

Federal Court



Cour fédérale

Date: 20250129

Docket: T-2144-23

Citation: 2025 FC 179

Ottawa, Ontario, January 29, 2025

PRESENT: The Honourable Madam Justice Tsimberis

BETWEEN:

T. ROWE PRICE GROUP, INC.

Applicant

and

GLIDEPATH TECHNOLOGIES INC.

Respondent

JUDGMENT AND REASONS

I. Overview

[1] The Applicant, T. Rowe Price Group, Inc. [Rowe], makes this appeal under section 56 of the *Trademarks Act*, RSC 1985, c T-13 [TMA] and Rule 300(d) of the *Federal Courts Rules*, SOR/98-106, challenging the decision of the Trademarks Opposition Board [Board] dated August 8, 2023 (2023 TMOB 140) [Decision]. The Board rejected Rowe's opposition to the Respondent Glidepath Technologies Inc.'s [Glidepath] application serial No. 1,906,787 for the trademark LIVE WITH CONFIDENCE in association with the services reproduced below based

on various grounds of opposition, including non-registrability under section 12(1)(d) of the TMA:

Management of portfolios comprising securities; Investment portfolio services, namely financial planning and investment advisory services, financial portfolio management, financial investment counselling, financial investment analysis and stock research, financial investments in the field of mutual funds, financial investments in the field of securities; Operation of a website in the field of financial management and financial planning.

[2] In its appeal, Rowe seeks a judgment setting aside the Decision, and directing the Registrar of Trademarks to refuse Glidepath's application for the LIVE WITH CONFIDENCE trademark. This appeal focusses solely on Rowe's section 12(1)(d) ground of opposition, based upon the likelihood of confusion between Glidepath's applied-for LIVE WITH CONFIDENCE trademark and Rowe's RETIRE WITH CONFIDENCE and INVEST WITH CONFIDENCE trademarks registered in association with services in the fields of financial investment planning, investment management and advisory services. More specifically, the central focus of this appeal is the Board's analysis and application of the section 6(5)(e) degree of resemblance factor, given that the Board found that each of the other relevant factors set out at section 6(5)(a) through 6(5)(d) favoured Rowe.

[3] In its appeal, Rowe argues that the Board made errors of law and errors of mixed fact and law in its analysis of the degree of resemblance between the marks that the Board found "slightly" favoured Glidepath. Glidepath argues that this is not the case and that none of the issues on appeal raised by Rowe meet the stringent standard of review on appeal of a decision of the Board. Rowe and Glidepath have not filed any new evidence on appeal.

[4] In summary, after careful review of the Decision and parties' submissions, I find that the Board committed both an error of law in the test for assessing the degree of resemblance between the trademarks and a palpable and overriding error in its application of this degree of resemblance test. For the reasons that follow, I grant this appeal, the Decision is set aside, and I direct the Registrar of Trademarks to refuse Glidepath's application for the LIVE WITH CONFIDENCE trademark.

II. Issues

[5] Rowe submits three (3) issues on appeal:

1. *The Board erred by engaging in a side-by-side comparison to differentiate between the parties' respective trademarks based on their first components (namely "LIVE" versus "INVEST" and "RETIRE"), despite finding that the trademarks are understood as "unitary phrases" and no portion is more striking or unique;*
2. *The Board erred in assessing the "degree of resemblance" by holding that the ideas conveyed by the parties' respective trademarks as a whole are different based on the ideas suggested by "LIVE" versus "INVEST" and "RETIRE", when the Board had already found as a fact that the suggestion of the marks as "unitary phrases" was similar and, in any event, neglecting to appreciate the clear overlap in ideas suggested; and,*
3. *The Board erred in finding that the impact of the similarity is "minimized" by the suggestive nature of the shared component "WITH CONFIDENCE" after concluding there is "some" degree of resemblance due to the similar grammatical structure and shared second half of the trademarks.*

III. Analysis

1. *Applicable Standards of Review*

[6] The Federal Court of Appeal settled the applicable standard of review in this type of application for judicial review made under the statutory appeal provision of section 56 of the

TMA in *Clorox Company of Canada, Ltd. v Chloretec S.E.C.*, 2020 FCA 76 [*Clorox*]. If the new evidence filed by the parties is not material (or no new evidence is adduced), the Federal Court should apply the Supreme Court's jurisprudence on appellate standards of review when dealing with an appeal under subsection 56(1) of the TMA (*Clorox* at paras 21-23; *Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 at paras 41-42, as cited in *Tokai of Canada Ltd v Kingsford Products Company, LLC*, 2021 FC 782 at para 22).

