



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

Citation: 2012 TMOB 67
Date of Decision: 2012-04-04

**IN THE MATTER OF AN OPPOSITION
by CoreLogic, Inc. to application
No. 1,339,483 for the trade-mark
MLXJET in the name of MLXjet Media
Corp.**

[1] On March 15, 2007, MLXjet Media Corp. (the Applicant) filed an application to register the trade-mark MLXJET (the Mark).

[2] The application is based on proposed use of the Mark in Canada in association with the following wares:

uniforms for employees and pens.

[3] The application is also based on use of the Mark in Canada since January 1, 2007 in association with the following services:

consulting services and seminars regarding use of real estate listing and email software; online email services, namely, operating and providing access to a web-based system for viewing, tracking, editing and organizing emails; and online listing services, namely, operating and providing access to a web-based system for viewing, tracking, editing and organizing real estate listings.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 30, 2008.

[5] On September 29, 2008, The First American Corporation (the Opponent) filed a statement of opposition against the application. The Opponent has pleaded grounds of opposition pursuant to s. 38(2)(a), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[6] The Applicant filed and served a counter statement.

[7] In support of its opposition, the Opponent filed an affidavit of Christopher Robert Williams. The Applicant obtained an order for the cross-examination of Mr. Williams and a transcript of the cross-examination is of record.

[8] In support of its application, the Applicant filed an affidavit of Sean Carolan. The Opponent obtained an order for the cross-examination of Mr. Carolan and a transcript of the cross-examination is of record.

[9] Only the Opponent filed a written argument. An oral hearing was not requested.

[10] The Opponent has merged with and into CoreLogic, Inc. The term Opponent will henceforth be used to refer to CoreLogic, Inc. and The First American Corporation.

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[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 38(2)(a)/30(b) Ground of Opposition

[12] The Opponent has pleaded that the application does not comply with s. 30(b) of the Act in that the Applicant has not used the Mark in Canada for the services since the date alleged.

[13] There is an initial evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with s. 30(b). This burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited*

v. Molson Breweries, a Partnership (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230]. However, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claims as set forth in its application [see *Ivy Lea Shirt Co. v. 1227624 Ontario Ltd.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), affirmed 11 C.P.R. (4th) 489 (F.C.T.D.)]. In addition, s. 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the material date [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.) at 262]. The material date with respect to s. 30 is 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].

[14] The Opponent is relying on the Applicant's evidence to meet its initial burden. In its written argument, it makes the following arguments:

1. The Applicant has not used the Mark in association with the applied-for online email services and online listing services because i) MLXJET is the Applicant's company name and MLXjet Pro is the trade-mark for the company's flagship product – email and real estate listing software and ii) the software and services are “intertwined”, such that when the Applicant's affiant refers to the software product, we can only assume that he is referring to the online email and listing services.
2. The “consulting services and seminars regarding use of real estate listing and email software” were merely provided for the Applicant's benefit, namely to sell subscriptions to its email and real estate listing software. The fact that the Applicant does not advertise these services or demand or receive payment for these activities confirms that they are not services offered to a third party, and are merely to the benefit of the Applicant.

[15] However, I find that the Applicant's evidence is not clearly inconsistent with its use claims.

[16] With regard to the Opponent's first point, the fact that MLXJET is also used as the company's name does not preclude it from also acting as a trade-mark. For example, Exhibit B to Mr. Carolan's affidavit shows trade-mark use of MLXJET, separate and apart from its references to MLXjet Pro.

[17] Regarding the "intertwining" of the computer software with the services, I note that services are generally granted a generous or broad interpretation [see *Aird & Berlis v. Virgin Enterprises Ltd.* (2009), 78 C.P.R. (4th) 306 (T.M.O.B.) and *Société Nationale des Chemins de Fer Français SNCF v. Venice Simplon-Orient-Express Inc. et al.* (2000), 9 C.P.R. (4th) 443 (F.C.T.D.)]. Also, in *Sim & McBurney v. Gesco Industries, Inc. and The Registrar of Trade-marks* (2000), 9 C.P.R. (4th) 480 (F.C.A.), the Court held that it does not matter whether services are independently offered to the public or are ancillary or incidental to the sale of wares [see also *TSA Stores, Inc. v. The Registrar of Trade-marks and Heenan Blaikie LLP* (2011), 91 C.P.R. (4th) 324 (F.C.), *Gesco Industries Inc. v. Sim & McBurney* (2000), 9 C.P.R. (4th) 480 (F.C.A.) and *Kraft Ltd. v. Canada (Registrar of Trade Marks)* (1984), 1 C.P.R. (3d) 457 (F.C.T.D.)].

