



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2016 TMOB 116
Date of Decision: 2016-07-08

IN THE MATTER OF AN OPPOSITION

**American Express Marketing &
Development Corp.
and**

Opponent

Black Card, LLC

Applicant

**1,432,158 for BLACK CARD
TELLAPAL**

Application

Introduction

[1] American Express Marketing & Development Corp. (the Opponent) opposes registration of the trade-mark BLACK CARD TELLAPAL (the Mark).

[2] The application was filed by Black Card, LLC (the Applicant) on March 24, 2009 on the basis of proposed use in Canada. The Applicant claimed a priority date of February 2, 2009 based on an application filed in the United States of America, No. 77/661154, seeking the registration of the same or substantially the same trade-mark for use in association with the same kind of services as described in the application.

[3] The list of services (the Services) enumerated in the application is reproduced in Annex A to this decision.

The Record

[4] The application was advertised in the *Trade-marks Journal* on July 25, 2012.

[5] The Opponent filed a statement of opposition on December 27, 2013 under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded are based on sections: 12(1)(b) (registrability), 16(3) (non-entitlement), and 2 (distinctiveness).

[6] The Applicant filed and served a counter statement on May 9, 2014 in which it denied each ground of opposition pleaded by the Opponent.

[7] The Opponent filed as its evidence the affidavit of Jennifer Leah Stecyk sworn on September 5, 2014. The Applicant filed as its evidence the affidavit of Gay Owens dated December 19, 2014. No reply evidence was filed. Neither of the deponents was cross-examined.

[8] Both parties filed written arguments and were represented at the hearing.

[9] For the reasons explained below, I reject the opposition.

Preliminary remarks

[10] I wish to point out that in reaching my decision I have considered all the evidence in the file but I will only refer in my reasons for this decision to the relevant portions of the evidence. In particular, the state of the register evidence filed through the affidavit of Gay Owens, and referred to by the Applicant, will not have any impact on my decision as it will appear from my decision, the Opponent has not met its initial onus with respect to each of the grounds of opposition pleaded.

[11] This file was heard together with 9 other files. One of the main issues in these files is the admissibility and weight to be given to various Internet searches performed by Ms. Stecyk, a trade-mark searcher employed by the Opponent's agent firm. The Opponent is relying on those searches to meet its initial burden of proof. If I rule that such evidence is inadmissible and/or have very little probative value, it will have a direct impact on whether or not the Opponent has met its initial burden under certain grounds of opposition.

The parties' respective burden of proof

[12] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

Ground of opposition based on section 16 of the Act

[13] The ground of opposition based on section 16 of the Act must be assessed at the filing date of the application which is February 2, 2009 in view of the priority date claimed [see sections 16(3) and 34 of the Act]. The Opponent pleaded in its statement of opposition that the Mark was confusing with the Opponent's trade-mark BLACK CARD previously used and/or made known in Canada by the Opponent in association with financial services. Consequently, the Opponent had the initial burden to prove that it had used or made known in Canada the trade-mark BLACK CARD, as alleged in its statement of opposition, prior to February 2, 2009.

[14] I note that the Opponent did not address this ground of opposition in its written argument and at the hearing. In this regard, there is no affidavit from a duly authorized representative of the Opponent to prove prior use of the trade-mark BLACK CARD in Canada. Still, I have to determine if the Opponent has met its initial burden to prove that it has made known its trade-mark BLACK CARD in Canada prior to February 2, 2009.

[15] Ms. Stecyk is a trade-mark searcher employed by the Opponent's agent firm. She conducted various searches on September 4, 2014 on the Internet, which is after the material date. Attached to her affidavit are the results of those searches as well as extracts of some of the websites she located. Some of the extracts filed make reference to the American Express Centurion Black Card.

[16] The admissibility of those portions of the Opponent's evidence has been raised by the Applicant. The Applicant argues that such evidence is inadmissible hearsay evidence as the Opponent failed to prove the necessity and reliability of the evidence in issue [see *R v Khan*, [1990] 2 SCR 531]. I agree.

