



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 138

Date of Decision: 2020-12-11

IN THE MATTER OF AN OPPOSITION

9333-4266 Québec inc.

Opponent

and

Clearsurance, Inc.

Applicant

1,779,348 for CLEARSURANCE

Application

[1] 9333-4266 Québec inc. (the Opponent) opposes an application to register the trademark CLEARSURANCE (the Mark) in the name of Clearsurance, Inc. (the Applicant).

[2] For the reasons that follow, the opposition is rejected.

THE RECORD

[3] The application at issue (the Application) was filed by the Applicant's predecessor in title, Clearsurance, LLC, on April 26, 2016, and accorded serial no. 1,779,348. It is based on proposed use of the Mark in Canada in association with the following services:

(1) Insurance services; providing a website that displays various requests, reviews, recommendations, rankings, trackings, votes, and information relating to insurance transactions and purposes (the Applicant's Services).

[4] The Application claims a priority filing date of October 26, 2015, based on U.S. application no. 86/799,964 filed on that date for the same or substantially the same trademark in association with the same kind of services.

[5] The Application was advertised for opposition in the *Trademarks Journal* on December 21, 2016, and was opposed on February 20, 2017, when the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. Pursuant to the transitional provisions in section 70 of the Act for applications advertised before June 17, 2019, the grounds of opposition in this case will be assessed based on the Act as it read immediately before amendment, an exception being that the definition of confusion in section 6(2) of the Act as it currently reads will be applied.

[6] The opposition is based primarily on the Opponent's allegation that the Mark is confusing with its registered trademarks CLICKINSURANCE and CLICASSURE (the Opponent's Trademarks), used in Canada in association with a web site enabling clients to fill out applications for insurance and financial products and to compare offers from insurers and financial institutions. The specific grounds of opposition are based on sections 12(1)(d), 16(3), and 2 of the Act.

[7] Clearurance, LLC filed a counter statement on April 19, 2017, denying each of the grounds of opposition.

[8] The Opponent filed as its evidence the affidavit of its Vice-President Business Development, Martin Dufour, dated August 16, 2017. In his affidavit, Mr. Dufour explains how the Opponent's Trademarks have been used and promoted in Canada. I note that he also comments on the visual similarity between the trademarks at issue as well as on the Opponent's rights and on the likelihood of confusion; however, as he has not established himself as an expert in trademark law and is not independent of the parties, I have disregarded his opinions on the questions of fact and law to be decided in this proceeding.

[9] Clearurance, LLC filed as its evidence an affidavit of Sarina Nemirov, a Trademark Administrator employed by its agent, dated December 15, 2017. Ms. Nemirov's affidavit

provides extracts from four online dictionaries (*www.dictionary.com*, *www.meriam-webster.com*, *www.vocabulary.com*, and *dictionary.cambridge.org*) that she searched for the keywords CLICK, CLEAR, INSURANCE and ASSURE using the Google search engine on December 12, 2017. In this case, although the affidavit is from an employee of a party's agent, it relates only to non-controversial and non-central matters and is thus admissible [per *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2005 FC 1254, aff'd 2006 FCA 133].

[10] Neither Mr. Dufour nor Ms. Nemirov was cross-examined.

[11] On March 19, 2018, Clearurance, LLC assigned the Application to the Applicant, effective September 19, 2017. The assignment was recorded on April 12, 2018. It is not at issue in this proceeding.

[12] Only the Applicant filed a written argument and was represented at an oral hearing.

EVIDENTIAL BURDEN AND LEGAL ONUS

[13] In opposition proceedings, the legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition should not prevent registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)

[14] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act because, at the Application's filing date, the Mark was confusing and/or was likely to cause confusion with the Opponent's Trademarks, registered under nos. TMA926,111 (CLICKINSURANCE) and TMA926,110 (CLICASSURE) for use in association with the following services (the Opponent's Services):

(1) *Opération d'un site web permettant à des clients de compléter des demandes d'assurance et comparer les offres des assureurs.*

(2) *Opération d'un site web permettant à des clients de compléter des demandes de produits financiers et comparer les offres des institutions financières.*

[TRADEMARKS JOURNAL TRANSLATION:

(1) Operation of a website enabling clients to fill out insurance applications and compare insurer offers.

(2) Operation of a website enabling clients to fill out applications for financial products and compare financial institution offers.]

[15] Certified copies of these two registrations (the Opponent's Registrations) are attached as Exhibits MD-6 and MD-7 to Mr. Dufour's affidavit.

[16] Although the pleading refers to the Application's filing date, the material date for the analysis of a section 12(1)(d) ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. Since this material date is well established by jurisprudence, I do not consider the obvious technical error in the pleading to affect the validity of the ground.

[17] The Opponent's initial burden for this ground is met if at least one of the registrations relied upon is in good standing at the material date. The Registrar has discretion to check the register in this respect [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I confirm that both of the registrations are extant and stand in the name of the Opponent.

[18] The Opponent having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with either of the Opponent's registered trademarks.

The test for confusion

[19] The relevant test for confusion is outlined in section 6(2) of the Act, which stipulates 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 (an international system to classify goods and services for trademark registration).

[20] This test does not concern confusion of the trademarks themselves, but rather confusion as to whether the goods and services associated with each of the trademarks come from the same source. It is described in the following terms by Justice Binnie in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, at paragraph 20:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [applicant’s mark], at a time when he or she has no more than an imperfect recollection of the [opponent’s] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[21] In determining whether trademarks are confusing, regard must be had to all the surrounding circumstances, including those set out in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks 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 trademarks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each of them equal weight [see *Veuve Clicquot, supra*; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Degree of resemblance between the trademarks

[22] As indicated by the Supreme Court of Canada in *Masterpiece, ibid*, in most instances, the degree of resemblance between the trademarks is the most important factor in assessing the likelihood of confusion. The trademarks should be looked at in their totality and assessed for their effect on the average consumer as a whole [see *Veuve Clicquot, supra*; and *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD)]. However, it is still possible to focus on particular features of each trademark that may have a determinative influence on the public’s perception of it [*United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA)]. The preferable approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra* at para 64].

