

**IN THE MATTER OF AN OPPOSITION
by Cloud 9 (The Tribe) Limited
to application no. 1,001,952 for the trade-
mark TRIBE 8 filed by Pierre Ouellette**

On January 12, 1999, the applicant Pierre Ouellette filed an application to register the trade-mark TRIBE 8 based on

(1) use in Canada by the applicant (and its predecessor in title Dream Pod 9 Inc.) since as early as June 1998 in association with the following wares:

printed matter namely, series of fictional books and novels featuring the exploits of fictional characters;

drawings and posters;

collectable card games featuring the exploits of fictional characters;

(2) proposed use in Canada in association with the following wares and services:

wares

large scale sculpts and miniatures made of lead or pewter being tri-dimensional representations of the game characters, the characters' equipment and vehicles created by the applicant to use in playing such tactical games or as collectable items;

interactive software programs to play electronic role-playing and tactical games created by the applicant;

video output game programs;

pre-recorded videocassettes and computer games on CD-ROMS; toys, namely: toy action figures and hobby craft kits of the role-playing and tactical games created by the applicant and small metal lapel pins;

services

production of feature and television films and television series.

The subject application was advertised for opposition purposes in the August 16, 2000 issue of the *Trade-marks Journal* and was formally opposed by Cloud 9 (The Tribe) Limited on October 16, 2001, after the opponent was granted several extensions of time to oppose with consent of the applicant. A copy of the statement of opposition was forwarded by the Registrar to the applicant on October 30, 2001. The applicant responded by serving and filing a counter statement generally denying the allegations in the statement of opposition.

The first ground of opposition alleges that the application is not in compliance with Section 30(b) of the *Trade-marks Act* because (i) the date of first use of the mark in association with wares is not correct, and (ii) the mark has not been used since June 1998 in association with all of the wares as claimed in the application.

The second ground of opposition alleges that the application is not in compliance with Section 30(e) of the *Act* because the applicant does not intend to use the mark, by itself or through a licensee, in association with wares and services as claimed in the application.

The third ground of opposition alleges that the application is not in compliance with Section 30(i) of the *Act* in view of “prior trade-mark rights of the Opponent” regarding the opponent’s trade-marks THE TRIBE, application no. 897,120; and THE TRIBE & Design, application no. 897,119, illustrated below, both filed on November 20, 1998.



The fourth ground alleges that the applicant is not entitled to register the applied for mark TRIBE 8, pursuant to Section 16(3), because at the date of filing the application on January 12, 1999, the applied for mark was confusing with the opponent's trade-mark applications referred to above.

The fifth ground, pursuant to Section 2 of the *Act*, alleges that the applied for mark is not distinctive of the applicant's wares and services.

The opponent's evidence consists of the affidavit of Aky Najeeb, CEO of the opponent company; the affidavit of Timothy C. Bourne, an associate of the firm representing the opponent; and certified copies of trade-mark application nos. 897,119 and 897,120 referred to above. I note that the aforementioned applications were filed prior to January 12, 1999 and were pending as of August 16, 2000 in compliance with Section 16(4) of the *Act*. The applicant Pierre Ouellette submitted an affidavit on his own behalf. Both parties filed written arguments, however, only the opponent attended at an oral hearing.

Mr. Najeeb's evidence, as it relates to the opponent's activities in Canada, may be summarized as follows. The opponent company develops and produces television shows for the international market. Included in the opponent's programming portfolio is the television series

entitled The Tribe. The aforementioned television series is aimed at a viewing audience consisting mostly of children and teenagers. The following synopsis of the series appears in Exhibit J of Mr. Najeeb's affidavit:

Each season of the series features 26 one-hour or 52 one-half hour episodes. The series was first broadcast in Canada on TV Ontario in October 2000 and was running continuously until at least June 2002 (the date of Mr. Najeed's affidavit). TV Ontario has promoted the The Tribe series by broadcasting promotional trailers and by listing broadcasting times in Canadian television magazines and in its *Signal* magazine. The opponent promotes The Tribe television series by maintaining a web site which provides information about the series, the actors appearing in the series, and background regarding the characters and the plot. At the web site fans may post messages about the show and may purchase memorabilia merchandise. Mr. Bourne's evidence provides further information regarding the opponent's web site for its television series The Tribe and corroborates other portions of Mr. Najeeb's affidavit testimony.