[17] As pointed out by the Applicant, the Opponent has not provided any evidence establishing that it was not in a position to file evidence, through one of its duly authorized representative, of its use of the trade-mark BLACK CARD in Canada. By filing evidence of alleged use of its trade-mark BLACK CARD from extracts of third parties' websites through the affidavit of Ms. Stecyk, the Opponent is depriving the Applicant of a meaningful cross-examination on such evidence. Other than facts related to the parameters used for this search, Ms. Stecyk would not be in a position to answer any questions during a cross-examination about the use of the Opponent's trade-mark BLACK CARD by the Opponent in Canada.

[18] Consequently, I am not giving any probative value to the extracts filed through the affidavit of Ms. Stecyk wherein reference is made to the Opponent's alleged use of the trade-mark BLACK CARD.

[19] In any event, at the hearing I asked the Opponent to identify documents annexed to Ms. Stecyk's affidavit that predate the material date. The Opponent was able to identify only four of them, namely:

- Article located at *rewardscanada.ca* dated April 22, 2008;
- Forum of discussion at *forum.redflags.com* posted on February 22, 2008.

[20] None of them constitutes evidence of use of a trade-mark within the meaning of section 4(2) of the Act. Being an article or comments published on the web, they are not advertisements of services provided by the Opponent in Canada prior to the relevant date in association with the trade-mark BLACK CARD.

[21] In *Porter v Don the Beachcomber*, (1966), 48 CPR 280, 1966 CarswellNat 37 Mr. Justice Thurlow then of the Exchequer court disposed of this issue by concluding:

«I shall therefore hold that "use in Canada" of a trade mark in respect of services is not established by mere advertising of the trade mark in Canada coupled with

performance of the services elsewhere but requires that the services be performed in Canada and that the trade mark be used or displayed in the performance or advertising in Canada of such services.»

[22] There is no admissible evidence in the record that the Opponent performed any services in association with the trade-mark BLACK CARD in Canada prior to the material date within the meaning of section 4(2) of the Act.

[23] Still, I have to determine whether the trade-mark BLACK CARD was made known in Canada at the material date. Section 5 of the Act reads:

5. A trade-mark is deemed to be made known in Canada by a person only if it is used by that person in a country of the Union, other than Canada, in association with goods or services, and

- (a) the goods are distributed in association with it in Canada, or
- (b) the goods or services are advertised in association with it in
 - (i) any printed publication circulated in Canada in the ordinary course of commerce among potential dealers in or users of the goods or services, or
 - (ii) radio broadcasts ordinarily received in Canada by potential dealers in or users of the goods or services,

and it has become well known in Canada by reason of the distribution or advertising.

[24] In *Williams Companies Inc et al v William Tel Ltd*, 1999 CarswellNat 443, (2000) 4 CPR (4th) 253 (TMOB), the Registrar stated:

«In other words, the opponents are obliged, as a matter of law, to show that their marks had been "made known" and had become "well-known" by the specific means set out in section 5: see *Valle's Steak House v. Tessier (1980)*, 49 C.P.R. (2d) 218 (F.C.T.D.) at pp. 224-5, and see *Motel 6, Inc. v. No. 6 Motel Ltd. (1981)*, 56 C.P.R. (2d) 44 (F.C.T.D.) at p. 56. It follows that a mark which becomes well-known in Canada by means of word of mouth, or through newspaper or magazine articles (as opposed to advertising) is not a mark that has been "made known" in Canada within the meaning of section 5: see *Motel 6*, supra, at page 59, where this distinction is made.

With respect to the articles appearing in the newspapers *The Globe and Mail*, *The Financial Post*, *The Montreal Gazette* and *The Toronto Star* between 1989 and 1996, as evidenced in exhibits B-Q of Mr. Nahm's affidavit, and the newspaper magazine circulation figures provided by both Mr. Nahm and by Robert W. White in their affidavits, I infer from this evidence that a fair number of Canadians would have been informed about the trade-marks WILTEL and WILLIAMS TELECOMMUNICATIONS in association with the telecommunications industry. However, such references in newspaper articles do not qualify as advertising. Thus, I am not satisfied that these marks have become "made known" in Canada within

the meaning of section 5 of the Act. I therefore find that as the opponents have not met their burden under sections 16(5) and 17(1) of the Act in relation to this ground, this ground of opposition is not successful.» (My underlines)

[25] Even If I were to consider the article published on the website *rewardscanada.ca*, the one article identified in paragraph 19 above does not constitute an advertisement and therefore the Opponent cannot rely on it to substantiate the argument that its trade-mark BLACK CARD has been used or 'made known' in Canada within the meaning of section 16 of the Act.