[18] With regard to the Opponent's second point, I have noted the outcome in *War Amputations of Canada/Amputés de Guerre du Canada v. Faber-Castell Canada Inc.* (1992), 41 C.P.R. (3d) 557 (T.M.O.B.). In that case, the applicant submitted that a service could only be performed within the scope of s. 4(2) of the Act if it is performed for money. The Chair of the Trade-marks Opposition Board reviewed the case law on this point and concluded that the display of the mark in association with free services fell within the definition of use in s. 4(2) of the Act, stating at paragraph 11:

11 In the present case, the public receives a benefit from the opponent's educational safety program. Further, there is no provision in the Trade-marks Act which states that a service must be paid for in order for the service to be performed and I am not prepared to infer that such should be the case. Further, unlike s. 4(1) of the Trade-marks Act, s. 4(2) does not include reference to services being "in the normal course of trade". As well, I am mindful of the comments of Strayer, J. in the *Kraft Ltd.* decision where he states that he could see no reason for imposing a restrictive interpretation on the word "services" in the Trade-marks Act.

[19] While the fact situation in *War Amputations of Canada* is not identical to the one at hand, I believe that similar logic applies. The fact that the Applicant does not sell its consulting

services and seminars does not mean that the public does not receive a benefit from such services. Therefore, I am not satisfied that the Applicant did not use its Mark in association with these services, as alleged.

[20] The s. 30(b) ground is accordingly dismissed.

Section 38(2)(a)/30(e) Ground of Opposition

[21] The Opponent has pleaded that the application does not comply with s. 30(e) of the Act because the Applicant did not and does not intend to use the Mark in Canada in association with the wares listed in the application.

[22] On cross-examination, Mr. Carolan stated that the uniforms for employees that bear the Mark are not offered for sale – they are simply provided to the Applicant’s employees for use during the course of their employment, e.g. to wear at seminars. [Carolan transcript, pages 30-31] In addition, pens bearing the Mark are never sold – they may be given away for promotional purposes or provided at seminars for the purpose of filling out forms. [Carolan transcript, page 31]

[23] Based on the foregoing information, I find that the Applicant did not intend to use MLXJET as a trade-mark in association with the applied-for wares. Section 2 of the Act defines a trade-mark as “a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others”. The way in which the Applicant has employed the uniforms and pens was not intended to distinguish its uniforms and pens from those of others – rather the uniforms and pens served to promote the Applicant’s services.

[24] The s. 30(e) ground accordingly succeeds.

Section 38(2)(a)/30(i) Ground of Opposition

[25] The Opponent has pleaded that the application does not comply with s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada having regard to the Opponent’s prior use of MLXCHANGE. However, where an applicant has

provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant, which is not the case here [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The s. 30(i) ground is accordingly dismissed.

Section 38(2)(d)/Distinctiveness Ground of Opposition

[26] The Opponent has pleaded that the Mark is not distinctive of the wares and services of the Applicant because it is confusing with the Opponent's MLXCHANGE mark which was previously used in association with computer software for accessing real estate multiple listing service databases of others, and providing multiple-user access to real estate multiple listing service databases of others via global computer networks.

[27] The material date for assessing confusion under this ground is the filing date of the opposition, namely September 29, 2008 [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)]. The Opponent has met its initial burden since its evidence (as discussed further below) establishes that its mark had, at that time, acquired a reputation in Canada that was sufficient to affect the distinctiveness of the Applicant's Mark [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[28] 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.

[29] The test for confusion is one of first impression and imperfect recollection. 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 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal

weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.), *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C).]

the inherent distinctiveness of the marks and the extent to which each mark has become known

[30] Both marks are inherently distinctive.

[31] The Opponent's mark has been used and promoted since as early as 2001. Although the Opponent has not provided any sales figures or promotional expenses, since 2002, the Opponent has had MLXCHANGE service contracts with major real estate boards and realtor associations across Canada.

