

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 31

Date of Decision: 2025-02-20

IN THE MATTER OF OPPOSITIONS

Opponent: AGF Management Limited

Applicant: LODE Global Corporation

Applications: 1,880,841 for AGX,
1,880,849 for AGX COIN

OVERVIEW

[1] This decision involves oppositions to application Nos. 1,880,841 and 1,880,849 for the trademarks AGX and AGX COIN, respectively, both of which stand in the name of LODE Global Corporation (the Applicant), and are generally applied for in association with financial services relating to digital currency and the provision of ancillary goods and services facilitating these financial services. I refer to these trademarks collectively as the “Marks”, unless they are being discussed individually.

[2] AGF Management Limited (the Opponent) has opposed these applications primarily on the basis that the Marks are confusing with the Opponent’s previous use and registration of the trademark AGF in

association with financial services, including the management of investment and mutual funds.

[3] For the reasons that follow, both applications are refused.

BACKGROUND

[4] The applications are based on proposed use in Canada in association with the following goods and services (the Goods and Services):

(1) Downloadable computer software for use in electronically trading, transmitting, receiving, storing, and sending digital currency, virtual currency, cryptocurrency, digital tokens, and digital assets, and managing payments and exchange transactions involving digital currency, virtual currency, cryptocurrency, digital tokens, and digital assets;

(1) Financial services, namely, storing and transferring of digital currency, virtual currency, cryptocurrency, digital tokens and digital financial assets by means of an electronic wallet; financial services, namely, conducting an online financial exchange for trading and transmitting digital currency, virtual currency, cryptocurrency, digital tokens, digital coins and digital financial assets; online trading of digital currency, virtual currency, cryptocurrency, digital tokens, digital coins and digital financial assets;

(2) Transmission of cryptographic data for digital currency, virtual currency, cryptocurrency, digital tokens, digital coins and digital assets via electronic communication networks; electronic transmission of cryptographic data via the blockchain for digital currency, virtual currency, cryptocurrency, digital tokens, digital coins and digital assets via computer terminals and electronic devices;

(3) Providing temporary use of online non-downloadable software for use in electronically trading, transmitting, receiving, storing, and sending digital currency, virtual currency, cryptocurrency, digital tokens, digital coins and digital assets, and managing payments and exchange transactions involving digital currency, virtual currency, cryptocurrency, digital tokens, and digital assets;

[5] Both applications were filed on February 1, 2018, and advertised for opposition purposes in the *Trademarks Journal* of July 6, 2022. On December 14, 2022, the Opponent filed statements of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds

of opposition, which are the same for both proceedings, relate to registrability under section 12(1)(d), entitlement to register under sections 16(1)(a) and 16(1)(c), distinctiveness under section 2, non-compliance with sections 38(2)(e), and 38(2)(f), and an allegation of bad faith under section 38(2)(a.1) of the Act.

[6] The Applicant filed counter statements denying the grounds of opposition.

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

OVERVIEW OF THE EVIDENCE

[8] A brief overview of the evidence is set out below. Pertinent portions of the evidence are discussed further in the analysis of the grounds of opposition.

The Opponent's evidence

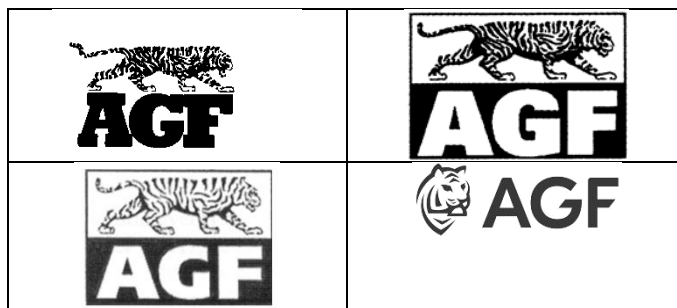
[9] The Opponent filed the affidavits of Oriana Dalla Benetta (sworn June 28, 2023), Christina Fradsham (sworn June 6, 2023), and Anne-José Villeneuve (sworn June 21, 2023). None of the affiants were cross-examined. As the affidavits filed in each case are essentially the same, I will use the singular to refer to each of these affidavits.

The Benetta affidavit

[10] Ms. Benetta is the Vice-President, Brand and Creative Services of the Opponent. She explains that the 'American Growth Fund' was created in 1957 and that, since at least 1971, the financial services performed by the Opponent in Canada have expanded to include a variety of financial services including financial investment services, financial advisory services, securities, commodity and investment advisory services, investment advice

and analysis, and financial planning services. A full list of these services is provided in paragraph 7 of the Benetta affidavit and, where applicable, I will refer to them collectively as the “AGF Financial Services”, as is done in the Benetta affidavit. Ms. Benetta advises that in addition to the AGF Financial Services, the Opponent provides financial sponsorship services, and education services including providing seminars, webinars, and courses in relation to the AGF Financial Services. I will refer to these services as the “AGF Educational Services”, as is done in the Benetta affidavit [at paragraph 7]. The Opponent provides the AGF Financial and Educational Services throughout Canada and it also has investment operations and client servicing teams on the ground in North America and Europe. The Opponent has more than \$41,000,000,000 in total assets under management and serves more than 800,000 investors.

