

**IN THE MATTER OF AN OPPOSITION  
by Canadian Tire Corporation, Limited to  
application No. 1,018,706 for the trade-  
mark CTC BANK OF CANADA filed by  
CTC Bank of Canada**

On June 11, 1999, the applicant, CTC Bank of Canada, filed an application to register the trade-mark CTC BANK OF CANADA based upon a) proposed use of the trade-mark in Canada in association with insurance services and b) use of the trade-mark in Canada in association with banking services since at least as early as March 18, 1999. The applicant has disclaimed the right to the exclusive use of the words BANK OF CANADA apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of September 19, 2001. On November 19, 2001, the opponent, Canada Tire Corporation, Limited, filed a statement of opposition against the application. The applicant filed and served a counter statement.

As rule 41 evidence, the opponent filed the affidavits of Sonja Shpeley and Imelda Wong. The applicant filed the affidavit of Frank F. H. Lin as rule 42 evidence. The opponent obtained an order for the cross-examination of Mr. Lin but did not proceed with a cross-examination.

On July 28, 2003, the opponent requested leave to amend its statement of opposition. Leave was granted on December 30, 2003.

Written arguments were filed by both parties. An oral hearing was held at which both parties were represented.

Grounds of Opposition

The grounds of opposition are summarized below:

1. the application does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) in that it does not relate to a trade-mark but is an application for registration of a trade-name;
2. the application does not comply with the requirements of s. 30(b) of the Act in that the alleged trade-mark has not been used in Canada in association with banking services since March 18, 1999, as claimed;
3. the application does not comply with the requirements of s. 30(e) of the Act in that the applicant does not intend to use the alleged trade-mark in Canada in association with insurance services;
4. the applicant is not the person entitled to register the mark pursuant to s. 16(1)(a) or (c) of the Act in that, at the alleged date of first use of the alleged trade-mark, in association with banking services, it was confusing with the trade-mark/trade-name CTC which had been previously used in Canada by the opponent in association with the operation of a business dealing in the selling of vehicular parts, tools and accessories of others; the selling of maintenance and service supplies of others; the selling of hardware of others; the selling of housewares of others; the selling of household goods of others; the selling of sporting goods of others; and the servicing and maintenance of vehicles by the opponent;
5. the applicant is not the person entitled to register the mark pursuant to s. 16(3)(a) or (c) of the Act in that, at the filing date of the alleged trade-mark for use in association with insurance services, it was confusing with the trade-mark/trade-name CTC which had been previously used in Canada by the opponent in association with the operation of a business dealing in the selling of vehicular parts, tools and accessories of others; the selling of maintenance and service supplies of others; the selling of hardware of others; the selling of housewares of others; the selling of household goods of others; the selling of sporting goods of others; and the servicing and maintenance of vehicles;

6. the applied-for mark is not, and cannot be distinctive of the services of the applicant within the meaning of s. 2 in that as of the date of the statement of opposition, it does not actually distinguish the services or is not adapted so as to distinguish them from the services of others, in that

- a) the subject matter of the application is a trade-name,
- b) there is a likelihood of confusion arising between the alleged trade-mark of the applicant and the opponent's trade-mark/trade-name and in particular of the public being led to the mistaken belief that the services of the applicant offered in association with the alleged trade-mark are authorized by or otherwise associated with the opponent, and
- c) the services alleged to have been offered by the applicant have been offered to the public in association with the Chinese language trade-mark (shown below) that is translated as China Trust Commercial Bank (Canada), which creates the impression the services are offered by this entity as well as the applicant.

**中國信託商業銀行(加拿大)**

#### Opponent's Evidence

##### *Wong Affidavit*

Ms. Wong, an operative with the firm of Monarch Investigation Services Ltd., attended at the premises of the applicant at 1518 West Broadway in Vancouver on March 11, 2002. She provides as exhibits various printed materials that she obtained during that visit and photographs that she took of the outside of those premises.

##### *Shpeley Affidavit*

Ms. Shpeley, a trade-mark agent, simply provides evidence that in 2001/2002 the applicant was listed as a foreign bank subsidiary and a Schedule II bank.

#### Applicant's Evidence

##### *Lin Affidavit*

Mr. Lin was, at the date of his affidavit, the applicant's President and Chief Executive Officer. He advises that the applicant, a bank whose head office is in Taiwan, operates a branch at 1518 West

Broadway in Vancouver. He states that the applicant has provided banking services in Canada since at least as early as March 18, 1999 in association with the trade-mark CTC BANK OF CANADA and that its business plan also includes the introduction of insurance services into the Canadian market in association with such trade-mark. He further states that the applicant is properly licensed to do business in Canada as a bank and explains the types of banking services that the applicant provides.

