

**IN THE MATTER OF AN OPPOSITION by
Royal Canadian Golf Association to application
No. 1,235,338 for the trade-mark ORCGA &
Design filed by Ontario Regional Common Ground
Alliance**

On October 28, 2004, Ontario Regional Common Ground Alliance, an unincorporated association, filed an application to register the trade-mark ORCGA & Design (the “Mark”), which is shown below:



The right to the exclusive use of the words ONTARIO, REGIONAL and ALLIANCE is disclaimed apart from the trade-mark.

The application is based upon use of the Mark in Canada in association with the following services:

- (1) Preventing damage to buried facilities through education, advocacy, public awareness, regulation and enforcement; operation of a non-profit organization engaged in preventing damage to buried facilities through education, advocacy, public awareness, regulation and enforcement - since at least as early as March 01, 2004
- (2) Operation of a website providing information related to promoting the protection of underground facilities - since at least as early as January 2004.

The application is also based upon proposed use of the Mark in Canada in association with the following wares:

Promotional items, namely, coffee mugs, plastic bags, posters, pens, clipboards, binders, measuring tapes, pocket calculators, calendars, sticky note pads, luggage tags, portfolios, mouse pads, tote bags, lanyards; publications, namely, magazines, books, brochures, newsletters, pamphlets; clothing, namely, shirts, golf shirts, t-shirts, jackets, baseball hats.

The application was advertised for opposition purposes in the Trade-marks Journal of July 13, 2005. On December 12, 2005, Royal Canadian Golf Association (the “Opponent”) filed a

statement of opposition. The Opponent has pleaded grounds of opposition under s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”).

The applicant filed and served a counter statement.

In 2006, the applicant notified the Registrar that its status had changed from an unincorporated association to a corporation and the Registrar recorded this amendment. The term “Applicant” will be used below to refer to Ontario Regional Common Ground Alliance, an unincorporated association, or the corporation Ontario Regional Common Ground Alliance, as may be temporally appropriate.

In support of its opposition, the Opponent filed the affidavits of Stephen D. Ross and Virginia Collins, plus certified copies of Canadian trade-mark registrations Nos. TMA 662,812 and TMA 671,589 for RCGA and RCGA & Design (#1) respectively, the public notice given under s. 9(1)(n)(iii) of the Act for the official mark RCGA & Design (#2), and Canadian trade-mark application No. 1,246,695 for RCGA & Design (#3). The design marks are shown below:

RCGA & Design (#1)



RCGA & Design (#2)



RCGA & Design (#3)



The Applicant elected to not file any evidence in support of its application and it did not cross-examine either of the Opponent’s affiants.

Only the Opponent filed a written argument. Each party participated in an oral hearing.

Onus

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)/Section 30(b) Ground of Opposition

The Opponent has pleaded that the application does not comply with the provisions of s. 30(b) of the Act, in that the alleged Mark has not been used in Canada in association with the services described in the application since the date first claimed, if at all.

The initial evidential burden on an opponent respecting its allegations of fact in support of a s. 30(b) ground is lighter, since information concerning an applicant's date of first use is most accessible to the applicant. [See *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.H.O.) at 89]

The Opponent's affiant, Ms. Collins, has provided pages from the Applicant's website as of September 27, 2006 and January 22, 2005. The latter was obtained using the Wayback Machine archive (Ms. Collins has provided as Exhibit "2" pages from www.archive.org that answer questions about the Wayback Machine). Ms. Collins conducted a search of the Wayback Machine's archive for earlier versions of the Applicant's website and received results that indicated that there was no website prior to 2005 (Exhibit "3").

I appreciate that there be limitations to the accuracy of the Wayback 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 of at least as early as

January 2004 with respect to the operation of a website providing information related to promoting the protection of underground facilities. The Applicant had the opportunity to file evidence to rebut the results of the Wayback Machine search but chose not to. In these circumstances, I conclude that the s. 30(b) ground succeeds with respect to the services marked (2) on the basis that the Applicant did not meet its burden,. As there is no evidence concerning the correctness of the claimed date of first use regarding the services marked (1), the s. 30(b) ground fails with respect to such services, on the basis that the Opponent did not meet its initial burden.

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

The requirement under s. 30(i) of the Act is to include, in the application, a statement that the Applicant is satisfied that it is entitled to use the Mark in Canada in association with the wares/services. Such a statement has been provided. 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. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] This is not such a case. The s. 30(i) ground is accordingly dismissed.

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

The Opponent has pleaded that the Applicant is not the person entitled to registration because ORCGA & Design is confusing with the trade-mark RCGA and the various design versions of that mark shown earlier, which were previously used and made known by the Opponent in Canada.

