



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

Citation: 2015 TMOB 202
Date of Decision: 2015-11-16

IN THE MATTER OF AN OPPOSITION

Sentis Pty Ltd.	Opponent
and	
Sentis Market Research, Inc.	Applicant
1,534,683 for SENTIS	Application

FILE RECORD

[1] On July 7, 2011, Sentis Market Research, Inc. filed an application to register the mark-
mark SENTIS, based on use of the mark in Canada “since at least as early as June 16, 2011” in
association with the following services:

providing market research, public opinion research and policy/issue research
services;

conducting and analyzing market, business and public opinion surveys, studies,
analyses, research and evaluations;

collecting and analyzing business and public opinion data and information through
telephone and internet surveys, focus groups and communications with business
and public audiences; providing market research reports, public opinion, polling
and survey reports, policy/issue research reports, business reports, financial reports
concerning products, services and policies/issues of others pursuant to marketing,
business and public research data and survey results;

providing strategic marketing, policy/issue and business consulting and analytical advice and services to others pursuant to marketing, business and public research data.

[2] The Examination Section of the Canadian Intellectual Property Office (“ CIPO,” under whose aegis this Board also operates) objected to the application on the basis that the applied-for mark was confusing with the registered marks SENTIS and SENTIS & Design, shown below, for use in association with various goods and services relating to psychological testing, employee relations, occupational health, safety and accident prevention.



[3] The applicant responded to the Examination Section by submitting, among other things, that the nature of the services covered by the marks was different and that the applied-for mark would not be used in the same channels of trade as the cited marks. Presumably, the Examiner accepted the applicant’s submissions (there is no indication on file) as the subject application proceeded to advertisement.

[4] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 14, 2012 and was opposed by Sentis Pty Ltd., the owner of the above-mentioned cited registrations, on April 15, 2013. The Registrar forwarded a copy of the statement of opposition to the applicant on April 23, 2013, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent subsequently requested and was granted leave to submit a revised statement of opposition: see the Board ruling dated March 26, 2015.

[5] The opponent filed as its evidence the affidavit of Patrizia Tomei and subsequently requested leave to file the affidavit of Hartmut Mauritz as additional evidence. The applicant

filed as its evidence the affidavit of Adam DiPaula (sworn March 14, 2014) and subsequently requested leave to file two further affidavits of Adam DiPaula (sworn September 10 and 25, 2014) as additional evidence. The parties' requests for leave were granted by the Board in rulings dated October 2 and November 19, 2014. Mr. DiPaula was cross-examined on his affidavit dated September 25, 2014. The transcript of his cross-examination and exhibits thereto form part of the evidence of record.

[6] Both parties filed written arguments, however, only the opponent was represented at an oral hearing.

STATEMENT OF OPPOSITION

[7] The amended statement of opposition was filed after the parties had submitted their written arguments. It differs only slightly from the original which alleged that the subject application does not contain "the date from which the Applicant has used the Trade-mark [the applied-for mark]." The amended pleadings allege that the subject application does not contain "the date from which the Applicant has used the Trade-mark . . . since the claimed date of first use is not accurate."

[8] The original pleadings were fairly and accurately summarized at para 7 of the applicant's written argument, reproduced below, and remains pertinent in respect of the amended pleadings:

SPL[the opponent Sentis Pty] raised the following grounds as the basis of its opposition:

A. **Non-Compliance of Section 30(a):** SPL alleged that the Application did not contain a statement in ordinary commercial terms of the specific services in association with which the Opposed Mark has been used.

B. **Non-Compliance of Section 30(b):** SPL alleged that the Application did not contain a date from which SMR[the applicant Sentis Market Research] has used the Opposed Mark in association with the Services.

C. **Non-entitlement under Section 30(i):** SPL alleged that SMR could not have stated that it was entitled to use the Opposed Mark in Canada under section 30(i) of the Trade-marks Act (the "Act") in view of SPL's prior use and registration of the trade-marks SENTIS (Reg. No. TMA765,302) and SENTIS & Design

(TMA765,294) (collectively, "**SPL's Marks**") and the trade name "Sentis Pty Ltd.." (collectively, with SPL's Marks, "**SPL's Marks and Name**").

D. Registrability under Section 12(d): SPL alleged that the Opposed Mark is not registrable, on the basis that it is confusingly similar with SPL's Marks within the meaning of s.6 of the Act.