[7] Under the Federal Court of Appeal's guidance in *Clorox*, the appellate standards laid out in *Housen v Nikolaisen*, 2002 SCC 33 [*Housen*], are applicable here. For questions of fact and mixed fact and law (except for extricable questions of law), the applicable standard is therefore that of the "palpable and overriding error". For questions of law, the standard is akin to correctness.

[8] "Palpable" means an error that is obvious, and "overriding" means an error that affects the outcome of the case (*Millennium Pharmaceuticals Inc. v Teva Canada Limited*, 2019 FCA 273 at para 6). The palpable and overriding error standard of review is a high threshold (see *Canada (Commissioner of Competition) v Rogers Communications Inc.*, 2023 FCA 16 [*Rogers*] at para 7). As the Federal Court of Appeal recently stated, the Court must find palpable and overriding error, or an "obvious error" going to the "very core of the outcome of the case", to interfere on factually suffused questions of mixed fact and law as the Court must "defer to the Tribunal, in fact quite significantly" (*Rogers* at para 7).

[9] If there is a pure question of law, this Court may review the question on a standard akin to correctness, free to replace the opinion of the trial judge with its own (*Canada (Minister of*

Citizenship and Immigration) v *Vavilov*, 2019 SCC 65 at para 37 citing *Housen* at para 8; see also *Clorox* at paras 22-23). If no new evidence is filed, the Court applies the correctness standard according no deference to the conclusions of the underlying decision-maker (*Caterpillar Inc v Puma SE*, 2021 FC 974 at para 35 (appeal dismissed: 2023 FCA 4) citing *Clorox* at para 23). In other words, this appellate standard of review applies to the determination of pure questions of law raised on this appeal (*Pentastar Transport Ltd. v FCA US LLC*, 2020 FC 367 at para 45 cited in *Clorox* at para 23).

(1) *Alleged Error No. 1 – Failure to consider the marks in their totality*

[10] Rowe’s first alleged error is that the Board failed to consider the marks in their totality, engaging in a side-by-side comparison between the parties’ respective marks to distinguish the degree of resemblance between them based on their first components, despite previously finding that the trademarks are understood as unitary phrases and no portion of the trademarks is more striking or unique than the remainder.

[11] The relevant paragraphs of the Decision under contention are as follows:

[83] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks. Furthermore, while the first portion of the trademark is usually the most important for the purpose of distinguishing [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)], the Supreme Court of Canada in [*Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27] has advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique.

[84] In the present case, I agree with the Opponent that its INVEST WITH CONFIDENCE and RETIRE WITH CONFIDENCE trademarks are intended to be understood as unitary phrases. Indeed, they are short slogan-like phrases suggesting that consumers can either invest or retire "with confidence" when they retain the Opponent's services. I therefore do not consider any of the individual words (or subset thereof) to be particularly striking or unique.

[85] Likewise, I do not consider any portion of the Trademark to be more striking or unique than the others. As with the Opponent's trademarks, it is intended to be understood as a unitary phrase. The Trademark is also suggestive in that it conveys the idea that consumers can live with confidence when they retain the Applicant's services.

[86] Further, I agree with the Applicant that the ideas conveyed by the parties' respective marks as a whole are different because the first word "live" encompasses all aspects of a client's life, and therefore has a somewhat broader meaning than the words "invest" and "retire", which reference only certain specific aspects of life.

[87] Ultimately, while there is some degree of resemblance owing to the similar grammatical structures and the shared second half of the marks (*i.e.* the term "with confidence"), I find that the impact of the similarity is minimized by the fact that this shared component is suggestive [see *Venngo Inc v Concierge Connection Inc*, 2015 FC 1338 [*Venngo*], *affd* 2017FCA 96].

[88] On balance, I find that the degree of resemblance factor slightly favours the Applicant.

[12] At paragraph 83 of the Decision, the Board correctly stated the applicable law for analyzing the degree of resemblance between trademarks. Neither party debates this. There is debate, however, between the parties firstly, on whether the alleged error is an extricable error of law or an error of mixed fact and law and secondly, on whether the Board committed any error. I will deal with these in turn.

