



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

Citation: 2015 TMOB 214
Date of Decision: 2015-11-30

IN THE MATTER OF AN OPPOSITION

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|----------------------------------|--------------------|
| Navsun Holdings Ltd. | Opponent |
| and | |
| Sadhu Singh Hamdard Trust | Applicant |
| 1,487,122 for AJIT | Application |

FILE RECORD

[1] On June 10, 2010, Sadhu Singh Hamdard Trust (located in Punjab, India) filed an application to register the trade-mark AJIT based on use of the mark since at least as early as 1968 in association with “printed and electronic publications, newspapers and magazines” and with the operation of a website. The application was subsequently amended to cover only

printed publications and newspapers.

[2] The Examination Section of the Canadian Intellectual Property Office (“ CIPO,” under whose aegis this Board also operates) objected to the application, in a letter dated August 9, 2010, on the basis that the applied-for mark AJIT was confusing with four pending applications, all in the name of one owner. The cited applications included the marks AJIT and AJIT WEEKLY for use in association with newspapers, among other goods. The applicant responded to the Examination Section in a letter dated May 18, 2012, advising that the cited applications

had been voluntarily withdrawn. The applicant also advised the Examination Section, as required under s.29(a) of the *Trade-marks Regulations*, that the Punjabi word AJIT means “unconquerable” or “invincible” in the English language.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated August 1, 2012 and was opposed by Navsun Holdings Ltd., the owner of the above-mentioned marks cited by the Examination Section, on December 28, 2012. The Registrar forwarded a copy of the statement of opposition to the applicant on January 29, 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.

[4] The opponent’s evidence consists of the affidavit of Kanwar Bains. The applicant’s evidence consists of the affidavit of Narinder Pal Singh. Mr. Bains was cross-examined on his affidavit testimony. The transcript of his cross-examination and the exhibits thereto form part of the evidence of record. Both parties filed a written argument and both were represented at an oral hearing.

STATEMENT OF OPPOSITION

[5] The first ground of opposition, pursuant to s.30(a) of the *Trade-marks Act*, alleges that the applicant did not begin to use its mark AJIT in Canada since as early as 1968 as stated in the subject application.

[6] The second ground of opposition, pursuant to s.30(i) of the *Act*, alleges that the applicant could not have stated that it was entitled to use the applied-for mark AJIT in Canada view of the opponent’s use of the same mark in Canada.

[7] The third ground of opposition, pursuant to s.16(1)(a), alleges that the applicant is not entitled to register the applied-for mark in view of the prior use of the same mark by the opponent and its predecessors in title.

[8] The last ground of opposition, pursuant to s.2, alleges that the applied-for mark AJIT is not distinctive of the applicant's printed publications and newspapers in view of the opponent's use of the same mark in association with newspapers.

[9] Before assessing the issues raised in the statement of opposition, I will first discuss the parties' evidence, the evidential burden on the opponent, and the legal onus on the applicant.

OPPONENT'S EVIDENCE - KANWAR BAINS

Affidavit Evidence

[10] Mr. Bains identifies himself as a director of the opponent company. His evidence may be summarized as follows.

[11] The opponent Navsun Holdings Ltd. (and its predecessors in title and licensees, collectively, "Navsun") have published in Canada a free weekly newspaper called the *Ajit Weekly* since 1993. Attached as Exhibit E to his affidavit is a copy of an invoice dated October 29, 1993 from Weller Publishing Company Limited for 6000 copies of "THE AJIT." The present publisher is 6178235 Canada Inc.

[12] The *Ajit Weekly* newspaper was started by Mr. Bains, his father (now deceased), and other family members. The newspaper is printed in the Punjabi language and targeted to the Punjabi community in Canada. The newspaper has always displayed the word-mark AJIT together with variations of an AJIT Design mark (the "Navsun Marks") on its front page and on the opponent's newspaper boxes. There are two forms of the AJIT Design mark, written in somewhat differing Punjabi scripts, as shown below (reproduced from Exhibits J and C attached to Mr. Bains' affidavit):

Exhibit J



Exhibit C



[13] Mr. Bains' testimony on cross-examination was that the first masthead (Exhibit J) was used until the end of 2009 and the second masthead has been used since then.

[14] Navsun Holdings Inc. (previously ANAMCI) has licensed the Navsun Marks to 6178235 Canada Inc. since January 2004. A copy of the license agreement is attached as Exhibit G to Mr. Bains' affidavit. Paragraph 4 of the agreement provides for the opponent to have direct control over the character and quality of the goods and services provided under the mark AJIT and the opponent's related design marks.