[11] Ms. Benetta states that, as of about 1964, the Opponent adopted the trademark AGF in association with the AGF Financial Services as its primary trademark and corporate brand in Canada. Since 1984, AGF’s primary corporate logos have predominantly featured the word trademark AGF together with the image of a tiger, either displayed above or adjacent thereto, generally in the formats shown below (with a full list provided in Exhibit B to the Benetta affidavit):



[12] Since its adoption more than 60 years ago, the Opponent has continuously used the trademark AGF on virtually every advertisement and piece of correspondence distributed by the Opponent in the advertisement or

performance of its AGF Financial Services. Exhibits G, H, and I contain representative samples of magazines, posters, promotional materials, investor summaries, prospectuses, published annual reports and corporate documents showing the use of the AGF Registrations in the advertisement and/or performance of the AGF Financial Services.

[13] In addition to the trademarks shown above, the Opponent has also used and registered various other trademarks which also feature or prominently include the term AGF in conjunction with other words and design elements. These are listed in Exhibit C to the Benetta affidavit.

[14] I will refer to the Opponent's trademarks listed in Exhibits B and C to the Benetta affidavit collectively as the "AGF Registrations", as is done by Ms. Benetta in her affidavit.

[15] From 1998 to 2021, annual Canadian sales of the AGF Financial Services by the Opponent in association with the AGF Registrations have ranged from in excess of \$1,000,000,000 CAD to in excess of \$6,000,000,000 CAD. Paragraph 29 of the Benetta affidavit sets out these sales on a yearly basis.

[16] Ms. Benetta estimates that in 2022 alone, the Opponent distributed to Canadian investors more than 1,160,000 pieces of individual statements and correspondence bearing the trademark AGF or one or more of the remaining AGF Registrations. Between 1984 and 2022, it is estimated that the Opponent would have distributed more than approximately 1,147,774,828 individual statements or pieces of correspondence bearing one or more of the AGF Registrations to Canadian investors. These estimates exclude further opportunities where Canadian purchasers of the AGF Financial Services would have an opportunity to view the trademark AGF through either accessing AGF's website at *agf.com*, or when viewing one or more of

the AGF Marks in television, movie, newspaper, magazine, or electronic advertisements [Exhibits L, J].

[17] Ms. Benetta estimates that, since 2000, the Opponent has expended more than \$81,970,000 CAD in the promotion of the AGF Financial Services in association with the AGF Registrations in the Canadian marketplace. Paragraph 31 of the Benetta affidavit sets out these advertising expenses on a yearly basis.

The Fradsham affidavit

[18] Ms. Fradsham is a legal assistant employed by the Opponent's agent. She provides the particulars of the trademark registrations relied on by the Opponent [Exhibits A-MM].

The Villeneuve affidavit

[19] Dr. Villeneuve is an Associate professor at the University of Alberta's Campus Saint-Jean, and an Adjunct Professor in the Department of Linguistics. As part of her academic work, Dr. Villeneuve has researched and studied linguistics and phonology in French and English.

[20] Dr. Villeneuve was retained by the Opponent's agent to provide expert opinion and testimony on certain topics relating to the trademarks AGF and AGX, including: the English, French and bilingual (French/English) pronunciation of AGF and AGX; and whether AGF and AGX resemble one another phonetically, visually, and conceptually.

[21] The Opponent also filed certified copies of the file histories for the applications.

The Applicant's evidence

[22] For each proceeding, the Applicant filed the affidavit of Ian Richard Toews (sworn November 1, 2023), a Director of the Applicant and a co-

founder and Chairman of the LODE Project. Mr. Toews was not cross-examined on his affidavit. As the affidavits filed in each case are essentially the same, save for the fact that one affidavit refers to the trademark AGX while the other refers to AGX COIN, I will use the singular to refer to the affidavits.

[23] The Toews affidavit provides information on the origin and objectives of the Applicant's business and the Marks. Mr. Toews explains that:

- From September 2017 to the present, the Applicant's mandate has been to develop a cryptographic silver money system (the "LODE Platform") that challenges the current financial and banking systems to connect general consumers, businesses, and underbanked individuals to a decentralized system that better serves their needs. The LODE Platform is a collectively organized distributed ecosystem comprised of two cryptographic assets, the LODE Token (the governance token) and AGX/AGX COIN (the stablecoin), each representing a unique relationship to physical silver bullion.
- The LODE Platform provides individuals, businesses, and the underbanked population accessibility to an online digital wallet that provides low cost processing transactions by using an asset-backed medium of exchange – AGX/AGX COIN.
- AGX/AGX COIN is a stable asset designed for sending, spending, and trading in digital wallets and on decentralized exchanges. AGX/AGX COIN are backed by physically vaulted silver. Each AGX/AGX COIN is backed by one gram of vaulted, audited and insured 99.99% investment-grade silver. For each AGX/AGX COIN issued, there is a corresponding one gram of silver vaulted in one of the five contracted LODE vaults located in Canada, the United States and Liechtenstein.