The trade-mark applications for THE TRIBE and THE TRIBE & Design relied on by the opponent are based, in part, on proposed use in Canada in association with the following:

wares

apparatus and instruments for use in the recording and reproduction of audio and visual images; pre-recorded cinematographic films, pre-recorded video tapes; computer software, computer programmes and data carriers therefor; computer-generated graphics; pre-recorded computer graphic and animations on film; CDs, CD ROMs, video tape, audio tape, records, mini-discs, video disc, laser disc and computer chips.

paper, cardboard and goods made from these materials, not included in another class; printed matter; books, periodicals, publications, photographs; stationery; instructional and teaching materials (except apparatus).

articles of clothing; footwear and headgear.

toys, games and playthings.

services

entertainment services relating to production, provision and supply of television and film entertainment services.

The above mentioned applications are also based on corresponding trade-mark applications filed in the United Kingdom. Accordingly, the opponent may request registration of its marks in Canada simply upon their registration in the United Kingdom without any requirement of having used its marks in Canada.

Mr. Ouellette's affidavit evidence may be summarized as follows. The applicant Mr. Ouellette is the President of Dream Pod 9 Inc., a company incorporated in December 1995. The applied for mark TRIBE 8 was in use by Dream Pod 9 Inc. since June 1998 until that company transferred its interest in the mark to Mr. Ouellette. After the transfer, Dream Pod 9 Inc. (DP9)

continued to use the mark under an exclusive license from Mr. Ouellette. DP9 is a Montreal based “entertainment properties design and publishing studio” which creates role playing game books. One of its main products is a game book sold under the mark TRIBE 8. The game is set in a tribal future with a post-apocalyptic background. A synopsis of the game, shown below, appears in Exhibit PO-3 of Mr. Ouellette’s affidavit.

The TRIBE 8 game is sold through about 30 distributors to thousands of gaming and hobby stores in Canada and worldwide, as well as directly by DP9 to retail stores and customers via its online store web site. DP9 releases about five books per year under its TRIBE 8 mark. Since release of the first game rule book in June 1998, sales of the books under the mark have

totalled to about \$350,000. DP9 intends to produce and license television films or television series related to its role playing game TRIBE 8, as well as video cassettes, games on CD-roms, toy action figures and miniatures of the characters featured in the game.

There is an initial evidential burden on the opponent in respect of each ground of opposition pleaded in the statement of opposition. To meet the evidential burden upon it in relation to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. Once the opponent satisfies that burden, the legal onus is on the applicant to establish, on a balance of probabilities, that its application complies with the provisions the *Trade-marks Act*.

With respect to the first and second grounds of opposition, the opponent has not submitted any evidence to support its pleadings. However, the opponent points to (1) the applicant's evidence (see paragraph 5 of Mr. Ouellette's affidavit) that the assignment of the applied for mark TRIBE 8 occurred on January 11, 1999, just one day prior to the filing of the subject application, and (2) the absence of documentation concerning the license agreement between the applicant and DP9 referred to in Mr. Ouellette's affidavit. The opponent submits that the above circumstances are sufficient to put into issue what person was using the mark and who in fact owned the mark. I do not accept the opponent's submission. Mr. Ouellette's uncontradicted and unchallenged evidence supports the applicant's claims regarding use and ownership of the applied for mark and supports the claims in the application regarding intended

use of the mark. While the applicant's evidence is open to criticism for not being more complete, it is not vague or self-contradicting. In the absence of further information that might have been elicited by cross-examination of Mr. Ouellette to support the opponent's submissions, the first and second grounds of opposition are rejected because the opponent has failed to meet its evidential burden. The applicant argues that the third ground of opposition should be rejected for the same reason, and I agree. Moreover in my view the third ground can also be rejected pursuant to Section 38(3)(a) for failing to plead sufficient particulars.

