



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

Citation: 2015 TMOB 106
Date of Decision: 2015-06-11

**IN THE MATTER OF AN OPPOSITION
by Titan Capital Ventures Inc. to
application No. 1,582,718 for the trade-
mark TEG & design in the name of Titan
Equity Group Ltd.**

I. Background

[1] Titan Equity Group Ltd. (the Applicant) has applied to register the trade-mark TEG & Design (the Mark), as shown below.



[2] The application for the Mark was filed on June 19, 2012. It is based upon proposed use in Canada and it covers the following services:

Real estate and property development services; Mortgage financing services; Syndicated mortgage investment services; Real estate and property investment services; Financial investment services; Facilitation of private and public equity investment services; Real estate and property acquisition services; Investment services, namely real estate, stocks, equities, commodity investment advice; Financial investment management services; Mortgage brokerage services

[3] Titan Capital Ventures Inc. (the Opponent) is the owner of a number of trade-mark applications for trade-marks consisting of or containing the word TITAN. A list of the Opponent's trade-marks is attached hereto as Schedule "A".

[4] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* on June 19, 2013 and on November 19, 2013, the Opponent opposed it by filing a statement of opposition under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[5] The application has been opposed on the grounds that: (i) it does not conform to the requirements of sections 30(e) and 30(i) of the Act; (ii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in view of the Opponent's prior use of its TITAN trade-marks; (iii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(b) of the Act in view of the Opponent's previously filed applications for its TITAN trade-marks; and (iv) the Mark is not distinctive within the meaning of section 2 of the Act.

[6] On December 12, 2013, the Applicant filed a counterstatement denying each of the allegations set out in the statement of opposition.

[7] In support of its opposition, the Opponent filed certified copies of its applications for its TITAN trade-marks (application Nos. 1,579,898; 1,579,899; 1,579,900; 1,579,902; and 1,579,903).

[8] As evidence in support of its application, the Applicant filed a certified copy of the application for the Mark (application No. 1,582,718).

[9] Only the Applicant filed a written argument.

[10] No oral hearing was held.

II. Onus

[11] 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].

III. Grounds of Opposition Summarily Dismissed

Non-conformity - Section 30(i)

[12] Where an applicant has provided the statement required by section 30(i), a ground of opposition based upon this section should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, this ground is dismissed.

Non-conformity - Section 30(e)

[13] The Opponent has pleaded that contrary to section 30(e) of the Act, the Applicant did not intend to use the Mark in Canada in association with the services which are set out in the application. Section 30(e) of the Act requires an applicant to make a statement that it, either by itself or through a licensee intends to use the applied for trade-mark in Canada. The application contains such a statement. It therefore formally complies with section 30(e) of the Act. In view of this, and since there is no evidence of record to suggest any lack of intention to use the Mark on the part of the Applicant, the Opponent has not met its initial burden in respect of this ground. Accordingly, this ground of opposition is also summarily dismissed.

Non-entitlement - Section 16(3)(a)

[14] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the Opponent's prior use of its TITAN trade-marks as set out in Schedule "A" attached hereto. There is an initial burden on the Opponent in respect of this ground to evidence use of its trade-marks prior to the Applicant's filing date and to show that it had not abandoned its trade-marks as of the date of advertisement of the Applicant's application [section 16(5)]. Since the Opponent has not provided evidence of use of any of its trade-marks, it has

failed to meet its initial evidential burden. Accordingly, this ground of opposition is also summarily dismissed.

Non-distinctiveness - Section 2

[15] The Opponent has pleaded that the Mark does not distinguish and is not capable of distinguishing the Applicant's services from those of the Opponent. In order to satisfy its initial burden with respect to a non-distinctiveness ground of opposition, an opponent's evidence must show that its trade-marks had become known sufficiently as of the commencement of the opposition to negate the distinctiveness of the applied-for trade-mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC) and *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. Since the Opponent has not filed evidence of use of any of its trade-marks, it has failed to meet this initial burden. Accordingly, this ground of opposition is also dismissed.

IV. Analysis of Remaining Ground of Opposition

Non-entitlement – Section 16(3)(b)

[16] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because as of the June 19, 2012 filing date of the application for the Mark, the Mark was confusing with the Opponent's aforementioned TITAN trade-marks which are the subject of its previously filed application Nos. 1,579,898 (TITAN CAPITAL); 1,579,899 (TITAN); 1,579,900 (TITAN CONSTRUCTION); 1,579,902 (TITAN CAPITAL ADVENTURES); and 1,579,903 (TITAN CAPITAL ADVENTURES & Design).

[17] The material date for assessing this ground of opposition is the filing date of the application for the Mark, namely, June 19, 2012. In order to meet its initial burden under this ground of opposition, the Opponent must show that one or more of its applications had been filed prior to the filing date of the application for the Mark and had not been abandoned as of the June 19, 2013 date of advertisement [section 16(4) of the Act].

[18] In support of this ground of opposition, the Opponent has filed certified copies of its applications for its TITAN trade-marks. I confirm that the Opponent's applications, which were

all filed on May 30, 2012, were filed before the filing date of the Applicant's application for the Mark and were still pending as of the date of advertisement of the Applicant's application.