[23] I find that the most striking and unique aspect of the Mark is that it is a coined word that combines the term “CLEAR” with the suffix “SURANCE” to suggest that the Applicant’s Services clarify how to select and buy insurance.

[24] With respect to the Opponent’s Trademarks, given that the portion “INSURANCE” or “ASSURE” is clearly descriptive, I find that “CLICK” or “CLIC”, although suggestive, is the most striking and unique aspect. These trademarks combine the English terms “CLICK” and “INSURANCE” or the French terms “CLIC” (meaning “click”) and “ASSURE” (a form of the verb “*assurer*”, meaning “to insure”) to suggest services for obtaining insurance by “clicking”.

Resemblance between the Mark and CLICKINSURANCE

[25] I find that the Mark and the trademark CLICKINSURANCE are somewhat similar in appearance, in that both consist of a single word starting with “CL” and ending with “SURANCE”, with only a few letters in between.

[26] However, given the phonetic difference between “CLEAR” and “CLICKIN”, I find there to be only a slight similarity when the two trademarks are sounded. I am of the view that these initial syllables will be more influential than the suffix SURANCE on the perception of the trademarks as a whole, given that the first portion of a trademark is generally considered to be the most important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)] and that descriptive or suggestive portions of trademarks tend to have diminished importance [see *Merial LLC v Novartis Animal Health Canada Inc.* (2001), 11 CPR (4th) 191 (FCTD)].

[27] With respect to ideas suggested, I again find the degree of resemblance to be relatively low. In my view, as a matter of first impression on an average consumer of insurance, the Mark would suggest the idea of clarifying insurance, whereas the Opponent’s trademark would suggest the idea of clicking a computer mouse to obtain insurance online. (I appreciate that the word “click” is also related to the concept of “clarity” when used in expressions such as “it all clicked” to mean that everything has suddenly become understandable. However, in the context of the Opponent’s Services, which are provided online, I consider the trademark CLICKINSURANCE more likely to evoke the concept of mouse clicks.)

[28] In the absence of submissions on the perspective of a unilingual Francophone consumer, I do not find that it would increase the degree of resemblance. In the context of the Opponent’s Services, to the extent that “CLICK” resembles its French translation “*CLIC*” and “INSURANCE” resembles the French noun “*assurance*”, I find the trademark CLICKINSURANCE likely to evoke the idea of insurance services that involve clicking. As for the Mark, in the context of the Applicant’s Services, I find CLEARSURANCE also likely to evoke the idea of insurance—perhaps with the added idea of creating “clarity”, since the word “CLEAR” is arguably somewhat similar to its French translation “*claire*”. However, even if no such additional idea is conveyed, the Mark would not convey the idea of “clicking”, whereas that idea constitutes the most striking and unique aspect of the Opponent’s trademark.

[29] Overall, this factor favours the Applicant for the trademark CLICKINSURANCE.

Resemblance between the Mark and CLICASSURE

[30] I find there to be even less similarity between the Mark and the trademark CLICASSURE. Although both trademarks consist of a single word starting with “CL” and share some subsequent letters, their respective endings differ in appearance and when sounded, regardless of the language used. As for the ideas conveyed, given the highly suggestive nature of the SURANCE element and the descriptiveness of the word ASSURE, I consider at least bilingual consumers to be likely to pay more attention to the initial portions of the trademarks and to perceive the Mark as suggesting the idea of clarifying insurance while the Opponent’s trademark suggests the idea of clicking a computer mouse to obtain insurance online. Although “assurance” and “*assure*” can also mean making sure something happens or giving someone confidence that something is true, I find the context of the parties’ services more likely to prompt the more specific idea of insurance.

[31] I consider unilingual Anglophone consumers likely to have a similar perception of the word CLICASSURE. The dictionary definitions attached as exhibits to Ms. Nemirov’s affidavit demonstrate that one meaning of the word “assure” in English is “to insure, as against a loss” (see *e.g.* definition no. 7 from *www.dictionary.com* at page 1 of Exhibit A.4). Although this particular meaning appears to be chiefly British, the word “assure” also means more generally “to pledge or promise; give surety of; guarantee”; “to make (a future event) sure; ensure”; and

“to secure or confirm; render safe or stable” (definitions nos. 3–5, *ibid.*). Given that insurance acts to guarantee, ensure, or secure one’s financial position in the event of a loss, the concepts of insurance and finances in general are also related to these more common meanings of the word “assure”. Furthermore, CLIC is visually and phonetically similar to the English word “click”. Accordingly, I find that if CLICASSURE suggests any idea to a unilingual Anglophone consumer of the Opponent’s Services, it would likely be the idea of clicking to obtain either insurance *per se* or at least some form of *assurance* in the sense of security, particularly financial security. Thus the degree of resemblance would be no greater from an Anglophone perspective.

[32] As for the perspective of the unilingual Francophone consumer, I find that the parties’ respective trademarks would be seen as different, for the reasons set out above in respect of CLICKINSURANCE, with the added comment that the idea of clicking to obtain insurance would be more obvious in the trademark CLICASSURE.

[33] Overall, this factor favours the Applicant for the trademark CLICASSURE as well.

Inherent distinctiveness of the trademarks and the extent to which they have become known

[34] It is well established that trademarks containing descriptive or suggestive words have little inherent distinctiveness and, as such, will be afforded only a minimal degree of protection [*Prince Edward Island Mutual Insurance Co v Insurance Co of Prince Edward Island* (1999), 86 CPR (3d) 342; *Kellogg Canada Inc v Weetabix of Canada Ltd*, 2002 FCT 724]. A greater degree of discrimination may fairly be expected from the public where a trademark consists wholly or in part of words describing the services to be rendered, such that even relatively small differences may be considered sufficient to avert confusion *General Motors Corp v Bellows*, [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL)].