[15] Through its licensee, Navsun started operating a website at the domain name *ajitweekly.com* in 1998 (the "Navsun website"). The opponent publishes electronic versions of the *Ajit Weekly* newspaper on the Navsun website as well as offering a range of other information, entertainment and communication services to the Punjabi community.

[16] Since 2005, Navsun licensees have provided radio programming in association with the names *Ajit Broadcasting Cmporation* [sic] and *ABC Radio* from Navsun's web-site. The radio programming caters to the Indian, Pakistani, West Indian and Bangladeshi communities in Canada. A more recent version of Navsun's website in which the opponent's marks are used is depicted in screenshots taken in 2011, attached as Exhibit N. The opponent tracks website usage on a monthly basis; the numbers of visits to the opponent's website varies from 14,000 to 38,000 each month.

[17] The *Ajit Weekly* is delivered in bundles to various locations around Greater Toronto and Vancouver. It is typically delivered to grocery stores, supermarkets, restaurants, temples and newspaper stands. There are rarely any *Ajit Weekly* newspapers left in the newspaper boxes at the end of the week. The *Ajit Weekly* newspaper is typically placed in newspaper boxes on which the Navsun Marks are clearly displayed. It is not unusual for the *Ajit Weekly* to be displayed alongside other ethnic newspapers.

[18] The volume of newspapers that are circulated each week has grown over the years. The opponent now prints 11,000 newspapers per week from its Vancouver-based printer and 13,000 newspapers per week from its Toronto-based printer.

[19] The opponent generates all of its revenue from the sale of advertising in the *Ajit Weekly* newspaper and on its website. Companies that have advertised in the newspaper, at various points in time, include Canadian Tire, Royal Bank, TELUS, Western Union, Remax, Royal LePage, Pizza Pizza, Honda, Toyota, GM, and Volvo.

[20] Mr. Bain asserts, without explaining why, that it is impossible for the applicant to have used the applied-for mark in Canada in association with its newspapers or website before 1993, that is, when the opponent started publishing the *Ajit Weekly* newspaper in Canada.

Testimony at Cross-Examination

[21] It is clear from the transcript of cross-examination that Mr. Bains did not have first-hand knowledge about the predecessor in title referred to in his affidavit, nor about the license agreements referred to in his affidavit, because his late father had made those arrangements.

[22] Nevertheless, Mr. Bains was, for the most part, a credible witness on cross-examination. He did, however, become a reluctant witness when questioned on his personal knowledge, and the knowledge of his target consumer group, of the applicant's newspaper. Because the applicant's newspaper is a major Punjabi newspaper in India, I find that it is likely that the opponent had knowledge of it when the opponent adopted the mark AJIT in Canada. It is also likely that the opponent's readers in Canada were, and continue to be, aware that a newspaper of the same name was being published in India. However, as will be discussed later, such knowledge by the opponent and its readership is not necessarily fatal to the opposition.

[23] At cross-examination there was some discussion of whether the word AJIT appearing in Punjabi script in the parties' newspaper mastheads were identical. It became apparent from remarks made by counsel for the applicant that the parties were in litigation over copyright issues concerning the word AJIT appearing in Punjabi script. Of course, such copyright issues are not

relevant in this proceeding. For the purposes of this proceeding, I accept Mr. Bains' testimony on cross-examination (at p.23, lines 114-115) concerning the parties' mark "AJIT" written in Punjabi script:

They are similar and they are not . . . It would be similar in terms of using an Arial font in [the] English language or using a Times Roman. So they would be similar and they would be different.

[24] I also accept Mr. Bains' testimony on cross-examination (at pp. 15-16) that the readers of the opponent's newspaper are literate in English and Punjabi, and although the English portion of the newspaper masthead reads "AJIT WEEKLY," the readers would understand that the name of the newspaper is AJIT.

[25] The applicant has not questioned whether the opponent's use of the term AJIT as a component of the mastheads shown in para 12, above, constitutes use of the mark AJIT *per se*. However, owing to the particular make-up of the opponent's client base, I would have found that the opponent has been using the mark AJIT *per se*: see *Cheung's Bakery Products Ltd. v. Saint Honore Cake Shop Limited*, (2011) 93 CPR (4th) 438 (TMOB); affirmed (2013) 121 CPR (4th) 64 (FC); affirmed (for partially different reasons) 2015 FCA 12. In this regard, the opponent's client base would perceive the Punjabi script as a trade-mark, and would understand that the English text AJIT functioned in the same capacity. In any event, it appears that the parties are on common ground in accepting that each party uses the English term AJIT as a trade-mark and also uses the Punjabi script form of the word "ajit" as a trade-mark.

