



LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 137

Date of Decision: 2017-10-05

IN THE MATTER OF AN OPPOSITION

**Dundee Corporation; Goodman and
Company, Investment Counsel Ltd.
and Ned Goodman Investment Counsel
Limited**

Opponents

and

**Goodman International Limited
1,355,707 for GOODMAN
1,355,705 for GOODMAN & Design**

Applicant

Applications

APPLICATION 1,355,707 FOR GOODMAN

FILE RECORD

[1] On July 16, 2007 Goodman International Limited filed an application to register the trade-mark GOODMAN, based on proposed use in Canada, in association with the following services:

real estate services; real estate management services; real estate agency services; rental of real estate property; real estate brokers; rent collection services; the development and management of commercial/industrial real estate assets.

[2] The application claims a priority filing date of April 23, 2007, pursuant to s. 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, based on the applicant's prior filing of a corresponding application in Australia.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated September 29, 2010. The application was then opposed jointly, on February 28, 2011, by Dundee Corporation; Goodman and Company, Investment Counsel Ltd. ("Goodman & Company"); and Ned Goodman Investment Counsel Limited.

[4] The Registrar forwarded a copy of the statement of opposition to the applicant on March 22, 2011, as required by s.38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponents subsequently requested, and were granted, leave to submit an amended statement of opposition. Further references to the statement of opposition are to the amended version dated December 1, 2011.

[5] The opponents' evidence consists of the affidavits of Harold P. Gordon; Roxana Tavana; and Mary P. Noonan, as well as (i) a certified copy of the file history for the opposed application No. 1,355,707; and (ii) a certified copy of the statement of opposition filed by the applicant in a related proceeding namely, the applicant's opposition to application No. 1,459,567 for the mark GOODMAN INVESTMENT CONSULTING filed by the opponent Dundee Corporation. Mss. Tavana and Noonan were cross-examined on their written testimony. The transcripts of their cross-examinations, and the answer to a question taken under advisement in the cross-examination of Ms. Tavana, form part of the evidence of record.

[6] The applicant's evidence consists of the affidavits of Samira Ali and Anick Desautels, as well as certified copies of (i) the registered marks GOODMANS. GOOD PEOPLE and GOODMANS. GOOD PEOPLE ARE GOOD FOR BUSINESS, both standing in the name of Goodmans LLP and both for use in association with legal and financial services, and (ii) trademark applications for BG BEUTEL GOODMAN and for BG BEUTEL GOODMAN & Design, shown below, consisting of the letters BG (in white against a dark rectangle) preceding the phrase BEUTEL GOODMAN.

[7] The above-mentioned applications stand in the name of Beutel, Goodman & Company Ltd. and both are for use in association with investment management services. Ms. Ali was cross-examined on her written testimony, the transcript of her cross-examination forming part of the evidence of record.

[8] Both parties submitted a written argument and both were ably represented at an oral hearing.

STATEMENT OF OPPOSITION

[9] The grounds of opposition alleged by the opponents are found in paras. 15(a)-15(i) of the statement of opposition, reproduced below. The opponents' registered marks referred to in the pleadings (standing in the name of the opponent Dundee) are those discussed in para. 11 below, while the opponents unregistered marks are those referred to in para. 14 below.

(a) Sections 38(2)(a) and 30(i).

The Application does not conform to the requirements of ss.30(i) of the Act as the Applicant falsely stated that it was satisfied that it was entitled to use the trade-mark applied for in Canada in association with the services described in the Application when, in fact, at the date of filing the Application, July 16, 2007, the Applicant was aware of, or should have been aware of, the Opponent's GOODMAN Registered Marks and the Opponent's GOODMAN Unregistered Marks with which the subject mark is confusing and/or the false connection with the living individual, Mr. Ned Goodman.

(b) Sections 38(2)(b) and 12(1)(a).

