



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

Citation: 2012 TMOB 252
Date of Decision: 2012-12-21

**IN THE MATTER OF AN OPPOSITION
by Lion Global Investors Limited to
application No. 1,366,769 for the trade-
mark LION in the name of Lion Capital
LLP**

[1] On October 9, 2007, Lion Capital LLP (the Applicant) filed an application to register the trade-mark LION (the Mark) based on proposed use in Canada as well as use in the United Kingdom and registration in OHIM (EU). The Applicant claimed a priority filing date of April 10, 2007 based on an application filed in OHIM (EU) for the same type of services. The statement of services, as amended (pursuant to a revised application dated July 20, 2010) are:

Financial affairs namely, management and administration of financial portfolios, lease financing of capital assets; monetary affairs namely fund investment consultation, funds management, investment of funds for others; financial services namely, financial analysis, financial research, financial forecasting, financial management, financial planning and financial investment in the consumer sector and in the field of consumer commodities; corporate finance; private equity; investment services namely, commodity investment advice, investment management, investing funds for others, the investing in and the management of businesses and the realization of dividends, profits, capital gains, cash and securities from such businesses and the distribution of dividends, profits, capital gains, cash and securities; capital, fund and trust investment services; investment management services; mutual fund, collective investment scheme and hedge fund services; unit trust services; financial and investment planning and research; advisory, consultancy and information services relating to all the aforesaid services (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 2, 2009.

[3] On February 1, 2010, Lion Global Investors Limited (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the application does not conform to the requirements of section 30(a) of the Act because the application does not contain a statement in ordinary commercial terms of the specific services in association with which the Mark has allegedly been used in the UK and is proposed to be used in Canada;
- pursuant to sections 38(2)(a) and 30(d) of the Act, the application does not conform to the requirements of section 30(d) of the Act because contrary to the Applicant's statement in the application, the Applicant had not, as of the date of filing the application used the Mark, *per se*, in the UK with each of the general classes of services described in the application;
- pursuant to sections 38(2)(a) and 30(e) of the Act, the application does not conform to the requirements of section 30(e) of the Act because the Applicant's statement in the application that it intends to use the Mark with the services described in the application in Canada was false. The Applicant had no such intention because it did not intend to use the Mark with all of the Services in Canada in a manner that would constitute use under section 4 of the Act; and it did not intend to use the Mark, *per se*, with all of the services described in the application in a manner that would constitute use under section 4 of the Act.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed an affidavit of Jaime Holroyd.

[6] In support of its application, the Applicant filed an affidavit of Janet Mary Dunlop. A cross-examination order issued to the Opponent on January 26, 2011 but the Opponent chose not to cross-examine Ms. Dunlop. The Applicant was also granted leave on October 26, 2011 to file an affidavit of Jaclyn Seidman.

[7] Only the Applicant filed a written argument. An oral hearing was held at which only the Applicant was represented.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential

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 CPR (3d) 293 (FCTD) at 298].

[9] All three grounds of opposition are based upon sections 38(2)(a) and 30 of the Act and thus the material date for all of the grounds of opposition is the date of filing the application for the Mark [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].

Section 30(a) Ground of Opposition

[10] The Opponent's initial evidential burden under section 30(a) is a light one. In fact, the Opponent may need only present sufficient argument in order to meet its initial burden [see *McDonald's Corporation and McDonald's Restaurants of Canada Ltd v MA Comacho-Saldana International Trading Ltd carrying on business as Macs International* (1984), 1 CPR (3d) 101 at 104 (TMOB)].

[11] In the present case, however, the Opponent has provided neither evidence nor argument in support of this ground of opposition and as a result, the Opponent has failed to meet its evidential burden and the ground of opposition based on section 30(a) of the Act is therefore dismissed.

