

appraisal and valuation, lease negotiations and the acquisition of commercial real estate property.

- (2) Acquisition of real estate for others; arranging of leases and rental agreement for real estate; leasing of real estate; real estate agency services; real estate appraisal and valuation; real estate brokerage; real estate consultation; real estate management services.

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

THE RECORD

[4] The Application was filed on March 14, 2018, and was advertised for opposition purposes in the *Trademarks Journal* of October 17, 2018.

[5] On November 27, 2018, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based on entitlement under section 16, and distinctiveness under section 2 of the Act. In accordance with section 70 of the Act, all references to sections of the Act pertaining to the grounds of opposition are to the Act as it read before June 17, 2019.

[6] The Applicant filed and served a counter statement denying the grounds of opposition.

[7] Both parties filed evidence. Neither party filed written representations nor attended a hearing.

OVERVIEW OF THE EVIDENCE

[8] The Opponent filed the affidavit of Shawn Abramovitz (sworn May 17, 2019), a commercial real estate broker and (currently) the sole director of the Opponent. As I understand it, the Opponent was incorporated in Ontario in January 2016 by Mr. Abramovitz's former business partner and close friend, Mr. Sari Samarah. Mr. Abramovitz started working with Mr. Samarah (at the Opponent) part time in January 2016, and was full time by March 2016 (para 6). By April 2016, both men were directors and shareholders of the Opponent.

[9] However, by the spring of 2018, Mr. Abramovitz's personal and business relationship with Mr. Samarah became strained (para 34). Mr. Abramovitz subsequently purchased Mr.

Samarah's shares in the Opponent, making him the sole shareholder and owner effective August 20, 2018 (para 35).

[10] The Opponent's position is that it is the earlier user of the trade name Core Consultants Realty Inc., and that the Applicant had no control, right, or interest in the Opponent or its trade name.

[11] The Applicant filed the affidavit of Corey Bessner (sworn September 12, 2019). Mr. Bessner is a commercial real estate broker and consultant, and the principal of the Applicant. As I understand it, the Applicant's position is that it had been using a variation of the Mark, namely CORE REALTY CONSULTANTS, since as early as June 2015 before moving to the CORE CONSULTANTS REALTY trademark and trade name. In early 2016, the Applicant granted the Opponent a license to use the Mark and trade name "Core Consultants Realty". The Applicant decided to terminate this license once Mr. Samarah (also a personal friend of Mr. Bessner) left the Opponent in August 2018.

[12] While the parties' evidence focuses on their competing allegations of ownership, as discussed below, I do not find it necessary to resolve this issue in order to resolve the present opposition.

LEGAL ONUS AND EVIDENTIAL BURDEN

[13] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, the Opponent must first adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 16(1)(a) ground of opposition

[14] The 16(1)(a) ground of opposition pleaded by the Opponent is reproduced below:

The Applicant is not the person entitled to registration pursuant to section 16(1)(a) of the Act in that at the date of filing of the trademark application the trademark had been previously used in Canada as a trade name (as defined in the Act), by the Opponent since at least as early as February 2016, in association with real estate services.

[15] As the Opponent is alleging confusion with a trade name previously used by the Opponent, this ground of opposition should have been pleaded under section 16(1)(c) of the Act. However, since the ground was otherwise set out in sufficient detail for the Applicant to reply, I am prepared to treat this as a typographical error and consider this ground as if it had been properly pleaded.

[16] I also note that the material date for a ground of opposition under section 16(1)(c) is not the date of filing of the Application but rather the date of first use claimed in the Application, namely May 8, 2016. Accordingly, to meet its evidential burden under section 16(1)(c) of the Act, the Opponent must show that as of May 8, 2016, the trade name “Core Consultants Realty” had been previously used in Canada by the Opponent and had not been abandoned as of the date of advertisement of the Application (October 17, 2018).

[17] With this in mind, portions of the Opponent’s evidence are summarized below.

Opponent’s evidence – the Abramovitz affidavit

[18] The Abramovitz affidavit introduces corporate records relating to the incorporation of the Opponent, provides a chronology of negotiations with the Applicant, and provides information relating to the Opponent’s assertions of entitlement to the Mark.

