

IN THE MATTER OF AN OPPOSITION
By Donvand Limited (formerly Donvand Limited t/a
Gullivars Travel Associates) to application No. 1162453
for the trade-mark GTA.biz filed by William Ghali

On December 19, 2002, William Ghali (the “Applicant”) filed an application to register the trade-mark GTA.biz (the “Mark”) based upon use of the Mark in Canada in association with wares and services since May 11, 2002. The statement of wares and services currently reads:

Business directories in electronic and print format.

Provision of an on-line directory and Internet search services containing advertising pertaining to individuals and various businesses for the benefit of others.

The application was advertised for opposition purposes in the Trade-marks Journal of January 21, 2004.

On June 18, 2004, Donvand Limited t/a Gullivars Travel Associates filed a statement of opposition against the application. An amended statement of opposition dated July 6, 2004, identifies the opponent as Donvand Limited (“the Opponent”). The Applicant filed and served a counter statement, in which it denied the Opponent’s allegations.

The Opponent’s evidence consists of the affidavits of Kim Parrott, and Kim Jezzard. The Applicant’s evidence consists of the affidavit of William Ghali. None of the affiants were cross-examined.

Only the Opponent filed a written argument. Neither party requested an oral hearing.

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The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

Section 30(b) Ground of Opposition

The Opponent has pleaded the following: “the application does not comply with the requirements of s.30(b) of the Act in that the application does not contain an accurate and true statement as to the date from which the Applicant, or its predecessors, had commenced use of the Applicant’s mark GTA.biz in association with the wares and services recited in the application in that the alleged mark GTA.biz has not been used by the Applicant since at least May 11, 2002, as alleged by the Applicant”.

The Opponent did not file any evidence in support of this ground of opposition and did not make any submissions concerning this ground in its written argument. I therefore find that the Opponent has not satisfied its evidentiary burden with respect to this ground of opposition and this ground of opposition fails.

Section 12(1)(b) Ground of Opposition

The Opponent alleged that the trade-mark GTA.biz is not registrable in view of s. 12(1)(b) of the Act in that it is, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the wares or services in association with which it has been claimed to have been used by the Applicant. Section 12(1)(b) of the Act provides as follows:

- 12.** (1) Subject to section 13, a trade-mark is registrable if it is not
(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

The material date for considering a ground of opposition based on s.12(1)(b) of the Act is the date of filing the application (see *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60).

The issue as to whether the trade-mark GTA.biz is clearly descriptive of the character or quality of the Applicant's wares or services must be considered from the point of view of the average consumer of those wares or services. Further, in determining whether the Mark GTA.biz is clearly descriptive, the trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978) , 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183, at p. 186]. While the legal burden is upon the Applicant to show that its trade-mark is registrable, there is an initial evidential burden upon the Opponent in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of its allegations that the Mark is clearly descriptive of the character or quality of the Applicant's wares or services. It is therefore necessary to consider the Opponent's evidence in order to determine whether it has met the initial burden upon it.

The Opponent's evidence shows that one meaning of GTA is an acronym for "Greater Toronto Area." The Applicant's affiant, Mr. Ghali, has conceded that it is generally accepted in Canada that the term GTA stands for "Greater Toronto Area". With respect to the component "BIZ", Ms. Parrott's evidence is that the letters BIZ are a short form for "business".

The Opponent further argues that the Mark is descriptive of the Applicant's wares and services because on its website, the Applicant uses the words generically to describe its services. Copies of pages of the Applicant's website at the domain name gta.biz are attached to Ms. Parrott's affidavit. The following statements appear on the Applicant's website:

- Business in the Greater Toronto Area
- Search the GTA's number one business directory
- GTA.biz provides superior business intelligence and directory services to more than five million residents and visitors of Ontario's Greater Toronto Area
- List your biz
- To list your business in the GTA directory, please fill and submit this form
- GTA.biz provides superior business intelligence and directory services to more than five million residents and visitors of Ontario's Greater Toronto Area

The Opponent also notes that in the Applicant's original application, the Applicant described its services as follows: "providing advertising, promotional and consulting services for Canadian businesses operating in the province of Ontario and more specifically in the Greater Toronto Area." Finally, the Opponent argues that since the Applicant has disclaimed the right to the exclusive use of the words GTA and BIZ apart from its trade-mark, this is arguably an admission by the Applicant that the words are not independently registrable in relation to its wares or services in that the words are either clearly descriptive of the character or quality of the Applicant's wares or services, or otherwise are common to the trade or are the name of such wares or services.

In my view, the fact that an acronym may be derived from particular words does not mean that it is necessarily descriptive of those particular words, or of a related product. Ms. Parrott's discovery of 28 meanings for the acronym "GTA" on the Internet supports the finding that the acronym "GTA" is not descriptive. Even if it were considered descriptive from the point of view of the average consumer of the Applicant's wares or services, I am not sure the words GTA.biz together as a whole are clearly descriptive or deceptively misdescriptive of the Applicant's wares or services. As stated above, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered **in its entirety** and as a matter of first impression.