Section 30(d) Ground of Opposition

[12] As pointed out in the opposition decision *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 at 89 (TMOB) "it is difficult for an opponent to prove an allegation of non-use by an applicant, the relevant facts being readily available to the applicant". While these comments related to a ground of opposition based on section 30(b) of the Act, they are equally applicable to a ground of opposition based on section 30(d) [see *105272 Canada Inc v Grands Moulins de Paris, Société Anonyme* (1990), 31 CPR (3d) 79 (TMOB)]. To the extent that the Applicant has easier access to the facts, the burden of proof on the Opponent in regard to

the ground of opposition based on the failure to respect section 30(d) is less onerous [see *Tune Masters*].

[13] An opponent can also discharge its initial burden of proof in regard to section 30(d) by relying on the applicant's evidence, provided it shows that the applicant's evidence is "clearly inconsistent" with the applicant's claims set forth in its application [see on this point *Labatt Brewing Co v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD); *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD); *York Barbell Holdings Ltd v ICON Health and Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB); *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), *aff'd* 11 CPR (4th) 489 (FCTD)].

[14] In the present case, both parties filed evidence. The Opponent's evidence constitutes printouts from the Applicant's website both current to the date of the affidavit and an archived version obtained from the Internet archive service Wayback Machine dated September 29, 2007, which predates the material date. The Applicant also adduces materials printed from its website as part of Ms. Duncan's affidavit. I note that the comments that I make with respect to the manner in which the Mark appears on the Applicant's website apply to the website as seen in both parties' evidence.

[15] The Opponent made no submissions in support of this ground of opposition. I presume that the evidence filed by the Opponent was an attempt to show that the Applicant could not have used the Mark as applied for in the UK before the date of filing the application in Canada as the Mark had not been used on its own as a trade-mark *per se* on the Applicant's website. Specifically, I presume the Opponent is alleging that the Mark is used as part of either a word mark LION CAPITAL, or as part of a design mark as shown below (the LION CAPITAL & Lion Logo):



[16] While it is true that the Applicant's materials, including the website, refer to the Applicant as LION CAPITAL, I note that as pointed out by the Applicant at the oral hearing, the evidence also shows that the Applicant refers to itself as LION. In fact, the evidence shows that the Applicant refers to itself and third parties refer to the Applicant, interchangeably as LION and/or LION CAPITAL.

[17] It is also true that the Applicant's materials, including the website, frequently feature the LION CAPITAL & Lion Logo design mark, however, this is not necessarily detrimental to the Applicant's position since the use of a word mark can be supported by the use of a composite mark featuring the word mark and other elements [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[18] A trade-mark will be found to be used within the meaning of the Act if it is used in such a way that it does not lose its identity and remains recognizable in spite of the differences between the form in which it was applied for and the form in which it is used. As set out in *Registrar of Trade Marks v Compagnie Internationale Pour L'Informatique CII Honeywell Bull, Societe Anonyme et al* (1985), 4 CPR (3d) 523 (FCA) at 525:

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

[19] The Applicant submits, and I agree, that the LION element of the LION CAPITAL & Lion Logo design mark is in a prominent position and is featured in a darker font. I find that this is sufficient to distinguish the LION element as apart from the remainder of the design mark such that use of the LION CAPITAL & Lion Logo design mark also constitutes use of the Mark as a trade-mark *per se*.

[20] I will now summarize the most relevant portions of the Applicant's evidence:

- a. a sworn statement from Ms. Duncan that the Applicant "is a private equity firm with a focus on making controlling investments in mid and large-sized consumer-oriented businesses in Europe and North America" (paragraph 8);