[24] As of November 1, 2023 (the date of swearing the Toews affidavit), the LODE Community consists of 14,757 active members worldwide. Mr. Toews estimates that, since September 2017, the Applicant has invested approximately \$23 million for the development of the LODE Platform.

[25] The total worldwide gross sales figures attributed to the Goods and Services associated with the trademark AGX/AGX COIN from 2019 to 2023 is \$1,900,000. Paragraph 21 of the Toews affidavit sets out these gross sales on a yearly basis for this period.

[26] The total number of AGX/AGX COIN digital asset holders from 2019 to 2023 is 4,346. Paragraph 22 of the Toews affidavit sets out the number of digital asset holders on a yearly basis for this period.

[27] AGX/AGX COIN have been sold and transferred into the LODE digital wallet from 2019 to the present (November 2023) in Canada, the United States, Great Britain, France, Australia, Netherlands, Germany, Sweden, Belgium, New Zealand, Switzerland, South Africa, and Spain.

[28] Currently, AGX/AGX COIN are sold using the LODE Wallet. A LODE Wallet can be opened by visiting the *lode.com* website and clicking on the Register/Login tab or by visiting the website *lodewallet.com*. Exhibit H is described as a step-by-step tutorial guide for opening a LODE Wallet and for buying LODE Tokens and AGX/AGX COIN. AGX/AGX COIN can also be purchased on the decentralized exchange 'Trader Joe', the block explorer 'Snowtrace', and the decentralized index tool 'Dex Tools' [Exhibit I].

[29] Mr. Toews states that, since 2018, the Marks have been consistently and extensively used in the advertising and marketing of the Applicant's Services through its website, informational brochures, valuation and due diligence reports and business plans in Canada and around the world. Copies of screenshots from the *agxpay.com* website, promotional brochures, an

investor valuation and due diligence report, business plan, and informational videos available for viewing on YouTube and the LODE website, all displaying the AGX or AGX COIN trademark, are provided as exhibits [Exhibits J-O].

[30] Mr. Toews explains that the Marks were derived in part using the 'Ag' symbol, which is the chemical element for silver shown on the periodic table of elements. Exhibit D contains a copy of a periodic table displaying the chemical element "Ag" under atomic number 47. Mr. Toews further notes that the letter X is derived from the word "exchange".

[31] The Applicant is also the owner of trademark registration No. TMA1,083,711 for the trademark AGX 360 & Design.

PRELIMINARY MATTER – ADMISSIBILITY OF EXPERT EVIDENCE

[32] As part of its evidence, the Opponent has submitted the affidavit of Anne-José Villeneuve. As noted above, Dr. Villeneuve provides expert evidence on certain topics relating to the trademarks AGF and AGX, including: the English, French and bilingual (French/English) pronunciation of AGF and AGX; and whether AGF and AGX resemble one another phonetically, visually, and conceptually.

[33] For expert evidence to be admissible, it must meet the criteria of relevance, necessity in assisting the trier of fact, the absence of any exclusionary rule, and a properly qualified expert [*R v Mohan*, [1994] 2 SCR 9]. While I find Dr. Villeneuve to be a properly qualified expert, I do not need her evidence to assist me in considering the resemblance between the parties' trademarks and determining whether the casual consumer would likely be confused, as I am already in a position to form my own view [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 92]. Accordingly, the Villeneuve affidavit is not admissible.

[34] I would add that if I am wrong in considering this expert evidence inadmissible, then it does not affect my overall conclusion on the likelihood of confusion.

LEGAL ONUS AND EVIDENTIAL BURDEN

[35] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155]. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all the evidence, then the issue must be decided against the Applicant.



ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) ground of opposition

[36] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd*, 1991 CanLII 11769, 37 CPR (3d) 413 (FCA)].

[37] The Opponent has pleaded that the Marks are not registrable because, contrary to section 12(1)(d) of the Act, the Marks are confusing with the Opponent's registered trademarks, including the following trademarks set out in Appendix A to the statement of opposition. The particulars of these registrations are set out in Schedule A to this decision:

1.	AGF	TMA185086
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2.		TMA349,787
3.		TMA570443
4.	AGF	TMA609303
5.		TMA581062
6.		TMA620419
7.		TMA1080227
8.		TMA1081008
9.		TMA1092465

[38] The Opponent has also pleaded that the Marks are confusing with several other registered trademarks which include the element AGF and which are listed in Appendices B and C to the statement of opposition.