The Application is not registrable having regard to ss. 12(1)(a) since the trade-mark consists of a word that is primarily merely the name or surname of an individual who is living or has died within the preceding thirty years, namely Mr. Gregory Goodman.

(c) Section[sic] 38(2)(b) and 12(1)(d).

The Application is not registrable having regard to ss. 12(1)(d) since the subject trade-mark is confusing within the meaning of s. 6 of the Act, with the Opponent's GOODMAN Registered Marks identified in Schedule "A" hereto.

(d) Sections 38(2)(b) and 12(1)(e).

The Application is not registrable having regard to s.12(1)(e) since the subject mark is prohibited by section 9 of the Act. The Application is prohibited under s.9(1)(k) of the Act, as the adoption of the Application in connection with a business, as a trade-mark or otherwise, is so nearly resembling as to be likely to be mistaken for a matter that may falsely suggest a connection with any living individual, namely, Mr. Ned Goodman.

(e) Sections 38(2)(c) and 16(3)(a).

The Applicant is not entitled to register the trade-mark applied for in view of ss. 16(3)(a) since at the date of filing the Application, July 16, 2007, the Application was and is confusing with the Opponent's GOODMAN Registered Marks detailed in Schedule "A" and the Opponent's GOODMAN Unregistered Marks detailed in Schedule "B", each of which had been previously used under licence in Canada with the Services. At no time did the Opponent Dundee Corporation abandon use of the aforementioned trade-marks in Canada.

(f) Sections 38(2)(c) and 16(3)(c).

The Applicant is not entitled to register the trade-mark applied for in view of ss. 16(3)(c) since at the date of filing the Application, July 16, 2007, the Application was and is confusing with the following trade names used under license: Goodman & Company; Goodman & Company, Investment Counsel; Goodman Investment Consulting; and Ned Goodman Investment Counsel. At no time did the Opponents abandon the use of these trade names in Canada.

(g) Sections 38(2)(d) and 2.

The trade-mark applied for is not distinctive, within the meaning of s. 2 of the Act. For the reasons expressed above, the Application does not actually distinguish the services in association with which [sic] is proposed to be used by the Applicant, from the services of the Opponents, nor is the trade-mark applied for adapted so as to distinguish the Applicant's services.

(h) Sections 38(2)(d) and 2.

The trade-mark applied for is not distinctive, within the meaning of s. 2 of the Act. The Application does not actually distinguish the services in association with which it is proposed to be used by the Applicant, from the services of the Opponents, nor is the trade-mark applied for adapted so as to distinguish the Applicant's services. Consumers will falsely associate the services offered in association with the applied-for trade-mark with Mr. Ned Goodman whose surname GOODMAN has been adopted as a trade-mark and is distinctive in Canada of financial services offered by the Opponents.

(i) Sections 38(2)(d) and 2.

The trade-mark applied for is not distinctive, within the meaning of s. 2 of the Act. The Application does not actually distinguish the services in association with which [sic] is proposed to be used by the Applicant, from the financial services of the Opponents, nor is the trade-mark applied for adapted so as to distinguish the Applicant's services as it is confusing with Mr. Ned Goodman's name, and falsely suggests a connection, license or endorsement by Mr. Ned Goodman.

[10] I note that the material date in respect of grounds (e) and (f) above should be the priority filing date April 23, 2017 rather than the actual filing date July 16, 2017. I will address the grounds of opposition after summarizing the evidence of record, below.

OPPONENT'S EVIDENCE

Harold Gordon

[11] Mr. Gordon identifies himself as Chairman of the Board of Directors of the opponent Dundee Corporation. His evidence may be summarized as follows.

[12] Dundee is the owner of various registered GOODMAN-formative trade-marks (listed in Schedule A of Exhibit HG-11 of his affidavit), including, for example, GOODMAN DISCIPLINED MOMENTUM FUND; GOODMAN ECONOWEALTH; and GOODMAN FOCUS + FUNDS. The opponents Goodman & Company and Ned Goodman Investment Counsel Limited are licensees of (i) the GOODMAN-formative marks and (ii) Dundee's trade-names Goodman and Goodman & Company.