- b. a sworn statement from Ms. Duncan that the Applicant has used the Mark in the UK and in the rest of the EU in association with the services: “financial services; corporate finance; private equity; investment services; capital, fund and trust investment services; investment management services; financial and investment planning and research; advisory, consultancy and information services relating to all of the aforesaid services” since at least as early as 2005 (paragraphs 6, 7);
- c. a sworn statement from Ms. Duncan that the Applicant adopted the LION branding (including the Mark, the trade-mark LION CAPITAL and the LION CAPITAL & Lion Logo design mark) in April 2005;
- d. a sworn statement from Ms. Duncan that, since the adoption of the LION branding in April 2005, the Applicant has consistently promoted itself interchangeably as LION and LION CAPITAL;
- e. a sworn statement from Ms. Duncan that since the adoption of the LION branding, the Applicant has taken steps to protect the names LION, LION CAPITAL and the Lion Logo design mark in the UK and the rest of the EU;
- f. a sworn statement from Ms. Duncan that since its inception the Applicant has maintained a website that makes prominent use of the LION marks including the Mark as well as the LION CAPITAL & Lion Logo design mark which I have already found qualifies as use of the Mark;
- g. printouts from the Applicant’s website, which Ms. Duncan states has been materially the same since its inception, which display the trade-marks LION and LION CAPITAL being used interchangeably to refer to the Applicant as well as the LION CAPITAL & Lion Logo design mark which I have found constitutes use of the Mark (Exhibit JD2);
- h. a sworn statement from Ms. Duncan that the Mark is used on corporate literature used by the Applicant in carrying out its business functions including on investor presentations, press releases and Private Placement Memorandums (PPM) (confidential documents presented to potential investors in the UK, EU, US,

Canada and elsewhere). In support of this statement Ms. Duncan attaches to her affidavit a sample PPM dated February 2007 which displays the Mark on its own and as part of the LION CAPITAL & Lion Logo design mark (Exhibit JD4);

- i. a sworn statement from Ms. Duncan that the Mark has been used repeatedly and extensively by the Applicant on a day to day basis since 2005 interchangeably with the LION CAPITAL trade-mark in all aspects of company activities including on the website and in corporate literature and as part of the LION CAPITAL & Lion Logo design mark. In support of this statement Ms. Duncan attaches to her affidavit sample business cards, letterhead and compliment slips (Exhibit JD3);

[21] I note that Ms. Duncan's sworn statement regarding use of the Mark in the UK and the rest of the EU (point (a) above) specifically reproduces only a portion of the Services. That said I find that the services outlined in Ms. Duncan's statement are defined more broadly than those in the application for the Mark. Thus I am satisfied that her statement includes all of the Services. Furthermore, I note that when the evidence is assessed as a whole, I have no reason to find the evidence clearly inconsistent with a finding that the Mark had been used in the UK at the material date in association with the Services, generally.

[22] The Applicant also provides evidence of the Applicant's revenues. Specifically, Ms. Duncan attaches to her affidavit copies of the Applicant's consolidated accounts including one for the year ending March 31, 2007. I am satisfied that the Applicant has established significant revenues as of the material date.

[23] At the oral hearing, the Applicant submitted that as Ms. Duncan was not cross-examined on her affidavit and as no contradictory evidence has been filed her evidence should be found to be uncontroverted. I have no reason to doubt the veracity of Ms. Duncan's sworn statements.

[24] Based on a review of the evidence as a whole, I am not satisfied that the Opponent has met its evidential burden. With respect to the Opponent's evidence, I find that the website materials attached to Ms. Holroyd's affidavit display the Mark on its own as well as part of the LION CAPITAL and & Lion Logo design mark which I have found constitutes use of the Mark.

As a result, the Opponent's evidence is not sufficient to enable the Opponent to meet its evidential burden. Furthermore, for the reasons set out above I am not satisfied that the Applicant's evidence is clearly inconsistent with the Applicant's claim to use of the Mark in the UK at the date of filing the application for the Mark in Canada.

[25] Based on the foregoing, the ground of opposition based on section 30(d) of the Act is dismissed.

Section 30(e) Ground of Opposition

[26] Since it is difficult to prove a negative, and certainly more so in the case of a proposed use application, the initial burden upon the Opponent with respect to the ground of opposition based upon non-compliance with section 30(e) is a relatively light one [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FC)].

[27] The Opponent bases this ground of opposition largely on an allegation that the Applicant did not intend to use the Mark as a trade-mark *per se*. However, I have already found that the manner in which the Applicant uses its Mark, including at times as part of the LION CAPITAL & Lion Logo design mark, constitutes use of the Mark as a trade-mark *per se*. Furthermore, I note that there is no evidence supporting a finding that the Applicant did not intend to use the Mark in Canada. Based on the foregoing, this ground of opposition necessarily fails on the basis that the Opponent has not met its evidential burden.

Disposition

[28] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office