E. Registrability [sic] under Section 16(1)(a) and (c): SPL alleged that SMR is not the person entitled to registration of the Opposed Mark pursuant to section 16(1)(a) and (c) of the *Act* because the Opposed mark is confusingly similar with SPL's Marks and Name, which were previously used by SPL in Canada.

F. Non-Distinctiveness under Section 2: SPL alleged that the Opposed Mark is not distinctive of the Applicant because of the prior use and registration of SPL's Marks and Name.

[9] The opponent in its written argument withdrew the first ground of opposition based on s.30(a).

[10] I will next summarize the parties' evidence before dealing with the remaining allegations in the amended statement of opposition.

OPPONENT'S EVIDENCE

Patrizia Tomei

[11] Ms. Tomei identifies herself as a legal assistant with the firm representing the opponent. Her affidavit serves to introduce in evidence, by way of exhibits, certified copies of the opponent's registrations; a certified copy of the file wrapper for the subject application; printouts from the opponent's website; and a search of the trade-marks register for applications and registrations containing the word SENTIS.

[12] The above evidence indicates that (i) the opponent's registrations are based on use of the marks in Canada since December 2004 and also based on use and registration of the marks in Australia, (ii) the opponent is an international company with offices in Canada (Calgary and Toronto), the United States, Australia, London, and Abu Dhabi.

[13] The information relating to how the trade-marks register search was conducted lacks the particulars of the search parameters usually identified in such evidence. The results of the search

are also lacking in particulars. In any event, from my review of the exhibit material, it appears that one third party mark was found.

Hartmut Mauritz

[14] Mr. Mauritz identifies himself as a manager in a company (BC Assessment) which “at least on one occasion engaged in business dealings” with the opponent. Mr. Mauritz states that he has acquired “at least a basic awareness of the types of services” provided by the opponent by virtue of his employment at BC Assessment. The opponent seeks to support its allegation of the likelihood of confusion by relying on paras 6 to 11 of Mr. Mauritz’ testimony, shown below:

6. In or about December 2013 my team informed me that they were dealing with "Sentis" in regards to market research services, including VOC and customer surveying matters.

7. I believed that my team was informing me that they were dealing with Sentis Pty Ltd.. [the opponent]

8. I later discovered that my team was in fact informing me that they were dealing with Sentis Market Research, Inc. [the applicant]

9. Subsequently, I spoke with a representative of Sentis Pty Ltd., to enquire whether Sentis Market Research, Inc. was a related party to Sentis Pty Ltd..

10. The representative informed me that the two companies were not related.

11. I thought that this was confusing, because the company names are very similar, especially when they are referred to in the abbreviated form "Sentis", and because it seemed that Sentis Market Research, Inc. and Sentis Pty Ltd.. provided similar services.

APPLICANT’S EVIDENCE

Adam DiPaula - First Affidavit

[15] Mr. DiPaula identifies himself as the managing partner of the applicant company. The applicant was founded in May 2011. It is a market research company which provides research design, data collection and analysis services to a wide range of clients in the commercial, institutional, government and university sectors. Research areas include customer and brand loyalty; market segmentation; brand positioning; advertising and communication effectiveness; and public opinion.

[16] The applicant conducts “quantitative research” using telephone surveys, online surveys, mail surveys and on-site intercept surveys. “Qualitative research” is conducted with focus groups (generally consisting of 6 to 8 persons and a moderator) and in-depth interviews. The data collected is subjected to advanced analytical and statistical techniques. The applicant’s clients include Telus, Thrifty Foods, FortisBC, and the Tourism Industry Association of BC. The vast majority of the applicant’s reports are confidential documents. The applicant’s primary competitors are market and opinion research companies.

[17] Mr. DiPaula explains how the applicant obtains and attracts clients in para 19 of his affidavit:

19. Sentis does not currently pay to advertise its services in any media channels. We obtain business through a) referrals from current/past clients, b) invitations to quote from clients or prospective clients, c) publicly posted requests for proposals and d) targeted marketing to specific prospects. Attached hereto and marked collectively as Exhibit 3 to this my Affidavit is a slide presentation that Sentis provides to clients and prospective clients summarizing Sentis' services. Attached hereto and marked collectively as Exhibit 4 to this my Affidavit is a slide presentation Sentis provides to clients and prospective clients in the financial services sector describing Sentis' online reporting services.