[35] In the present case, the Opponent’s Trademarks are made up of ordinary dictionary words and the Mark begins with an ordinary dictionary word as well. I note in particular the following select definitions and usage example from the *dictionary.cambridge.org* extracts attached as exhibits to Ms. Nemirov’s affidavit:

click:

- to carry out a computer operation by pressing a button on the mouse or keyboard
- to be understood, or become clear suddenly (*Suddenly everything clicked and I realized where I'd met him.*)

clear:

- easy to understand, hear, read, or see

insurance:

- an agreement in which you pay a company money and they pay your costs if you have an accident, injury, etc.

assure:

- to tell someone confidently that something is true, especially so that they do not worry
- to cause something to be certain
- UK (of an organization) to promise to pay an amount of money to a person or their family if that person becomes ill, gets injured, or dies, in return for small regular payments

[36] Although not cited by either party, I also note the following select definitions from the French language dictionary *dictionnaire.lerobert.com*, which provide similar meanings for the nouns “*clic*” (finger pressure on a mouse button) and “*assurance*” (promise; insurance contract) and the verb “*assurer*” (affirming; causing something to be certain; insuring) [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 645, with respect to the Registrar’s discretion to take judicial notice of dictionary definitions]:

clic:

- *Pression du doigt sur le bouton de la souris d'un ordinateur.*

assurance:

- *Promesse ou garantie qui assure qqn de qqch.*
- *Contrat par lequel un assureur garantit à l'assuré, moyennant une cotisation, le paiement d'une somme convenue en cas de réalisation d'un risqué déterminé.*

assurer:

- *Assurer à qqn que, lui affirmer, lui garantir que.*
- *Rendre sûr, certain, durable ; mettre à l'abri des accidents, des risques.*
- *Garantir par un contrat d'assurance.*

[37] Since the Opponent’s Trademarks combine ordinary dictionary words to suggest an aspect of the Opponent’s Services—being the operation of a website where users click to fill out applications and receive offers for insurance—the Opponent’s Trademarks have only a low degree of inherent distinctiveness. I do not find that presenting the two verbal elements as a single word increases the level of distinctiveness to any significant extent.

[38] The Mark combines an ordinary dictionary word with the suffix SURANCE to suggest an aspect of the Applicant’s Services: the provision of a website with information to clarify insurance options. As such, it too has only a low degree of inherent distinctiveness. However, to the extent that the Mark uses a truncation of the word “insurance” rather than the ordinary dictionary word to evoke the idea of insurance, I find that the Mark is more evocative of a single coined word and slightly more inherently distinctive than either of the Opponent’s Trademarks.

[39] A trademark’s distinctiveness can be enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. Only the Opponent filed evidence in this respect. It consists of the affidavit of its Vice-President Business Development, Martin Dufour. Mr. Dufour states that he is also one of the founders and the Vice-President and Director of the Opponent’s predecessor in title, Informatique Devexpert Inc. (Devexpert) (para 5). Devexpert assigned the Opponent’s Trademarks to the Opponent on December 17, 2015, effective March 1, 2016 (para 9, Exhibit MD-2), and the Opponent has provided the services associated with the Opponent’s Trademarks since March 2016 (para 8).

[40] Mr. Dufour’s evidence shows that the Opponent’s Trademarks have been used in association with the website available in English at www.clickinsurance.ca and in French at www.clicassure.com (the Opponent’s Website). Printouts from the Internet Archive at web.archive.org dated March 16, 2015, March 24, 2016, and June 7, 2017 show the English version of the site while an August 4, 2017 printout directly from www.clicassure.com shows the French version; both versions appear to be the same in terms of style and content, which also appears to be consistent over time (Exhibits MD-4, MD-5). Approximately one hundred insurers—referred to as “partners”— are listed on the site, the majority having addresses in Quebec, with a few in Ontario and one in Nova Scotia (Exhibit MD-5).

[41] However, I note that the webpage from *www.clicassure.com*, dated August 4, 2017, displays the following notice (my emphasis): “© 2017 *Ce site et la marque de commerce « clicassure » sont exploités sous licence par 9333-4233 Québec inc. Tous droits réservés.*” [TRANSLATION: © 2017 This site and the trademark “clicassure” are used under licence by 9333-4233 Québec inc. All rights reserved.] Accordingly, following the March 1, 2016 assignment, or at least as of August 2017, use of the trademark CLICASSURE would appear to be by a licensee and not by the Opponent directly. However, Mr. Dufour provides no information about the licensee’s relationship to the Opponent or the terms of the licence. In the absence of any indication that the Opponent had control of the character or quality of the services provided under licence in accordance with the requirements of section 50(1) of the Act, and as the notice does not identify the trademark owner in accordance with section 50(2) of the Act, I am unable to conclude that use of CLICASSURE by the licensee benefits the Opponent.

[42] The only other such notice appears on the *www.clickinsurance.ca* webpage that predates the assignment, and it reads simply “© 2015 *Informatique DevExert Inc. All Rights Reserved.*” Accordingly, I accept that use of the Opponent’s Trademarks prior to the assignment would have been by the Opponent’s predecessor in title. Furthermore, as there is no such notice, or any other sign of a licensing arrangement, on the *www.clickinsurance.ca* webpages postdating the assignment, I am also prepared to accept use of CLICKINSURANCE after the assignment as enuring to the Opponent’s benefit for the purposes of this proceeding. However, had I not been prepared to accept such use, it would not have changed the outcome of this case.

[43] The English and French versions of the site display the trademarks CLICKINSURANCE and CLICASSURE respectively, as a logo at the top of each webpage. I am satisfied that the use of such logos constitutes use of the Opponent’s Trademarks: applying the principles set out in *Canada (Registrar of Trade-marks) v Cie Internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA); *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); and *Stikeman, Elliot v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB), I find that the Opponent’s Trademarks have not lost their identity and remain recognizable despite the logos’ stylization and minor design elements.