[13] Rowe submits that whether the Board failed to assess the marks in their totality by conducting a side-by-side comparison of the parties' trademarks based only on their first components is an extricable error of law, even despite the fact that the Board correctly identified the Supreme Court of Canada's preferable approach "to first consider whether there is an aspect of the trade-mark that is particularly striking or unique" at paragraph 64 of *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27 [*Masterpiece*]. Rowe submits that the failure to assess the trademarks in their totality was the result of the Board applying an incorrect legal standard, amounting to an extricable error of law reviewable on a correctness standard. In the alternative, Rowe submits this constitutes a palpable and overriding error on a question of mixed fact and law.

[14] Rowe also relies on *International Stars S.A. v Simon Chang Design Inc.*, 2013 FC 1041 [*International Stars*], where Justice Campbell found that the Board's conclusion that "the differences between the marks suffice to make confusion unlikely" was "the result of a side-by-side comparison and constitutes an error in law" (*International Stars* at para 10).

[15] Glidepath submits that the Board both cited and applied the correct approach for assessing the degree of resemblance between the trademarks, and Rowe's allegation that the Board engaged in a side-by-side comparison of the trademarks is not accurate because the Board found that no aspect of the trademark was more striking or unique than the remainder, and so the first word of the trademark should be retained as the most important when assessing confusion, also citing *Masterpiece* at paragraph 64.

[16] In its totality, paragraphs 63 through 65 from the section entitled “(7) The Resemblance Between the Trademarks in Issue” of *Masterpiece* read as follows:

[63] **The first word in both Alavida’s and Masterpiece Inc.’s trade-marks is the identical word “Masterpiece”.** It has been held that for purposes of distinctiveness, the first word is important (see *Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.), at p. 188, *per* Cattanach J.).

[64] While the first word may, for purposes of distinctiveness, be the most important in some cases, **I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.** Here there is nothing striking or unique about the word “Living” or the words “the Art of Living”. “Masterpiece” is the word that distinguishes Alavida and Masterpiece Inc. from other sources of retirement residence services. **It is a reasonable conclusion that “Masterpiece” is the dominant word in these trade-marks,** and it is obviously identical as between Alavida and Masterpiece Inc. By the same token, in the context of the retirement residence industry, the idea evoked by the word “Masterpiece”, high quality retirement lifestyle, is the same for both Alavida and Masterpiece Inc. Finally, the word “Living” is identical as between the Alavida and Masterpiece Inc. trade-marks.

[65] Given these striking similarities, it is, in my respectful view, very difficult not to find a strong resemblance **as a whole between the two, Masterpiece Inc.’s trade-marks and Alavida’s trademark.**

(Emphasis added).

[17] To be certain, I note that the *Masterpiece* approach reproduced above does not preclude the first word of a trademark from being the most striking or unique aspect of a trademark. I do, however, interpret that the *Masterpiece* approach did away with the *presumption* or *default* approach that the first word **is** the most important when assessing the degree of resemblance between trademarks, as is submitted by Glidepath at paragraphs 39, 41 and 44 of its Memorandum of Fact and Law reproduced below:

39. It is **well established in caselaw that the preferable approach** when assessing confusion **is to first consider whether there is an aspect of a trademark that is particularly striking or unique, failing which, the first word of the trademark should be retained as the most important part when assessing confusion.**

41. Upon failing to identify a particularly striking or unique aspect in the Applicant's Marks and the Opposed Mark, the [Board] **rightly pointed to the aforementioned principle that the first word or syllable of a trademark is generally the most important for the purpose of confusion.**

44. Therefore, **the TMOB should not dissect component parts of trademarks** it is comparing for evaluation of resemblance and confusion, **except for some instances, namely, regarding the first portion/word, which is recognized as the most important.**

(Emphasis added).

[18] I disagree with this summary of the law by Glidepath. Indeed, it is entirely open and within the bounds of the jurisprudence for the Board to determine that any aspect or no aspect of a trademark is the most striking or unique.

[19] This point can be illustrated within *Masterpiece* itself, as I have emphasized above. The word "Masterpiece" was the first word of the trademarks at issue and, after determining the preferable approach, Justice Rothstein went on to *apply* the preferable approach and found that the word "Masterpiece" was the dominant word in both trademarks and it was therefore the most striking aspect of both trademarks. In light of this, he found it "very difficult not to find a strong resemblance as a whole between the two, Masterpiece Inc.'s trade-marks and Alavida's trade-mark" (*Masterpiece* at para 65).

