



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 129
Date of Decision: 2020-11-23

IN THE MATTER OF AN OPPOSITION

Citigroup Inc.	Opponent
and	
City Credit Solutions Inc.	Applicant
1,773,311 for City Credit Logo	Application

INTRODUCTION

[1] Citigroup Inc. (the Opponent) opposes registration of the trademark City Credit Logo (the Mark), which is the subject of application No. 1,773,311 by City Credit Solutions Inc. (the Applicant). The Mark includes a colour claim and is shown below:

CityCredit

Colour is claimed as a feature of the trade-mark. The colour royal blue (Adobe RGB: 52 58 142) is claimed as a feature of the mark. The colour picton blue (Adobe RGB: 105 172 226) is claimed as a feature of the mark.

[2] The Mark is applied for in association with the following goods and services:

Goods

(1) Key chains

(2) Calendars; felt tip markers; highlighter pens; highlighting markers; office paper stationery; pencils; pens; postcards; posters

(3) Hats; sweaters; t-shirts.

Services

(1) Credit counselling and administrative services; financial consulting services; consumer proposal counselling and administrative services; debt counselling services; debt consolidation services; bankruptcy counselling services;

(2) Debt advisory services; debt management services.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's CITI trademarks previously used and registered in association with similar goods and services.

THE RECORD

[4] The application for the Mark was filed on March 21, 2016 on the basis of proposed use in Canada.

[5] The application was advertised for opposition purposes on November 23, 2016.

Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. As the application was advertised prior to June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[6] On April 24, 2017, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on sections 30(b), 30(e), 30(i), 12(1)(d), 16(3), and 2 of the Act.

[7] The Applicant submitted a counter statement denying each of the grounds set out in the statement of opposition. The content of the counter statement is discussed further below.

[8] In support of its opposition, the Opponent submitted the affidavit of Troy Underhill, sworn December 11, 2017 in Toronto, Ontario [the Underhill Affidavit].

[9] In support of its application, the Applicant submitted the affidavit of Sukhbir Singh, sworn April 5, 2018 in Toronto, Ontario [the Singh Affidavit].

[10] Neither affiant was cross-examined. Only the Opponent submitted written representations and was represented at an oral hearing.

[11] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

[12] The Underhill Affidavit provides an overview of the Opponent's business and its use of its CITI trademarks and CITIGROUP trade name worldwide and in Canada. It can be summarized as follows:

- Mr. Underhill is a director for Citibank Canada, a subsidiary of the Opponent [para 1].
- The Opponent is a financial services company, with its predecessors, affiliates and subsidiaries operating across Canada since 1919 [paras 5 to 9].
- The Opponent operates under the CITI brand and its principal trademarks include CITI and the CITI logo (shown below) [paras 10 and 11]:



- The CITI brand includes various CITI-prefixed trademarks, including CITIBANK, CITIFINANCIAL, CITI VELOCITY, and CITIDIRECT [para 12].
- The Opponent has granted licences to its affiliates and subsidiaries to use its CITI marks in Canada in association with various financial products and services [paras 12 and 13].
- The CITI trademark and CITI logo have been used extensively in Canada in association with, *inter alia*, credit card services [paras 14, 15 and 22, Exhibits 1 and 6]; banking and investment services [paras 16 to 18, Exhibit 2]; and prepaid card services [para 23, Exhibits 7 and 8].
- The CITIDIRECT trademark has been used extensively in Canada in association with online financial services [paras 19 to 21].

- The CITI VELOCITY trademark has been used in Canada in association with cash management services [para 20].
- The Opponent’s licensee, CitiFinancial Canada, has been providing community lending services in Canada for over 15 years in association with the CITI brand, in particular the CITIFINANCIAL trademark. As of the filing date of the opposed Mark, CitiFinancial had over 200 branches across Canada, with over 1300 employees and more than 250,000 customers [paras 25 to 27].
- In association with the CITI brand, the Opponent and its subsidiaries/licensees have sponsored various charitable causes and events in Canada [paras 28 and 34].
- The Opponent and its licensees have significant advertising expenditures, estimated at over \$3 million annually in Canada [para 35].
- Exhibit 11 includes copies of letterhead, business cards and account statements showing various CITI marks and names, including the CITI logo and CITIGROUP trade name [para 36].
- The Opponent and its subsidiaries/licensees have a significant online presence, including websites and on social media platforms [paras 37 to 40].