[26] Finally, one article and one forum of discussion with no information on the number of Canadians that may have read them is insufficient to establish that the Opponent's trade-mark BLACK CARD has been made known in Canada at the relevant date.

[27] Consequently, I dismiss the ground of opposition based on section 16 of the Act as the Opponent failed to meet its initial evidential burden.

Lack of distinctiveness of the Mark

[28] The Opponent has attacked the distinctiveness of the Mark under several angles. I reproduce paragraph 2(c) of its statement of opposition:

(c) Under the provisions of section 38(2)(d) of the *Trade-marks Act*, the Trade-mark is not distinctive of the applicant because it does not distinguish, nor is it adapted to distinguish, the services of the Applicant from the services of the Opponent and others having regard to:

- (i) the use and/or making known by the Opponent in Canada of the confusingly similar trade-mark BLACK CARD in association with the services enumerated in paragraph (b) above;
- (ii) the descriptive significance of the applied for mark in that the credit, debit and/or charge cards issued, promoted or intended to be issued by the applicant to permit customers to avail themselves of the applicant's services are black in colour;
- (iii) the issuance, promotion and/or distribution by the Opponent in Canada of credit, debit and/or charge cards which are black in colour;
- (iv) the issuance, promotion and/or distribution in Canada by parties other than the applicant of black coloured credit cards, charge cards, debit cards, customer loyalty cards and cards which award incentives to consumers;
- (v) the fact that BLACK CARD connotes a "high end" charge or credit card.

[29] It is generally accepted that this ground of opposition must be assessed as of the filing date of the statement of opposition (December 27, 2013) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 CF 1185, 34 CPR (4th) 317 (FC)].

[30] I will analyze each angle of the distinctiveness ground of opposition not necessarily in the order raised by the Opponent in its statement of opposition. I will start with sub-paragraphs 2(c)(i), and (iii) as described above.

Lack of distinctiveness of the Mark based on prior use and/or making known by the Opponent of the trade-mark BLACK CARD and the issuance, promotion and/or distribution by the Opponent in Canada of credit, debit and/or charge cards which are black in colour (sub-paragraphs 2(c)(i) and (iii) of the statement of opposition).

[31] In *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 the Federal Court determined that:

- A mark needs to be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada.

[32] The Opponent had the initial burden to prove that:

- its mark BLACK CARD was used and/or known in Canada to some extent or it was well known in a specific area of Canada;
- it issued, promoted and/or distributed in Canada credit, debit and/or charge cards which were black in colour.

[33] I already ruled that there is no admissible evidence in the record of prior use of the Opponent's trade-mark BLACK CARD in Canada. The fact that the relevant date under this ground of opposition is subsequent to the relevant date associated with the ground of opposition based on section 16(3) of the Act does not improve the Opponent's situation. There is no admissible evidence of use of the trade-mark BLACK CARD by the Opponent in Canada within the meaning of section 4(2) of the Act.

[34] Accordingly, I dismiss the ground of opposition pleaded in sub-paragraphs 2(c)(i) and (iii) of the statement of opposition in so far as prior use by the Opponent of the trade-mark

BLACK CARD or the issuance of credit, debit and/or charge cards by the Opponent, which were black in colour, prior to December 27, 2013 is concerned.

[35] There remains the issue of lack of distinctiveness of the Mark because of the making known by the Opponent in Canada of its confusingly similar trade-mark BLACK CARD.