[20] The situation is factually different in the case before me. The Board did "not consider any of the individual words (or subset thereto) to be particularly striking or unique" at paragraph 84

of the Decision and at paragraph 85, the Board went on to find that no portion of the trademarks is more striking or unique than the others, and the trademarks are instead intended to be understood as unitary phrases. Given these findings, I disagree with Glidepath's submission that the first word of the trademark should be retained as the most important when assessing confusion, as this was not the approach set out and applied in *Masterpiece*. As mentioned above, Justice Rothstein applied what he stated as the preferable approach to first consider whether there is an aspect of the trademark that is particularly striking or unique, finding the word "Masterpiece" was the dominant word of the trademarks at issue *regardless of* whether it was the first word of either trademark (*Masterpiece* at paras 63-64). Here, the Board did not "consider any of the individual words (or subset thereto)" to be dominant, striking or unique.

[21] Next, Rowe helpfully pointed to *Housen* to illustrate how what may appear to be a question of mixed fact and law can actually be, in certain circumstances, a question of law:

27 Once it has been determined that a matter being reviewed involves the application of a legal standard to a set of facts, and is thus a question of mixed fact and law, then the appropriate standard of review must be determined and applied. Given the different standards of review applicable to questions of law and questions of fact, it is often difficult to determine what the applicable standard of review is. In *Southam, supra*, at para. 39, **this Court illustrated how an error on a question of mixed fact and law can amount to a pure error of law subject to the correctness standard:**

. . .if a decision-maker says that the correct test requires him or her to consider A, B, C, and D, but in fact the decision-maker considers only A, B, and C, then the outcome is as if he or she had applied a law that required consideration of only A, B, and C. If the correct test requires him or her to consider D as well, then the decision-maker has in effect applied the wrong law, and so has made an error of law.

Therefore, what appears to be a question of mixed fact and law, upon further reflection, can actually be an error of pure law.

(*Housen* at para 27, citing *Canada (Director of Investigation and Research) v Southam Inc.*, 1997 CanLII 385 (SCC), [1997] 1 SCR 748 [*Southam*] at para 39, emphasis added).

[22] I agree with Rowe that, while the application of law to produce an allegedly incorrect finding typically amounts to a question of mixed fact and law, an incorrect finding resulting from applying incorrect law is indeed an error in law. Contrary to Glidepath's submission, the fact that the Board correctly *cited* the applicable law does not mean by default that the Board correctly *applied* the applicable law. If the Board considered, then compared, only the first word of each of the parties' trademarks in spite of the *Masterpiece* approach and *Masterpiece's* instructions that "[n]either an expert, nor a court, should tease out and analyze each portion of a mark alone" (*Masterpiece* at para 83) and "judges should consider the marks at issue, each as a whole, but having regard to the dominant or most striking or unique feature of the trade-mark" (*Masterpiece* at para 92), the Board did not incorrectly apply the correct law, they applied the incorrect law. To put this in the words of *Housen/Southam*, *Masterpiece* required the Board to consider the trademarks as a whole (A) by following the preferable approach (B) and not to conduct a side-by-side analysis parsing each mark into its constituent parts and engaging in side-by-side comparison of their constituent parts (C). Having only partly followed the preferable approach by identifying no part of the trademarks is more striking or unique than the remainder (B) and are therefore unitary phrases, then going on to apply a side-by-side analysis of only the first portion of the trademarks (not the totality of the marks), the Board has in effect applied the wrong law (applying only B and not applying A and C). Therefore, applying *Housen*, Rowe's alleged error No. 1 is a pure question of law, and I shall review it on the standard of correctness.

[23] Despite correctly noting “the law is clear that the trademarks must be considered in their totality; it is not correct to lay them side by side and compare (...) similarities or differences among the elements or components of the trademarks” and correctly noting *Masterpiece*’s above-mentioned preferable approach, the Board appears to continue onward at paragraph 86 of the Decision to not only dissect the unitary phrases into their components, but then goes on to do this sort of side-by-side comparison of the first component of each trademark by analyzing the idea conveyed by the word “live” specifically in reference to the ideas conveyed by the words “invest” and “retire”. When read as a whole, it appears the Board *only* found a difference in the ideas conveyed by the respective trademarks *because* they compared the first component of the marks and subsequently used them as reference points to distinguish them from one another. Based on the limited analysis conducted at paragraph 86, there appears, in my view, to be no other conclusion that can be drawn from the Decision than that the Board could only have reached the conclusion they did, using the reasons they did, if they had not considered the parties’ trademarks in their totalities and employed a side-by-side comparison parsing each mark into its component parts and comparing the ideas suggested between the trademarks’ components. I agree with Rowe’s submission that the flawed application of the degree of resemblance analysis, namely, the Board’s failure to assess the marks in their totalities, led the Board to erroneously conclude the “ideas suggested” by the parties’ marks are different.