[39] I have exercised my discretion to check the Register and confirm that these registrations are extant [*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 for 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 Marks and any of the Opponent's registered trademarks.

[40] In considering the issue of confusion, I will focus on the Opponent's registrations for the word trademark AGF as, in my view, it represents the Opponent's best case. That said, I also consider the use of the composite trademarks listed in the table above (identified as Nos. 2, 3, and 5-9) to constitute use of the word mark AGF since AGF stands out from the other elements in those composite marks [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 at 538-9].

[41] If the Opponent is not successful based on its AGF word trademark, then it will not be successful based on any of the other trademarks identified in the statement of opposition since the applied-for Marks bear a greater degree of resemblance to the AGF word trademark.

Test for confusion

[42] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks, 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 [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401]. I also refer to *Masterpiece, supra*, at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

[43] 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

trademark, 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].

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

[44] Trademarks consisting of a combination of letters generally lack inherent distinctiveness and are seen as weak marks [*GSW Ltd v Great West Steel Industries Ltd et al* (1975), 22 CPR (2d) 154 (FCTD)]. Accordingly, both the Opponent's AGF trademark and the Applicant's AGX trademark are not inherently strong. As for the Applicant's trademark AGX COIN, I do not consider the inclusion of the word "coin" to increase the overall inherent distinctiveness of this trademark given its descriptive meaning in relation to various of the applied-for Goods and Services. In this regard, I note that the *Merriam-Webster* online dictionary includes a definition for coin as "a unit of cryptocurrency" [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 regarding the Registrar's discretion to take judicial notice of dictionary definitions].

[45] With respect to the extent to which the parties' trademarks have become known, this element significantly favours the Opponent in view of the longstanding and extensive use of the AGF trademark in Canada. In particular, the Benetta affidavit demonstrates that the Opponent has a substantial base in Canada and, since adopting the trademark AGF in association with the AGF Financial Services as its primary trademark and brand in Canada more than 60 years ago, has continuously used the AGF trademark on virtually every advertisement and piece of correspondence distributed by the Opponent in the advertisement or performance of the AGF Financial Services. Since the year 2000, more than \$81,970,000 has been

expended by the Opponent in the promotion of the AGF Financial Services in association with the AGF Registrations in the Canadian marketplace.

[46] In contrast, the Applicant's evidence of use of the Marks – and the extent to which they have become known in Canada – is limited. The Toews affidavit suggests that the Applicant began offering the Goods/Services in association with the Marks in 2019. Annual worldwide sales from 2019 to 2023 are provided, however, there is no indication of the amount attributable to consumers in Canada. Similarly, while the total worldwide number of AGX/AGX COIN digital asset holders for the same period is provided, there is no indication of the number of digital asset holders in Canada. Further, while approximately \$23 million has been invested by the Applicant in the development of the LODE Platform, there is no breakdown of this number explaining the proportion dedicated to development, promotion, or advertising of the Goods/Services in association with the Marks in Canada. All of this makes it difficult to assess the extent known of the Marks in Canada.

[47] Overall, I find that this factor, which is a combination of inherent and acquired distinctiveness, favours the Opponent.

Length of time the trademarks have been in use

[48] The Benetta affidavit indicates that AGF has been used as the Opponent's primary trademark in Canada since 1964. The applications for the Marks are based on proposed use, and the Applicant's evidence indicates that use of the Marks started in 2019. Therefore, this factor also favours the Opponent.

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

[49] The Opponent's AGF registrations generally cover financial services including the management of mutual funds and investments, financial planning services, investment advice and analysis.

[50] The applied for Goods and Services generally cover financial services relating to digital currency, virtual currency, cryptocurrency, digital tokens and digital financial assets including their storing and transfer by means of an electronic wallet; conducting an online financial exchange for trading and transmitting these currencies and assets; and online trading of these currencies and assets. They also include the provision of ancillary goods and services facilitating these financial services such as downloadable computer software, the transmission of cryptographic data for these currencies and assets via electronic communication networks, and the electronic transmission of cryptographic data via the blockchain for these currencies and assets via computer terminals and electronic devices.

[51] In its written representations, the Applicant submits that the Goods and Services "are not traditional financial instruments (i.e., the purchasing, selling, sending, receiving and storage of digital and cryptocurrency assets is different than traditional financial instruments such as mutual funds, stocks and bonds) and it requires specialized knowledge and understanding for the purchase, sale, send, receipt and safe storage of the cryptocurrency assets in digital wallets" [Applicant's representations at paragraph 5(c)]. At the hearing, the Applicant also characterized the AGX assets as more of an alternate form of cash or payment, as opposed to an investment vehicle such as a mutual fund.