[18] I have noted that the applied-for mark SENTIS is prominently featured on each page of the slide presentations referred to above.

Second Affidavit

[19] Mr. DiPaula’s second affidavit was submitted in response to Mr. Mauritz’ testimony. The salient portions of Mr. Dipaula’s evidence are shown below:

3. I have personally interviewed all staff of Sentis [the applicant] that are responsible for client relations, which comprised a total of four people, and can confirm that none of these staff member[sic] had contact with anyone at BC Assessment regarding market research, VOC (Voice of the Customer) or customer surveying services in December 2013.

4. In April 2014, I was invited by BC Assessment to make a presentation at BC Assessment with respect to Sentis's[sic] services. Recently in August 2014, Sentis submitted a proposal in response to a publicly posted Request for Proposals (RFP) by BC Assessment on the BC Bid website.

5. Sentis does not have, and never has had a working relationship with BC Assessment; and Sentis has[sic] no contact with BC Assessment prior to April, 2014.

6. Sentis possesses expertise in market research, VOC and customer surveying. To the best of my knowledge, the Opponent does not provide market research, VOC or customer surveying services. Furthermore, as of today, I could not find these services listed or mentioned on the Opponent's website.

[20] I place greater reliance on Mr. Dipaula's testimony than on Mr. Mauritz' testimony because Mr. Dipaula's testimony is more comprehensive and more detailed.

Third Affidavit

[21] Mr. Dipaula's third affidavit is intended to support the applicant's claimed date of first use (June 16, 2011) of the applied-for mark SENTIS by introducing the following exhibit materials:

Exhibit 1 consists of a Certificate of Incorporation dated May 13, 2011 for Genesys Market Research and Consulting, Inc and a Certificate of Amendment dated June 16, 2011 changing the name of the corporation to Sentis Market Research Inc.

Exhibit 2 consists of redacted invoices dated June 24, 2011 and August 29, 2011. The earlier invoice features the applicant's trade-name Sentis Market Research, Inc. while the later invoice features both the trade-name and the applied-for mark SENTIS.

Exhibit 3 is a copy of an email, dated June 3, 2011, from the Canadian Internet Registration Authority advising the applicant of its registration of the domain name "sentisresearch.ca"

Exhibit 4 is a printout obtained through the Wayback Machine showing pages from the applicant's website as of August 2011. The exhibit shows the applicant using the term SENTIS as a trade-mark and as a trade-name.

[25] It became apparent on cross-examination that Mr. DiPaula was not personally involved in preparing Exhibit 4 and I have disregarded it as inadmissible hearsay. Exhibits 1 to 3 are not

conclusive of the date of first use (June 16, 2011) claimed in the subject application, however, they are consistent with the general time frame for the claimed date of first use. I note further that the opponent, for its part, has not submitted any evidence to cast doubt on the claimed date of first use, nor did the opponent question Mr. DiPaula concerning the date of first use at cross-examination.

FIRST THREE GROUNDS OF OPPOSITION

[26] The applicant's submissions with respect to the first three grounds of opposition are found at paras 16-19 of its written argument:

16. We request the three grounds of opposition raised under section 30(a), 30(b) and 30(i) of the *Act* be summarily dismissed for the reasons that follow.

17. Firstly, the section 30(a) ground of opposition, which alleges that the Application does not contain a statement in ordinary commercial terms of the Services, be dismissed for SPL's failure to meet its evidential burden. In addition to not filing any evidence in support thereto, the Tomei Affidavit did not contain any reference as to how the Application does not contain a statement in ordinary commercial terms.

18. Secondly, the section 30(b) ground of opposition, which alleges that the Application did not contain the date from which SMR has used the Opposed Mark in association with the Services, be dismissed for the Application clearly contains a claimed date of first use of June 16, 2011. This ground of opposition is clearly inconsistent with the information as contained in the Application. Note that SPL did *not* challenge the claimed date of first use as incorrect. Even if it has done so, however, we submit that SPL did not advance any evidence to cast doubt as to the accuracy of the claimed date of first use.