Corporate records of the Opponent

[19] The Opponent was incorporated on January 13, 2016; a copy of the document is attached as Exhibit C. Copies of subsequent corporate documents are also provided, including corporate resolutions adding Mr. Abramovitz as a director and shareholder of the Opponent in April 2016 (Exhibit A), and a shareholder’s agreement formalizing Mr. Samarah and Mr. Abramovitz’s equal ownership of the Opponent in May 2016 (Exhibit B).

Chronology of negotiations with the Applicant

[20] Mr. Abramovitz states that for many years prior to actually doing so, he and Mr. Samarah discussed setting up a commercial real estate brokerage business in Toronto. In the year 2015, they committed to setting up such a business (para 5).

[21] Mr. Abramovitz states that Mr. Samarah told him he had a commercial real estate contact in Montreal who was looking to align with a Toronto brokerage. The name of this contact was Corey Bessner (the principal of the Applicant) (para 13). Mr. Abramovitz and Mr. Samarah considered that the benefit of some kind of arrangement with the Applicant would be to make their Toronto brokerage (which was not yet operational) appear to be a more substantial brokerage with a national basis (para 14).

[22] Mr. Abramovitz notes that discussions were held in November and December 2015 regarding the possibility of a potential business arrangement with the Applicant. During this time, Mr. Samarah also took steps to see whether the name “Core Consultants Realty Inc., Brokerage” would be available for registration as a new brokerage in Ontario with the Real Estate Council of Ontario (RECO). RECO subsequently advised that this name was available (para 15).

[23] Mr. Abramovitz states that on December 24, 2015, Mr. Samarah sent an email to Mr. Bessner setting out a proposed business structure between the “Ontario office (run by Samarah and Abramovitz) and the Quebec office (run by Bessner)”. The email also proposed that “all three partners would own equal shares of intellectual property” (para 27). Mr. Samarah also sent a copy of this email to Mr. Abramovitz (Exhibit F).

[24] Mr. Abramovitz states that “sometime before January 2016, Samarah advised me that Bessner had conducted discussions with him agreeing to the conditions set out in the December 24, 2015 email” (para 30). I note that this statement comprises hearsay as these discussions occurred between only Mr. Samarah and Mr. Bessner.

[25] Mr. Abramovitz states that after receiving confirmation of Mr. Bessner’s agreement with these terms, Mr. Samarah took steps to incorporate a company with the corporate name “Core Consultants Realty Inc.” in Ontario (para 30).

[26] Mr. Abramovitz states that on February 1, 2016, RECO advised Mr. Samarah by email that the transfer of his brokerage registration to “Core Consultants Realty Inc.” had been completed effective February 1, 2016 (para 31). Mr. Samarah provided a copy of this email confirmation to Mr. Abramovitz (Exhibit G).

Opponent’s entitlement to the Mark

[27] Mr. Abramovitz states that Mr. Bessner had no control, right, or interest in the Opponent or its business. Mr. Bessner was not an officer, director, or shareholder of the Applicant, nor was Mr. Bessner licensed to practice as a real estate broker in Ontario (para 33).

[28] Mr. Abramovitz states that the Opponent has been incorporated since January 13, 2016 and operating under the trade name for real estate services since that time (para 35). More specifically, Mr. Abramovitz states that he and Mr. Samarah, as equal partners at the time, “were the first to conduct real estate services under the trade name Core Consultants Realty Inc. in Canada, as evidenced by our incorporation of the trade name Core Consultants Realty Inc. [and] registration of the trade name Core Consultants Realty Inc. with RECO” (para 36).

[29] Mr. Abramovitz states that the Opponent has earned over one million dollars in gross revenue since it commenced operations in Ontario since January 2016, and that it has incurred over \$117,000 in promotional and entertainment expenditures since commencing operations in Ontario. In particular, Mr. Abramovitz states that the Opponent invested \$27,500 in the construction of Core Consultants Realty Inc’s (Ontario) custom exhibits booth for use at International Council of Shopping Centres (ICSC) conference meetings. The customized exhibit booth “included the Core brandings, including the shared name and logo” (para 38).

Analysis

[30] The Act defines a trade name as “the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual”. As for assessing use of a trade name, the Act does not contain a definition of what constitutes such use. However, the topic was considered by the Federal Court in *Mr. Goodwrench Inc. v General Motors Corp* (1994) 55 CPR (3d) 508 (FCTD), with Simpson J. stating:

There are no provisions in the Act which define and describe the use of a trade name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207 Mr. Justice Strayer considered the problem and held that the principles in ss 2 and 4(1) of the Act apply to trade name use. In this regard, His Lordship said:

While there is no definition in the *Trade Marks Act* of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

Accordingly, use in the normal course of trade will be the test applied in these reasons.