[44] The Opponent’s Trademarks are also incorporated into domain names used textually on the site, in phrases such as “ClickInsurance.ca allows you to get, at no cost, proposals from several different insurers by filling out only one quote request form” (Exhibit MD-4 at page 4), and webpage titles, such as “*Le Comparateur d’Assurance Auto #1 au Québec | clicassure.com*” [TRANSLATION: The #1 Auto Insurance Comparison Tool in Quebec | clicassure.com)] (*ibid.* at pages 8-12). The incorporation of a trademark in a domain name can constitute use in association with services if, as here, the domain name is immediately linked to substantial information about the services [see *Salam Toronto Publications v Salam Toronto Inc.*, 2009 FC 24].

[45] Additionally, the Opponent’s Trademarks are used on the site as trade names to identify the Opponent and its predecessor in title, for example, in phrases such as “ClickInsurance is not an insurance company” (Exhibit MD-4 at page 1) and “I authorize ClickInsurance to collect and disclose my personal information to her business partners so they can send me insurance quotes by email, telephone or mail” (*ibid.* at page 6). Trademark and trade name usage are not necessarily mutually exclusive [*Consumers Distributing Co v Toy World Ltd.*, 1990 CarswellNat 1398 (TMOB)]. However, in phrases such as these, a question may be raised as to whether ClickInsurance and ClicAssure are used as brands to distinguish specific services or only as names to identify a legal entity. In the latter case, they would not meet the definition of a “trademark”, only that of a “trade name” (see section 2 of the Act). I will return to the significance of this distinction in the discussion below.

[46] Regarding the extent to which the Opponent’s Trademarks have become known in Canada, the most relevant portions of Mr. Dufour’s evidence can be summarized as follows:

- 1) As of November 26, 2008, the French-language version of the Opponent’s Website has been offered in Canada at *clicassure.com* under the trademark CLICASSURE (para 11).
- 2) Between January 2010 and February 2017, the site was advertised under the CLICASSURE trademark in a wide range of media, including on several television and radio stations and through Google AdWords (para 35, see also sample invoices at Exhibit MD-16). Mr. Dufour states that such media have significant coverage in Canada (“*une couverture importante au Canada*”); however, all of the television and radio stations from which sample invoices are provided appear to be in Montreal and Quebec

City. Advertising expenditures totalled over \$4 million (para 36, with table of monthly expenses at Exhibit MD-17). Sample advertisements are not provided.

- 3) Between January 1, 2010 and February 28, 2017, *clicassure.com* generated over 4.6 million sessions and over 36 million page views (para 37). An extract from Google Analytics is provided in support (Exhibit MD-18). It includes a line graph showing the number of visitors growing over time, but the graph appears to end slightly short of 2016. Moreover, there is no direct indication of where any of the sessions originated. At best, it would appear from those whose language is “fr-ca” or “en-ca”—which I interpret to mean Canadian French and Canadian English, respectively—that there were just under 1.2 million sessions from Canada. A pie chart shows that approximately 45% of global sessions represent new visitors; however, there is no indication of the percentage of unique visitors from Canada. There is also no indication of whether the visitors were potential consumers, insurer partners, other individuals, or automated bots.
- 4) On or about February 17, 2011, the Opponent’s Website was made available in English at *clickinsurance.ca*, under the trademark CLICKINSURANCE (para 12). Advertising for the site began in 2011 and targeted primarily Anglophones in Quebec (para 24).
- 5) From January 1, 2013 to February 28, 2017, over \$200,000 was spent on Google AdWords campaigns to generate goodwill on the site in connection with the trademark CLICKINSURANCE, the first \$190,000 of which was spent prior to April 26, 2016 (paras 28-29). Mr. Dufour specifies that, from 2014 to 2017, such campaigns targeted the search term “car insurance” in particular, and costs reports show campaigns targeting Ontario with keywords such as “Car Insurance” and “Home Insurance” (para 27, Exhibits MD-10, MD-11). However, the Google search engine results from 2017 furnished in support are for the search term “click insurance” instead (Exhibit MD-9). The first result is an ad titled “clickinsurance.ca – Free Car Insurance Quote”. The next four result are hits for *www.clickinsurance.ca*, the first being a page titled “ClickInsurance”. The results also include a map showing the Quebec location of the insurance company “Clic Assure”.

- 6) A marketing campaign in Ontario and the Maritime provinces was launched from the end of 2014 and Mr. Dufour provides two sample articles and a press release from this campaign, published in January 2015 on the informational websites Insurance Business Canada (www.insurancebusinessmag.com), Canadian Underwriter (www.canadianunderwriter.ca), and insPRESS.ca Insurance Press Release Service (www3.canadianunderwriter.ca/inspress/) (para 25, Exhibit MD-8). A CLICKINSURANCE logo is displayed above the press release and Insurance Business Canada article. I note that these publications mention *clicassure.com* generating over 4,000 requests for quotes every week, which I accept would generally have been requests from Canadian consumers.
- 7) Between February 2015 and February 2017, approximately \$300,000 was spent to advertise the CLICKINSURANCE trademark and the *clickinsurance.ca* website (para 32, with table of monthly expenses at Exhibit MD-14).
- 8) In 2015 and 2016, the site was advertised in connection with the CLICKINSURANCE trademark on the CTV television network, for which expenditures were in the tens of thousands of dollars (para 30, with sample invoices at Exhibit MD-12). Although Mr. Dufour states that CTV reaches a vast audience (“*rejoint un vaste auditoire*”), the sample invoices appear to cover only Montreal and Toronto/Hamilton. No sample advertisements are provided.
- 9) Also in 2015 and 2016, the website was promoted with the CLICKINSURANCE trademark on the Facebook social network, with sponsored ads for over \$10,000 (para 31, with Facebook account printout at Exhibit MD-13). However, no sample advertisements are provided and the number of views from Canada is not indicated.
- 10) From January 1, 2015 to February 28, 2017, *clickinsurance.ca* generated over 140,000 sessions and over 500,000 page views (para 33). The extract from Google Analytics provided in support (Exhibit MD-15) includes a line graph showing the number of visitors over time, but the graph ends around August 2016. Moreover, none of the analytics data indicates where any of the sessions originated. At best, it would appear from those whose language is “en-ca” or “fr-ca” that there were just over 30,000 from

Canada. A pie chart shows that approximately 68% of sessions represent new visitors, but does not indicate the proportion from Canada.