OVERVIEW OF THE APPLICANT’S EVIDENCE

[13] The Singh Affidavit is brief and can be summarized as follows:

- Mr. Singh is the sole officer, director and manager of the Applicant [para 1].
- The Applicant is an Ontario company that provides services to individuals and businesses “in relation to debt and credit counselling, the insolvency process and related counselling services” [paras 2 and 3].
- The Mark is used by the Applicant to promote its business “on various promotional and related materials” [para 4].

- Mr. Singh asserts that the Mark “is in no way materially similar or confusing with [the Opponent’s trademarks] in word, design or otherwise” and that he has never had a client or other person indicate to him that they perceived the Applicant to be in any way related to the Opponent “for any reason whatsoever” [para 5].

EVIDENTIAL BURDEN AND LEGAL ONUS

[14] Before considering the grounds of opposition, it is necessary to review the basic requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[15] With respect to (i), 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 [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (FCTD) at para 11]. 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.

[16] With respect to (ii), the legal onus is on the applicant to show that the application does not contravene the provisions of the 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 has been considered, then the issue must be decided against the applicant.

SECTION 12(1)(D) – CONFUSION WITH OPPONENT’S REGISTERED TRADEMARKS

[17] The Opponent pleads that the Mark is not registrable in that, contrary to section 12(1)(d) of the Act, at all relevant times, the Mark was and is confusing with the Opponent’s registered CITI trademarks.

[18] The material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA) at para 18].

[19] Attached to the statement of opposition is a table showing 21 trademarks owned by the Opponent, all registered in association with a variety of finance or investment-related services.

[20] I have exercised my discretion and have checked the register to confirm that 20 of these registrations are extant [per *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[21] The first of these registrations is for the trademark CITI (TMA871,950). The second is for the CITI logo (TMA711,155), shown above in the evidence summary. The remaining 18 registrations are for trademarks that incorporate the prefix CITI, such as CITIBANK (TMA150,890) and CITI MATCH (TMA876,984).

[22] As the Opponent has met its evidential burden in respect of this ground of opposition for each of the extant registrations, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and any of those registered trademarks.

[23] In the present case, I note that the nature of the Opponent's trademarks and the supporting evidence necessarily results in some overlap in the analysis and consideration of the surrounding circumstances. However, under this ground, the Opponent's trademarks must be reviewed individually and not collectively for the purpose of assessing the likelihood of confusion with the Applicant's Mark. As discussed below, however, the Opponent's family of CITI trademarks is a relevant surrounding circumstance.

[24] As such, I will begin my analysis with the Opponent's CITI trademark (TMA871,950); as noted by the Opponent at the hearing, this trademark represents the Opponent's strongest case.

[25] The CITI trademark is registered in association with the following goods and services:

Goods

Computer software for facilitating financial investment, trade execution and foreign exchange services; computer software for allowing customers to transact debit and credit related financial business; computer hardware for use in the banking and financial services industry; and computer software for allowing customers to transact banking and financial business.

Services

Promoting the goods and services of others through credit card and financial service customer loyalty, reward and redemption programs; promoting the sale of credit card accounts through the administration of incentive award programs; credit card user loyalty and reward programs, namely providing cash and other rebates for credit card use; financial services, namely, banking; credit card; commercial and consumer lending and financing; trust, estate, and fiduciary management, planning and consulting; securities and fund investment and investment advisory consulting services; securities brokerage and trading services for others; underwriting services in connection with financial matters; facilitating secure financial transactions, namely, electronic funds transfers, electronic cash transactions, electronic credit card transactions, electronic bill payment, and electronic debit transactions; providing online interactive news and information in the banking and financial industries provided via a global computer network.