[24] In my respectful opinion, I find, therefore, that the Board erred in law by engaging a legal standard different from and contrary to the approach prescribed in *Masterpiece*. Having found the Board erred in law on this point, I shall complete the correctness analysis by applying the correct law to determine the correct outcome. Had I not concluded that the Board erred in law, I

would have nonetheless agreed with Rowe that this constitutes a palpable and overriding error on a question of mixed fact and law for essentially the reasons in Section C below.

[25] Having reviewed the evidence and the parties' submissions to the Court on this point, I agree with the Board that the parties' trademarks are all unitary phrases, as no aspect of the trademarks appears more striking or unique than the remainder. I likewise agree that the phrase "WITH CONFIDENCE" in each trademark within the context of the audience and services for both parties are dictionary words that within the trademarks as a whole suggest that a consumer can either live, invest, or retire, having confidence in one's financial security by engaging either party for their financial management service offerings. I also agree with the Board that Rowe's trademarks INVEST WITH CONFIDENCE and RETIRE WITH CONFIDENCE are short slogan-like phrases (3 words) suggesting that consumers can invest or retire "with confidence" when they retain Rowe's services. I am similarly of the view that Glidepath's trademark LIVE WITH CONFIDENCE is a short slogan-like phrase (3 words) suggesting that consumers can live "with confidence" when they retain Glidepath's services. Given the virtually identical services in association with which the parties' trademarks are used, which the Board characterized as management and advisory services in the financial and investment planning field (Decision at para 78), and when considering the ideas suggested by the trademarks as a whole, I see little or no distinction between the trademarks' respective meanings, namely "living with confidence in one's financial security" and either "investing with confidence in one's financial security" or "retiring with confidence in one's financial security". I cannot find a meaning for living with confidence in one's financial security if one is not either investing or retiring with that same confidence. I find the trademarks bear sufficient resemblance in the ideas suggested by them that the factor of degree of resemblance favours Rowe.

[26] As the Board found all the other factors in the confusion analysis favoured Rowe and, after applying the correct law following the *Masterpiece* approach, the factor of degree of resemblance likewise favours Rowe for the reasons mentioned above and those in paragraph 32 below. I find that, as a matter of first impression, and upon the vague or imperfect recollection of a casual consumer “somewhat in a hurry” (*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 [*Veuve*] at para 20), there exists a likelihood of confusion between Glidepath’s LIVE WITH CONFIDENCE applied-for trademark and Rowe’s INVEST WITH CONFIDENCE and RETIRE WITH CONFIDENCE registered trademarks. As such, pursuant to section 12(1)(d) of the TMA, Glidepath’s LIVE WITH CONFIDENCE trademark is not registrable.

2. *Alleged Error No. 2 - Erred in assessing the "degree of resemblance" by differentiating based on the ideas suggested by "LIVE" versus "INVEST" and "RETIRE" despite prior findings of fact*

[27] I begin by noting that, in my view, Rowe's alleged error No. 2 is, in essence, the same as alleged error No. 1, with the difference being alleged error No. 1 is framed as a question of law, while alleged error No. 2 alleges the same error as a question of mixed fact and law. The parties' positions on this error are, at their core, the same as their positions on alleged error No. 1. In its Memorandum of Fact and Law, Glidepath argues the following:

53. In the Decision, the [Board] observed that no component of either the Applicant’s Marks or the Opposed Mark were particularly striking or unique, concluding the Trademarks were to be understood as unitary phrases.

54. Following this conclusion, the TMOB looked at the **ideas conveyed** by the parties’ respective Trademarks **as a whole**. This led the TMOB to give less weight to the aspects of the Trademarks that resembled one another – the shared second halves of the Trademarks – and more weight to the ideas conveyed as a whole.

(Emphasis in original).