[13] Based on the evidence before me, I have determined that (i) the licensed use of GOODMAN-formative marks was in compliance with s.50(1) of the *Trade-marks Act*, however (ii) such compliance ceased with respect to the opponent Goodman & Company in early 2011 when it was acquired by the Bank of Nova Scotia (see para. 20 below).

[14] Goodman & Company has been providing investment and financial services in Canada for many decades, at both institutional and retail levels. Goodman & Company has since 2003 managed, and offered to the Canadian public, investment funds that are focused on real estate, real estate investment trusts, and real estate management companies. Such funds are sold under

various GOODMAN-formative marks including, for example, GOODMAN ASSET ALLOCATION FUND and GOODMAN CANADIAN BOND FUND. Other GOODMAN-formative marks, including **Goodman & Design** (white lettering in a dark rectangle) and **Goodman & Company & Design** (white lettering in a dark rectangle), shown below, have been associated with Goodman & Company funds since 2003 and 1996, respectively.

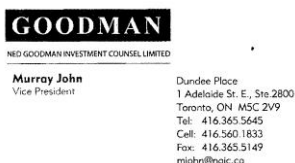


since 2003



since 1996

[15] Ned Goodman Investment Counsel Limited has provided investment management services in Canada under its eponymous trade-name since 2010. Examples of its use of GOODMAN-formative marks are found in Exhibit HG-9, as shown below in a business card:



[16] The scale and extent of the opponents' businesses are described in paras. 4 and 5 of Mr. Gordon's affidavit:

4. Dundee Corporation, through its subsidiaries, affiliates and licensees, including Goodman & Company and Ned Goodman Investment Counsel Limited, is a national leader in the investment and asset management businesses in Canada. The investment and asset management businesses of Dundee Corporation are unique because of the management style and independence of Dundee Corporation and its affiliates, a business that competes head-to-head in the Canadian financial arena that is dominated by a small group of six very large banks and three large insurance and financial companies, as well as being active in the resource and real estate management business in Canada.

5. Today, Dundee Corporation, by itself and through its subsidiaries and licensees, including the Opponents Goodman & Company and Ned Goodman Investment Counsel Limited, currently have assets under management and administration in association with the GOODMAN trade-marks and trade names

exceeding \$100 billion. In addition, Dundee Corporation's resource investing and real estate management businesses have dramatically expanded over time.

[17] Ned Goodman is the founder of the opponent Dundee Corporation. He continues to play an active day-to-day role in its businesses and is CEO, President and lead portfolio manager at the opponent Ned Goodman Investment Counsel Limited. He has worked in the investment industry for over 49 years and is “an icon in the Canadian investment and real estate asset management communities.” Canadian media, including *The Globe and Mail* and *National Post*, have reported on his activities since 2001. His association with THE GOODMAN INSTITUTE is described at para. 25 of Mr. Gordon’s affidavit:

Dundee Corporation also owns and licenses the name rights and trade-marks for THE GOODMAN INSTITUTE and THE GOODMAN INVESTMENT INSTITUTE. The Goodman Institute was founded by Ned Goodman, who is also a benefactor and adjunct professor, in 2001 and is run through the John Molson School of Business at Concordia University. The Goodman Institute operates out of Toronto and Montreal offering programs that award combined MBA and CFA accreditation. The school draws business professionals, generally with some business experience, and provides a “real-world” approach to learning investing strategies, investor psychology and business ethics . . .

Roxana Tavana

[18] Ms. Tavana identifies herself as Vice President, Legal & Secretary of the opponent Goodman & Company. Her evidence is generally confirmatory of Mr. Gordon’s evidence.

[19] In addition, she states that, as of February 1, 2011, the corporate holdings of the opponent Dundee Corporation changed when Goodman & Company (at that time closely held by Dundee) was acquired by the Bank of Nova Scotia. Goodman & Company continued to carry on business in association with GOODMAN formative marks under license from Dundee during a phase-out period following the acquisition.

