



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 263
Date of Decision: 2011-12-23

**IN THE MATTER OF AN OPPOSITION
by Reed Solutions Plc to application No.
1,164,803 for the trade-mark REED
EXHIBITIONS in the name of Reed
Elsevier Group Plc**

[1] On January 15, 2004, Reed Elsevier Group Plc (the Applicant), filed an application for the trade-mark REED EXHIBITIONS (the Mark) based upon use of the Mark in Canada since at least as early as February 2002. The statement of wares/services currently reads:

Wares:

Printed materials namely leaflets, calendars, business cards, stationery, namely, writing paper, guides, newsletters, instructional and teaching materials, namely, books, guides, charts, manuals, booklets, pamphlets, newspapers, diaries and brochures relating to tradeshows, exhibitions, expositions, fairs, business and educational conferences in a wide variety of fields including aerospace, defense, marine, arts, entertainment, music, building, property, interior design, construction, books, publishing, electronics, electrical engineering, engineering, manufacturing, processing, food service, hospitality, information technology, communications, marketing, business services, training, retail, safety, security, sports, leisure, health, healthcare, pharmaceutical, and travel.

Services:

Arranging and conducting tradeshows, fairs, exhibitions and expositions directed to a wide variety of industries including aerospace, defense, marine, arts, entertainment, music, building, property, interior design, construction, books, publishing, electronics, electrical engineering, engineering, manufacturing, processing, food service, hospitality, information technology, communications, marketing, business services, training, retail, safety, security, sports, leisure, health, healthcare, pharmaceutical, and travel; promoting

tradeshows, fairs, exhibitions and expositions directed to a wide variety of industries including aerospace, defense, marine, arts, entertainment, music, building, property, interior design, construction, books, publishing, electronics, electrical engineering, engineering, manufacturing, processing, food service, hospitality, information technology, communications, marketing, business services, training, retail, safety, security, sports, leisure, health, healthcare, pharmaceutical, and travel by displaying information on the worldwide web, by distributing information by electronic mail, by distributing printed material and by issuing press releases; promoting the goods and services of others in a wide variety of industries including aerospace, defense, marine, arts, entertainment, music, building, property, interior design, construction, books, publishing, electronics, electrical engineering, engineering, manufacturing, processing, food service, hospitality, information technology, communications, marketing, business services, training, retail, safety, security, sports, leisure, health, healthcare, pharmaceutical, and travel by displaying information on the worldwide web, by distributing information by electronic mail, by distributing printed material and by issuing press releases; arranging and conducting business and education conferences in a wide variety of fields including aerospace, defense, marine, arts, entertainment, music, building, property, interior design, construction, books, publishing, electronics, electrical engineering, engineering, manufacturing, processing, food service, hospitality, information technology, communications, marketing, business services, training, retail, safety, security, sports, leisure, health, healthcare, pharmaceutical, and travel; promoting business and education conferences in a wide variety of fields including defense, marine, arts, entertainment, music, building, property, interior design, construction, books, publishing, electronics, electrical engineering, engineering, manufacturing, processing, food service, hospitality, information technology, communications, marketing, business services, training, retail, safety, security, sports, leisure, health, healthcare, pharmaceutical, and travel by displaying information on the worldwide web, by distributing information by electronic mail, by distributing printed material and by issuing press releases.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 19, 2006.

[3] On December 19, 2007, Reed Solutions Plc (the Opponent) filed a statement of opposition against the application. The grounds of opposition are that: the Applicant's application does not conform to the requirements of s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) because the Applicant has not used the trade-mark in Canada in association with the applied for wares and services since the date of first use; the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(a) of the Act in that at the date

of first use, it was confusing with the Opponent's previously used and made known trade-mark REED, used in association with:

Recruitment services and employment agency services, namely, employment counselling and recruitment, personnel placement and recruitment, work force management services, human resource consulting, research and analysis, staffing and outsourcing services, contract staffing services, career consulting and career management, business consultation services in the field of personnel management, placement, recruitment and location, employee attraction, retention and analysis programmes; and

the Mark is not distinctive in view of the prior use, advertising and making known in Canada of the REED trade-mark for the services set out above. The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[4] The Opponent's evidence consists of the affidavits of Ryan Osten and Dane Penney. Both Mr. Osten and Mr. Penney were cross-examined on their affidavits and the cross-examination transcripts, exhibits and replies to undertakings form part of the record. The Applicant elected not to file any evidence.

[5] Only the Applicant filed a written argument and while both parties requested an oral hearing, an oral hearing was conducted at which only the Applicant was represented.

Onus and Material Dates

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[7] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 38(2)(c)/s. 16(1) - the Applicant's date of first use [see s. 16(1)];
- s. 38(2)(d)/s. 2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30(b) Ground

[8] The Opponent has pleaded that the Applicant has not used the trade-mark in Canada in association with the wares and services set out in the application, either at all, or since the date of first use alleged in the application.

[9] To the extent that the relevant facts pertaining to a ground of opposition based upon s. 30(b) of the Act are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to such a ground of opposition is lower [see *Tune Masters v. Mr. P.'s Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. Also, the Opponent may rely upon the Applicant's evidence provided that such evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. In this regard, s. 30(b) of the Act requires that there be continuous use of the trade-mark applied for since the date claimed [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.)].

[10] The affidavit of Mr. Osten, an articling student employed by the Opponent's agent, contains the results of a search conducted through an Internet Archive website in respect of the Applicant's mark. Mr. Osten was instructed to print the home pages of the January 22, 2002, and March 26, 2002, archived versions of the website *www.reedexpo.ca*, click on the "event calendar" on the left hand side of the pages for each date and print the event calendars for both archived versions.