[47] I am prepared to accept the Google Analytics data as evidence of a significant number of Canadian sessions generated by *clicassure.com* prior to the March 1, 2016 assignment. Furthermore, I am prepared to accept the press release's figure of 4,000 weekly quote requests through *clicassure.com* in early 2015 as being reliable: although the press release is technically hearsay, it is presented as part of the Opponent's marketing campaign and, when Mr. Dufour states that it deals with the CLICKINSURANCE website, I consider him to be adopting the press release's contents as they relate to both versions of the site. The press release displays the English version of the logo and I find it reasonable to infer that the corresponding French version would have been in use at the same time, displayed on the Opponent's Website in the manner shown on the exhibited webpages, the earliest of which is roughly contemporaneous with the press release. I also find it reasonable to infer that the trademark CLICASSURE would have been used at that time in the text of the webpages, as discussed above. Therefore, I accept that the trademark CLICASSURE had become known to at least a certain extent in Canada by the time it was assigned. However, in the absence of more recent data, and of particulars on the licence that appears to have been in effect since at least August 2017, it is not possible to assess the extent to which the trademark's reputation would continue to benefit the Opponent at the material date.

[48] Mr. Dufour suggests in his affidavit that the English version of the site also benefits from the reputation of the French version (para 34). However, for the purpose of assessing the likelihood of confusion under a section 12(1)(d) ground of opposition, each of an opponent's trademarks must be considered individually. In this case, there is no indication of the weekly insurance quote request rate from *clickinsurance.ca* and the Google Analytics data shows the number of Canadian visits to this version of the site to be significantly lower. Thus I find that the CLICKINSURANCE trademark would have become known to a lesser extent.

[49] With respect to advertising, the CLICKINSURANCE logo is displayed on the aforementioned article and press release, published on insurance information websites (para 25, Exhibit MD-8). However, although Mr. Dufour attests that these are among the most important

websites in the insurance field, consulted by users throughout the country (“*comptent parmi les plus importants sites Web dans le domaine de l’assurance au Canada et sont consultés par des utilisateurs partout au pays*”) (para 26), he does not provide any concrete indication of the extent to which Canadians—be they insurance providers or consumers—have viewed the article and press release in question. These materials thus provide little assistance in showing the extent to which the Opponent’s Trademarks may have become known through promotion and advertising.

[50] Moreover, although Mr. Dufour provides information on advertising expenditures in various other media, such as television and radio advertising, the only sample advertisement provided is the Google search result titled “clickinsurance.ca – Free Car Insurance Quote”. However, as this result was obtained by searching for the term “click insurance”, it is not evidence of the trademark becoming known to individuals who do not know it already. In the absence of any examples of the radio, television and Facebook advertising, it is not possible to determine to what extent such advertisements featured the Opponent’s Trademarks. As discussed above, for a domain name to be used as a trademark, it must be immediately linked to substantial information about the associated services. Likewise, the use of a trade name will not necessarily meet the definition of a trademark in all cases. In the absence of further particulars, it is not possible to assess the extent to which the Opponent’s Trademarks were used as such in advertising or thereby brought to Canadians’ attention. Nor do advertising expenditures alone permit me to determine the extent to which Canadians were exposed to such advertising.

[51] As for the Mark, there is no evidence of it having become known in Canada. Although Mr. Dufour includes in his affidavit some printouts from the Applicant’s U.S. website (Exhibit MD-19), there is no indication that the Applicant has begun operating under the Mark in Canada or that any Canadians have visited the U.S. site.

[52] Overall, I find the Mark to be slightly more inherently distinctive than each of the Opponent’s Trademarks; however, there is no evidence that the Mark has become known in Canada, whereas there is at least some evidence to suggest that each of the Opponent’s Trademarks has become known in Canada to at least a certain extent. On balance, I find that use and promotion of the Opponent’s Trademarks will have increased their distinctiveness—particularly in the case of CLICASSURE; however, the evidence does not allow me to conclude

that either of the Opponent's Trademarks has become known to an extent that would significantly enhance the protection to which it is entitled at the material date.

Length of time the trademarks have been in use

[53] Mr. Dufour attests to the Opponent's Website being available in Canada under the trademark CLICASSURE since November 26, 2008, and under the trademark CLICKINSURANCE since February 17, 2011. However, mere assertions of use are insufficient to demonstrate use within the meaning of section 4 of the Act [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[54] The earliest documentary evidence of use shows the trademark CLICKINSURANCE on a press release and on the Opponent's Website in 2015 (Exhibits MD-5 and MD-8). As discussed above, I find it reasonable to infer that there would have been corresponding use of the trademark CLICASSURE on the Opponent's Website at the same time.

[55] As there is no evidence that the Applicant has commenced use of the Mark in Canada, this factor favours the Opponent, for both of its trademarks.

Nature of the parties' services and trades

[56] When considering the nature of the parties' services and trades under section 12(1)(d) of the Act, it is the statement of services in the applicant's application and the statement of services in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such services [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The statements must be read with a view to determining the probable type of trade intended by the parties, rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd*, 1999 CarswellNat 3465 (TMOB)].

[57] From a plain reading of the Application and Opponent's Registrations, the nature of the parties' services overlaps, as both parties' services involve a website providing information on

insurance transactions and enabling users to compare insurers. Moreover, the broader description “Insurance services” in the Application could directly encompass the service in the Opponent’s Registrations enabling clients to fill out applications for insurance offers.

