The material date is January 10, 2014 as the Applicant has shown use of the Mark as of this date on its Youtube channel which was viewed in Canada (section 16(1)(a) of the Act, Singh affidavit, paras 6-8, Exhibits B-C).

### **The Opponent Meets its Evidential Burden**

[19] The Opponent meets its evidential burden of demonstrating the use of its trademark AJIT WEEKLY Logo in association with a newspaper (in paper and electronic formats) and a website that provides news and entertainment prior to January 10, 2014 (Bains affidavit, paras 33, 37, Exhibit 28).

[20] The Opponent fails to meet its evidential burden with television services as there is no evidence that it commenced use of the AJIT WEEKLY Logo trademark with these services prior to the material date (Bains affidavit, paras 40-42). The Opponent also fails to meet its evidential burden with radio services as there is no evidence that these services were offered in association with the trademark AJIT WEEKLY Logo (Bains affidavit, para 36).

### ***Test for confusion***

[21] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates 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 or services associated with those trademarks are manufactured, sold, leased, hired 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.

[22] Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but of the goods or services from one source as being from another. Essentially, the question here is whether a consumer, with an imperfect recollection of the Opponent's trademark AJIT WEEKLY Logo, would think that the Applicant's AJIT WEB TV Services emanate from, are sponsored by or approved by the Opponent.

[23] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time they have been in use; (c) the nature of the goods, 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. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 where the Supreme Court of Canada states at para 49 that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

#### Inherent Distinctiveness

[24] The parties' trademarks are inherently distinctive as the word AJIT, which is a Punjabi word meaning 'unconquerable' or 'invincible', has no meaning in and of itself in relation to the goods and services of the parties. That being said the fact that AJIT is a first or given name and has historic significance (see Bains affidavit, Exhibits 12-13; 19-20) does somewhat reduce the inherent distinctiveness of this component [for a similar finding see *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2021 FC 602 at para 54]. While the design component of the Opponent's trademark adds a measure of distinctiveness to it, the components WEEKLY and WEB TV do not add any inherent

distinctiveness to the parties' respective trademarks as these components are descriptive of the associated goods and services.

#### Extent Known and Length of Time in Use

[25] The extent known and length of time in use of the trademarks favours the Opponent as the Applicant's earliest evidence of use is at the material date. The Opponent's evidence is that its AJIT WEEKLY Logo (or an earlier variant of this trademark) has appeared on its AJIT WEEKLY newspaper which has a circulation of over 5,000 in Toronto and Vancouver (Bains affidavit, paras 30, 44; Exhibits 22-23; 33-34). The Opponent's website displays the trademark AJIT WEEKLY Logo and publishes electronic versions of the *Ajit Weekly* newspaper as well as offers other information, entertainment and communication services to the Punjabi community since at least as early as 2011 (para 37; Bains affidavit, Exhibits 28-29).

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

[26] There is direct overlap between the Services and the Opponent's goods and services. The Services are described on the Applicant's Youtube channel as "The Official Ajit Web TV Channel for Daily Ajit Newspaper" and "News Bulletin" tagged on videos (Singh Affidavit, Exhibits A and B). The Opponent has provided evidence that it provides newspapers and a website which includes electronic versions of the *Ajit Weekly* newspaper as well as offering a range of other information, entertainment and communication services to the Punjabi community (Bains Affidavit, para 33, Exhibit 28). The precise difference in how the news is provided is not sufficient for the nature of the goods, services and trade and business to be different.

#### Degree of Resemblance

[27] The degree of resemblance between the marks in appearance, sound and ideas suggested must be considered. However, it is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [*Veuve Clicquot*, supra].



[28] In *Masterpiece*, the Supreme Court of Canada stated that a preferred approach when assessing the degree of resemblance is to first consider whether there is an aspect of a trademark that is particularly striking or unique [para 64].

[29] Here, the most striking part of each trademark is the component AJIT. I do not find that the word components WEEKLY and WEB TV diminish the degree of resemblance between the parties' trademarks in appearance, sound or ideas suggested because these components are suggestive, if not descriptive, of the parties' services [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) at para 58]. While the design in the Logo does result in a somewhat differently appearing trademark, it does not impact the ideas suggested by the trademarks, nor the similarity in sound. In view of the foregoing, I find that there is a significant degree of resemblance between the parties' marks.

#### Surrounding Circumstance: Admitted Confusion

[30] In its statement of opposition, the Opponent alleges:

The Applicant has admitted in Court File No. T-1127-10 that the Opponent's use of [its] AJIT Logo (the "**Opponent's Mark**") is confusing with the Applicant's use of [its] AJIT Logo (the "**Admitted Confusion**").

[31] I do not find this to be a relevant surrounding circumstance for several reasons. First, the decision as to whether or not a trademark is confusing involves a determination of a practical question of fact and the facts in this case are not identical to those in the T-1127-10 case. Importantly, the marks at issue are not the same, nor are the relevant material dates. Second, in *Molson Breweries v Labatt Brewing Co* (1996), 68 CPR (3d) 202 (FCTD), the Court concluded that a prior inconsistent position taken by a party with respect to whether another party's trademark was confusing was not a relevant surrounding circumstance in assessing the likelihood of confusion.

## Conclusion

[32] 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 when they have no more than an imperfect recollection of the Opponent's AJIT WEEKLY Logo trademark and do not pause to give the matter any detailed consideration or scrutiny.

[33] Having considered all of the surrounding circumstances, in particular, the degree of resemblance between the trademarks, and the direct overlap in the parties' goods and services, I find that the Applicant has failed to meet its legal onus of proving that there is no reasonable likelihood of confusion on a balance of probabilities. In my view, the ordinary consumer experiencing imperfect recollection, might not be particularly alert to the differences between the Opponent's trademark AJIT WEEKLY Logo and the Mark and may think the Services emanate from or are otherwise associated with the Opponent.