[28] At paragraphs 84 and 85 of the Decision reproduced above at paragraph 11, the Board finds and continually reinforces their finding that the trademarks are intended to be understood as unitary phrases, and the Board considers them as such, with Rowe’s “phrases suggesting that consumers can either invest or retire “with confidence” when they retain the [Applicant’s] services” and with Glidepath’s trademark “convey[ing] the idea that consumers can live with confidence when they retain the [Respondent]’s services”. Despite this, and as discussed at paragraph 22 above, the Board does not analyze the degree of resemblance of the trademarks as though they were unitary phrases, instead at paragraph 86 of the Decision analyzing the ideas conveyed by the parties' respective marks based on the ideas suggested purely by the first word of each trademark.

[29] Once again, I found *Housen* instructive on this point:

28 However, where the error does not amount to an error of law, a higher standard is mandated. Where the trier of fact has considered all the evidence that the law requires him or her to consider and still comes to the wrong conclusion, then this amounts to an error of mixed law and fact and is subject to a more stringent standard of review: *Southam, supra*, at paras. 41 and 45. While easy to state, this distinction can be difficult in practice because matters of mixed law and fact fall along a spectrum of particularity. This difficulty was pointed out in *Southam*, at para. 37:

. . .the matrices of facts at issue in some cases are so particular, indeed so unique, that decisions about whether they satisfy legal tests do not have any great precedential value. If a court were to decide that driving at a certain speed on a certain road under certain conditions was negligent, its decision would not have any great value as a precedent. In short, as the level of generality of the challenged proposition approaches utter particularity, the matter approaches pure application, and hence draws nigh

to being an unqualified question of mixed law and fact. See R. P. Kerans, *Standards of Review Employed by Appellate Courts* (1994), at pp. 103-108. Of course, it is not easy to say precisely where the line should be drawn; though in most cases it should be sufficiently clear whether the dispute is over a general proposition that might qualify as a principle of law or over a very particular set of circumstances that is not apt to be of much interest to judges and lawyers in the future.

(*Housen* at para 28, citing *Southam* at para 37).

[30] Even had I not found the Board erred in law in doing so, I find their manner of analyzing the degree of resemblance between the trademarks based on the ideas suggested by their first words alone is entirely at odds with their finding that the trademarks are unitary phrases. It is internally inconsistent, incoherent, and illogical to find the trademarks are understood as unitary phrases and then, in the same breath, assess them based only on ideas suggested only by their first words. If the trademarks are unitary phrases, they must be assessed by the ideas suggested by each unitary phrase in their totality. To again characterize this error in the wording of *Housen*, while the Board may have considered all the evidence required, the Board came to the wrong conclusion as a result of their flawed application of the law to the facts.

[31] This finding by the Board appears to be the only component that swayed the factor of the degree of resemblance in favour of Glidepath. If this finding is an error, it stands to reason that all factors would then favour Rowe, and the Board would have found there to be a likelihood of confusion between the trademarks. This being the case, I find the Board erred in assessing the degree of resemblance between the trademarks based on the ideas suggested only by the first word of each trademark. As this analysis appears to have swayed the factor of degree of resemblance in favour of Glidepath, being the only factor in favour of Glidepath, I find the Board

committed a palpable and overriding error in conducting an analysis between the trademarks as unitary phrases based on the ideas suggested only by the first word of each trademark. This error is palpable and overriding because, as Justice Stratas highlighted the requirements thereof, it was "an 'obvious error' going to the 'very core of the outcome of the case'", or rather, the entire "tree" of the Decision falls (*Rogers* at para 7).

[32] In addition to the Board's findings at paragraphs 84 and 85 of the Decision that I have summarized at paragraph 20 above, the Board went on at paragraph 67 of the Decision to agree that the term "with confidence" in all three marks "alludes to the relationship of trust which underlies the provision of financial investment management and advisory services" and finds the words "live", "invest" and "retire" in the trademarks LIVE WITH CONFIDENCE, INVEST WITH CONFIDENCE and RETIRE WITH CONFIDENCE "suggest that one can live, invest, and retire, having confidence in one's financial security". I agree with the Respondent that the Board made findings of fact that the connotation of all three marks as unitary phrases was similar and all linked by "having confidence in one's financial security", which implies the marks are similar in the ideas suggested when considered in their totalities. In my view, such "factual findings (...) cannot sit together" and constitute a palpable error by the Board (*Arterra Wines Canada Inc. v Diageo North America, Inc.*, 2020 FC 508 at para 31 citing the Federal Court of Appeal in *Mahjoub v Canada (Citizenship and Immigration)*, 2017 FCA 157 at para 62:

[62] "Palpable" means an error that is obvious. **Many things can qualify as "palpable." Examples include obvious illogic in the reasons (such as factual findings that cannot sit together),** findings made without any admissible evidence or evidence received in accordance with the doctrine of judicial notice, findings based on improper inferences or logical error, and the failure to make findings due to a complete or near-complete disregard of evidence.