[36] As stated earlier, Ms. Stecyk performed Internet searches on September 4, 2014, after the relevant date, and located articles wherein reference is made to the Opponent's BLACK CARD trade-mark. She conducted a search using the Google search engine by entering the terms 'American Express Black Card Canada'. She then proceeded to file as Exhibit 6 the first five pages of the search results. Thereafter, she accessed and viewed each of the websites corresponding to the 'hits' revealed in the first five pages of the Google search results for the term 'American Express black card'. Extracts of the web pages taken from the websites she visited were filed as Exhibit H.

[37] As pointed out by the Opponent at the hearing, some of the documents bear a date prior to the relevant date. As such, I am prepared to take them into consideration. They are articles found as part of Exhibits H and I to Ms. Stecyk's affidavit, namely:

- Article dated August 30, 2013 taken from the website *www.zerohedge.com* where reference is made to AMERICAN EXPRESS CENTURION BLACK CARD;
- Article dated August 28, 2013 published on the website *www.creditcardinsider.com* entitled 'The American Express Centurion Black Card-Infographic'. In the text we can read: 'The American Express 'black' card is actually called the American Express Centurion card (not to be confused with the more recent Visa Black Card)';
- A thread published on *creditcardforum.com* from April 30, 2010 to November 13, 2013 containing over 50 comments with several references to 'black card' or 'black cards';
- Article dated July 11, 2011 taken from the website *www.dailyfinance.com*;
- Article dated June 4, 2010 taken from the website *finance.yahoo.com*;
- Article dated January 25, 2011 taken from the website *www.forbes.com*;
- Article dated December 7, 2011 taken from the website *www.dolcemag.com* (reference to American Express' Black Card);
- Article dated April 18, 2011 taken from the website *www.snopes.com* (with reference to 'Black American Express Card');
- Article dated July 9, 2009 taken from the website *www.theglobeandmail.com* (but updated September 6, 2012 such that it is impossible to determine what was first published on July 9, 2009);
- Article dated June 11, 2009 taken from the website *www.bcbusiness.ca* with mention '2657 fans' but no explanation on the meaning of such reference;

- Article posted on March 6, 2009 taken from the website *www.luxuryplastic.com*;
- Article posted on April 22, 2008 on the website *rewardscanada.ca*.
- Thread posted on February 22, 2008 on the website *forums.redflagdeals.com* posted on February 22, 2008.

[38] There are 11 articles and two threads published over a period of more than five years. Ms. Stecyk does not provide any information on the websites she visited such as for example: *www.luxuryplastic.com*, *www.rewardscanada.ca*, *www.dolcemag.com*, *www.creditcardinsider.com*, *www.zerohedge.com* and *www.dailyfinance.com*. Moreover, I have no information as to whether Canadians visited those websites and if so, how many. I have no information if Canadians participated in the threads identified above. Despite the fact that I can infer that the following publications are available in Canada: *Globe and Mail* and *Forbes*, and to a lesser extent, *BC Business*, it does not necessarily mean that Canadians read the content of their corresponding websites.

[39] I may add that some of the articles identified above do not make specific reference to ‘Black Card’ but to other expressions and/or trade-marks such as ‘MyBlackCard’; ‘black Centurion card’; and ‘Black American Express Card’. Finally, despite the fact that Ms. Stecyk obtained 18,800,000 hits, as it appears from the search results pages she filed, only very few of them are relevant.

[40] In all, I am not convinced that the Opponent has met its initial burden to prove that its trade-mark BLACK CARD was known in Canada or was well known in portions of Canada at the material date such that it negated the distinctiveness of the Mark. There is no admissible evidence of use of that trade-mark by the Opponent in Canada prior to the relevant date. Moreover the limited number of articles produced and the lack of information on the number of Canadians that may have read those articles constitute additional reasons justifying my conclusion.

[41] Under those prongs of the distinctiveness ground of opposition, I would have expected an affidavit from a duly authorized representative of the Opponent providing evidence that the Opponent has issued X number of credit cards under the trade-mark BLACK CARD in Canada; that it has carried out advertising campaigns in major newspapers and print publications

circulating in Canada to promote its credit card in association with the trade-mark BLACK CARD, etc... but I have no information of that nature.