[31] I find that the Opponent has failed to meet its initial burden as its evidence does not show use of the Opponent's trade name in Canada prior to May 8, 2016 (or at any other time). While the Abramovitz affidavit includes a copy of the certificate of incorporation of the Opponent (Exhibit C), the mere formation or registration of the company under a particular name does not, by itself, constitute use as a trade name [*Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc.*, (1995) 62 CPR (3d) 108]. Similarly, I do not consider the corporate records included in Exhibit A (for instance, the Consent to Act as Director, Subscription for Common Shares, Shareholder and Director Resolutions, and Share Certificates) and Exhibit B (Shareholder's Agreement) to be sufficient to constitute use as a trade name.

[32] While reference is made to an email from RECO confirming that the transfer of Mr. Samarah's brokerage registration to "Core Consultants Realty Inc." was completed effective February 1, 2016, the mere fact of this registration does not establish that the trade name was used in the normal course of trade and in relation to the class/classes of persons with whom such trade is to be conducted.

[33] Mr. Abramovitz also makes several assertions relating to revenues, promotion and entertainment expenses, including an investment in the construction of "Core's (Ontario) custom exhibit booth for use at ICSC conference meetings" under the trade name. However, the affidavit contains no evidence demonstrating such use at the material date.

[34] Accordingly, this ground of opposition is rejected.

[35] As the Opponent has failed to meet its initial burden to establish prior use, it is unnecessary for me to discuss the Applicant's evidence, which as previously noted, focuses on

its allegations of ownership over the Mark and the trade name Core Consultants Realty. However, I note that this was among the key issues considered by the Federal Court in *Corey Bessner Consulting Inc. v Core Consultants Realty Inc.* 2020 FC 224. The Federal Court found that the plaintiff (Mr. Bessner) had not granted any ownership interest in the trademark CORE CONSULTANTS REALTY and the CORE Logo (the CORE Marks) to the defendants (Core Consultants Realty Inc. and Mr. Abramovitz personally) either expressly or through its conduct, and that the plaintiff was the sole owner of the CORE Marks as between the parties. The defendants' use of the CORE Marks from the launch of the parties' business alliance in early 2016 to August 2018 was found to be pursuant to a license under section 50 of the Act, and the plaintiff's revocation of its permission and license to use the CORE Marks in August 2018 (following Mr. Samarah's departure from Core Consultants Realty Inc.) was found to be effective.

[36] The Federal Court further held that the defendants' continued use of the CORE Marks infringed the CORE logo registered trademark and constituted passing off contrary to section 7(b) of the Act, thus entitling the plaintiff to a permanent injunction restraining the defendants from using the CORE Marks.

Section 16(1)(b) ground of opposition

[37] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in that at the date of filing of the Application, "the Applicant used the Mark only as a licensee of the Opponent since at least May 2016, in association with real estate services".

[38] Under section 16(1)(b) of the Act, a Mark is not registrable if, at the material date, the Mark was confusing with a trademark in respect of which an application for registration had been previously filed in Canada by any other person.

[39] This ground of opposition has been improperly pleaded as the Opponent has not cited a trademark application applied for by the Opponent or any other person. Accordingly, this ground of opposition is summarily dismissed.

Section 2 ground of opposition

[40] The Opponent has pleaded that the Mark is not distinctive as it is not distinguishable from the trade name of the Opponent, Core Consultants Realty Inc., which has been used for advertisements, marketing, social media, and communication purposes so that the trade name is sufficiently known in the province of Ontario and in such real estate industry.

[41] To meet its initial evidential burden under this ground of opposition, an opponent must show that its trademark had a substantial, significant or sufficient reputation in Canada in association with the relevant goods and/or services so as to negate the distinctiveness of the applied for trademark [*Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, (2006), 48 CPR (4th) 427].

[42] In this case, the Opponent has provided no evidence of the use of its trade name in Canada. Therefore, the Opponent has not met its initial evidential burden and this ground of opposition is rejected.

DISPOSITION

[43] In view of all the foregoing, 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.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No hearing held

AGENTS OF RECORD

None

FOR THE OPPONENT

Shift Law Professional Corporation

FOR THE APPLICANT