[58] As for the parties’ actual trades, the Applicant did not file evidence of how it intends to use the Mark in Canada. However, Mr. Dufour’s affidavit for the Opponent introduces printouts made between December 21, 2016 and August 4, 2017 from *www.clearsurance.com*, which he states is the Applicant’s U.S. website (para 39, Exhibit MD-19). The site is presented as an independent resource for insurance information in the nature of crowdsourced reviews, customer scores, ratings from independent agencies, and the like, to assist users in choosing an insurer; customers may also submit content (reviews, ratings, and articles) and read “information and tips” on how to improve existing coverage (*www.clearsurance.com/faq* at pages 4-5, 10-12, 15-16). The site’s “Learning Centre” includes articles on topics such as “The Basics of Homeowners Insurance” and “Renters Beware: Top 5 Things to Know about Renters Insurance” (homepage at page 4). The platform allows subscribing insurers to publish a profile and respond to customer’s feedback left on the site, and, for a fee, to deploy a widget to encourage customer feedback (*www.clearsurance.com/for-companies* at pages 2-5).

[59] This evidence is technically hearsay; however, it is necessary to the extent the Opponent lacks personal knowledge of the Applicant’s activities and it is reliable as the Applicant is the source of the webpages and had the opportunity to refute them [re the admissibility of hearsay evidence that is necessary and reliable, see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. Indeed, the Applicant appeared to accept this evidence and referred to it in its oral submissions. A conclusion that the Applicant’s services in Canada will necessarily mirror those provided in the United States would be somewhat speculative; however, the furnished webpages fall within the scope of the services defined in the Application. On balance, I am prepared to give some consideration to this evidence, as discussed below.

[60] As for the Opponent’s Website, Mr. Dufour’s affidavit shows that it enables users to receive and compare offers from up to three insurers by filling out a single application form; the offers are sent by e-mail from insurers selected by the Opponent (Exhibit MD-4). The site also

provides what appears to be a series of internal links to articles containing “practical information that will help you fully complete your quote request” (*ibid.* at page 4). Titles range from “How condominium insurance works” and “Five benefits of a home security system” to “Top 10 Stolen Vehicles in Ontario” and “Our Back to School Insurance Tips for Students and Parents”. The sample article furnished explains how some of the site’s partners specialize in helping customers whose home and auto insurance has been cancelled for non-payment (*ibid.* at page 5).

[61] At the oral hearing, the Applicant emphasized that the Opponent’s Website is a marketplace (the site describes itself as such: see *e.g. ibid.* at page 1) whereas the Applicant’s website does not allow consumers to initiate purchases and is more akin to a digital newsstand. In addition, although the titles of the articles to which the respective websites link suggest similar subject matter, the Applicant submitted at the hearing that there is no evidence of any similarity in the nature and perspective of the articles. The Applicant emphasized that the information on its site is provided by consumers and submitted that this is an important distinction.

[62] Nevertheless, I find there to be considerable overlap in the nature of the parties’ services. Both parties’ services involve providing a website with information enabling consumers to compare insurer offers, which can be either specific or general. It is true that the Applicant’s current services in the U.S. appear to differ from those of the Opponent in the perspective of the information provided; in the nature of the comparison tools provided; and in the specific mechanisms for consumers to interact with insurers. However, the Applicant’s platform already allows insurers to publish a profile and respond to customer feedback and nothing in the Application would prevent the Applicant from expanding insurers’ options for promoting their business and engaging with customers through the proposed Canadian version of the site.

[63] There is also the potential for significant overlap between the parties’ channels of trade. It appears that both parties currently offer a neutral website targeting consumers, including those of home and automobile insurance, while also inviting insurance companies to benefit by becoming “partners” or “subscribers”. Indeed, the Opponent’s press release for the Ontario and Maritime expansion sought new partners and listed the advantages partnership has to offer, such as “A very competitive price per lead” (Exhibit MD-8). The Applicant’s website advertises itself to insurance companies as “a platform for you to engage with your customers, enhance your

reputation, and grow your brand”, offering both free and paid subscriptions (Exhibit MD-19 at www.clearsurance.com/for-companies pages 2-4). Although the Applicant may not necessarily offer precisely the same services in Canada, the specification of services in the Application includes “Insurance services” and “providing a website that displays various requests, ... recommendations, ... and information relating to insurance transactions...”. This specification is broad enough to encompass an online platform to which *insurers* may subscribe, for the purpose of not only responding to customer questions and feedback but also providing insurance offers and other recommendations.

[64] At the oral hearing, the Applicant argued that the Opponent’s partners are sophisticated companies in a highly regulated industry, who themselves use the suggestive term “Assurance” in their trade names (as shown in the list of insurers at Exhibit MD-5), and are thus not likely to be confused when faced with the trademarks at issue. With respect to consumers, the Applicant argued that the parties can coexist in an “ecosystem” where consumers read the information on the Applicant’s website and then go to the Opponent’s website to initiate a purchase.

[65] However, the fact remains that both the Application and the Opponent’s Registrations may target the same trade channels, being (i) consumers seeking a comparison platform and (ii) insurers seeking access to potential customers. Moreover, confusion is not to be assessed from the perspective of a sophisticated client or of a consumer looking at both parties’ services side-by-side. It is rather to be assessed as a matter of first impression on a casual consumer who does not pause to give the matter any detailed consideration or scrutiny.

[66] Finally, I note that the Opponent’s Registrations also cover a website enabling clients to fill out applications for financial products and to compare offers from financial institutions; however, no evidence is provided for that being an additional aspect of the Opponent’s services. In any event, I consider it to be less relevant, since there is no indication that the Applicant’s Services relate to products other than insurance.

[67] Overall, I find that the sections 6(5)(c) and (d) factors favour the Opponent.

Additional Surrounding Circumstances

[68] In its written argument and at the oral hearing, the Applicant raised several additional surrounding circumstances, as follows.