19. Thirdly, section 30(i) of the *Act* requires SMR to include a statement in the Application that SMR is satisfied that it is entitled to use the Opposed Mark in Canada. Since SMR has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the *Act* can be found only where there are exceptional circumstances that render SMR's statement untrue, such as evidence of bad faith (see *Sapodilla Co. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (Reg. T.M.), at 155). SPL has advanced no such evidence.

[27] As mentioned earlier, the opponent has withdrawn the first ground of opposition, which is no longer in issue. I agree with the applicant's submissions with respect to the third ground of opposition, which is therefore rejected.

[28] With respect to the second ground of opposition, as amended, I would first note that the claimed date of first use does not have to be precise. It may be inaccurate (provided that it is not too far off the mark) as noted by Mr. Justice Cattanach in *Marineland Inc. v. Marine Wonderland & Animal Park Ltd.* (1974), 16 CPR (2d) 97 at page 106:

... I can see no reason why the applicant may not, out of a super abundance of caution, select a later date of which he has no doubt as to the confirmed use as of that date particularly when it is to the disadvantage of the applicant to forego the advantage of an earlier date in the interest of greater certainty. (my emphasis)

[29] At the oral hearing, counsel for the opponent took the position that the claimed date of first use of the applied-for mark was in fact before the actual date of first use. If such an allegation is substantiated, then it is fatal to the application by operation of s.30(b). The opponent further noted that the evidential burden to put the date of first use into issue is relatively light as the facts are particularly within the knowledge of the applicant. I agree with the opponent regarding its light evidential burden. I am also aware that, even if an opponent is unable to adduce any evidence concerning the date of first use, the opponent is not limited to relying only on “clearly inconsistent” evidence adduced by the applicant: see *Corporativo de Marcas GJB, SA de CV v. Bacardi & Company Ltd.*, 2014 FC 323 at paras 30-38.

[30] The evidence that the opponent relies on to meet its evidential burden, and to substantiate its allegation, is discussed at paragraphs 29 and 30 of the opponent’s written argument, shown below:

29. In the Tomei Affidavit, there is a page showing the result of a search of the Internet conducted by the Trade-marks Examiner on January 6, 2012 using the search engine www.google.ca. The Opponent's business is the first result returned. The Applicant's business is not among the eight results shown on the first page of results. In the DiPaula Affidavit there is a suggestion that the Applicant has an online presence in that it conducts online surveys, and has a website.

30. In the DiPaula Affidavit, there is an assertion that the Applicant has provided its services using the word "Sentis" since June 16, 2011. No other evidence was produced by the Applicant proving use of the mark SENTIS as of that date. As such, it is respectfully submitted that the Board and Opponent have insufficient evidence to determine that use by the Applicant of the mark SENTIS, as defined in Section 4 of the Act, has been occurring since the date of first use stated in the Application.

[31] I agree with the opponent that the evidence of record that it is relying on, and the lack of comprehensive documentation from the applicant concerning the exact date of first use of the applied-for mark, suffices to put the date of first use of the applied-for mark into issue: see *Corporativo*, above.

[32] The legal onus therefore falls on the applicant to show, on the usual civil balance of probabilities standard, that the applicant has in fact used its mark with the services specified in the application since the claimed date of first use namely, June 16, 2011. On this issue, all of the pertinent evidence of record is to be assessed according to the usual criteria, that is, taking into consideration its provenance (including its quality and reliability), the absence of evidence that might reasonably be expected to exist, whether the evidence has been tested on cross-examination and if so, how it fared. Multiple diverse considerations inform the assessment of evidence: see *Corporativo*, above.

[33] At the oral hearing, counsel for the opponent argued cogently that there is no clear, unequivocal evidence establishing the claimed date of first use of the applied-for mark in any of the exhibit material attached to Mr. DiPaula's affidavit. I agree. On the other hand, it appears to me that Mr. DiPaula's testimony is credible and that the applicant's exhibit material supports the general time frame of the claimed date of first use. I have also noted that on cross-examination no questions were directed to Mr. DiPaula concerning the date of first use of the applied-for mark when the opponent had every opportunity to do so. Taking these considerations into account, and following the guidance in *Corporativo*, above, I conclude that it is more probable than not that the applied-for mark was in fact used as early as June 16, 2011. The second ground of opposition is therefore rejected.