[42] Consequently, the grounds of opposition described in sub-paragraphs 2(c)(i) and (iii) of the Opponent's statement of opposition are dismissed as the Opponent failed to meet its initial burden with respect to them.

Lack of distinctiveness based on the issuance, promotion and/or distribution in Canada by parties other than the applicant of black coloured credit cards, charge cards, debit cards, customer loyalty cards and cards which award incentives to customers (sub-paragraph 2(c)(iv) of the statement of opposition)

[43] Again, the Opponent had the initial burden to prove that third parties have, prior to December 27, 2013, issued, promoted and/or distributed in Canada black coloured credit cards, charge cards, debit cards, customer loyalty cards and cards which award incentives to customers.

[44] Once more, the Opponent is solely relying on the content of Ms. Stecyk's affidavit. Generally speaking, the Registrar has ruled that the content of third parties' websites, in general, constitutes evidence that such websites exist but not as proof of the truth of their contents [see *Envirodrive Inc v 836442 Canada Inc* 2005 ABQB 446]. However, in *ITV Technologies Inc v Wic Television* 2013 FC 1056, the Federal court expressed the view that the content of official websites could be admitted as evidence in the record. There are no general guidelines as to what constitutes an official website.

[45] Ms. Stecyk visited numerous Canadian banks' and financial institutions' websites such as RBC Bank, BMO, CIBC, TD CanadaTrust, ScotiaBank, Laurentian Bank and Mastercard. I have no problem in considering them as official websites as they contain information emanating directly from these institutions and I have no reason to doubt the reliability of the information contained in these extracts.

[46] However, I do not consider a forum of discussion to be an official website such that its content would be admissible as evidence. I have no information on the source of the information contained therein and no indication that such information is reliable. For example, I refer to

extracts from the website *redflags.com*, *creditcardforum.com* and some extracts from *www.luxuryplastic.com*. Also, there are websites for which we have no background information on their origins such as *www.davemanuel.com*, *www.scene.ca* and *www.citylab.com*.

[47] The extracts from the RBC Bank's website (*www.rbcbank.com*) relate to 'RBC Bank Visa Signature Black Credit card' available in the United States. Moreover, the pages filed were printed on September 4, 2014 and there is a copyright notice © 2014 which suggests that such content was not available to Canadians prior to the relevant date. Therefore, its content cannot support this ground of opposition.

[48] The extracts filed from the website located at *www.mastercard.ca* relate to 'WORLD ELITE MASTERCARD'. There is no reference to a 'black coloured card' in the extracts filed and we have no information on the date when such content was posted on the web.

[49] The extracts from *www.bmo.com* have to do with the credit card BMO World Elite MasterCard. There is no reference to a 'black coloured card' and we have no information as to when such content was made available to Canadians.

[50] The extracts from the website *www.cibc.com* make reference to 'CIBC Dividend Unlimited World Elite MasterCard'. There is no mention in the extracts filed of 'black coloured card' and no information as to when those extracts were published and made available to Canadians.

[51] The extracts from the TD Canada Trust's website relate to various Aeroplan credit cards including, the TD Aeroplan Visa Infinite Card and TD Gold Elite Visa Card. There is no reference in the extracts filed to a 'black coloured card'; no information on the date of publication of those extracts on the web; and when they were made available to Canadians.

[52] The extracts from *www.scotiabank.com* website touch on the 'Scotia Momentum Visa Infinite' credit card and the 'Scotia Platinum American Express' card. There is no reference on the extracts filed to a 'black coloured card' and no information on the date when such content was posted on the web and made available to Canadians.

[53] Finally, the extracts filed from the Laurentian Bank's website contain references to 'VISA Black Card'. However, we have no information as to when those extracts were made

available to the Canadian consumers. In all likelihood, it would have been posted after the relevant date as there is a copyright notice ‘© Laurentian Bank of Canada, 2014’.

[54] Consequently, there is no reference in the material filed to ‘black coloured card’, except for the Laurentian Bank’s website but in that case the material appeared to have been published after the relevant date. There is also the RBC Bank’s website that makes mention of ‘RBC Bank Visa Signature Black Credit card’ but it appears from the extracts filed that the aforesaid card is only available in the United States and the extracts were published after the relevant date.