[52] For its part, the Opponent submits that the Applicant's Goods and Services include "types of cryptocurrencies which for example, would be analogous to types of bitcoin exchange – traded products sold to investors",

and that “the Applicant’s own evidence shows that it markets its goods and services as “silver-money” and to individuals acting as investors seeking to secure their financial future” [Opponent’s representations at page 30], with the result that there is close or direct overlap with the Opponent’s Financial Services.

[53] In my view, there is at least some meaningful overlap between the parties’ respective goods and services in that both parties operate in the financial sphere and offer financial services, though as noted by the Applicant, its Goods and Services are not “traditional” financial instruments but rather reflect new advances in technology (blockchain). Moreover, while the Applicant’s focus may be to establish the AGX/AGX COIN Goods and Services as an alternate form of cash or payment, I agree with the Opponent’s submission that the Applicant’s evidence does suggest the AGX/AGX COIN Goods and Services go beyond that and are also considered and marketed as “silver-money” appealing to those seeking, from an investment perspective, to secure their financial future and enhance wealth. In this regard, I note the following excerpts from the Toews affidavit and exhibits:

- “AGX is modern silver-money designed with you in mind to give you freedom to build your wealth, the way you want. With AGX, you will be free to send, spend, and build wealth with borderless digital silver. Don’t break even. Break Free...” [Exhibit J – downloaded screenshots from the *agxpay.com* website]
- “In terms of financial security, AGX Coins are adjusted for inflation and deflation, and feature stable pricing against the market price of silver. Accordingly, holders of AGX Coins can create returns by speculating against future increases and decreases in the price [of] silver.” [Exhibit M – copy of investor valuation and due diligence report provided to investors in Canada, page 17].
- AGX Coins – Nine Case Uses: [Exhibit M, page 32]

3) Crypto-Traders – Fund managers of cryptographic currencies and blockchain assets can position into AGX Coins as a means to stabilize and diversify their portfolios, insulate profits, or hedge against volatility...

7) Silver Investors – Silver Exchange Traded Funds (ETF's) may discover that AGX Coin positions provide better security and flexibility than Silver Exchange Traded Funds, which require administration by various counter-parties...

8) Bullion Investors – Silver bullion [investors] may exchange their physical coins and bars for AGX Coin and tap its purchasing power among AGX friendly merchants and retailers seeking sound silver settlement. Additionally, AGX Coins can be deposited with a cryptocurrency exchange operator and converted into other digital assets like Bitcoin, and allow silver 'stackers' to seamlessly position into the cryptographic investment space.

[54] Accordingly, this factor favours the Opponent.

[55] With respect to the channels of trade, in its written representations, the Applicant submits that the sales flow, purchase and reporting of the Opponent's financial services such as mutual funds, stock or bond assets is different [paragraph 5(g)]. In particular, the Applicant explains that "typically, the sales of mutual funds, stocks and bonds is accomplished through a sales representative who advises the merit and performance of the fund and its related risks to the consumer...". The Applicant emphasizes that, in contrast, "a user wishing to purchase AGX/AGX COIN Goods and Services would first have to visit and conduct research on the Applicant's website at "lode.one" and thereafter download a wallet at "lodewallet.com"... Once the wallet is downloaded, the user can purchase the digital asset through the LODE wallet. Alternatively, if the user already has a pre-existing cryptocurrency wallet, it can purchase the AGX/AGX COIN digital assets through the Trader Joe decentralized exchange" [Applicant's representations at paragraphs 36 and 38].

[56] For its part, the Opponent submits that the channels of trade for the Applicant's Goods and Services and the services of the Opponent are identical [Opponent's written representations at paragraph 9.2]. At the hearing, the Opponent also noted that the Applicant's statements regarding the nature of trade for the Opponent's services, for instance, how sales of mutual funds are typically effected, is not in the evidence of record.

[57] When considering the nature of the trade of the parties, while evidence of the parties' actual trades may be useful, it is ultimately the statement of Goods and Services in the Applicant's applications and the Opponent's registrations that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CanLII 8953 (FCA), 19 CPR (3d) 3 (FCA)]. With this in mind, notwithstanding that the Applicant's financial services already integrate advances in technology, there do not appear to be any restrictions in the statement of goods and services in the Opponent's registrations that would rule out the Opponent's ability to implement or incorporate similar technologies in the provision of its financial services.

[58] The Applicant also takes the position that the target consumer of each party is different and highly sophisticated, thus reducing the likelihood of confusion [paragraphs 40-44 of the Applicant's written submissions]. However, the evidence indicates that there is at least some overlap in the parties' target customers in that both cater to individuals and investors [see Benetta affidavit at paragraph 8 and Toews affidavit at paragraphs 12, 29-31 and Exhibits L, M, N].