[20] From my reading of Ms. Tavana’s transcript of cross-examination, it is apparent that after the acquisition of Goodman & Company by BNS, Dundee no longer exercised the requisite degree of control over the character or quality of Goodman & Company’s services for the

licensing agreement to comply with s.50(1) of the *Trade-marks Act*. Accordingly, any use of GOODMAN-formative marks by Goodman & Company after February 1, 2001 did not inure to the benefit of Dundee Corporation and lessened the distinctiveness of the GOODMAN-formative marks. However, in my view nothing turns on the lessened distinctiveness of the GOODMAN-formative marks; it is not a critical surrounding circumstance which is determinative of any of the grounds of opposition.

Mary Noonan

[21] Ms. Noonan identifies herself as a trade-marks searcher employed by the agents for the opponents. Her affidavit serves to introduce into evidence, by way of an exhibit, particulars of 29 extant trade-mark registrations and applications (mostly registrations) “containing the element GOODMAN that were owned by Dundee Corporation.” Her cross-examination adds nothing of probative value.

APPLICANT’S SUBMISSIONS ON THE OPPONENTS’ EVIDENCE

[22] A portion of the applicant’s submissions concerning the use of the opponents’ GOODMAN-formative marks are found at paras. 16 and 62-65 of its written argument, reproduced below:

16. Exhibit HG-20 contains printouts of sample pages from the Dundee Real Estate Asset Management (DREAM) website located at www.dream.com and Dundee REIT website located at www.dundeereit.com summarizing the respective roles of each. It appears that none of the services which relate to the management of real estate-related assets have any connection to the trademark or trade name GOODMAN (but instead are related to the trademarks or trade names DUNDEE and DREAM). Further, DREAM (Dream Unlimited Corp.) is a separate corporate entity. The scope of its business includes Dundee REIT (now Dream Office REIT). Accordingly, any services which may relate to the management of real estate are not provided by the Opponents and do not relate to any relevant mark.

.....

62. The word GOODMAN is the surname of Mr. Ned Goodman, the founder, President and CEO of Dundee Corporation, the trademark owner. Mr. Goodman has been involved in the financial and investment industry for over four decades.

63. The Opponents have adduced evidence to show use of the Opponents' GOODMAN-formative trademarks and/or the Opponents' Trade names in association with services related to the offering of mutual funds . . . the Opponents are trying to make a connection between "Goodman & Company" and/or "Goodman & Company, Investment Counsel Ltd." and real estate. However . . . to the extent that there is any connection between the Opponents' GOODMAN-formative trademarks and/or the Opponents' Trade names and real estate, it is only with respect to the sales of mutual funds, which is a very tenuous connection. (emphasis added)

64. . . . the Opponents, and related companies, are primarily in the business of providing mutual funds. The mutual fund services provided by the Opponents are unrelated to the Applicant's services, which pertain to the development and management of real estate.

65. Moreover, none of the Opponents' services which relate to real estate-based mutual funds are associated with any of the relevant marks. Rather, those services are associated with the trademark or trade name DYNAMIC and/or DYNAMIC FUNDS and not with any of the Opponents' GOODMAN-formative trademarks and/or the Opponents' Trade names . . .

[23] I agree with the applicant that the opponents' evidence does not establish that the opponents have provided any services, under the mark or trade-name GOODMAN, or any other of the opponents' GOODMAN formative marks or trade-names, that are explicitly related to the management of real estate, i.e., to services that would overlap with the applicant's services.

APPLICANT'S EVIDENCE

Samira Ali

[24] Ms. Samira identifies herself as a private investigator. In the summer of 2013 she reviewed websites for, and made telephone calls to, businesses having GOODMAN as an element of their company name. Her evidence is sufficient to establish that the following businesses were operating at the time of her investigation:

- BUSCEMI GOODMAN LEGAULT INC.: The firm provides insurance and financial planning services in Montreal and has been doing so for about 25 years.