As noted by the applicant in its written argument, the fourth ground of opposition is based on Section 16(3)(b) of the *Act* which relates only to the proposed use portion of the subject application. In other words, the fourth ground does not raise a ground of opposition against the wares for which the applicant claims use since June 1998. Thus, the issue raised by the fourth ground is whether the applied for mark TRIBE 8, proposed for the wares and services specified in the subject application, is confusing with the opponent's trade-mark applications for THE TRIBE and THE TRIBE & Design. As the differences between the opponent's marks are quite minor, I will simply refer to the opponent's marks together in the singular as THE TRIBE. As set out in Section 16(3) of the *Act*, the material time to assess the issue of confusion is the date of filing the subject application, in this case January 12, 1999.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark TRIBE 8 and the opponent's mark THE TRIBE. The presence of an onus on the applicant means that if a

determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The opponent's mark THE TRIBE does not possess a high degree of inherent distinctiveness as TRIBE is a common word, and the mark as a whole suggests the general concept reflected in the opponent's wares and services. Similarly, the applied for mark does not possess a high degree of inherent distinctiveness as the numeral 8 adds little to the distinctiveness of the mark TRIBE 8 as a whole. I infer from the evidence that the opponent's mark THE TRIBE may have acquired some reputation in Canada after October 2000, however, the opponent has not established any reputation for its mark as of the material date January 12, 1999. Further, use of the term The Tribe for the name of a television show is not necessarily use of the term as a trade-mark for the wares and services set out in the opponent's trade-mark applications. In the instant case, the opponent has not established how or why use of the name The Tribe for a television

series qualifies as trade-mark use. In any event, in the absence of quantitative information concerning use and advertising of the term THE TRIBE, I am not prepared to infer any reputation for the term above the *de minimus* level at any material date. The applied for mark TRIBE 8 would have acquired some reputation in association with printed matter (not in issue under the fourth ground) for a role playing game, however, the dearth of evidence presented by the applicant makes it impossible to infer any acquired distinctiveness in Canada above the *de minimus* level at any material date. The length of time that the parties' marks have been in use is not a relevant factor under the fourth ground of opposition, which deals only with the proposed use portion of the subject application, as neither party claims use of their marks as of the material date January 12, 1999.

With respect to the wares and services of the parties, it is the applicant's and the opponent's descriptions of wares and services in their respective applications that govern: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), *Henkel Kommanditgesellschaft v. Super Dragon* (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and *Miss Universe, Inc. v. Dale Bohna* (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in *McDonald's Corporation v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.). In the instant case, a comparative reading of the parties' wares and services shows that they are generally the same or overlapping. However, as far as I am able to infer from the evidence, both

parties appear to limit the wares and services associated with their marks to one particular product line. For the applicant, its mark appears to be intended for use in association with wares and services related to its role playing game TRIBE 8, while the opponent's mark appears to be intended for use in Canada in association with wares and services related to the television series The Tribe. Therefore, while the parties' wares and services are similar or overlapping and the parties are engaged in related or overlapping trades, it appears that the parties' use of their marks are narrowly focussed and concentrate on different products for different target markets. Lastly, there is a fairly high degree of resemblance between the marks in issue visually, aurally and in ideas suggested since the component TRIBE is common to the marks in issue.

Having regard to the above, and noting in particular that the marks in issue do not have a high degree of inherent distinctiveness, that the opponent's mark cannot claim a reputation in Canada, that the parties' intend to use their marks for specific product lines and for different target consumers, I find that the marks in issue are not confusing despite their resemblance. Accordingly, the fourth ground of opposition is rejected.

With respect to the last ground of opposition alleging non-distinctiveness, the legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of the opponent: see *Muffin Houses Inc. v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R.(3d) 272 (TMOB). The material time for considering the

circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case October 16, 2001: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

The factors considered above in determining whether the marks in issue are confusing are also applicable to determine whether the applied for mark TRIBE 8 is distinctive of the applicant's wares and adapted to distinguish the applicant's proposed wares and services. The later material date October 16, 2001 alters the considerations in so far as the opponent's television series The Tribe would have been available to the public for viewing since October 2000. However, as discussed earlier, use of the term The Tribe as the name of a television series does not necessarily enure to the benefit of the opponent as use of its trade-mark for the wares and services set out in its applications. Further, in the absence of quantitative information relating to the extent to which the public may be familiar with the television series, I am not prepared to infer that the opponent's television series had any significant negative impact on the distinctiveness of the applied for mark. Accordingly, in view of the above and the considerations discussed earlier under the fourth ground of opposition, I find that the applied for mark is

distinctive and adapted to distinguish the applicant's proposed wares and services.

Accordingly, the opponent's opposition is rejected.

DATED AT GATINEAU, QUEBEC, THIS 29 DAY OF APRIL, 2005.

Myer Herzig,
Member,
Trade-marks Opposition Board