[55] If the Opponent wanted to establish, through the filing of these extracts, that black coloured credit cards and/or charge credit cards have been issued in the past by referring to some of the credit cards illustrated on the pages filed, they are reproduced in black and white and as such, it is impossible to determine the true colour of the cards illustrated on those pages. In any event, none of the extracts taken from the Canadian banks’ and financial institutions’ websites described above (except for the RBC website) bear a date prior to the relevant date.

[56] Consequently, I have no material evidence that, at the relevant date, namely December 27, 2013, black coloured credit cards have been issued by third parties such that they negate the distinctiveness of the Mark at that date. Even if black coloured cards had been issued in the past, I have no information on the extent of the use of black coloured cards in Canada as of December 27, 2013 to determine if it was sufficient to negate the distinctiveness of the Mark at the material date.

[57] I dismiss the ground of opposition described in sub-paragraph 2(c)(iv) of the Opponent’s statement of opposition for failure by the Opponent to meet its initial burden.

Lack of distinctiveness based on the fact that BLACK CARD connotes a ‘high end’ charge or credit card (sub-paragraph 2(c)(v) of the statement of opposition)

[58] The Opponent had the initial burden to prove that, at the relevant date, the Mark connoted a ‘high end’ charge or credit card.

[59] The Opponent filed dictionary definitions for the words ‘black’ and ‘card’ through the affidavit of Ms. Stecyk. There is no dispute that the word ‘black’ identifies a colour, while ‘card’

is defined as ‘a piece of stiff paper or thin cardboard, usually rectangular, with varied uses, such as for filing information in an index, bearing a written notice for display, entering scores in a game, etc...’ (see Exhibit A to Ms. Stecyk's affidavit, extracts taken from the website *dictionary.reference.com*). Similar definitions were filed as Exhibits B and C to Ms. Stecyk’s affidavit taken from *dictionary.cambridge.org* and *thefreedictionary.com*.

[60] I reviewed all the extracts filed and noticed numerous examples of use of those words as part of expressions found in the English vocabulary such as, for example: black belt, black box, black coffee, black economy, black hole, black magic, black market etc... As for card, reference is made to greeting card, postcard, calling card and even credit card; but there is no reference to ‘black card’ and its meaning.

[61] Exercising the Registrar’s discretion to consult dictionaries [see *Tradall SA v Devil’s Martini Inc* 2011 TMOB 65, 92 CPR (4th) 408], I searched for the term ‘black card’ in *Miriam-webster.com*, *Oxforddictionaries.com* and *Dictionary.com* and can confirm that such term does not appear in any of them.

[62] In its written submissions, at paragraphs 25 to 27 the Opponent argues:

25. The Opponent has submitted evidence of the established reputation stemming from the association that exists in the minds of the consuming public between American Express and the term ‘BLACK CARD’ in Canada and abroad from a date well prior to the date of filing of the Statement of Opposition. The Opponent has also submitted evidence of the issuance, promotion and/or distribution in Canada of the black-coloured American Express Centurion Card that is known informally as the ‘Black Card’ and is referred to as such in the media and by numerous third parties.

26. Furthermore, the Opponent’s evidence establishes the existence of Third Party Black Cards that are issued, promoted and/or distributed by numerous third parties other than the Applicant (including entities that operate in the financial services industry such as RBC Royal Bank, Visa, MasterCard, TD Canada Trust, Scotiabank, and Laurentian Bank of Canada, among others). As noted in paragraph 8 (h) above, Third Party Black Cards are promoted and/or described by others as being, among other things, ‘exclusive’, ‘ultra exclusive’, ‘prestigious’, ‘elite’, and associated with ‘premier benefits’ (i.e. top tier or high end benefits).