While the evidence shows that the Applicant has used the components GTA and BIZ generically to describe its services on its website, the evidence does not show descriptive use of the two components together. Further, although the fact that both words in the Applicant's mark have been disclaimed may be interpreted as an admission that each word individually is descriptive of the character or quality of the applied for wares, s.12(1)(b) does not preclude the registration of a trade-mark comprised of a combination of words individually descriptive of the character or quality of the wares (see *Molson Companies Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157 at 161 (F.C.T.D.)). Finally, while I agree that the component "biz" has some significance in relation to a business directory service, I do not consider that the Mark GTA.biz is a term that the average consumer would use to describe the character or quality of a business directory or related service. This ground is accordingly dismissed.

Section 12(1)(d) Ground of Opposition

The Opponent has pleaded that the Applicant's Mark is not registrable pursuant to s. 12(1)(d) of the Act because the Mark is confusing with the trade-mark GTA & Design registered in Canada by the Opponent under No. TMA593,507 in association with: 1) Travel and tourist agency services; tour operation services; travel guide, escort and courier services; reservation services for transportation of passengers; luggage transportation services; passenger transportation services; vehicle rental services; vehicle transport services; tourist offices; arranging of tours; services relating to obtaining passports and travel and entry visas; travel consultation services; consultancy services relating to travel and holidays being services; and 2) Arranging and providing accommodation; hotel reservations; chaperoning; computer software design relating to holidays and travel; studies and research relating to travel and holidays; rental and distribution of computer software relating to travel and holidays; holiday camp services.

The material date with respect to this ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

The Opponent has met its initial burden because its registration is in good standing.

the test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade;

and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. (for a more detailed discussion about the analysis of confusion, please refer to the Supreme Court of Canada decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401)).

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

In her affidavit at paragraph 20, Ms. Parrott states that she has lived in the Greater Toronto Area since 1996 and is personally aware that the letters GTA are a short form or acronym for “Greater Toronto Area”. As previously noted, Mr. Ghali conceded in his affidavit that it is generally accepted in Canada that the term GTA stands for “Greater Toronto Area”. Further, the ending of the Applicant’s mark, i.e. “biz”, is commonly used as an abbreviation for the word “business”. I therefore consider that the Applicant’s GTA.biz mark to be inherently weak because it is suggestive that the Applicant’s business directories relate to the Greater Toronto Area. The Opponent’s mark is also weak because GTA is an abbreviation for Gullivers Travel Associates, the trade-name under which the Opponent operates, although the Opponent’s mark also includes a distinctive design component (shown below).



The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

The evidence of the Opponent’s affiant, Kim Jezzard, provides the following information:

- GTA is an abbreviation for Gullivers Travel Associates, the trade-name under which the Opponent operates

- GTA is a company in the United Kingdom, and is one of the largest independent suppliers of global tourism products to the travel industry
- GTA has provided travel services in Canada prior to May 2002 in association with the GTA and design mark, the word mark GTA, and the trade-name GTA.
- GTA has had relationships with many travel agencies in Canada for several years, going back to at least 1997
- from at least prior to May, 2002, GTA has distributed in Canada various printed publications advertising and describing GTA's travel services; a representative sample of the type of brochure that has been distributed in Canada is attached as Exhibit A
- since prior to May, 2002, GTA has provided its travel services through on-line and Internet facilities; a representative printout of GTA's website is attached as Exhibit B
- sales figures for the Opponent's travel services provided in Canada in association with the Opponent's marks were over 3,650,000 pounds prior to May, 2002; 5,921,000 pounds prior to July 2004 and 6,602,000 pounds prior to December, 2004

Based on the foregoing information, I conclude that the Opponent's mark has become known to some extent in Canada. As the Applicant has not provided any evidence of use of its mark in Canada, this factor favours the Opponent.

s. 6(5)(b) - the length of time each trade-mark has been in use

This factor also favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

The Applicant's primary business is the provision of directory related services. The Opponent, on the other hand, states that it is one of the largest independent suppliers of global tourism products to the travel industry.

To demonstrate the connection between the Applicant's wares and services and the Opponent's services, the Opponent argues that the Opponent would be listed in the Applicant's directory. The Opponent submits that persons in Canada who are at least vaguely familiar with the Opponent's trade-marks and trade-name, upon seeing the Opponent's trade-name or trade-marks in the Applicant's directory, would reasonably believe that the business directory was in some way connected or associated with the Opponent, either through the Opponent providing the business directory and services itself or by the Opponent licensing or sponsoring another party to operate and provide the business directory and business services.

The Opponent's own evidence, however, showed 117 business listings for business names that include the component GTA in a Canada 411 search. Given the dozens of entries evidenced in Canadian telephone listings for businesses that have adopted the prefix GTA as part of their name, I fail to see how persons in Canada seeing the Opponent's name in the Applicant's directory would likely believe that the directory was in some way connected with the Opponent. To the contrary, I find that this evidence shows that the public is accustomed to distinguishing among the marks of different traders containing these components.