[59] As for the level of sophistication of the target consumers, it is questionable whether any specialized expertise or knowledge is needed in

order to use the Applicant's AGX/AGX COIN Goods and Services given that the Applicant's evidence characterizes them as an option "no matter who you are, where you live, what you earn" and "Simple and oh so easy to use" [Exhibit J, Toews affidavit]. Leaving this aside, even assuming that the parties' target consumers are sophisticated, the test for confusion is one of first impression, and any subsequent steps taken by sophisticated consumers in an attempt to remedy a potential instance of confusion when they are exercising time and due diligence in the purchasing decision are irrelevant [by analogy see paragraphs 68-74 of *Masterpiece, supra*].

[60] Accordingly, in view of the potential overlap in the parties' channels of trade, I find that at best for the Applicant, this factor is neutral.

Degree of resemblance

[61] As mentioned above, the degree of resemblance between the parties' trademarks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[62] When considering the degree of resemblance, the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent's trademark [*Veuve Cliquot, supra* at para 20].

[63] In *Masterpiece, supra*, the Court observed that while the first word (or syllable) of a trademark may, for purposes of distinctiveness, be the most important in some cases [*Conde Nast Publications Inc v Union des editions moderns* (1979), 46 CPR (2d) 183 (FCTD)], a preferable approach is to first consider whether there is an aspect of the trademark that is particularly striking or unique.

[64] The Opponent's AGF trademark and the Applicant's AGX Mark both consist of combinations of three letters. In my view, neither trademark possesses an aspect that is particularly striking or unique.

[65] On consideration of both trademarks as a whole in appearance and sound, I find that their similarities outweigh their differences. They share the first two letters, and the presence of an F versus X as the last letter does not result in a significantly different appearance or sound.

[66] In terms of the ideas suggested, the Opponent's trademark AGF appears to have originated as an acronym for 'Advanced Growth Fund', while the Applicant's AGX Mark is derived from the chemical element for silver (AG) from the Periodic Table of Elements, and the letter 'X' derived from the word "exchange." However, the evidence does not establish that consumers would recognize the underlying meanings attributable to each trademark. In my view, despite the fact that AGF may have originated as an acronym and some consumers may be aware of this, the trademark AGF would be just as, if not more, likely to be viewed on first impression as a coined mark conveying no particular idea. Similarly, I am of the view that the Applicant's Mark would, on first impression, be more likely to be viewed as a coined mark conveying no particular idea rather than conveying the particular idea of the combination of the chemical element 'AG' and 'exchange'. Accordingly, no particular idea is suggested by the trademarks themselves, aside from the particular three letters that constitute each trademark.

[67] As for the degree of resemblance between the Opponent's AGF trademark and the Applicant's AGX COIN Mark, while there is still some resemblance between this trademark and the Opponent's AGF trademark because of their similar first components, there is a lower degree of resemblance overall because of the presence of the COIN component of this Mark.

[68] Nevertheless, overall, this important factor favours the Opponent with respect to both Marks.

Surrounding circumstances – the fame of the AGF trademark and the Opponent’s family of AGF marks

[69] The Opponent takes the position that the AGF trademark is very well known, if not famous, in association with its financial services. The Opponent also submits that it owns and uses a family of AGF trademarks in association with financial services.

[70] I consider that the Opponent’s evidence supports a finding that the AGF trademark is extremely well known in Canada in association with the Opponent’s financial services. I also find that the Opponent’s evidence demonstrates use of more than two of its trademarks that incorporate the AGF element (for instance, TMA609,303; TMA620,419; TMA1,092,465; TMA620,292; TMA1,080,233), and in this sense may be considered to have demonstrated the existence of a family of trademarks.

[71] Accordingly, these surrounding circumstances do assist the Opponent. That being said, with respect to the renown of the Opponent’s AGF trademark, I note that this has already largely been accounted for in my assessment of the section 6(5)(a) factor.

Surrounding circumstance – state of the Register and marketplace

[72] The Applicant submits that there are dozens of acronyms used in the financial industry that co-exist on the Canadian Trademark Register and in the Canadian marketplace, with the result that consumers may be presumed to be “more alert to differences in the letters comprising financial services and capable of making fine distinctions” [Applicant’s written representations, paragraph 45(e)]. However, the Applicant filed no supporting state of the

register or marketplace evidence. In the absence of such evidence, I do not consider this to be a surrounding circumstance assisting the Applicant.

Surrounding circumstance – absence of actual confusion

[73] In its written representations [at paragraph 13.2], the Opponent submits that the Applicant has not provided any evidence which shows that the Applicant's Marks have been used to any substantial extent in the Canadian marketplace from which it could be shown that actual confusion has not occurred, whereas in contrast, it has provided uncontested evidence of its longstanding and extensive use and promotion of the AGF trademark.

[74] An absence of evidence of actual confusion over a period of time may allow the Registrar to draw a negative inference about the likelihood of confusion. Nevertheless, the Opponent is under no obligation to submit evidence of instances of actual confusion. Moreover, the absence of such evidence does not necessarily raise any presumptions unfavourable to the Opponent as the burden is on the Applicant to demonstrate the absence of likelihood of confusion.