- BEUTEL, GOODMAN & COMPANY LTD.: The firm provides investment management services in Toronto and has been doing so since about 1967. A division of the firm which operates under the name Beutel, Goodman manages Funds Inc.
- GOODMAN BROWN FINANCIAL: The firm provides financial planning services in St. Catharines and in Fonthill, Ontario.
- GOODMANS LLP: The firm is a law firm which provides legal services. It has two offices, one in Toronto and one in Vancouver.

[25] Ms. Samira's transcript of cross-examination adds little of probative value.

Anick Desautels

[26] Ms. Desautels identifies herself as a Research Analyst employed by a division of Thomson Reuters Canada Limited. She performed a search to ascertain the extent to which the word "Goodman" appears in trade-marks, trade-names and company names in Canada. The search had three components namely, official business name registers (the "common law" search); several Internet search engines (the "web common law" search); and a domain name search. She also conducted a second computerized search for telephone numbers of people in Canada with the surname "Goodman." The results of her searches are attached as exhibits to her affidavit.

[27] From my review of the exhibit materials, I conclude that there is a plethora of companies operating in Canada having the component "Goodman" as part of the company name, which companies offer a very diverse range of wares and services.

[28] The opponents' summary of Ms. Desautel's findings, with which I agree, is found at para. 64 of their written argument:

63. The following three material observations emerge from Ms. Desautels search results:

(a) Goodman is a common surname in Canada. Ms. Desautels' search of the telephone directory revealed more than thirteen hundred (1300) entries for Goodman as a surname in Canada. The number of entries was artificially limited to 1300, as only the first 50 pages of the telephone listings were printable in the source used by Ms. Desautels.

(b) In all, or virtually all identified instances where the word Goodman is purportedly used as part of a trademark, trade name or business name, the circumstances make it reasonable to conclude that the word "Goodman" is a reference to an individual with that surname who is or was associated with the identified business.

(c) There is no evidence of use of the applied-for mark in Canada.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

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

[29] Section 30(i) of the *Trade-marks Act* requires the applicant to include a statement, in the application to register the applied-for mark, that the applicant is satisfied that it is entitled to use the trade-mark in Canada.

[30] Non-compliance with s. 30(i) can be found in two general situations. The first is where there are exceptional circumstances such as bad faith which render the applicant's statement that it is satisfied that it is entitled to use the applied-for mark untrue: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155 (TMOB); *Cerverceria Modelo, S.A. de C.V. v. Marcon*, (2008), 70 C.P.R. (4th) 355 at 369 (TMOB). The second is where there is a *prima facie* case of non-compliance with a federal statute such as the *Copyright Act R.S.C. 1985, c. C-42*, *Food and Drugs Act, R.S.C. 1985, c. F-27* or *Canada Post Corporation Act, R.S.C. 1985, c. C-10*: see *Interactiv Design Pty Ltd. v. Grafton-Fraser Inc.*, (1998), 87 CPR (3d) 537 at 542-543 (TMOB).

[31] The applicant's actual or deemed awareness of the opponents' trade-marks, or of Ned Goodman, does not preclude the applicant from making a *bona fide* statement of entitlement to use the applied-for mark: see, for example, *National Research Council of Canada v Randox Laboratories Limited*, 2008 CanLII 88650 (CA TMOB); *1772887 Ontario Limited v Registrar of Trade-marks*, 2010 FC 645 at para. 14.

[32] In view of the above, the first ground of opposition is rejected because the opponents have not pleaded any material facts to support a s.30(i) ground of opposition.