[26] At cross-examination, counsel for the applicant introduced, as Exhibit A, a partial copy of the first page of the applicant's newspaper, dated July 22, 2005, showing the applicant's masthead, reproduced below. It may not be immediately noticeable that the phrase "Daily Ajit, Jalandhar" appears in the bottom left corner.



[27] Counsel for the applicant also introduced, as Exhibit B, copies of records from the trademarks register showing that the opponent had cancelled its registration for the mark shown below:



The above logo was registered on March 3, 2005 and cancelled on June 10, 2010. Mr. Bains testified that the above logo was used by the opponent from 1993 until the end of 2009. Of course, Mr. Bains also testified that the logo appearing in Exhibit C to his affidavit (see para 12, above) had been used during that time period. Presumably, Mr. Bains is of the view that one form of the logo is a permitted variation of the other. I would agree: see *Promafil Canada Ltée v. Munsingwear, Inc.* (1992), 44 CPR (3d) 59 (FCA) at pp. 71-72).

APPLICANT'S EVIDENCE - NARINDER PAL SINGH

[28] Mr. Singh identifies himself as an employee of the applicant and the Circulation Manager of the AJIT newspaper in Jalandhar, India. The mark AJIT has always appeared together with, and subsidiary to, the Punjabi script for the word AJIT, an example of which is shown in para 26, above.

[29] The newspaper is delivered to Canadian addresses. In para 5 of his affidavit, Mr. Singh has evidenced the number of subscriptions in Canada for the period 1990 - 2010 inclusive. By my calculations, there were, on average, 29 annual subscribers for the period 1990 - 1993

inclusive; 13 annual subscribers for the period 1994 - 2001 inclusive; and 6 annual subscribers for the period 2002 - 2010 inclusive.

[30] Mr. Singh relies on records produced by the Audit Bureau of Circulation in India to substantiate the applicant's claim to use of the applied-for mark in Canada "since at least as early as 1968." Those records establish that there were four subscriptions in Canada for the period January to June 1968.

EVIDENTIAL BURDEN AND LEGAL ONUS

[31] As in other civil proceedings, there is (i) an evidential burden on the opponent to support the allegations in the statement of opposition and (ii) a legal onus on the applicant to prove its case.

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

ASSESSING THE GROUNDS OF OPPOSITION

First Ground - non-compliance with s.30(a)

[33] The first ground of opposition alleges that the applicant has not used its mark in Canada since at least as early as 1968. The opponent has not adduced any evidence in support of the allegation nor is there any evidence of record that the opponent can rely on to support the

allegation. The first ground is therefore rejected for the reason that the opponent has not met its evidential burden to put the first ground into issue. In any event, I accept the applicant's uncontradicted and unchallenged evidence (see para 30, above) to establish its claimed date of first use.

Second Ground - non-compliance with s.30(i)

[34] The second ground is also rejected. In this regard, the fact that an applicant knew of or ought to have known of the opponent's allegedly confusing trade-mark is not an exceptional circumstance which can form the basis of a ground of opposition pursuant to s.30(i): see *Luxo Laboratories Limited v Magistral Fabrication Inc*, 2004 CanLii 71818; *Woot Inc. v. WootRestaurants Inc. / Les Restaurants Woot Inc*, 2012 TMOB 197 at paras 10-11. To be valid, a section 30(i) ground of opposition must allege exceptional circumstances such as bad faith or non-compliance with a Federal statute: see *Les Abris Harnois Inc v Prima Innovations Inc*, 2012 TMOB 27.

Third Ground - non-entitlement pursuant to s.16(1)(a)

[35] The pertinent section of the *Trade-marks Act* reads as follows:

16. (1) Any applicant who has filed an application . . . for registration of a trade-mark . . . that he or his predecessor in title has used in Canada . . . is entitled . . . to secure its registration . . . unless at the date on which he or his predecessor in title first so used it . . . , it was confusing with

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person; (emphasis added)

[36] In the instant case, the applicant has established use of its mark AJIT in Canada since 1968 while the opponent's use of its mark AJIT in Canada did not begin until 1993. The third ground fails because the opponent has not established prior use or making known of its mark AJIT.