(Emphasis added).

[33] I agree with Rowe that the Board's inconsistent findings and assessment of the ideas suggested by the parties' trademarks constitutes a palpable and overriding error. Other than analysing the ideas suggested by the parties' trademarks, the Board did not make any other clear conclusions with respect to any differences in the appearance or sound of the parties' respective trademarks, finding only that the grammatical structure of the trademarks was similar, concluding at paragraph 88, that "[o]n balance, I find the degree of resemblance factor slightly favours the [Respondent]." As such, I need not balance any of the Board's findings of the degree of resemblance between the marks in appearance or sound against my findings on the degree of resemblance in the ideas suggested by the trademarks. Considering the evidence before the Board *de novo* on the degree of resemblance of the marks in the ideas suggested by them, given what I consider to be a strong resemblance between the marks, and given that the Board found that all other factors in the confusion analysis favour Rowe, I find that, as a matter of first impression, and upon the vague or imperfect recollection of a casual consumer "somewhat in a hurry" (*Veuve* at para 20), confusion is likely between Glidepath's LIVE WITH CONFIDENCE trademark and Rowe's INVEST WITH CONFIDENCE and RETIRE WITH CONFIDENCE trademarks. As such, pursuant to section 12(1)(d) of the TMA, Glidepath's LIVE WITH CONFIDENCE trademark is not registrable.

- (2) *Alleged Error No. 3 - Erred in holding the suggestive nature of "WITH CONFIDENCE" minimizes the degree of resemblance*

[34] Having already found the Board committed both an error in law and a palpable and overriding error that swayed the factor of the degree of resemblance in favour of Glidepath, and given that all the other confusion factors were in favour of Glidepath, I find it unnecessary to

spend judicial resources analysing Rowe’s alleged error No. 3 in much detail. For completeness, I will do so very briefly.

[35] Glidepath argues that Rowe’s assertion that the Board erred in concluding the similarity between the parties’ marks is “minimized” due to the suggestive nature of the shared component “WITH CONFIDENCE” does not correspond to a palpable and overriding error. Suffice it to say that I agree with the Rowe’s submissions at paragraphs 77 and 78 through 79 of its Memorandum of Fact and Law, which I reproduce below:

77. Plainly, “WITH CONFIDENCE”, on its own, is not suggestive of financial investment management and advisory services. It can only become suggestive when used in combination with the first words. This is what the [Board] found as a fact when it considered the inherent distinctiveness of the marks (Decision at para 67). Specifically, the [Board] found the term “with confidence” is not clearly descriptive, but at a minimum, alluded to the relationship of trust underlying the provision of financial investment management and advisory services when used in combination with the first words “live”, “invest”, and “retire”—“dictionary words which suggest that one can live, invest, and retire, having confidence in one’s financial security.” (Decision at para 67)

(Emphasis in original).

78. In its application of the law, the [Board] again failed to consider the trademarks as a whole and as unitary phrases, contrary to established jurisprudence. For example, in *Accessoires d’Autos Nordiques Inc v Canadian Tire Corp*, [2007 FCA 367 at para 23], the Federal Court of Appeal held as follows:

In considering the possibility of confusion, the trade-marks in question must be considered as a whole. This was stated in *British Drug Houses Ltd. v. Battle Pharmaceuticals*, 1944 CanLII 308 (CA EXC), [1944] Ex. C.R. 239, at p. 251, affirmed 1945 CanLII 49 (SCC), [1946] S.C.R. 50:

It is, I think, firmly established that, when trade marks consist of a combination of elements, it is not a proper approach to the determination of whether they are similar to break them up onto their

elements, concentrate attention upon the elements that are different and conclude that, because there are differences in such elements, the marks as a whole are different. Trade Marks may be similar when looked at in their totality even if differences may appear in some of the elements when viewed separately. It is the combination of the elements that constitutes the **trade mark and gives distinctiveness to it, and it is the effect of the trade mark as a whole, rather than of any participate part in it, that must be considered** (the emphasis is ours) (*British Drug Houses*, p. 251).