[75] In my view, the Applicant's evidence is not sufficient to determine whether any concurrent use has been extensive, with the result that I am not prepared to consider the absence of evidence of any instances of actual confusion to be a significant surrounding circumstance in this case.

Surrounding circumstance – Applicant's registration for AGX 360 & Design

[76] In addition to the applied-for Marks, the Applicant owns a registration (No. TMA1,083,711) for the trademark AGX 360 & Design. However, the existence of a prior registration owned by a party does not automatically entitle that party to register a similar trademark [see *Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB) at para 15]. Moreover, this registration appears to cover different services, and the

Applicant has showed no use of this trademark. Accordingly, this does not constitute a surrounding circumstance assisting the Applicant.

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

[77] With respect to the applied for trademark AGX, having considered all the surrounding circumstances, including the high degree of resemblance between the parties' trademarks, the longstanding and extensive use and extent known of the Opponent's AGF trademark, and the overlap in the nature of the parties' goods and services, I find that the Applicant has not met its legal onus of establishing on a balance of probabilities that there is not a reasonable likelihood of confusion between the applied-for trademark AGX and the Opponent's AGF trademark.

[78] With respect to the applied-for trademark AGX COIN, given all the surrounding circumstances, including some degree of resemblance between the parties' marks, the longstanding and extensive use and extent known of the Opponent's AGF trademark, and the overlap in the nature of the parties' goods and services, I find that the likelihood of confusion is, at best for the Applicant, 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.

[79] Accordingly, the section 12(1)(d) ground of opposition is successful.

Section 16(1)(a) ground of opposition

[80] The material date for a ground of opposition under section 16(1)(a) of the Act is the date of filing of the applications, namely February 1, 2018. The Opponent has met its initial evidential burden through its evidence demonstrating use of the AGF trademark, as discussed above, since well prior to the material date.

[81] In my view, the earlier material date for this ground of opposition does not change to any meaningful degree the confusion analysis conducted for the section 12(1)(d) ground of opposition set out above. Accordingly, the Applicant has not met its legal burden to demonstrate no likelihood of confusion as of the material date under the 16(1)(a) ground of opposition. Therefore, the section 16(1)(a) ground of opposition is also successful against both Marks.

Remaining grounds of opposition

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



DISPOSITION




[83] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse both application Nos. 1,880,841 and 1,880,849, pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Opponent's registrations included in Appendix A to the statement of opposition

Trademark	Goods/Services
AGF TMA185,086	(1) Providing financial services namely, managing mutual funds and the selling and distribution of mutual fund shares. (2) Selling life insurance. (3) Providing income tax services and the preparation and filing of income tax returns.
 TMA349,787	(1) Financial and investment management and consultation services including founding, promoting, distributing and managing mutual funds, and managing investment portfolios. (2) Trust company services and lending services.
 TMA570,443	(1) Providing financial services, namely, managing mutual funds; selling and distributing mutual funds and mutual fund shares; investment management and consultation services; founding, promoting, distributing and managing investment in portfolios; financial planning services; trust company services; lending services, mortgage and loan company services; accepting deposits, withdrawals and the borrowing of funds; and investment of deposits.
AGF TMA609,303	(1) Financial services, namely, securities dealer services, securities agency in the fields of bonds and negotiable instruments; stock brokerage services, brokerage house services, securities, commodity and investment advisory services, underwriting services namely underwriting of securities; securities, bond, debenture and stock trading and dealer services, transfer agency services; investment advice and analysis; sale and distribution of mutual fund shares; investment management and consultation services; founding, promoting, distributing and managing investment portfolios; financial planning services; accepting deposits, withdrawals and the borrowing of funds, investment of deposits on behalf of individuals; investment of deposits on behalf of institutions; lending services, namely, trust company services; mortgage and loan company services.

 <p>TMA581,062</p>	<p>(1) Investment services, namely, investment management of mutual funds of others; securities dealer services; securities agency in the fields of bonds and negotiable instruments; stock brokerage services; brokerage house in the fields of stocks, commodities and futures; research and advisory services related to securities, stocks, bonds, commodities and other instruments; underwriting, distributing and trading of securities; trading and dealing in bonds, debentures, stocks and shares; transfer agency services rendered to issuers of investment securities; providing investment advice.</p>
 <p>TMA620,419</p>	<p>(1) Securities dealer services; securities agency in the fields of bonds and negotiable instruments; stock brokerage services; brokerage services; brokerage house services; securities, commodity and investment advisory services; underwriting services, including, underwriting of securities; securities, bond, debenture and stock trading and dealer services; transfer agency services; investment advice and analysis; sale and distribution of mutual fund shares; founding, promoting, distributing and managing investment portfolios; investment of deposits; financial planning services; accepting deposits, withdrawals and the borrowing of funds; lending services; trust company services; investment management and consultation services; mortgage and loan company services; educational services in the field of economics; financial planning and investment strategies; educational services namely conducting classes, conferences and workshops in the field of investment planning, retirement planning, investment strategies and financial planning strategies; conducting seminars in the field of estate and retirement planning; financial and retirement investment planning and advisory services.</p> <p>(2) Financial sponsorship of cultural events for others; financial sponsorship and promotion of film festivals for others; entertainment services, namely, the sponsorship of film festivals and live musical performances; charitable organization services relating to fundraising, sponsorship relating to fundraising; sponsorship of research and education relating to the preservation of endangered animal species.</p>
	<p>(1) Financial and investment services, namely, investment management, portfolio management, wealth management, namely, financial planning and investment</p>