27. As a result, it is submitted that the term ‘BLACK CARD’ connotes a ‘high end’ charge/credit card or other debit card, customer loyalty card or award incentive card issued to permit customers to avail themselves of various services (including those that overlap with the Applicant’s Services) and that this meaning of the term ‘‘BLACK CARD’’ has become known sufficiently to negate the distinctiveness of the [Mark]. The

fact that others use, and have for many years used, the term ‘BLACK CARD’ (and variations thereof) in the same general class of goods and/or services supports the conclusion that the Applicant ought not to be given the exclusive right to monopolize this mark by securing registration of the [Mark].

[63] I have discussed at length the Opponent’s evidence previously. I reviewed the extracts of third party’s websites and in one case where there is reference to ‘Black Card’ (website of the Laurentian Bank of Canada) the material filed is dated after the relevant date, while the RBC website that makes reference to RBC Bank Visa Signature Black Credit Card, such card appears to be available only in the United States of America. Contrary to the Opponent’s assertions, the extracts of websites of Canadian financial institutions do not refer to their ‘exclusive’, ‘ultra exclusive’, ‘prestigious’, ‘elite’, and associated with ‘premier benefits’ cards as a ‘Black Card’. Finally, I have no admissible evidence of use of the trade-mark BLACK CARD in Canada by the Opponent, for the reasons discussed previously. Reference to third parties’ websites to prove the Opponent’s use of its trade-mark BLACK CARD is not the proper way to do so.

[64] I am fully aware that in *Masterpiece Inc v Alavida Lifestyles Inc* [2011] 2 S.C.R. 387, 92 C.P.R. (4th) 361, the Supreme Court of Canada has enunciated some reserve on the usefulness of expert evidence in confusion cases, but the present case appears to me an appropriate situation. An affidavit from an expert in the field of financial institutions and credit and/or charge cards, together with an affidavit from a duly authorized representative of the Opponent establishing that the Opponent and other Canadian financial institutions have been referring to their ‘exclusive’, ‘ultra exclusive’, ‘prestigious’, ‘elite’, and associated with ‘premier benefits’ cards as a ‘Black Card’, together with documentation to support such claims could have led to a different result.

[65] For all these reasons, I dismiss this prong of the lack of distinctiveness ground of opposition.

Ground of opposition based on Section 12(1)(b) of the Act

[66] The relevant date to examine this ground of opposition is the filing date of the application. However, in this case the Applicant has claimed a priority date of February 2, 2009 and therefore I will assess this ground of opposition at that date [see *Shell Canada Limited v P T Sari Incofood Corp* 2005 FC 1040, 41 CPR (4th) 250 and section 34 of the Act]. In any event,

the difference between the priority date and the filing date of the application will have no effect on the end result.

[67] The Opponent pleads in its statement of opposition that the Mark is not registrable pursuant to the provisions of section 12(1)(b) of the Act because it is either clearly descriptive or deceptively misdescriptive of the character or quality of the Services.

[68] My colleague Pik-Ki Fung in *Special Fruit NV v Berry Fresh, LLC*, 2016 TMOB 52 (CanLII) outlined the analysis of such ground of opposition in the following words:

[49] The analysis under section 12(1)(b) of the Act has been summarized as follows in *Engineers Canada/ Ingénieurs Canada v Burtoni*, 2014 TMOB 174 (CanLII) at para 14 to 16:

When conducting an analysis under section 12(1)(b) of the Act, a trade-mark must be considered as a matter of first impression, in its entirety and not dissected into its constituent parts [Wool Bureau of Canada Ltd v Registrar of Trade Marks (1978), 40 CPR (2d) 25 (FCTD) at 27-8; Atlantic Promotions Inc v Registrar of Trade Marks (1984), 2 CPR (3d) 183 (FCTD) at 186].

The word “character” in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product and the word “clearly” has been held to mean “easy to understand, self-evident or plain” [Drackett Co of Canada Ltd v American Home Products Corp (1968), 55 CPR 29 (Ex Ct) at 34]. The test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act has been summarized by the Federal Court of Appeal in *Ontario Teachers’ Pension Plan Board v Canada* (2012), 2012 FCA 60 (CanLII), 99 CPR (4th) 213 (FCA) at para 29:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. [...] One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

[50] Whether a trade-mark is clearly descriptive of the character or quality of the goods or services is to be assessed from the point of view of the average retailer, consumer or everyday user of the type of goods or services it is associated with [see *Wool Bureau of Canada, supra, Oshawa Group Ltd v Canada (Registrar of Trade Marks)* (1980), 46 CPR (2d) 145 (FCTD), *A Lassonde Inc, supra*, and *Stephan Cliche v Canada* 2012 FC 564 (CanLII)].