Second and Fourth Grounds (b and d): registrability pursuant to s.12(1)(a) and non-compliance with s.9(1)(k), respectively

[33] The second ground alleges that the applied-for mark GOODMAN is “primarily merely” the name or surname of Mr. Gregory Goodman. The short answer to this allegation is that there is no evidence to support it. Further, as noted by the applicant in its written argument, the allegation is inconsistent with the allegation in the fourth ground of opposition (denoted by (d) in para. 9 above) that the applied-for mark GOODMAN so nearly resembles “as to be likely to be mistaken for a matter that may falsely suggest a connection with any living individual, namely, Mr. Ned Goodman.”

[34] In order for the opponents to succeed on the fourth ground, the opponents must establish that Ned Goodman had so significant a reputation (at the material date which is the date of my decision) among the general public such that the applied-for mark GOODMAN would suggest a connection with him. However, based on the opponents’ evidence, I am only prepared to find that Ned Goodman had at all material times acquired a reputation in Canada mainly limited to those professionally involved in the mutual funds and financial investing businesses. In this regard, I agree with the applicant’s submission at para.120 of its written argument that “the Opponents have fallen well short of standard to establish that there is a Canadian public awareness of a person named Ned Goodman, let alone that such awareness reaches a level of a significant public reputation in Canada.” The fourth ground of opposition is therefore rejected.

Third, Fifth and Sixth Grounds(c,e,and f): registrability pursuant to s.12(1)(d) and entitlement to registration pursuant to s.16(3)(a) and 16(3)(c), respectively

[35] The above mentioned grounds of opposition are based on the issue of confusion between the applied-for mark GOODMAN and the opponents’ GOODMAN-formative marks (registered and unregistered) and trade-names, respectively. The material dates to assess the issue of

confusion are the date of my decision in respect of the third ground of opposition based on s.12(1)(d); and the priority date of filing of the subject application (August 23, 2017) with respect to the fifth and sixth grounds based on s.16(3)(a) and s.16(3)(c), respectively. As the component GOODMAN forms the dominant constituent of the opponents' marks and trade-names, while the remaining elements consist of fairly descriptive words and phrases, I will consider that use of each of the marks and trade-names relied on by the opponents is equivalent to use of the mark and trade-name GOODMAN *per se*. For the purpose of deciding the issues of confusion and distinctiveness, I will therefore refer to various marks and trade-names relied on by the opponents simply as GOODMAN.

Determinative Issue and Legal Onus

[36] Consequently, the determinative issue for decision with respect to the above grounds of opposition is confusion between the applied-for mark GOODMAN and the opponents' mark GOODMAN, that is, whether purchasers of the applicant's various real estate services, provided under the mark GOODMAN, would believe that those services were offered or authorized or licensed by the opponents who provide mutual fund sales and management services under the identical mark (and trade-name) GOODMAN. In this regard I agree with the applicant's submissions concerning the approach to be taken in evaluating the opponents' services, at para. 102 of the applicant's written argument:

102. The Opponents services are described as "investment management services," which is ambiguous. Accordingly, the other services listed in the Opponents' Registered Trademarks in conjunction with the actual marketplace activities must be looked at to determine the type and appropriate scope of business of the Opponents. In looking at the Opponent's Registered Trademarks together with the evidence submitted by the Opponents, it is clear that "investment management services" means services related to the offering of mutual funds.

[37] Authority for the approach taken in quoted para. 102 above is found in *McDonald's Corp v Coffee Hut Stores Ltd.* (1966), 68 CPR(3d) 168 at 169 (FCA). I note that I have made a similar, related finding in para. 23 above.

[38] 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 between the marks in issue.