[19] The Opponent has therefore met its initial burden in respect of this ground of opposition. Accordingly, the onus shifts to the Applicant to demonstrate that there is no likelihood of confusion between the marks at issue.

[20] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[21] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion.]

[22] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis. For this reason, I will begin my analysis of the section 6(5) factors by first considering the degree of resemblance between the parties' trade-marks.

Section 6(5)(e) - The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[23] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality and that it is not correct to lay them side by side and carefully compare and observe the similarities or differences among their elements.

[24] The first portion of a trade-mark is usually considered more important for assessing the likelihood of confusion [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)]. However, at paragraph 64 of the *Masterpiece* decision, the Court writes that to measure the degree of resemblance, a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[25] In the present case, I find that the word element TEG is what stands out most in the Mark, as it appears in large block letters which are superimposed over the design feature of the Mark and it is the part of the Mark which would be heard first orally. In the Opponent's TITAN trade-marks, I find that the word TITAN stands out, as it is the more distinctive part of the Opponent's trade-marks and it appears in the dominant first position of the marks.

[26] When viewed in their totality, I consider the parties' trade-marks to be quite different both visually and phonetically. To the extent that the letter "A" is stylized in three instances in the Opponent's trade-mark TITAN Design (application No. 1,579,903) and to the extent that stylization is similar to the design feature which is present in the Mark, that particular trade-mark of the Opponent may be said to have slightly more in common with the Mark than its other trade-marks. However, when viewing the trade-marks as a whole and as a matter of first impression, I do not find this to be impactful. Overall, I find that there is a very low degree of resemblance between the parties' trade-marks in appearance and sound.

[27] In terms of ideas suggested, while the word TEG may be defined as "a sheep in its second year", I find it more likely that the Mark would be viewed as being a coined word or perhaps an acronym. I acknowledge that upon some reflection, it may be perceived as being an acronym for the Applicant's company name. However, there is no evidence to support that consumers would attribute such a meaning to the Mark as a matter of first impression. By contrast, the Opponent's trade-marks are all either solely comprised of the ordinary dictionary word TITAN (which has been defined as "a person or organization of very great power, importance, or strength") or are comprised of the word TITAN with other ordinary dictionary words such as CAPITAL,

CONSTRUCTION, MANAGEMENT and VENTURES [see *Canadian Oxford Dictionary*, (2 ed.); see *Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29 which confirms that I may take judicial notice of dictionary definitions)].

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[28] Both of the parties' trade-marks possess some degree of inherent distinctiveness. Neither party has filed any evidence of use to enable me to conclude that its trade-mark(s) has become known to any extent.

Section 6(5)(b) – the length of time the trade-marks have been in use

[29] The application for the Mark is based upon proposed use and the Applicant has not filed any evidence of use. Although some the Opponent's applications claim a 2009 date of first use, the date of first use does not pertain to any services which overlap with those of the Applicant. In any event, no evidence of use has been filed by the Opponent either.

Sections 6(5)(c) and (d) – the nature of the goods, services, trade and business

[30] The application for the Mark covers a variety of real estate, property development, mortgage and investment related services. The Opponent's applications cover at least some services which directly overlap with those of the Applicant. For example, "property development" and "real estate development". In view of this overlap and in the absence of any evidence to the contrary, it is reasonable to assume that there would also be overlap in the parties' channels of trade.

Conclusion

[31] Having considered all of the surrounding circumstances, I find that on a balance of probabilities, confusion is not likely between the parties' trade-marks. Although the parties' services and channels of trade overlap, there is not a significant degree of difference in the inherent distinctiveness of the parties' trade-marks and there is no evidence to show that the

parties have used or acquired any reputation in their marks. I am of the view that the differences between the marks suffice to make confusion unlikely.

[32] Accordingly, the section 16(3)(b) ground of opposition is unsuccessful.

V. Disposition

[33] In view of the foregoing, 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.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule "A"

Trade-mark	Application No.	Filing Date	Services
TITAN	1,579,899	May 30, 2012	(1) financial consulting services, marketing consulting services and sports marketing services (2) construction, construction services, property development, Real estate, real estate development, real estate financing services, housing services, income property, real estate rentals, industrial real estate, commercial real estate, residential real estate, realty
	1,579,903	May 30, 2012	(1) financial consulting services, marketing consulting services and sports marketing services (2) construction, construction services, property development, Real estate, real estate development, real estate financing services, housing services, income property, real estate rentals, industrial real estate, commercial real estate, residential real estate, realty
TITAN CAPITAL	1,579,898	May 30, 2012	(1) financial consulting services, marketing consulting services and sports marketing services
TITAN CAPITAL VENTURES	1,579,902	May 30, 2012	(1) financial consulting services, marketing consulting services and sports marketing services (2) construction, construction services, property development, Real estate, real estate development, real estate financing services, housing services, income property, real estate rentals, industrial real

			estate, commercial real estate, residential real estate, realty
TITAN CONSTRUCTION MANAGEMENT	1,579,900	May 30, 2012	(1) construction, construction services, property development, Real estate, real estate development, real estate financing services, housing services, income property, real estate rentals, industrial real estate, commercial real estate, residential real estate, realty