[51] As noted in *Ottawa Athletic Club Inc (Ottawa Athletic Club) v Athletic Club Group Inc*, 2014 FC 672 (CanLII), a section 12(1)(b) analysis “is not an abstract exercise of determining whether the services offered in connection with a trade-mark match the dictionary definitions of the component terms encompassed within the mark, but a contextual inquiry based on the immediate impression of the potential users of the service” [para 188], although dictionaries or other reference works might be used as guides to help determine possible meanings of a trade-mark [see *ITV Technologies Inc v WIC Television* 2013 FC 1056 (CanLII) citing *Brûlerie Des Monts Inc v 3002462 Canada Inc* (1997), 1997 CanLII 6008 (CF), 132 FTR 150 and *Bagagerie SA v Bagagerie Willy Ltée* (1992), 97 DLR (4th) 684]. Moreover, one must apply common sense in making the determination [see *Neptune SA v Canada (Attorney General)* 2003 FCT 715, para 11]. (my underlines)

[69] Ms. Stecyk filed extracts of various online dictionaries for the definition of the words ‘black’, and ‘card’. There is no contested issue over the plain meaning of these words. I refer to my earlier comments contained in paragraphs 59 to 61 above.

[70] I fail to see how the combination of the words ‘black’ and ‘card’ would be clearly descriptive or deceptively misdescriptive of the character or quality of the Services. The fact that the card issued or to be issued by the Applicant is black in colour does not describe the character or quality of the Services. The potential users of the Services in association with the Mark would not have an immediate impression of the character or quality of the Services from a plain meaning of the words forming the Mark.

[71] The Opponent argues that the combination of the words ‘BLACK’ and ‘CARD’ is widely used to identify ‘high end’ charge/credit cards and other black-coloured credit cards, charge cards, debit cards, customer loyalty cards and cards which award incentives to consumers. Furthermore, the Opponent adds that such cards are promoted and/or described by others as being, among other things, ‘exclusive’, ‘ultra exclusive’, ‘prestigious’, ‘elite’, and associated with ‘premier benefits’.

[72] Even if I were to consider such argument, which was not pleaded under this ground of opposition in the statement of opposition, I already disposed of it in the context of the ground of opposition based on lack of distinctiveness of the Mark and my conclusion on this argument would be equally applicable under the present ground of opposition. Moreover, the earlier material date eliminates most of the evidence discussed above on this issue (secondary meaning of ‘black card’).

[73] Finally, even if I were wrong in concluding that the Opponent has not discharged its burden to prove that ‘black card’ is widely used to identify ‘high end’ charge/credit cards, the addition of a coined word ‘TELLAPAL’ makes the Mark, as a whole, not clearly descriptive or not deceptively misdescriptive.

[74] As a result, the ground of opposition based on section 12(1)(b) of the Act is dismissed.

Disposition

[75] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2016-05-12

APPEARANCES

Ms. Donna G. White

FOR THE OPPONENT

Mr. Philip Lapin

FOR THE APPLICANT

Agents of Record

Osler, Hoskin & Harcourt LLP

FOR THE OPPONENT

Smart & Biggar

FOR THE APPLICANT

ANNEX A

The services covered by the application are:

Providing a web site where users can post ratings, reviews and recommendations and referrals on all of the wares and services provided by Applicant; online advertising for others; promotional management services, namely, providing sales promotion of the wares and services of others through arranging and conducting incentive reward programs to promote the opening of credit/debit card accounts and providing promotional information for the wares and services of others, namely, information for users to employ in social media marketing to earn incentive rewards; providing online advertising for others; application service provider (ASP) featuring software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network (the Services).