Mr. Lin provides the number of the applicant's Canadian customers and volume of its Canadian banking business for each of the years 1999 through 2002.

He provides certified copies of registrations that the applicant owns for two other trade-marks in Canada:

1. TMA 519,232 for CHINATRUST
2. TMA 559,480 for the Chinese Characters Design mark shown below, which translates as CHINATRUST COMMERCIAL BANK (CANADA)

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He also provides a collection of printed and promotional/advertising material "which display the trade-mark CTC BANK OF CANADA and which are used by the applicant in association with the operation of its banking business in Canada."

#### Material Dates

The material dates with respect to the grounds of opposition are as follows: s. 30 - the date of filing of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475]; s. 16(1) - the applicant's date of first use; s. 16(3) - the date of filing of the application; non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4<sup>th</sup>) 317 (F.C.T.D.) at 324].

### Onus

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act, there is an initial burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

The evidential burden on the opponent respecting the issue of the applicant's non-compliance with s. 30(b) and (e) of the Act is a light one [see *Tune Masters v. Mr. P's Mastertune* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89 and *Canadian National Railways Co. v. Schwauss* (1991), 35 C.P.R. (3d) 90 (T.M.O.B.)]. This burden can be met by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) at 230]. In such a case however, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in its application.

### Grounds 4, 5 and 6(b)

In its written argument, the opponent advised that it was no longer asserting grounds 4, 5 and 6(b). Accordingly, those grounds are treated as withdrawn.

### Issues

There are three main issues raised by the opponent:

1. whether the applicant has used CTC BANK OF CANADA as a trade-mark, as opposed to as a trade-name;
2. whether the applicant can properly state that it intends to use its mark for insurance services, given that by law it is restricted to certain insurance services;

3. whether the simultaneous use of a Chinese language trade-mark meaning China Trust Commercial Bank (Canada) impacts the distinctiveness of the applied for mark.

*Issue No. 1*

Exhibit B to Mr. Lin's affidavit shows use of CTC BANK OF CANADA in the following ways:

- At the top left-hand corner of various printed documents such as debit memos, deposit slips, and foreign currency forms, there appears a CC logo to the right of which appears CTC BANK OF CANADA above the Chinese Characters Design mark shown earlier (collectively "Use 1").
- On a Chinese language promotional brochure, Use 1 appears at the bottom of the cover page.
- On a brochure entitled Deposit Register, Use 1 appears at the top of the cover page with the words Member of Canada Deposit Insurance Company appearing immediately below. In addition, CTC BANK OF CANADA appears on what might be the last page, above the Chinese Characters Design mark, which in turn is above the applicant's address.
- On a Chinese language advertisement, Use 1 appears at the top, with the applicant's address appearing at the bottom.
- On pages discussing Personal Account Services and Fees, the CC Logo appears at the top of each page with CTC BANK OF CANADA to its right.
- On a sheet entitled Cheque Holding Policy and dated January 1, 2002, Use 1 appears in the upper right hand corner.

The Act provides the following definitions for "trade-mark" and "trade-name":

"trade-mark" means

- (a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,
- (b) a certification mark,
- (c) a distinguishing guise, or

(d) a proposed trade-mark

"trade-name" means the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual

The Act does not define when a trade-name is used but it does define when a trade-mark is used in association with services, as follows, in s. 4(2): A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

In the present case, the applicant's name is the same as its trade-mark. The case law is somewhat sketchy regarding when a business name is being used as a trade-mark as opposed to as a trade-name. However, in *Road Runner Trailer Mfg. Ltd. v. Road Runner Trailer Co. Ltd. et al.* (1984), 1 C.P.R. (3d) 443 (F.C.T.D), a s. 45 proceeding with respect to the registered trade-mark ROAD RUNNER TRAILER, the Court held that the presumption that a company name is a trade-name rather than a trade-mark is rebuttable.

In *Registrar of Trade Marks v. Datel Communications Ltd.* (1991), 35 C.P.R. (3d) 443, the issue was whether the registrant Datel Communications Ltd. was using its registered trade-mark DATEL COMMUNICATIONS LTD. in association with services as required by s. 45. At page 445, the Registrar stated,

In my opinion, the perception of the average person who would utilize the registrant's services is that the manner of use of the mark DATEL COMMUNICATIONS LTD. by the registrant is as a trade name or corporate name which identifies the registrant in the exhibits annexed to the Lindsay statutory declaration rather than as a trade mark which distinguishes the registrant's services from those of others. In particular, the close association between the mark DATEL COMMUNICATIONS LTD. and either the registrant's business addresses or its registered trade mark DATEL Design, representations of both of which are shown below, strongly supports the conclusion that the mark DATEL COMMUNICATIONS LTD. would be perceived by the average person as being used as either a trade name or corporate name as opposed to a trade mark.