Use of the Mark in design form

[69] At the hearing, the Applicant noted that, in the Opponent’s logos, the word CLICK or CLIC is in a lighter shade than the word INSURANCE or ASSURE, thereby reinforcing the impression of two separate words. In the Applicant’s submission, this manner of presentation creates the impression that the Opponent’s trademark is actually CLICK or CLIC while INSURANCE or ASSURE describes the service.

[70] Factors such as the branding context in which a trademark is used may be important in a passing off action. However, when considering a section 12(1)(d) ground of opposition, it is the effect of the opponent’s registered trademark itself that must be considered, not the effect of other indicia that may appear with it. When an opponent’s registration is for a word mark, its actual use is not irrelevant, but the analysis should not focus entirely on the current manner of display, since what is granted by the registration is the right to display the mark using any style of lettering, colour, design or other features [*Masterpiece, supra; Advance Magazine Publishers, Inc v Banff Lake Louise Tourism Bureau*, 2018 FC 108].

[71] Applied to the present case, this factor does not assist either party.

Suggestive terms commonly used in the trade

[72] In its written argument, the Applicant submits that the average consumer will tend to distinguish between trademarks incorporating words common to the trade by the marks’ non-common features. The Applicant submits that to find otherwise would “blur those principles of fairness in commercial activities which allow a merchant to distinguish its goods and services from those of its competitors by drawing freely upon the common vocabulary of traders” (at para 21) and that granting the Opponent a monopoly over the usage of ordinary dictionary words would “stretch the reach of the Opponent beyond the object and purpose of the Act, which is to protect consumers from likelihood of confusion” (para 27).

[73] In particular, the Applicant seeks to draw a parallel between the present case and that in *Assurant, Inc v Assurancia, Inc*, 2018 FC 121, where the Federal Court found that the degree of resemblance between the trademarks ASSURANT and ASSURANCIA came from the shared feature ASSURAN, which is highly suggestive of the insurance industry in which both parties offered their services. The Court held that, as a result, slight differences between the two trademarks would suffice to distinguish them and to reduce the risk of confusion, and the Court found the suffixes T and CIA to be such a distinguishing difference. In so finding, it cited with approval “the longstanding principle that when a party uses words or terms commonly used in their trade, some degree of confusion is to be expected, but that the average consumer in such context will tend to distinguish between the non-common features of the respective trademarks” [at para 46, citing *Molson Co v John Labatt Ltd* (1994), 58 CPR (3d) 527 (FCA) at paras 6-8].

[74] Indeed, it is trite law that the common occurrence of a certain element in trademarks tends to cause purchasers to pay more attention to the trademarks’ other features and to distinguish between them by those other features [see *Polo Ralph Lauren Corp v United States Polo Assn* (2000), 9 CPR (4th) 51 (FCA); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[75] At the oral hearing, the Applicant drew attention to the list of the Opponent’s partners at Exhibit MD-5 to Mr. Dufour’s affidavit, many of whom are identified in this list by a trade name that includes the word “Assurance”. In the Opponent’s submission, this evidence indicates that the Opponent’s Trademarks are not entitled to a wide ambit of protection, because consumers of insurance products will be used to distinguishing between trademarks and trade names incorporating the word “Assurance” or “Insurance”. Indeed, over half of these insurers’ trade names incorporate the term “Assurance” wholly or in part and six incorporate the term “Insurance” (for example, LEDOR Assurances, Assurpro Direct inc., and BMT insurance, among others). I note in particular “Club Assurance”, whose logo consists of the word “clubassurance” in plain lettering; this company also appears in the partial list of partners’ logos that appears at the end of each of the exhibited webpages (Exhibit MD-4).

[76] I am prepared to accept the list of insurers at Exhibit MD-5 as evidence of the state of the marketplace with respect to insurers’ trade names. This list is from the Opponent’s Website as it

appeared in 2015; however, trade names incorporating the term “Assurance” remain prevalent in the partial lists of insurers at the end of the later-dated webpages at Exhibit MD-4, and I have no reason to doubt that they would remain prevalent to this day.

[77] This factor favours the Applicant.

No instances of actual confusion

[78] The Applicant argues in its written submissions that the Opponent filed no evidence that either of its trademarks has been confused with the Mark and no evidence of “actual knowledge, nor a reasonable basis, for apprehension that the [Mark] would suggest an association with the Opponent” (para 25).

[79] However, an opponent is under no obligation to submit evidence of instances of actual confusion or association. The burden is on an applicant to demonstrate the absence of a likelihood of confusion. An adverse inference *may* nevertheless be drawn where evidence of actual confusion would readily be available [*Mattel, supra*]. However, in the present case, since there is no evidence of the Mark being used or made known in the Opponent’s markets in Canada, it is not possible to draw any meaningful conclusion with respect to the absence of actual confusion.

[80] Consequently, I do not consider the absence of evidence of actual confusion in this case to be a relevant factor.

Conclusion with respect to likelihood of confusion

[81] For an applicant to meet its legal burden, the Registrar must be reasonably satisfied that, on a balance of probabilities, the registration sought is unlikely to create confusion; the Registrar need not be satisfied beyond doubt that confusion is unlikely [*Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29].

[82] Following my analysis of all the relevant factors, I am satisfied that, on a balance of probabilities, the Mark is not likely to create confusion with either of the Opponent’s Trademarks. I find that the differences between the Mark and each of the Opponent’s

Trademarks are sufficient to avoid a likelihood of confusion as to the source of the parties' respective services, even as a matter of first impression and imperfect recollection, despite the overlap in the general nature of the services and trades. Given the relatively low degree of resemblance between the parties' trademarks, I do not find it likely that the Applicant's Services would be assumed to be from the same source as the Opponent's, either as an extension thereof or as a complement thereto.