[32] Although the Applicant has provided sales and promotional expenses, I cannot afford these figures any weight insofar as this ground is concerned because Mr. Carolan simply provided a lump sum figure for the time period January 1, 2007 to January 11, 2010, without any indication of the value as of the material date of September 29, 2008.

[33] Overall, a consideration of the extent to which the parties' marks had become known as of the material date favours the Opponent.

the length of time the marks have been in use

[34] The Opponent had already been using its mark for approximately six years when the Applicant adopted or commenced use of its Mark in 2007.

the nature of the wares, services, business and trade

[35] The Applicant describes its general business as "consulting services and seminars regarding Visa statements, email software, online email services, namely operating and providing access to a web-based system for viewing, tracking, editing and organizing emails." [Carolan transcript, page 1] The application's statement of services describes two of the applied-for services as relating to real estate listings. During cross-examination, Mr. Carolan informed us

that the majority of the Applicant's clients are realtors but its software can also be used by other industries. [Carolan transcript, pages 6, 10, 11]

[36] The Opponent's mark is used in association with computer software for accessing real estate multiple listing service databases of others and in association with providing multiple user access to real estate multiple listing service databases of others by a global computer network, which includes systems training, technical support and consulting services. [Williams affidavit, paragraphs 6 and 7]

the degree of resemblance between the marks

[37] The most striking portion of each mark is its first portion, namely MLX. *The Canadian Oxford Dictionary* does not have a definition for MLX, whereas the latter portions of the marks, JET and CHANGE, are ordinary dictionary words.

[38] It is a well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.)]. Moreover, while marks should be assessed in their entirety, it is still acceptable to "focus on a particular feature of the mark that may have a determinative influence on the public's perception of it" [*United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at 263)].

[39] Therefore, although there are differences between the parties' marks, I find that overall the degree of resemblance between the marks favours the Opponent.

conclusion

[40] Having considered all of the surrounding circumstances, I find that the Applicant has not established, on a balance of probabilities, that confusion was not likely between MLXJET and MLXCHANGE as of September 29, 2008. The issue is whether a consumer who has a general and not precise recollection of the Opponent's mark, will, upon seeing the Applicant's Mark, be likely to think that the two services share a common source. I cannot answer that question in the negative. The fact that both parties' services are related to the real estate industry plus the fact

that there is no evidence that any one else uses the prefix MLX in that field supports a conclusion that confusion as to source is likely.

[41] The distinctiveness ground of opposition therefore succeeds.

Section 38(2)(c)/16 Grounds of Opposition

[42] The statement of opposition reads in part: “the Applicant is not the person entitled to registration of the [M]ark in Canada in view of ss. 16(1) and 16(3) of the Act, because, at the date of filing, the [M]ark was confusing with the Opponent’s trade-mark MLXCHANGE, which had been continuously, extensively and previously used and advertised in Canada by the Opponent and/or its predecessors in title.” The statement of opposition states elsewhere that the Opponent’s MLXCHANGE mark has been used prior to the filing of the application in association with computer software for accessing real estate multiple listing service databases of others, and providing multiple-user access to real estate multiple listing service databases of others via global computer networks.

[43] In order to succeed under s. 16(1), there must be a likelihood of confusion as of the material date of the Applicant’s first use, namely January 1, 2007. However, the Opponent has pleaded only that there was a likelihood of confusion as of the later filing date, namely March 15, 2007. The question therefore arises as to whether the Opponent adequately pleaded a s. 16(1) ground of opposition. In view of the fact that the services have already been refused under the distinctiveness ground of opposition, and given that the Applicant has not made any submissions, I do not intend to explore that point further. Suffice to say that if the ground has been sufficiently pleaded, then it would succeed for reasons similar to those set out under the distinctiveness ground of opposition.

[44] The Opponent has met its initial burden with respect to its s. 16(3) ground of opposition because it has shown use of its mark in Canada prior to March 15, 2007. However, the s. 16(3) ground only applies to the Applicant’s proposed use wares. As I have already found that the application ought to be refused with respect to such wares under the s. 30(e) ground, I will not discuss the s. 16(3) ground further.

Disposition

[45] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office