### ***Distinctiveness Ground of Opposition***

[34] The Opponent pleads that the Mark is not distinctive because it does not actually distinguish the Services with which it is used by the Applicant from the Opponent's use of the trademark AJIT WEEKLY Logo in association with a newspaper (in paper and electronic formats), a website that provides news and entertainment, radio and audio services and television services and advertising services as set out in paragraph 1(d) of the statement of opposition. The Opponent also pleads in paragraph 1(e):

Under Section 38(2)(d), the Trademark is not distinctive, within the meaning of Section 2, as the Trademark does not actually distinguish the wares and services of the Applicant from the like wares and services of others, and is not adapted so to distinguish them.

[35] The material date for this ground of opposition is August 31, 2020, the date the statement of opposition was filed [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[36] To succeed, an opponent relying on its own trademark must establish that its trademark was known in Canada to some extent at least, i.e. that its reputation was

“substantial, significant or sufficient” to negate the established distinctiveness of another trademark, or else that it was well known in a specific area of Canada [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles’ International LLC v Bojangles Café Ltd*, 2006 FC 657; *1648074 Ontario Inc v Akbar Brothers (PVT) Ltd*, 2019 FC 1305]. In this respect, an opponent must demonstrate that its trademark had acquired a reputation among consumers as an indicator of source [*Akbar Brothers*, supra; *Scott Paper Ltd v Georgia-Pacific Consumer Products LP*, 2010 FC 478]. Moreover, there must be clear evidence of the extent to which the trademark was known [*Bojangles*, supra; *Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10].

### ***Opponent’s Evidence is Sufficient to Meet its Evidential Burden***

[37] The Opponent’s evidence is sufficient to meet its evidential burden with its AJIT WEEKLY Logo trademark which prior to the material date has appeared on its newspapers distributed in Vancouver and Toronto and its website which appears to receive 5000 visitors a month (Bains affidavit, paras 37-38, 44; Exhibits 29-30).

### ***Applicant’s Evidence is Insufficient to Meet its Legal Onus***

[38] The Applicant makes two main submissions with respect to the distinctiveness ground of opposition. First, that if the Mark is adapted to distinguish the Services then the ground of opposition must fail. Second, that considering its use of the Mark at the material date, the Mark actually distinguished the Services of the Applicant.

[39] The Applicant submits that a trademark is distinctive if it meets either “test” set out in section 2 of the Act (Applicant’s Written Submissions, para 87):

Section 2 of the [Act] states that “distinctive”, in relation to a trademark, describes a trademark that either actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them. In other words, a trademark is distinctive if it meets EITHER test.

[40] In support, the Applicant points to the discussion in *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16:

The definition of "distinctive" now appearing in section 2 of the Act is directly traceable to Dr. Fox's report. By that definition a mark is "distinctive" either if it "actually distinguishes" the wares or services in association with which it is used by its owner from the wares or services of others or "is adapted so to distinguish them". A mark actually distinguishes by acquiring distinctiveness through use, resulting in distinctiveness in fact. A mark that is "adapted so to distinguish" is one that does not depend upon use for its distinctiveness because it is inherently distinctive. A coined or invented word mark falls into this category: *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.*, [1971] FC 106 (TD), at 115; *The Molson Companies Limited v. Carling O'Keefe Breweries of Canada Limited*, [1982] 1 FC 175 (TD), at 278-79.

[41] A trademark is distinctive when consumers associate it with a single source; if a trademark is related to more than one source it cannot be distinctive [*Moore Dry Kiln Co of Canada Ltd v US Natural Resources Inc*, (1976), 30 CPR (2d) 40 (FCA) at 49]. A trademark cannot lead to confusion as to the source of the goods and services associated with it to be distinctive [*Yiwu Thousand Shores E-Commerce Co Ltd v Lin*, 2021 FC 1040 at para 32]. As such, if at the material date for distinctiveness, the Mark is confusing with the Opponent's trademark AJIT WEEKLY Logo, the fact that the Mark is inherently distinctive will be insufficient for the Applicant to succeed with respect to this ground of opposition.

[42] At the material date for the distinctiveness ground of opposition, the Applicant had been using the Mark for six years and had well over 1,000,000 views in the previous year (Singh affidavit, Exhibit C). While the Opponent put in no evidence of actual confusion, I do not find this is a significant factor which favours the Applicant as it may be that Canadians are using other source indicia on the Applicant's Youtube channel to distinguish between the Mark and the Opponent's use of its trademark AJIT WEEKLY Logo. In particular, the Applicant's website includes reference to Daily Ajit, Daily Ajit News and "the Official Ajit Web TV Channel for Daily Ajit Newspaper" (Singh affidavit, Exhibits A and B).

[43] Notwithstanding this, due to the overlap in the Services with the Opponent's goods and services and the similarity of the trademarks as described with respect to the section 16 ground of opposition, I find that the Applicant has failed to meet the legal

onus on it to satisfy me on a balance of probabilities that the Mark was distinctive of the Services as of the material date. The distinctiveness ground of opposition therefore succeeds.

***Remaining Grounds of Opposition***

[44] As the Opponent has succeeded under two grounds of opposition, it is not necessary to address the remaining grounds of opposition.

**DISPOSITION**

[45] In view of the above, and 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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Natalie de Paulsen  
Member  
Trademarks Opposition Board

# Appearances and Agents of Record

**HEARING DATE:** 2023-03-01

## **APPEARANCES**

**For the Opponent:** Tamara Ramsey

**For the Applicant:** Gregory C. Ludlow

## **AGENTS OF RECORD**

**For the Opponent:** Dale & Lessmann LLP

**For the Applicant:** PCK IP Lawyers LLP