In *Montana Silversmiths v. Montana* (1999), 1 C.P.R. (4th) 570, another s. 45 proceeding, Claude Montana owned the trade-mark CLAUDE MONTANA registered for use in association with various items of clothing and services related to the design of clothing. At page 573, the Registrar stated,

In my opinion, where, as in this case, the mark in question is also the name of the owner, it is a question of fact whether the manner the owner uses its name is something more than mere use of its name, but also qualifies as use of a trade-mark.

Here, the words as they appear on the label and hand tag would appear to be trade-name use only. The perception of the average consumer upon seeing those words thereon would be that it consists of the name of the owner or designer for the clothing rather than a trade-mark, partly because the name is followed by the word "Paris" which would identify the place of origin of the wares and of the owner, partly because of their location on the label and hang tag, and the fact that there is absolutely nothing that would permit the average consumer to perceive them as other than the name of the owner. Although the use of the designation TM or ® to identify trade-mark matter is not mandatory under the present Trade-marks Act, R.S.C. 1985, c. T-13, I am of the view that if the registrant had used such designation after the words "Claude Montana" in the present case, such designation would have helped in identifying those words and in perceiving them as a trade-mark.

The present case is distinguishable from those cited for several reasons. Unlike the Roadrunner case, the alleged trade-mark at hand is not just part of the applicant's name, it consists of the applicant's entire name. The quote from the Montana case is directed to use with wares, but here we are dealing with services. In my view, the distinction between a trade-name and a service mark can be quite tenuous. Most importantly, in the present case there is not a legal onus on the applicant to establish that it has used the applied for trade-mark. Rather, the issue is whether the applicant's evidence is clearly inconsistent with its use claim. I conclude that it is not. If all of the evidence showed CTC BANK OF CANADA followed by an address, then I might have found that the evidence was clearly inconsistent with trade-mark use, but given that the applicant often uses CTC BANK OF CANADA far removed from any address and instead in between two other trade-marks, I find that the evidence is not clearly inconsistent with the applicant's claim that it has used CTC BANK OF CANADA as a trade-mark. It is noted that the opponent was entitled to cross-examine Mr. Lin on his affidavit but chose not to. Mr. Lin's evidence must therefore be treated with greater deference than evidence in a s. 45 proceeding where cross-examination is not available to the other



side.

For the foregoing reasons, I find that the opponent has not met its evidential burden with respect to grounds 1 and 2. Accordingly, those grounds of opposition are dismissed. For similar reasons, ground 6(a) is also dismissed.

*Issue No. 2*

I have no reason to doubt that the applicant intends to use its trade-mark in association with insurance services. However, the opponent's points out that the *Bank Act* restricts the type of insurance services that the applicant may perform and argues that the applicant cannot therefore intend to use the mark with every type of insurance service. I do not think that this is an appropriate argument under s. 30(e). Perhaps it could be an argument under s. 30(a), but the opponent has not pleaded it as such and in any event, "insurance services" have been treated by the Examination Division as a specific ordinary commercial term.

The opponent also submits that it would be in violation of federal law if the applicant proceeded to use its mark with all insurance services and points to the opposition decision in *Interprovincial Lottery Corp. v. Western Gaming Systems Inc.* (2002), 25 C.P.R. (4<sup>th</sup>) 572. That decision however dealt with s. 30(i), not s. 30(e).

In the present case, I consider it only fair to assume that the applicant's intentions are honourable and that it intends to use its mark only with those types of insurance services that it is entitled by law to perform.

For the foregoing reasons, I dismiss the third ground of opposition.

*Issue No. 3*

The opponent submits that the distinctiveness of the applicant's mark has been compromised by the contemporaneous use of the Chinese Characters Design mark. The evidence does show that the applicant quite often positions its CTC BANK OF CANADA mark above its Chinese Characters Design mark but I do not see how the use of this latter mark jeopardizes the distinctiveness of the former mark. Although Chinese-speaking consumers might understand the characters to mean CHINA TRUST COMMERCIAL BANK (CANADA), this does not harm the distinctiveness of the applied for mark. After all, the applicant is the owner of both trade-marks and the impression at worst would be that CTC in CTC BANK OF CANADA stands for China Trust Commercial. Furthermore, there is nothing preventing a party from using two trade-marks at the same time [see *A. W. Allen Ltd. v. Warner-Lambert Canada Inc.* (1985), 6 C.P.R. (3d) 270 (F.C.T.D.)].

I therefore dismiss ground 6(c).

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 29th DAY OF DECEMBER 2005.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board