TMA1,080,227	<p>portfolio management, asset management, mutual fund sales and management, exchange-traded fund sales and management, pooled fund sales and management, segregated fund sales and management, discretionary investment management, private client investment management, investment counselling, institutional investment management, mutual fund dealing, securities dealer services; transfer agency services for mutual funds and pooled funds; retirement investment planning and advisory services; providing stock market investment information and research in the field of financial planning and financial investments; financial planning services; investment advice and analysis; financial services, namely, the development, sale and management of alternative asset funds; financial investments in the fields of infrastructure, real estate, and private equity; investment of funds for others; fund investment consultation; financial advice and consultancy services, namely, financial analysis and research services; financial sponsorship of cultural events for others, namely, theatrical, film, music, and dance performances and festivals, art and museum exhibitions; financial sponsorship of film festivals for others; charitable organization services relating to fundraising, sponsorship relating to fundraising; financial sponsorship of educational programmes in the field of business; financial sponsorship of medical research.</p> <p>(2) Educational services in the field of economics, financial planning and investment strategies; educational services namely, conducting classes, conferences and workshops in the field of investment planning, retirement planning, investment strategies and financial planning strategies; conducting seminars in the field of estate and retirement planning.</p>
 AGF TMA1,081,008	<p>(1) Financial and investment services, namely, investment management, portfolio management, wealth management, namely, financial planning and investment portfolio management, asset management, mutual fund sales and management, exchange-traded fund sales and management, pooled fund sales and management, segregated fund sales and management, discretionary investment management, private client investment management, investment counselling, institutional</p>

	<p>investment management, mutual fund dealing, securities dealer services; transfer agency services for mutual funds and pooled funds; retirement investment planning and advisory services; providing stock market investment information and research in the field of financial planning and financial investments; financial planning services; investment advice and analysis; financial services, namely, the development, sale and management of alternative asset funds; financial investments in the fields of infrastructure, real estate, and private equity; investment of funds for others; fund investment consultation; financial advice and consultancy services, namely, financial analysis and research services; financial sponsorship of cultural events for others, namely, theatrical, film, music, and dance performances and festivals, art and museum exhibitions; financial sponsorship of film festivals for others; charitable organization services relating to fundraising, sponsorship relating to fundraising; financial sponsorship of educational programmes in the field of business; financial sponsorship of medical research.</p> <p>(2) Educational services in the field of economics, financial planning and investment strategies; educational services namely, conducting classes, conferences and workshops in the field of investment planning, retirement planning, investment strategies and financial planning strategies; conducting seminars in the field of estate and retirement planning.</p>
 <p>TMA1,092,465</p>	<p>(1) Financial and investment services, namely, investment management, portfolio management, wealth management, namely, financial planning and investment portfolio management, asset management, mutual fund sales and management, exchange-traded fund sales and management, pooled fund sales and management, segregated fund sales and management, discretionary investment management, private client investment management, investment counselling, institutional investment management, mutual fund dealing, securities dealer services; transfer agency services for mutual funds and pooled funds; retirement investment planning and advisory services; providing stock market investment information and research in the field of financial planning and financial investments; financial planning services;</p>

	<p>investment advice and analysis; financial services, namely, the development, sale and management of alternative asset funds; financial investments in the fields of infrastructure, real estate, and private equity; investment of funds for others; fund investment consultation; financial advice and consultancy services, namely, financial analysis and research services; financial sponsorship of cultural events for others, namely, theatrical, film, music, and dance performances and festivals, art and museum exhibitions; financial sponsorship of film festivals for others; charitable organization services relating to fundraising, sponsorship relating to fundraising; financial sponsorship of educational programmes in the field of business; financial sponsorship of medical research</p> <p>(2) Educational services in the field of economics, financial planning and investment strategies; educational services namely, conducting classes, conferences and workshops in the field of investment planning, retirement planning, investment strategies and financial planning strategies; conducting seminars in the field of estate and retirement planning</p>
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Appearances and Agents of Record

HEARING DATE: 2024-10-23

APPEARANCES

For the Opponent: Michael Adams

For the Applicant: Sandra Wright

AGENTS OF RECORD

For the Opponent: Riches, McKenzie & Herbert LLP

For the Applicant: Sandra Wright (Infuse Works Inc.)