REMAINING GROUNDS OF OPPOSITION AND MATERIAL DATES

[34] The main issue with respect to the remaining grounds is whether the applied-for mark SENTIS is confusing with the opponent's mark SENTIS. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Trade-marks Act*, shown below, between the applied-for mark and the opponent's mark:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services . . . associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services . . . are of the same general class.

[35] Thus, section 6(2) does not concern confusion between the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether customers of the applicant's services, sold under the mark SENTIS, would believe that those services were provided or authorized or licensed by the opponent who also provides services under the same mark. The test is one of first impression and imperfect recollection. The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

[36] The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability, pursuant to s.12(1)(d); (ii) the date of first use of the mark with respect to the ground of opposition alleging non-entitlement, pursuant to s.16(1); and (iii) the date of filing the statement of opposition, in this case April 15, 2013, in respect of the ground of opposition alleging non-distinctiveness, pursuant to s.2: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD). In the circumstances of the instant case, nothing turns on whether the issue of confusion is assessed at a particular material date.

[37] The considerations for assessing the likelihood of confusion are correctly set out at paras 34-35 of the opponent's written argument:

34. The test for assessing confusion among trade-marks and trade-names is set forth in s.6(2) of the Act. The Registrar must have regard to all the surrounding circumstances, including those listed in s. 6(5):

- (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- (b) the length of time the trade-marks or trade-names have been in use;

- (c) the nature of the wares, services, or business;
- (d) the nature of the trade; and
- (e) the degree of resemblance between the trade-marks or trade-names in appearance, sound, or in the ideas suggested by them.

35. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight.

CONSIDERATION OF S.6(5) FACTORS

First Factor - Inherent and Acquired Distinctiveness

[38] The opponent's mark SENTIS possesses a high degree of inherent distinctiveness as it is a coined term without any suggestive connotations relating to the applicant's services. The same is true for the applicant's mark. The applicant discusses the acquired distinctiveness of the opponent's mark SENTIS at para 27 of the applicant's written argument:

SPL did not file any evidence to show how the[*sic*] SPL's Marks and Name are known in Canada. In fact, SPL did not file any evidence to show that the[*sic*] SPL's Marks and Name are in use in Canada or are being promoted in Canada. Exhibit D of the Tomei Affidavit contains printouts of certain pages of SPL's website. The top right hand corner of the website contains the national flags of Australia/New Zealand, the European Union and the United States, but it does not contain the Canadian flag. Accordingly, the webpage, without more, does not support a finding that the SPL Marks and Name are in use in Canada. There is no information regarding advertising or promotion of SPL's Marks and Name. While the 'Contact Us' page identifies a phone number in Calgary and a phone number in Toronto, SPL provided no information as to the nature of activities it conducts in Calgary, Toronto or Canada in general. Are these phone numbers merely call centres that direct callers to the principal place of business of SPL, which is in Australia? If SPL does in fact conduct active business through the offices of which the two phone numbers belong (which SPL's evidence did not support), there is still no information to support, or to allow the Board to draw any inference that such use renders the[*sic*] SPL's Marks and Name to become known in Canada to any extent.

[39] I agree with the above submissions and therefore find that the opponent's mark has not acquired any meaningful reputation in Canada. The applicant's evidence shows that its mark had acquired at least some reputation in Canada at all material dates. The first factor therefore favours the applicant, but only slightly.

Second Factor - Length of Time the Trade-marks have been in Use

[40] The applicant discusses the second factor at para 29 of its written argument:

SMR commenced use of the Opposed Mark since June 16, 2011. While the registrations of SPL's Marks were issued based in part on use in Canada since December 2004, SPL has filed no evidence that SPL's Marks were in fact in use in December 2004 or that the use has been continuous thereafter. We respectfully request such doubt be resolved in favour of SMR.

[41] I agree with the above submissions. The opponent's registrations establish, at best, a minimal period of use of its marks in December 2004. The second factor therefore favours the applicant at the later material times, but again only slightly as the applicant only began to use its mark in June 2011.

Third and Fourth Factors - Nature of the Services, Business and Trades

[42] The applicant discusses the third and fourth factors at paras 33-40 of its written argument:

33. . . . for a finding of confusion under sections 6(5)(c), the degree of similarity and relatedness between the wares and services of the two marks is an important factor in determining the likelihood of confusion. Again, the question is whether those[sic] meet with the two kinds of goods will suppose, because of the marks, that they are the goods of the same entity.