Fourth Ground - non-distinctiveness

[37] The meaning of distinctiveness in relation to a trade-mark is found in the *Interpretation* section of the *Trade-marks Act*:

“distinctive”, in relation to a trade-mark, means a trade-mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[38] It has been judicially noted that the hallmark of a trade-mark is the message that it sends to the public that the goods or services have one single source. If a trade-mark does not function to indicate a single source, then the mark is not registrable and is in fact not a trade-mark at all.

[39] The commonly accepted material date to assess distinctiveness is the date of filing of the opposition: see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC) at 324. Accordingly, in the instant case the evidential burden is on the opponent to put the distinctiveness of the applied-for mark AJIT into issue at the material date December 28, 2012. Mr. Bains’ evidence of the opponent’s use of its mark AJIT beginning in 1993 satisfies that burden.

[40] The distinctiveness of a mark has been considered by this Board, and by the Court, on numerous occasions. In particular, in *Bojangles' International LLC v. Bojangles Café Ltd.* (2004) 40 CPR (4th) 553 this Board discussed where the bar is set in order for the distinctiveness of one mark to negate the distinctiveness of another mark:

Spanada [*Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975) 25 CPR (2d) 126 (FCA), reversing (1974) 14 CPR (2d) 204 (FCTD), affirming (1973) 9 CPR (2d) 154 (TMOB)] and *Motel 6* [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981) 56 CPR (2d) 44 (FCTD)] . . . are the leading cases to examine the extent to which a mark must be known if it is to negate the distinctiveness of another mark. The bar set by those cases is that the opponent’s mark must be well known in at least one part of Canada or widely known.

[41] However, on appeal to the Federal Court ((2006) 48 CPR (4th) 427), Noël J. noted that the Board had applied an erroneous standard and set the bar in the following terms:

A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient.

[42] In the instant case, it is clear from Mr. Bains' evidence that, as of the material date December 28, 2012, the opponent's mark AJIT had acquired a significant reputation in Canada for the target population served by its newspaper. It is equally clear from Mr. Singh's evidence (six subscribers in the period 2002 -2010) that, as of December 28, 2012, the applicant's mark had, at best, a minimal reputation in Canada for the same target population. Accordingly, I find that the opponent's mark AJIT was known sufficiently to negate the distinctiveness of the applied-for mark AJIT as of the material date. In other words, at the material date the target population reading the Canadian newspaper AJIT would identify a Canadian publisher as the source of the newspaper, rather than the applicant. The opponent therefore succeeds on the fourth ground of opposition.

RELATED JURISPRUDENCE

[43] In the recently decided Federal Court case *Sadhu Singh Hamdard Trust v. Navsun Holdings Ltd* 2014 FC 1139, the plaintiff Sadhu (the applicant herein) accused Navsun Holdings (the opponent herein) of copyright infringement, passing-off, and making false statements about Sadhu's publication the *Ajit Weekly*. None of Sadhu's claims succeeded. The Court case is of course distinguishable from the present opposition in many respects and in particular the Court was concerned with the mark AJIT in Punjabi script rather than with the English term AJIT. Nevertheless, I note that the Court made findings of fact comparable to the findings of fact that I have made in this opposition, albeit on the basis of a different evidentiary record:

[83] The Plaintiff alleged that the mark is "famous" amongst the Punjabi speaking public. At the hearing, the Plaintiff argued that there is "no dispute - it is a famous institution". The Plaintiff submitted that the evidence of large circulation in the Punjab and the paper's availability on the internet shows that everyone knows of the paper. The Plaintiff's evidence is that every Punjabi family worldwide knows the Ajit Daily and in fact even the Defendants' family read the Ajit Daily in India.

[84] The Plaintiff's evidence falls short of demonstrating reputation in the Defendants' geographic region. There is no survey or other independent reputable evidence before me to find that the Ajit Daily has commercial goodwill in Canada or is famous in Canada as the only evidence presented to me is of seven subscribers in Canada in 2010 . . . (emphasis added)

DISPOSITION

[44] As the opponent has succeeded on the fourth ground of opposition, the subject application is refused. 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: 2015-08-15

Appearances

Tamara Ramsey

For the Opponent

David Allsebrook

For the Applicant

Agents of Record

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For the Opponent

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For the Applicant