The material date for determining the likelihood of confusion regarding the Applicant's proposed use wares is the filing date, October 28, 2004 [s. 16(3)]. Regarding the Applicant's use-based services, the material date would typically be the claimed date of first use [s. 16(1)]. However, where an opponent has successfully challenged an applicant's claimed date of first use under a s. 30(b) ground of opposition, the material date for assessing a s. 16(1) ground of opposition becomes the applicant's filing date [see *American Cyanamid Co. v. Record Chemical Co. Inc.*

(1972), 6 C.P.R. (2d) 278 (T.M.O.B.); *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)] Accordingly, the material date for determining the likelihood of confusion with respect to the services identified above as (1) is March 1, 2004, whereas the material date with respect to the services identified above as (2) is October 28, 2004. That said, in the circumstances of this case, nothing turns on the date at which the issue of confusion is determined.

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 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.)]

As the Opponent's position under s. 16 is strongest with respect to its reliance on its previously used trade-marks [s. 16(1)(a) and 16(3)(a)], I will focus my discussion on such trade-marks, rather than on the Opponent's pending trade-mark applications or trade-names. Similarly, since the Opponent's position is strongest with respect to its RCGA mark, I will focus my discussion on that mark.

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known
“A trade mark or design mark consisting only of letters is characterized as a ‘weak mark’.” [*GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.) para. 29]
Thus the Opponent’s RCGA mark is inherently weak. As the Applicant’s Mark consists of words and design features in addition to letters, it is inherently stronger than the Opponent’s mark.

There is no evidence that the Applicant’s Mark has become known to any extent. In contrast, there is evidence that the Opponent’s RCGA mark has become known. In particular, evidence in Mr. Ross’ affidavit concerning the use or promotion of the Opponent’s mark prior to March 2004 includes the following:

- Publications entitled *The Rules of Golf* (which display RCGA in certain places) have been distributed and sold (paragraph 17; Exhibit “11”) – 150,000 copies distributed every four years;
- Publications concerning golf handicap systems (which prominently display the RCGA mark) have been distributed and sold (paragraph 20; Exhibit “14”) – 2000 copies distributed bi-annually;
- Various other golf-related publications display RCGA (paragraphs 21 and 22; Exhibits “15” and “16”);
- Brochures promoting the Canadian Open golf tournament display the RCGA mark (paragraph 26; Exhibit “18”);
- Brochures promoting the Canadian Women’s Open golf tournament display the RCGA mark (paragraph 27; Exhibit “19”);
- Canadian Golf Course Operations Survey Reports and other surveys display the RCGA mark (paragraphs 40 and 41; Exhibits “28” and “29”);
- GOLF CANADA magazine (which displays the RCGA mark) is published and distributed by the Opponent (paragraphs 55-56; Exhibits “37A” to “37J”) – distribution figures of 670,000 copies per year were provided based on information and belief;
- Hats that prominently display the RCGA mark have been distributed to members of the public who joined the Opponent’s “public member program” (paragraph 65; Exhibit “43”) – 1500 distributed in 2000;

- T-shirts that display the RCGA mark on the sleeve have been worn by volunteers at the Women's Open golf tournament (paragraph 66; Exhibit "44") – 1800 distributed annually;
- Golf tees that display the RCGA mark have been distributed to amateur teams (paragraph 67; Exhibit "45") – 50,000 distributed annually;
- Bag tags that display the RCGA mark have been distributed to amateur teams (paragraph 68; Exhibit "46") – 1295 distributed annually;
- Money clips that display the RCGA mark have been distributed to amateur teams (paragraph 69; Exhibit "47") - 1295 distributed annually.

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

There is no evidence that the Applicant has ever used its proposed Mark in association with wares but the Opponent's evidence indicates that the Applicant's website did exist in 2005. Given that the Opponent claims use of its RCGA mark since 1948, the length of time that each mark has been in use clearly favours the Opponent.

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

Since its inception in 1895, the Opponent has acted as the governing body of amateur golf in Canada. Mr. Ross lists fourteen types of activities that the Opponent is responsible for (paragraph 10). Most of these are in the nature of overseeing golf rules, organizing golf tournaments and encouraging the development of golf. However, one area is slightly more akin to the Applicant's services, namely the Opponent's responsibility for "promoting and funding national research and development in environmental and agronomic fields as these pertain to golf". Mr. Ross discusses the Opponent's environmental stewardship responsibility in greater detail at paragraph 38 as "taking every practical precaution to ensure that products and techniques used in the development and maintenance of golf courses present the lowest possible risk to employees of golf courses, golfers, the public and the environment." Thus the typical clientele of the Opponent appears to be golf courses, golfers and golf enthusiasts.

In contrast, it appears from the website of the Applicant (as well as from the Applicant's statement of services), that the Applicant's chief concern is the prevention of underground infrastructure damage, as exemplified by its campaign to promote legislation to establish a mandatory "Call Before You Dig" system (Collins affidavit, Exhibit "1"). The website also indicates that typical members of the Applicant would be an "[underground] facility owner or operator, locator, design professional, One-Call Center employee, excavator, contractor or other stakeholder".