The parties' channels of trade overlap to the extent that both parties provide their services through websites. However, given the difference in the nature of the parties' services, along with the fact that many products and services today are either advertised and/or available for purchase on the Internet, I do not consider the web site availability of both parties' services to be a factor that favours the Opponent.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

The only similarity between the parties' marks are that both include the non-distinctive component "GTA". The Opponent's mark includes a distinctive design component of a circle with a curving arrow appearing before the letters "gta", which are all in lowercase. The Applicant's mark GTA.biz is different in that the letters GTA are followed by a period and the letters "biz" in lowercase, suggesting that the Mark is a domain name. With respect to ideas suggested, the Applicant's mark suggests businesses in the Greater Toronto Area while the Opponent's mark does not suggest any particular idea.

conclusion re likelihood of confusion

There is ample judicial authority for the proposition that in the case of "weak" marks, small differences may be accepted to distinguish one from the other and a greater degree of discrimination may be fairly expected of the public.

Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the marks is unlikely. This is primarily because of the inherent weakness of the parties' marks, and the differences between the nature of the Opponent's wares and services and the Applicant's wares and services. Even though the marks are somewhat similar and the Opponent's mark has been used for a longer period of time, the fact that the Opponent's reputation lies primarily in the travel and tourism industry, makes it seem unlikely that the typical consumer would think that the Applicant's business directory wares and services emanate from the Opponent. The fact that promotion of the Opponent's services includes by means of the Internet is not in itself enough to indicate a link between the Opponent's wares and services and the Applicant's wares and services.

The s. 12(1)(d) ground is accordingly dismissed.

Section 16(1)(a) Ground of Opposition

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(1)(a) on the basis that the Mark is confusing with each of the marks GTA and Design and GTA which had been previously used and made known in Canada by the Opponent in association with printed publications and the services identified above and on-line and Internet services.

With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use or making known of its trade-marks prior to the Applicant's claimed date of first use, namely May 11, 2002, and non-abandonment of its marks as of the date of advertisement of the Applicant's application [s. 16]. I am not satisfied that the Opponent has shown use of its Mark in association with printed publications pursuant to s.4(1) of the Act. In this regard, the printed publications attached as Exhibit A to the Jeppard affidavit are, in my view, nothing more than promotional materials that advertise and describe the Opponent's travel services. There is no evidence showing that the printed publications have been the object of a commercial transaction (see *Gowling, Strathy and Henderson v. Royal Bank of Canada* (1994), 58 C.P.R. (3d) 251).

The Opponent has not shown making known of its mark in association with printed publications either. In this regard, the Opponent has not shown that its mark has become well known in Canada by reason of distribution or advertising pursuant to s.5 of the Act.

With respect to on-line and Internet services, in view of the evidence of Ms. Leppard, I am satisfied that the Opponent has met its initial burden. However, my conclusions above under the s.12(1)(d) ground of opposition are, for the most part, also applicable here since nothing turns on the date at which the issue of confusion is assessed. This ground of opposition therefore fails.

Section 16(1)(b) Ground of Opposition

The Opponent has further pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(1)(b) on the basis that the Mark is confusing with an application for registration of the Mark GTA & Design previously filed by the Opponent on May 11, 2001, under Application No. 1,102,758. It would appear that the application that the Opponent is referring to

is one that issued to registration as TMA 593507 on October 29, 2003. As that application was not pending as of the advertisement of the Applicant's application, this ground is dismissed.

Section 16(1)(c) Ground of Opposition

In addition, the Opponent has pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(1)(c) on the basis that the Mark is confusing with the trade-name GTA previously used in Canada by the Opponent in association with printed publications and the services identified above and on-line and Internet services, and which has never been abandoned.

The Opponent has met the initial burden on it to show use of its trade-name prior to the Applicant's claimed date of first use and non-abandonment as of the Applicant's date of advertisement.

The s. 16(1)(c) ground fails for reasons similar to those set out above in my discussion of the s. 12(1)(d) ground of opposition.

Distinctiveness Ground of Opposition

The Opponent has pleaded that the Mark does not distinguish the wares and services of the Applicant from the wares and services of others, including the printed publications, on-line and Internet services, and other services of the Opponent referred to above, which had been distributed, advertised, sold and performed in Canada in association with each of the trade-marks GTA & Design, GTA, and the trade-name GTA since prior to the Applicant's filing date.

In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition (i.e. June 18, 2004) the Opponent's marks or name had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. Ms. Jezzard's evidence satisfies the Opponent's initial burden with respect to the Opponent's registered services, as well as on-line and Internet services. For reasons similar to those set out above with

respect to the s. 12(1)(d) ground of opposition, I find that the Applicant has met its legal burden, with the result that this ground also fails.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s.38(8).

DATED AT Gatineau, Quebec, THIS 4th DAY OF November, 2007.

Cindy R. Folz
Member
Trade-marks Opposition Board