(2) Monitoring consumer credit reports and providing notifications as to changes therein; providing credit consultation and inquiry services; providing information on credit education.

(3) Financial services - namely, extending consumer and industrial loans to others; factoring services; credit card servicing and the purchasing and servicing of consumer receivables associated therewith; commercial lending; servicing loans and extensions of credit; real estate lending; mortgage financing and mortgage servicing; investment advisory and financial advisory services; providing venture capital to others.

Test to Determine Confusion

[26] The test to determine the issue of confusion is set out in section 6(2) of the Act, which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[27] This test is a matter of first impression in the mind of a casual consumer “somewhat in a hurry” who sees the Mark in association with the applied-for goods or services at a time when they have no more than an imperfect recollection of the Opponent’s trademark and does not

pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[28] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[29] The criteria in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to first consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66].

Degree of Resemblance

[30] I agree with the Opponent that the first portion of the applied-for Mark, “City”, is also the most striking element given that “Credit” is suggestive of the Applicant’s credit counselling-related services and that the design elements are somewhat minor. This important first portion of the Mark is identical to the Opponent’s CITI trademark when sounded and has a high degree of resemblance in appearance, notwithstanding the particular design elements of the Mark. To the extent that a consumer may view CITI as a variant spelling of “city”, the trademarks also have resemblance in the idea suggested.

[31] As such, in particular with respect to the degree of resemblance in appearance and when sounded, this important factor favours the Opponent.

Inherent Distinctiveness and the Extent Known

[32] Both trademarks have some degree of inherent distinctiveness in relation to the relevant financial and counselling services; however, there is merely an assertion in the Singh Affidavit that the Mark has become known in Canada to any extent.

[33] In contrast, I agree with the Opponent that the evidence shows that its CITI trademark has become well-known in Canada through the business, promotional, and charitable activities of the Opponent and its related companies [Opponent's Written Representations at para 37].

[34] As such, this factor strongly favours the Opponent.

Length of Time in Use

[35] With respect to the Mark, the length of time in use is at best unclear. The Opponent submits that the Applicant's counter statement includes an "admission" that the Mark has been in use since the filing date of the application [Opponent's Written Representations at para 39, referring to paragraphs 1a, 1b and 1c of the counter statement, discussed further below]. The Singh Affidavit itself merely indicates that the Mark was already in use when the affidavit was sworn on April 9, 2018.

[36] In any event, the evidence shows that the Opponent's CITI trademark has been used in Canada in association with financial services generally since at least as early as 1998 [Underhill affidavit at para 7] and in particular in association with credit card services since at least as early as 2004 [para 15].

[37] Accordingly, this factor strongly favours the Opponent.

Nature of the Goods, Services or Business / Nature of the Trade

[38] When considering the nature of the goods and services of the parties in respect of the issue of confusion, it is the statements of goods and services in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749, 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA) at paras 24-25].

[39] At a minimum, the Opponent's registered services and the Applicant's applied-for services are in the nature of financial services. In particular, the Opponent's services include various "credit" and "loan" services, and the application includes various counselling services related to such. Accordingly, I agree with the Opponent that there "is clear overlap between the Opponent's business and services and the Applicant's business and services" [Opponent's Written Representations at para 41].

[40] Furthermore, while the Opponent's registration does not include "key chains" or the like as found in the application for the Mark, the applied-for goods appear to be merely in the nature of promotional items relating to the Applicant's business.

[41] Accordingly, I find that these factors favour the Opponent, with respect to both the applied-for services and the applied-for goods.

Additional Surrounding Circumstance - Family of CITI marks

[42] Where there exists a family of trademarks, there may be a greater likelihood that the public would consider a similar trademark to be another trademark in the family and, consequently, assume that the good or service that is associated with that trademark is manufactured or performed by the owner of the family of trademarks. There is, however, no presumption of the existence of a family of trademarks in opposition proceedings. A party seeking to establish a family of trademarks must establish that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 145 FTR 59 (FCTD), aff'd (1999), 3 CPR (4th) 298 (FCA); and *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB) at para 35].