Although the Opponent submits that there is an overlap between the parties' services "in that both parties are involved in educational programs and regulations pertaining to outdoor grounds and green spaces" (Opponent's written argument; paragraph 14.2), it seems to me that the connection between the two parties' fields of interest and their channels of trade is tenuous. There is however an overlap between some of the wares of the parties, in particular publications and clothing.

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

The Applicant's Mark incorporates the Opponent's RCGA mark in its entirety. The Applicant's Mark has added a letter in front of the common initials, but the initial added, "O", is not particularly strong, as it stands for Ontario. Although the first component of a mark is often considered more important for the purpose of distinction, when that component is common, descriptive or suggestive, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

The Applicant points out that the words that surround ORCGA serve to distinguish the Applicant's Mark from the Opponent's RCGA mark, as does the design feature that overlaps the letter "A". However, the Opponent submits out that the latter design feature could be viewed as a golf ball in flight.

There is no evidence concerning how the public would sound the ORCGA portion of the Applicant's Mark. It may be that they would sound the individual letters but it may also be that they would sound it as an invented two-syllable word. If the latter, then this would distinguish it from the inevitable pronunciation of RCGA as its individual letters.

There is no idea suggested by RCGA, unless one considers it as the abbreviation for Royal Canadian Golf Association. The idea suggested by the Applicant's Mark is stated within the mark itself, namely Ontario Regional Common Ground Alliance.

"While the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features 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] In the present case, the fact that the letters ORCGA dominate the Applicant's Mark results in there being a resemblance between the two marks. Nevertheless, the marks must be viewed as a whole and the Applicant's Mark is more than just the letters ORCGA; of particular import is the fact that the Mark incorporates within it the meaning of the acronym ORCGA.

other surrounding circumstances

i) Ms. Collins has provided pages from the Applicant's website that promote an annual ORCGA Golf Tournament. However, I do not consider this to be a significant surrounding circumstance given that it is apparent that the Applicant is not in the business of organizing golf tournaments but simply has one for its members once a year.

ii) Mr. Ross has attested, but not shown, that the RCGA mark is associated with additional promotional wares, namely jackets, vests, tote bags and lanyards (paragraph 53).

iii) Both parties seem to have corporate sponsors.

conclusion regarding likelihood of confusion

The following comments of Mr. Justice Cattanach in *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.) are particularly appropriate to the case at hand:

29 It is clear from the *du Cros* case, *supra*, and others that a trade mark consisting only of letters, ...without any accompanying distinctive *indicia* as registered, is a trade mark that lacks inherent distinctiveness. Accordingly a trade mark or design mark consisting only of letters is characterized as a "weak mark".

30 In *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 C.P.R. (2d) 1, [1972] F.C. 1271 [affirmed 14 C.P.R. (2d) 127] Noel, A.C.J., said at p. 5 C.P.R. [sic]:

No doubt, in the case of weak marks or of marks possessing little inherent distinctiveness, small differences may be accepted to distinguish one from the other, but this does not mean that any such weak portions of a mark must be discounted in so distinguishing.

31 In short, **where a trader has appropriated letters of the alphabet as a design mark without accompanying distinctive *indicia*, and seeks to prevent other traders from doing the same thing, the range of protection to be given that trader should be more limited than in the case of a unique trade mark and comparatively small differences are sufficient to avert confusion and a greater degree of discrimination may fairly be expected from the public in such instances.** (See Lord Simond's remarks concerning trade names in *Office Cleaning Services v. Westminster Window and General Cleaners Ltd.* (1944), 61 R.P.C. 133 at p. 135.)
[emphasis added]

Having considered all of the surrounding circumstances, I find that there is not a reasonable likelihood of confusion between the parties' marks in so far as the Applicant's services are concerned. I reach this conclusion because there are differences between the marks at issue and significant differences between the parties' main fields of interest. These differences also extend to the wares at issue, given that each of the Opponent's wares is clearly associated with the game of golf, and presumably the Applicant's promotional wares would be used to promote its own specialized services. However, in view of the reference to golf in the item "golf shirts", it seems appropriate to find that the Applicant has not met its onus in regards to that particular ware. Otherwise, I find that the Applicant has met its onus with respect to the applied-for proposed use wares based on the differences between the marks and the parties' fields of interest. I note that if the Applicant had applied to register ORCGA without the additional words ONTARIO

REGIONAL COMMON GROUND ALLIANCE, the Opponent's case would have been stronger. However, I do not find the Opponent's case to be any stronger based on any of its design versions of RCGA than it is with respect to RCGA *simpliciter*.