[83] I reach this conclusion bearing in mind that the Opponent's Trademarks have a low degree of inherent distinctiveness and, as such, are not entitled to a particularly wide ambit of protection. Where a party has reached inside the common trade vocabulary for its mark and seeks to prevent competitors from doing the same thing, the range of protection accorded is more limited than in the case of an invented, unique or non-descriptive word [*General Motors, supra*]. Although a trademark's distinctiveness can be enhanced through use and promotion, the evidence of record does not allow me to conclude that either of the Opponent's Trademarks is known to such an extent as to counterbalance its lack of inherent distinctiveness.

[84] For these reasons, I dismiss the ground of opposition based on section 12(1)(d) of the Act.

GROUND OF OPPOSITION BASED ON ENTITLEMENT UNDER SECTION 16(3)(A)

[85] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark under section 16(3) of the Act because, at the Application's filing date, the Mark was confusing with the Opponent's Trademarks, which had been previously used in Canada. More specifically, the Opponent pleads confusion with its trademarks CLICKINSURANCE, used in Canada since at least as early as February 17, 2011, and CLICASSURE, used in Canada since at least as early as November 26, 2008, in association with the Opponent's Services.

[86] To meet its initial burden, the Opponent must evidence the prior use of at least one of its trademarks in accordance with section 16(3)(a) of the Act and also that this trademark had not been abandoned at the date of advertisement of the Application, as stipulated in sections 16(5) of the Act. The use on which the Opponent relies must be its own use or that of its predecessor in title, *per* section 17(1) of the Act.

[87] The material date to assess this ground of opposition is the priority filing date claimed in the application, namely October 26, 2015, *per* section 34(1) of the Act [see *Shell Canada Limited v P T Sari Incofood Corp* 2005 FC 1040].

[88] The evidence shows that the trademark CLICKINSURANCE has been displayed on the Opponent's Website since at least March 16, 2015 (Exhibit MD-5). Furthermore, although the evidence could have been more explicit, it appears from the Google Analytics report at Exhibit MD-15 that this version of the site generated at least 30,000 Canadian sessions from January 1, 2015 to February 28, 2017, and a line graph included in the report shows that the number of monthly users overall was generally greater in and before October 2015 than after. I am therefore prepared to infer that at least some of the Canadian sessions would have been generated prior to October 26, 2015. Thus I am satisfied that the Opponent has demonstrated use of the trademark CLICKINSURANCE (through its predecessor in title) prior to the material date. Furthermore, I accept this trademark's display on the Opponent's webpages dated March 24, 2016 and June 7, 2017 (Exhibit MD-4) as evidence that the trademark had not been abandoned when the Application was advertised on December 21, 2016.

[89] As discussed above, I find it reasonable to infer from the evidence that the trademark CLICASSURE would have been displayed on the Opponent's Website in early 2015 as well and I accept that, at that time, approximately 4,000 Canadians per week were requesting insurance quotes from the site (Exhibit MD-8). I am thus satisfied that the trademark CLICASSURE was also used in Canada prior to the material date. Furthermore, I accept this trademark's display by a licensee on the Opponent's webpage dated August 4, 2017 (Exhibit MD-4) as evidence that the trademark had not been abandoned when the Application was advertised on December 21, 2016. Regardless of whether this licensed use enures to the Opponent's benefit under the Act, it appears the Opponent did not intend to abandon the trademark [re abandonment requiring both an absence of use and an intention to abandon use, see *Labatt Brewing Co v Formosa Spring Brewery Ltd* (1992), 42 CPR (3d) 481 (FCTD); and *Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)].

[90] Accordingly, I find the Opponent's initial burden to be met in respect of both trademarks. The onus is therefore on the Applicant to satisfy the Registrar, on a balance of probabilities, that

the Mark was not likely to cause confusion with either of them at the material date. I would note that, had I not been prepared to infer display of CLICASSURE on the Opponent's website in 2015 and a lack of intention to abandon in 2017, I would not have found the Opponent to have met its evidential burden for the trademark CLICASSURE; however, for the reasons set out below, it would not have affected the outcome of this ground of opposition.

[91] The earlier material date associated with the section 16 ground of opposition does not significantly alter the results of the test for confusion performed under the section 12(1)(d) ground. Under section 16(3)(a), the evidence of the Opponent's Trademarks being used and promoted is closer to the material date, but I find that it is still insufficient for a conclusion that either trademark has become known to such an extent as to counterbalance its lack of inherent distinctiveness. I also note that, under section 16(3)(a), it is the statement of services as defined in the Application versus the services for which the Opponent has shown actual use that governs the analysis of the sections 6(5)(c) and (d) factors. However, I am satisfied from my review of the evidence discussed under the previous ground that the services actually offered by the Opponent were essentially the same as the most relevant services covered by its registrations.

[92] Consequently, the Applicant has met its legal onus and the section 16(3) ground of opposition is dismissed as well.

GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[93] The Opponent also pleads that the Mark is not distinctive or capable of becoming distinctive within the meaning of section 2 of the Act, because the Mark does not actually distinguish the Applicant's Services from the services of the Opponent, given the prior and current use and making known of the Opponent's Trademarks for the same or similar services.

[94] The material date for this ground of opposition is February 20, 2017, the date the statement of opposition was filed [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. To succeed under this ground, an opponent relying on its own trademark must establish that, as of the material date, its mark had become sufficiently known in Canada to negate the distinctiveness of the applicant's mark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. If this initial

burden is met, the applicant will then have the legal onus of showing, on a balance of probabilities, that the mark it seeks to register was adapted to distinguish or actually distinguished the applicant's services from those of the opponent. In this respect, an applicant must establish that its trademark was not likely to create confusion with the opponent's trademark at the material date [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[95] It is not necessary to address this ground of opposition in detail. To the extent that the Opponent may have met its initial burden, the applicant will have met its legal onus, as the opponent's case for confusion would be no stronger at the material date of February 20, 2017 than it is at the material dates for assessing confusion under the section 12(1)(d) and 16(3)(a) grounds. Thus the outcome of the ground of opposition based on section 2 of the Act would be the same and, accordingly, this ground of opposition would be dismissed as well.

DISPOSITION:

[96] In view of all the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2020-08-27

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