Test for Confusion and Factors for Assessing Confusion

[39] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks (or a mark and a trade-name) are confusing, are “all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks (or trade-names) and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks (or trade-names) or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

First and Second Factors: inherent and acquired distinctiveness; length of time in use

[40] The mark GOODMAN possesses little inherent distinctiveness because it would be perceived as the surname of a person being used to identify services from a particular source. The inherent distinctiveness of the mark GOODMAN is further lessened owing to the evidence pointing to a surfeit of businesses, including those offering financial services, having the component GOODMAN as part of their trade-name. Based on the opponents’ evidence I am prepared to find that its mark GOODMAN had, at all material times, acquired a significant reputation in the area of mutual fund services. The applied-for mark is based on proposed use and there is no evidence that it acquired any reputation at any material time. The first factor, which is the combination of inherent and acquired distinctiveness, therefore favours the

opponents. The second factor also favours the opponents as Goodman & Company, Investment Counsel Ltd. has been using the mark GOODMAN since 1985 while there is no evidence that the applicant has commenced use of the applied-for mark.

Third and Fourth Factors: the nature of the services or business; the nature of the trade

[41] These factors have been discussed previously. A brief summary of these factors, with which I agree based on my review of the evidence of record, is found at 89-91 of the applicant's written argument, shown below:

89. . . . the evidence filed by the Opponents' is primarily in relation to use of the Opponents' GOODMAN-formative trademarks and/or the Opponents' Trade names in the field of providing mutual fund services and related investment management services, and more specifically, the management of investment funds (i.e. mutual funds). The Applicant's application, on the other hand, describes services in the field of real estate development and management.

90. While the Opponent, Dundee Corporation, claims to be actively involved in real estate asset management in Canada for many years, the Opponents' evidence with respect to its GOODMAN-formative trademarks and/or the Opponents' Trade names does not support this statement. Certainly, the offering of mutual funds does not qualify as "real estate asset management" (even if the mutual funds have a connection to real estate).

91. In this regard, an important distinction must be emphasized. Even if Dundee Corporation or any of the other Opponents may be involved in the management of real estate (which is not admitted), there is no connection between any of the Opponents' GOODMAN-formative names or marks and the management of real estate . . .

[42] Consequently, the third and fourth factors favour the applicant.

Fifth Factor: degree of resemblance

[43] As discussed in para. 35 above, for the purposes of the analysis of confusion I consider the parties' marks to be identical. The fifth factor therefore strongly favours the opponents.

JURISPRUDENCE CONCERNING WEAK MARKS

[44] In *Handi-Foil Corporation v. Sunbeam Products Inc.* 2014 TMOB 35 (CanLII), 2014 TMOB 35 this Board considered whether the applied-for mark COOK & CARRY, filed on the basis of proposed use in Canada for “portable heated casseroles” was confusing with the opponent’s mark COOK-N-CARRY used in association with “storage containers formed of aluminum foil with plastic lids.”

[45] The Board discussed the importance of the degree of resemblance in relation to weak marks, that is, marks of low inherent distinctiveness, as follows:

The marks COOK-N-CARRY and COOK & CARRY resemble each other to a very high degree visually, are essentially identical in sounding and are entirely identical in ideas suggested. The fifth factor therefore strongly favours the opponent. However, it appears that in cases involving inherently weak marks the fifth factor in s.6(5), that is, resemblance, becomes a less important factor and the other factors - acquired distinctiveness, length of time in use, the nature of the wares/services and the nature of the trades - assume greater importance; further, the ambit of protection accorded to descriptive marks is narrow . . . (emphasis added)

[46] In *AIL International Inc. v Canadian Energy Services L.P.*, 2017 TMOB 2 (CanLII), this Board considered whether the applied-for mark SUPERCORR, filed on the basis of use and registration in the United States of America in association with a corrosion inhibiting protective coating for use in petroleum extraction was confusing with the opponent’s mark SUPER-COR used in association with corrugated drain pipe.