The s. 16(1)(a) and 16(3)(a) grounds accordingly succeed only with respect to "golf shirts".

The Opponent has also pleaded entitlement grounds of opposition pursuant to s. 16(1)(b), 16(1)(c), 16(3)(b) and 16(3)(c) of the Act. However, the Opponent's position with respect to these grounds is no stronger than it is with respect to its s. 16(1)(a) and 16(3)(a) grounds. In other words, none of the s. 16 grounds succeed beyond "golf shirts". (I note that each of the Opponent's prior applications covers only services.)

Section 38(2)(b)/Section 12(1)(e) Ground of Opposition

The issue under this ground of opposition is whether the Mark consists of, or so nearly resembles as to be likely to be mistaken for, the Opponent's official mark RCGA & Design (#2). In this regard, no consideration is to be given to the parties' wares/services or channels of trade.

As stated by Mr. Justice O'Keefe in *Canadian Council of Professional Engineers v. APA - The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C. T.D.) at para. 69:

[69] ...In order to offend subparagraph 9(1)(n) (iii) so as to be unregistrable under paragraph 12(1)(e), the proposed mark must either be identical to the official mark or so nearly resemble it so as to be likely to be mistaken for it. The words "consists of" in the subsection of the Act are to be interpreted to mean "identical to" as was apparently held by the Registrar.

...

[71] ... "Mistaken therefor" and "confusing with" are not synonymous.

Furthermore, in *Assoc. Olympique Canadienne c. Coopérative Fédérée de Québec* (2000), 7 C.P.R. (4th) 309 (F.C.T.D.) Mr. Justice Lemieux stated:

I take from Gibson J.'s reasons after trial the following principles relevant to this case when dealing with official marks under section 9 which are raised to block a trade-mark applicant:

(1) The test under section 9 is one of resemblance and where the official mark and the applied for mark are not identical, the issue "then is whether or not the Defendant's mark is almost the same as, or substantially similar to any or all of BSAO's marks" and that the relevant test to determine this question, as set out in the *R. v. Kruger* [(1978), 44 C.P.R. (2d) 135 (Reg. T.M.)], is whether "a person familiar with [BSAO's] marks [or any of them] but having an imperfect recollection thereof would... be likely to mistake the [Defendant's mark therefor]". (page 217)

(2) The test adopted by Rothstein J. (as he then was) in *Canadian Olympic Assn. v. H.C.E.U.A.*, *supra*, is nothing more than a useful restatement of the *Kruger* test and does not vary from the *Kruger* test. Mr. Justice Rothstein had formulated the test as follows at page 19:

The question must be determined in the context of whether a person who, on a first impression, knowing one mark only and having an imperfect recollection of it, would likely be deceived or confused.

(3) The straight comparison test is rejected. Gibson J. at page 217 said this:

I cannot accept the argument advanced on behalf of the Plaintiffs that the test is one of "straight comparison". The concept of "straight comparison" implies a close and careful look at or comparison between BSAO's marks and the mark of the Defendant. Such a close and careful look or comparison was specifically rejected by Mr. Justice Rothstein in *Canadian Olympic Assn. v. Health Care Employees Union of Alberta*.

For convenience, I reproduce the two marks at issue here:



The question therefore is whether a person familiar with the above RCGA & Design mark but having an imperfect recollection thereof would be likely to mistake the ORCGA & Design mark therefor. The answer is "no".

Section 38(2)(d) Ground of Opposition

The Opponent has pleaded that the Applicant's Mark is not distinctive in that it does not actually distinguish the wares/services of the Applicant from those of the Opponent. The material date with respect to this ground is the filing of the opposition, December 12, 2005 [*Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

The likelihood of confusion between the parties' marks as of December 12, 2005 does not differ significantly from the likelihood as of the earlier dates in 2004. Therefore, the outcome of the distinctiveness ground of opposition is similar to that of the s. 16 grounds; the distinctiveness ground of opposition succeeds only with respect to "golf shirts".

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) of the Act, I refuse the application with respect to:

- Operation of a website providing information related to promoting the protection of underground facilities;
- golf shirts.

The opposition is rejected with respect to:

- Preventing damage to buried facilities through education, advocacy, public awareness, regulation and enforcement; operation of a non-profit organization engaged in preventing damage to buried facilities through education, advocacy, public awareness, regulation and enforcement;
- Promotional items, namely, coffee mugs, plastic bags, posters, pens, clipboards, binders, measuring tapes, pocket calculators, calendars, sticky note pads, luggage tags, portfolios, mouse pads, tote bags, lanyards; publications, namely, magazines, books, brochures, newsletters, pamphlets; clothing, namely, shirts, t-shirts, jackets, baseball hats.

DATED AT TORONTO, ONTARIO, THIS 23rd DAY OF JANUARY 2009.

Jill W. Bradbury
Member
Trade-marks Opposition Board