[43] In this case, I agree with the Opponent that the Underhill Affidavit shows use of various CITI-prefixed trademarks in association with financial services in Canada, constituting a family of trademarks along with the CITI trademark and the CITI logo. This family includes CITI VELOCITY [Underhill Affidavit at para 19], CITIDIRECT [para 20], CITIFINANCIAL [para 25] and CITIBANK [para 36].

[44] Accordingly, I find this to be a relevant surrounding circumstance that favours the Opponent.

Additional Surrounding Circumstance – No evidence of actual confusion

[45] As indicated above, Mr. Singh attests that, “I have never had a client or other person indicate to me that ... they perceived [the Applicant] to be related in any way to [the Opponent] or its related entities for any reason whatsoever” [Singh Affidavit at para 5].

[46] Since the Applicant did not furnish any evidence with respect to the extent and period of use of the Mark, I cannot draw any meaningful conclusion with respect to the absence of confusion. In the absence of evidence showing that the parties’ services did in fact co-exist in the marketplace, the absence of evidence of actual confusion is not surprising.

Conclusion – Confusion with the trademark CITI

[47] As mentioned above, the degree of resemblance between the parties’ marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties’ services and the parties’ channels of trade are the same or overlapping, as in this case [see *Reynolds Consumer Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119, 111 CPR (4th) 155 at paras 26-30].

[48] Having considered all of the surrounding circumstances and applying the test for confusion as a matter of first impression and imperfect recollection, I conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between the Mark and the Opponent’s CITI trademark in association with the applied-for goods and services. I conclude this based on the degree of resemblance between the trademarks, the nature of the goods and services, and the overlap in the nature of the businesses and trade in view of the evidenced use and extent known of the Opponent’s CITI trademark and its family of CITI trademarks.

[49] Accordingly, this ground of opposition based on section 12(1)(d) of the Act is successful.

SECTION 16 – NON-ENTITLEMENT

[50] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark in that, contrary to sections 16(3)(a), 16(3)(b) and 16(3)(c) of the Act, as of the date of filing the application and at all relevant times, the Mark was and is confusing with:

- the CITI trademarks, in word and design form, previously used or made known in Canada by the Opponent;
- the CITI trademarks in respect of which applications Nos. 1,648,265 and 1,648,260 for registration had been previously filed by the Opponent; and
- the Opponent's trade names including CITI and CITIGROUP, previously used in Canada by the Opponent.

[51] As noted above, attached to the statement of opposition is a table that includes 20 extant registered trademarks owned by the Opponent, all registered in association with a variety of finance or investment-related services. While the Opponent did not furnish evidence of use for all of these trademarks, as described above, it did submit evidence of use with respect to the CITI trademark, the CITI logo and some other CITI-prefixed trademarks.

[52] As above, I will focus the non-entitlement analysis on the Opponent's CITI trademark, as it represents the Opponent's strongest case.

[53] To meet its initial burden with respect to a section 16(3)(a) ground of opposition based on prior use of a trademark, the Opponent must demonstrate use of its previously-used trademark in Canada prior to the material date, March 21, 2016 (the filing date of the subject application). The Opponent must also show that it had not abandoned its trademark as of the advertisement date, namely, November 23, 2016 [per section 16(5) of the Act]. In view of my findings above, I am satisfied that the Opponent has met its initial burden to show prior use of its CITI trademark and, further, that the trademark had not been abandoned.

[54] Therefore, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's CITI trademark.

[55] However, notwithstanding the earlier material date, my findings above with respect to confusion largely apply here as well.

[56] Accordingly, this ground of opposition based on non-entitlement is successful. As such, I do not consider it necessary to further consider the pleadings related to sections 16(3)(b) and 16(3)(c) of the Act.