[47] At para. 45 of its decision, the Board considered the applicant’s submissions that:

There is considerable case law establishing that even identical trade-marks may coexist when used in association with different wares and services and in different areas of trade. For example in *Bridgestone Corp. v. Campagnolo S.R.L.* 2014 FC 37, 117 C.P.R. (4th) 1, the Federal Court found that the identical marks POTENZA and POTENZA were not confusing. In this case, the Federal Court refused an appeal of a decision of the Trade-mark Opposition Board (the “TMOB”) that rejected the ground of opposition based on s.12(1)(d). The Court upheld the TMOB's decision that the mark POTENZA used in association with various

bicycle parts and accessories, specifically excluding tires, wheels, and rims, was NOT confusing with the Opponent's mark POTENZA registered in association with tires, tubes and wheels. While the Opponent was an automotive manufacture and part of the Court's reasoning centered around the fact that the parties' respective statements of services must be read with a view to determining the probable types of business or trade in which the goods would be sold, the Court ultimately held that the TMOB's decision was reasonable . The Court found that despite the marks being identical (and factors 6(5)(a), (b), and (e) favoring the Opponent): (i) the nature of the respective goods were fundamentally distinct; (ii) the channels would not overlap due to the specialized nature of the goods; and (iii) due to the level of sophistication of the purchasers of the Applicant's goods they would likely know the difference between a Campagnolo and Bridgestone bicycle tires if Bridgestone was ever eventually to sell bicycle tires in Canada . . .

Disposition of Third, Fifth and Sixth Grounds

[48] In the instant case, the opponents' mark GOODMAN possesses a very low degree of inherent distinctiveness. Although the mark has acquired distinctiveness, in my view it has not acquired so high a degree of distinctiveness with the general public as to substantially broaden the scope of protection accorded to an inherently weak mark. Further, in the instant case, as in *Bridgestone Corp.* above, the parties' services are fundamentally distinct, the channels of trade would not overlap owing to the specialized nature of the services, and some level of sophistication may be expected from the purchasers of the applicant's services.

[49] I therefore find that, at all material times, the applied-for mark GOODMAN and the opponents' GOODMAN-formative marks (registered and unregistered) and trade-names are not confusing. The third, fifth and sixth grounds of opposition are therefore rejected.

Remaining Grounds(g,h,i) - distinctiveness

[50] The remaining grounds of opposition allege that the applied-for mark GOODMAN is not adapted to distinguish the applicant's services from the services of the opponents. The material time to assess the issue of distinctiveness is the date of opposition, in this case February 28, 2011. The bases on which the allegation of non-distinctiveness is made are confusion between the parties' marks and a false association of the applicant's services with Ned Goodman.

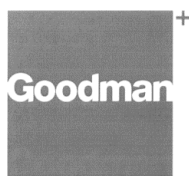
However, the evidence does not support a finding of confusion at the material date February 28, 2011 any more than at the material dates discussed at para. 35 above.

[51] In my view the grounds of opposition alleging non-distinctiveness based on a false association with Ned Goodman are not properly pleaded as they are derivative of the fourth ground of opposition: see para. 9(d) above. In any event, the allegation of non-distinctiveness is based on a material fact which is no more supported by the evidence at the material date February 28, 2011 than at the material date for the fourth ground of opposition discussed in para. 34 above.

[52] In view of the foregoing, the grounds of opposition alleging non-distinctiveness of the applied-for mark GOODMAN are rejected.

APPLICATION 1,355,705 for GOODMAN & Design

[53] The trade-mark application for GOODMAN & Design, shown below, consists of the word Goodman in white block lettering centered within a dark square background, with the mathematical symbol for “add” appearing in diminutive form to the right of the upper right corner of the dark square.



[54] The opposition to the above application is entirely analogous to the '707 opposition decided above. In this respect, the '705 and '707 applications cover the same services and have the same basis for registration; the evidence of record, the grounds of opposition and the material dates are the same for both oppositions. It follows that the same considerations apply with the result that each of the grounds of opposition are rejected for the same reasons discussed in the '707 opposition.

DISPOSITIONS for Applications 1,355,707 and 1,355,705 for GOODMAN and GOODMAN & Design, respectively

[55] In view of the foregoing the oppositions to applications 1,355,707 and 1,355,705 for the marks GOODMAN and GOODMAN & Design, respectively, are rejected.

[56] These decisions have 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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2017-6-29

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