(Underlining in the original, emphasis in bold added).

[36] I agree with Rowe that the Board erred at paragraph 87 of its Decision when it found that “the impact of the similarity” in “the shared second half of the marks (i.e. the term “WITH CONFIDENCE”) “is minimized by the fact that this shared component is suggestive” and that the Board’s reliance on *Venngo* in the different factual circumstances of this matter is misapplied. What the Member of the Board appears to be saying at paragraph 87 is that the words WITH CONFIDENCE are suggestive; so I, the Member, minimize them in considering the overall resemblance between the marks. In my view, what the Member seems to have done, however, is discount them to the point of nothingness, in contradiction to the finding that they are suggestive (as opposed to clearly descriptive – see para 67 of the Decision). Given that the Board found as a fact that this “WITH CONFIDENCE” term was only suggestive, the term should have been considered in combination with the first words “LIVE”, “INVEST”, or “RETIRE” in their totalities, as unitary marks (Decision at paras 84 and 85) . In my view, this constitutes a reviewable error similar to the “mistake” the Federal Court of Appeal pointed out was made in *Miss Universe, Inc. v Bohna*, (C.A.), 1994 CanLII 3534 (FCA), [1995] 1 FC 614 at pages 629-630, which related to an appeal from a Federal Court decision holding there was no

serious likelihood of confusion between the MISS NUDE UNIVERSE and MISS UNIVERSE trademarks:

Lastly, I note that the Trial Judge did not refer, when he dealt with the issue of confusion, to the factor set out in paragraph 6(5)(e), i.e. the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. The only related comment he made, and that was in regard to the issue of the distinctiveness of the proposed trade-mark, is the following, which I have reproduced earlier:

Further, while the two trade-marks have two words in common, my first impression when looking at the two is that the word “Nude” in the middle of the applicant’s trade-mark is of an arresting significance which would convey to all but the most indifferent reader a profound difference between the two contests. Therefore the applicant’s trade-mark is distinctive.

I am prepared, for the sake of argument, to accept that these comments could also have been made by the Trial Judge in the context of paragraph 6(5)(e) and to treat them in that context.

It is a mistake, in my view, to consider the word “Nude,” in isolation, as being of “an arresting significance.” There is, when one looks at both marks, a degree of resemblance. That degree of resemblance may be small when the marks are considered as a whole “but,” once more referring to Thurlow C.J.’s reasons in Mr. *Submarine*, “there is resemblance and in my view it cannot be ignored.”

[37] Having already completed above the *de novo* analysis for the degree of resemblance factor for another error of law and palpable and overriding error that swayed the factor of the degree of resemblance in favour of Glidepath, I am of the view that I need not continue any further.

IV. Costs

[38] At the hearing, the parties agreed that the costs award should be \$5,000 inclusive of taxes and disbursements to the successful party. Finding Rowe has been successful on this appeal, I order costs payable to Rowe in the amount of \$5,000 inclusive of taxes and disbursements.

V. Conclusion

[39] Given both the error of law in the test for assessing the degree of resemblance between the trademarks that materially impacted the result of the Decision, and the noted palpable and overriding errors present in that part of the Decision, Rowe's appeal is granted. The Registrar of Trademarks will be directed to refuse Glidepath's application for the LIVE WITH CONFIDENCE trademark. As the successful party, Rowe is awarded the agreed-upon lump sum costs award of \$5,000, inclusive of taxes and disbursements.

JUDGMENT in T-2144-23

THIS COURT'S JUDGMENT is that:

1. The Application and the within appeal are granted with costs payable to T. Rowe Price Group, Inc. in the amount of \$5,000 inclusive of taxes and disbursements;
2. The decision of the Trademarks Opposition Board dated August 8, 2023 (2023 TMOB 140) rejecting T. Rowe Price Group, Inc.'s opposition to application No. 1,906,787 is set aside;
3. The Court directs the Registrar of Trademarks to refuse Glidepath Technologies Inc.'s application No. 1,906,787 to register the LIVE WITH CONFIDENCE trademark.

"Ekaterina Tsimberis"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-2144-23

STYLE OF CAUSE: T. ROWE PRICE GROUP, INC. v GLIDEPATH
TECHNOLOGIES INC.

PLACE OF HEARING: TORONTO, ONTARIO

DATE OF HEARING: JUNE 18, 2024

JUDGMENT AND REASONS: TSIMBERIS J.

DATED: JANUARY 29, 2025

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