[11] On cross-examination, the Applicant's agent pointed Mr. Osten to the Frequently Asked Questions (FAQ) section on the Internet Archive website which outlined some of the limitations of the website including the following:

- when a dynamic page of a website contains forms, java script or other elements that require interaction with the originating host, the archive will not contain the original site; and
- when looking at the collection of archive sites, one will find sometimes broken pages and missing graphics.

[12] Mr. Osten admitted that he did not know whether the printouts of the home pages and event calendars represented the complete representation of the entire website at *www.reedexpo.ca* including graphics and functionality as of January 22, 2002 or March 26, 2002. Further, he admitted that he did not click on the link to Global Event Directory for a listing of REC Worldwide events in the U.S. and other countries.

[13] Relying on the decision in *GSW Inc. v. Registrar of Trade-marks* (1999), 87 C.P.R. (3d) 300 (F.C.T.D.), the Applicant submits that since it has put the reliability of Mr. Osten's evidence in issue through cross-examination, the evidence of Mr. Osten is either inadmissible or very little weight should be given to it. The Applicant's agent also distinguished the present case from the decision in *ITV Technologies, Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4th) 182 at 192 (F.C.T.D.), affirmed (2005), 38 C.P.R. (4th) 481 (F.C.A.), on the basis that in the *ITV* decision, both parties were seeking to rely on evidence by using the Way Back machine and had therefore consented to its admissibility whereas in the present case, the Applicant has not consented to the use of this website.

[14] While the Applicant's comments about the limitations of the Way Back machine have been noted, the evidence produced by the Way Back Machine indicating the state of websites in the past has been found to be generally reliable [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.); reversed on other grounds 2008 F.C.A. 100]. More particularly, the admissibility of such evidence in support of an opponent's s. 30(b) ground of opposition has been commented on as follows by Board Member Bradbury in *Royal Canadian Golf Assn. v O.R.C.G.A.* (2009), 72 C.P.R. (4th) 59 (T.M.O.B.), at pages 64-65:

I appreciate that there may be limitations to the accuracy of the Way Back Machine, including but not limited to possible hearsay issues. However, for the purpose of meeting the Opponent's light initial burden under s. 30(b), I find that the search results are sufficient to raise a doubt concerning the correctness of the Applicant's claimed date of first use [...].

The Applicant had the opportunity to file evidence to rebut the results of the Way Back Machine search but chose not to.

[15] In the present case, however, Mr. Osten's search results are not sufficient to meet the Opponent's light initial burden under s. 30(b) of the Act. In this regard, the Opponent has not presented any oral or written argument explaining how the Internet Archive pages evidenced by Mr. Osten put the Applicant's claimed date of first use into issue. In any case, my review of these pages show the mark REED EXHIBITIONS appearing at the top of what Mr. Osten identifies as the home page of the Internet archive, and the Trade Show and Events Calendars show dates of various trade shows and events beginning in March of 2001, which is clearly before the Applicant's claimed date of first use. The fact that the Applicant did not promote the applied for wares or other services on the web pages is not sufficient by itself to show that the Applicant did not use the Mark in Canada in association with such wares and services continuously between its claimed date of first use and the filing date of its application. In conclusion, in my view, there is nothing in Mr. Osten's evidence that is clearly inconsistent with the Applicant's claimed date of first use.

[16] As the Opponent has failed to meet its evidential burden under this ground, this ground of opposition fails.

Section 16 Ground

[17] In order for the Opponent to meet its burden under the s. 16(1)(a) ground, the Opponent must show evidence of use of its mark in Canada prior to the Applicant's date of first use. In this regard, s. 16(1)(a) of the Act reads as follows:

(1) Any applicant who has filed an application in accordance with s. 30 for registration of a that is registrable and that he or his predecessor in title has used in Canada or made known in Canada in association with wares or services is entitled, subject to section 38, to secure its registration in respect of the wares or services, unless at the date on which he or his predecessor in title first so used it or made it known it was confusing with:

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

[18] The Opponent has not met its initial burden with respect to the s. 16(1) ground because it has not evidenced that its REED mark was used or made known in Canada prior to February, 2002, the Applicant's date of first use. This ground is therefore unsuccessful.

Section 38(2)(d) Ground

[19] The Opponent has pleaded that the Mark is not distinctive and is not adapted to distinguish the wares of the Applicant from the wares or services of others, including the business and services of the Opponent, in view of the prior use, advertising and making known in Canada of the REED mark for the above noted services.

[20] While there is a legal burden on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[21] In order to meet its initial burden with respect to this ground, the Opponent must show that, as of December 19, 2007, its trade-mark was known to an extent that could negate the distinctiveness of the Mark, and that its trade-mark's reputation in Canada was substantial, significant or sufficient [*Bojangles' International LLC v. Bojangles Café Ltd.*, 48 C.P.R. (4th) 427 (F.C.) at para. 34].

[22] As noted above, the Opponent did not file any evidence of prior use, advertising or making known in Canada of its REED mark. Other than the affidavit of Mr. Osten, the only evidence of the Opponent is the affidavit of Mr. Penney which introduces as exhibits particulars of six trade-marks containing the word REED. Out of the six marks evidenced by Mr. Penney, one of these marks is currently abandoned, two of the marks are those of the Applicant, and only one of the remaining three marks is a registered mark.

[23] The Opponent's distinctiveness ground, as pleaded, does not rely on any third party's use to prove non-distinctiveness of the Mark. Even if it did, a copy of one third party registration would not be sufficient to meet the Opponent's burden under this ground.

[24] In view of the Opponent's failure to meet its evidential burden under this ground, this ground of opposition fails.

Disposition

[25] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office