SECTION 2 – NON-DISTINCTIVENESS

[57] The Opponent pleads that the Mark is not distinctive of the Applicant in that, as of the date of filing of the application and at all relevant times, including the date of opposition, the Mark does not distinguish nor is it adapted to distinguish the goods and services of the Applicant from the goods and/or services of the Opponent sold, performed and/or advertised in Canada by the Opponent in association with the CITI trademarks, in word and design form, which were previously used and/or made known in Canada.

[58] The material date for a ground of opposition based on non-distinctiveness is the filing date of the opposition, namely, April 24, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 at para 25].

[59] Section 2 of the Act, as it then was, defined “distinctive” as follows:

distinctive, in relation to a trademark, means a trademark 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.

[60] A trademark “actually distinguishes” by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is “adapted so to distinguish” is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[61] In *Suzanne’s Inc v Auld Phillips Ltd*, 2005 FCA 429, in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that “Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result” [at para 7].

[62] Accordingly, first, in order to meet its evidential burden with respect to this ground, the Opponent must show that its CITI trademarks had a substantial, significant or sufficient

reputation in Canada in association with the relevant goods and services [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at para 34; see also *Navsun Holdings Ltd v Sadhu Singh Handrad Trust*, 2020 TMOB 64 at para 40].

[63] In view of my findings above, I am satisfied that the Opponent has shown that its CITI trademarks had a substantial, significant and/or sufficient reputation in Canada in association with the relevant financial and investment-related services.

[64] The Opponent having met its initial evidential burden, the question then becomes whether the Applicant has demonstrated, on a balance of probabilities, that the Mark is distinctive of the Applicant in Canada pursuant to section 2, despite the reputation and use of the Opponent's CITI trademarks [see *Navsun, supra*, at para 41].

[65] In this case, the Applicant has submitted no clear evidence of use of the Mark prior to the material date or otherwise to show distinctiveness in fact. Furthermore, notwithstanding the differing material dates, my findings above with respect to confusion substantially apply here as well.

[66] Accordingly, I am not satisfied that the Applicant has met its legal burden with respect to this ground. It follows that this ground of opposition based on non-distinctiveness is also successful.

SECTIONS 30(B) AND 30(E) – APPLICATION REQUIREMENTS

[67] The Opponent pleads that the application does not conform to the requirements of section 30 of the Act in that, contrary to section 30(b), at the date of filing the application, the Applicant had used the Mark in Canada in association with “debt counselling services” and possibly other counselling services described in the application.

[68] Similarly, the Opponent also pleads that the application does not conform to the requirements of section 30 of the Act in that, contrary to section 30(e), the Applicant has already used the Mark in association with “debt counselling services” and possibly other counselling services described in the application.

[69] Sections 30(b) and 30(e) of the Act, as it then was, stated as follows:

30 An applicant for the registration of a trademark shall file with the Registrar an application containing

...

(b) in the case of a trademark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trademark in association with each of the general classes of goods or services described in the application;

...

(e) in the case of a proposed trademark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

[70] The Registrar has held that an applicant who has already commenced use of the trademark in Canada is not permitted to file its application based on “proposed” use under section 30(e) of the Act but must instead file based on “use” under section 30(b) [see, for example, *Manulife Cassuci Di Caucci Ugo & C Sas v Cassuci Clothes Inc* (1993), 52 CPR 3d 250 (TMOB)]. Section 30(b) of the Act requires an applicant who has already used the trademark in Canada to provide its date(s) of first use with each of the classes of goods or services.

[71] The material date for considering the circumstances with respect to these grounds of opposition is the filing date of the application, namely, March 21, 2016 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[72] To the extent that the relevant facts pertaining to an allegation that a proposed-use trademark was used prior to the filing date are more readily available to the applicant, the evidential burden on an opponent with respect to such a ground of opposition is not onerous [*Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, this burden can be met by reference not only to the opponent’s evidence but also to the applicant’s evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD) (*Labatt Brewing*)].