34. When considering sections 6(5)(c) and 6(5)(d) of the *Act*, it is the statement of wares and services as defined in the application for the Opposed Marks and the registration of the SPL's Marks that govern the assessment of the likelihood of confusion under the *Act* (*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.), (3d) 381 (F.C.A.)).

35. The registrations of SPL's Marks cover education and training services in relation to (i) psychological testing, employee relations and occupational health and safety, and (ii) performing tests in relation to health, safety and accident prevention, as services, as well as multi-media and printed materials in those fields. SMR provides no such services, or any services that are remotely related to SPL's wares and services. SMR is a market research company that designs and conducts opinion polls, and nothing more.

36. There is no relatedness or similarity between SPL's education and training services (and related wares) as covered by the SPL's Marks and the market research services associated with the Opposed Mark. One service does not suggest the other.

37. There is no evidence to suggest that the parties' services would be carried out by the same business. SPL, according to the webpage filed as Exhibit D to the Tomei Affidavit, engages "in the application of psychology to safety, leadership development and wellbeing in the workplace." SMR is a market research company. The field of focus of the two businesses is plainly very different and do not share similarities.

38. There is also no evidence to suggest that the two parties share the same channel of trade or that the probable purchasers of the two parties' business are the same group of people. In considering whom the resemblance is calculated to deceive, it is necessary to question the natural or probable purchasers of the wares and services in question (*Pepper King Ltd. v. Sunfresh Ltd.* (2000), 8 C.P.R. (4) 485 at 499 (F.C.T.D.)). In *Ciba-Gieby Canada Ltd. v. Apotex Inc.* (1992), 44 C.P.R. (3d) 289 (S.C.C.), the Supreme Court of Canada confirmed that the ultimate purchaser must in each case be considered . . .

39. Confusion is much less likely in the case of customers who have more intimate knowledge of the products or industry people where they might generally exercise care in placing their orders to secure the goods they actually desire (*Dastous v. Matthews-Wells Co.* (1947), 8 C.P.R. 2 at 14 (Can. Ex. Ct.), reversed but not on this point (1949), 12 C.P.R. 1 (S.C.C.); and *Lambert Pharmacal Co. v. J Palmer and Son, Ltd.*, [1912] 2 D.L.R. 358 at 365 (Que. K.B.)).

40. The services offered under the Opposed Mark are not everyday purchase[sic], and neither are the wares and services offered under SPL's Marks. Purchase decisions of the wares and services associated with the parties' marks are likely made at the management level of an entity, and will likely only be made after careful research and due diligence, which reduces the likelihood of confusion.

[43] I agree that the applicant's above submissions are applicable to the facts in this case. The third and fourth factors therefore favour the applicant.

Fifth Factor - Degree of Resemblance

[44] The last factor requires little discussion. The parties' marks are the same. The last factor therefore strongly favours the opponent.

JURISPRUDENCE

[45] The judicial approach in assessing confusion between marks that are the same or very similar has been to acknowledge that (i) trade-marks are always used and recognized in association with certain goods or services, (ii) the registration of a mark does not grant the registrant ownership of the registered term – rather, the protection granted by registration is

limited to certain goods or services, and (iii) confusion is less likely when the goods or services are markedly different, even when the registered mark is well-known: see, for example, *Mattel U.S.A. Inc v 3894207 Canada Inc* 2006 SCC 22 , 49 CPR (4th) 321; *Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 , 49 CPR (4th) 401; *United Artists Corp v Pink Panther Beauty Corp*, [1998] 3 FCR 534 (FCA), 80 CPR (3d) 247 where the parties' marks were the same or very similar, there was no connection between the goods and/or services of the parties, and the Court found no likelihood of confusion.

DISPOSITION

[46] Having regard to the above, and considering in particular the different services offered by the parties, and that the opponent has not, at any material time, established a reputation for its mark that would entitle the opponent's mark to a widened ambit of protection (i.e., outside the specific services covered in its registrations), I find that the balance of probabilities with respect to the issue of confusion favours the applicant. Accordingly, as each of the grounds of opposition has been rejected, the opposition is rejected.

[47] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-07-09

Appearances

Ian Bies For the Opponent

No one appearing For the Applicant

Agents of Record

McCarthy Tétrault LLP For the Opponent

Borden Ladner Gervais LLP For the Applicant