[73] In this case, the Opponent relies on alleged admissions in the Applicant’s counter statement indicating that use of the Mark had commenced prior to the filing date. For example, paragraph 1a of the counter statement includes the following:

The Applicant denies the Opponent's allegations ... and asserts that the Applicant has used the mark in connection with "debt counselling services" and other counselling services at the time of filing the Application and other relevant times and therefore, such use is not a contravention of subsection 30(b). (underlining added)

[74] Similar statements are made at paragraphs 1b and 1c with respect to the grounds based on 30(e) and 30(i) of the Act, respectively.

[75] At the hearing, the Opponent submitted that such admissions satisfy the Opponent's initial burden and, further, as the Singh Affidavit does not refute such admissions, the Applicant has not satisfied its legal onus under these grounds. The Opponent made an analogy to proceedings in the Federal Court and, with respect to opposition proceedings before the Registrar in particular, cited *Société nationale Elf Aquitaine v Spex Design Inc* (1988), 22 CPR (3d) 189 (TMOB) (*Spex*) as precedent for accepting an admission in counter statement pleadings.

[76] I note that the Registrar has considered *Spex* and the issue of whether alleged admissions in pleadings can satisfy a party's burden only on rare occasions [see, for example, *Les Systèmes de Formation et de Gestion Perform Inc v Patrick Scissons & Micheal Scissons, a joint venture*, 2004 CanLII 71840 (TMOB); *Stravina Operating Company, LLC v DeeJay Jewellery Inc*, 2009 CanLII 90373 (TMOB); and *Elektra Printz Gorski v Henrietta Colleen Prasad*, 2017 TMOB 89 (*Elektra Printz*)]. This rarity will likely continue, especially in view of the recent amendments to the Act regarding the grounds of opposition and the minimum content requirements of counter statements.

[77] In this case, I do not accept that the subject statements constitute an admission by the Applicant resulting in the Opponent meeting its evidentiary burden with respect to these section 30 grounds. In this respect, to the extent that the above-underlined portions of the statement may suggest actual use of the Mark in association with some or all of the applied-for services prior to the filing date, I note the subsequent assertion that any such use was not in contravention of the Act. In my view, for an apparent admission in a counter statement to satisfy an opponent's initial evidential burden, that admission must be clear. I consider such an approach to be more consistent with *Labatt Brewing, supra*, and the evidential burden and legal onus, respectively, of the parties.

[78] In view of the foregoing, these grounds of opposition are rejected as the Opponent has not met its initial evidential burden.

SECTION 30(I) – APPLICATION REQUIREMENTS

[79] Finally, the Opponent pleads that the application does not conform to the requirements of section 30 of the Act in that, contrary to section 30(i), the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the goods and services described in the application because the Applicant knew or ought to have known that the Mark was and is confusing with the Opponent's CITI trademarks previously used or made known in Canada by the Opponent in association with similar goods and services.

[80] Again, the material date for considering the circumstances with respect to this ground of opposition is the filing date of the application, namely, March 21, 2016 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[81] Section 30(i) of the Act, as it then was, merely required that an applicant include a statement in its application that it is satisfied that it is entitled to use its trademark in Canada in association with the goods or services described in the application. Where this statement has been provided, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol Myers Co*, 1974 CarswellNat 476, 15 CPR (2d) 152 (TMOB)]. Mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use its trademark [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197 at para 10].

[82] The application for the Mark contains the statement required under section 30(i) of the Act and there is no evidence that this is an exceptional case.

[83] Accordingly, this ground of opposition based on section 30(i) of the Act is rejected.

DISPOSITION

[84] In view of all of the foregoing and pursuant to section 38(12) of the Act and the authority delegated to me under section 63 of the Act, I refuse the application.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2020-08-12

APPEARANCES

Gervas Wall For the Opponent

No one appearing For the Applicant

AGENTS OF RECORD

Deeth Williams Wall LLP For the Opponent

No agent appointed For the Applicant