



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

Citation: 2010 TMOB 223
Date of Decision: 2010-12-20

**IN THE MATTER OF AN OPPOSITION
by St. Joseph Media Inc. to application
No. 1,205,134 for the trade-mark
WHERE VISIONS BECOME REALITY
in the name of Synaptic Vision Inc.**

[1] On January 23, 2004, Synaptic Vision Inc. (the Applicant) filed an application to register the trade-mark WHERE VISIONS BECOME REALITY (the Mark). The application is based on use of the Mark in Canada since April 1, 2001 in association with the following wares and services:

wares:

(1) Business management software, allowing customers to track and manage: Consumer contact details - recording inbound and outbound communications via Email, Fax, Phone, record meetings and tasks. Orders with a configurable workflow system and complete audio trail. Inventory both serialized and non-serialized with integrated barcode scanner support. Document Storage with a complete online document center assigned to customers, or customer orders, or users on the system. Reporting with online reports and the ability to create custom reports. Time Management and Resource Scheduling. API's with interfaces for both inbound and outbound data communication with other applications.

services:

(1) Software Development and Custom Application Design
(2) Custom software development based on customer and user requirements. Software solutions typically require the creation of new software technologies or the incorporation of open source tools. Applications tend to focus on system

integration and the ability to transfer data across the Internet.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 4, 2005.

[3] On October 4, 2005, St. Joseph Media Inc. (the Opponent) filed a statement of opposition. The grounds of opposition pleaded pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) are summarized below.

1. s. 12(1)(d): the Mark is not registrable because it is confusing with the Opponent's registered trade-marks: WHERE, TMA368,571 and TMA496,282; WHERE MAGAZINES INTERNATIONAL, TMA408,695; WHERE FAMILY, TMA463,529; and WHERE ON-LINE, TMA520,864 (collectively the WHERE Marks)
2. s. 16(1)(a): the Applicant is not the person entitled to register the Mark because the Mark is confusing with the WHERE Marks previously used by the Opponent
3. s. 16(1)(c): the Applicant is not the person entitled to register the Mark because the Mark is confusing with the trade-names Where Canada, Where International, Where Magazines International and Where On-line previously used by the Opponent
4. s. 2: the Mark is not distinctive in view of the foregoing
5. s. 30(i): the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because it was or ought to have been aware of the Opponent's trade-marks and trade-names
6. s. 30(b): the Mark has not been used by the Applicant since the date of first use alleged or at all on the wares and services.

[4] The Applicant, who has been self-represented throughout, filed and served a counter statement. The counter statement improperly contains argument and seeks to introduce evidence – I have disregarded those portions of the counter statement.

[5] In support of its opposition, the Opponent filed an affidavit of Elenita Anastacio. Ms. Anastacio is a trade-mark searcher employed by the Opponent's trade-mark agents. She provides copies of the five trade-mark registrations and two trade-mark applications owned by the Opponent that were referenced in its statement of opposition. She also states that she conducted an Internet search "to determine whether and when the Applicant first used its trade-mark in

Canada.” She states, “I could not locate any use of the mark Where Visions Become Reality in Canada.” However, Ms. Anastacio provides no additional information concerning her search, such as when she conducted it or her search strategy; I am therefore not according any weight to the results of her Internet search.

[6] In support of its application, the Applicant filed an affidavit of Errol Rowe, its General Manager. The Opponent obtained an order for the cross-examination of Mr. Rowe on his affidavit and the transcript of the cross-examination has been filed.

[7] Part of Mr. Rowe’s affidavit is argument; that part is being disregarded. There are very few facts put forward in his short affidavit. The most substantive paragraph in his affidavit reads as follows:

“The application was reviewed and understood by the Canadian Intellectual Property Office; including Wares and Services when it was originally submitted for registration under application no. 1110101. Synaptic Vision Inc. has used the phrase ‘where visions become reality’ in a continuous manner, from web site to printed brochures and advertising since March, 2001. See Schedule ‘A’, attached.”

[8] Schedule “A” consists of i) a copy of a letter dated 9/20/2003 from two individuals who say that they created the Applicant’s print materials and website and that the website was officially launched on April 1, 2001 while the print materials were published on November 1, 2001; ii) a copy of the application that is the subject of the present opposition.

[9] In his affidavit, Mr. Rowe attests that Schedule “A” also shows examples of references to the word “where” from “a quick search by GOOGLE [that showed] 1,910,000,000 references for the word ‘where’.” I confirm that Schedule “A”, as filed in the Canadian Intellectual Property Office, does not contain any such references. Despite this, I am prepared to accept that the word “where” would be frequently used by others given its ordinary dictionary meaning. There is however no evidence that it is commonly used as part of a trade-mark or in either party’s field.

[10] On cross-examination, Mr. Rowe provided evidence concerning the nature of the Applicant’s business and its website. As will be discussed in greater detail below, he stated that

as of March 26, 2008 there was no product that bears the Mark and basically admitted that he is not sure when the website displaying the Mark first appeared on the Internet.

[11] Only the Applicant filed a written argument. The Applicant's written argument refers in numerous instances to evidence that is not of record in this proceeding. In addition, it inappropriately challenges the validity of the Opponent's registered trade-marks [see *Sunshine Biscuits, Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53 (F.C.T.D.)]. All such improper "argument" must be disregarded. That leaves some written argument directed to the issue of whether the Mark is confusing with the Opponent's marks. The written argument did not address the s. 30(b) ground.

[12] Both parties participated in an oral hearing. Submissions at the oral hearing focussed on the s. 30(b) ground of opposition.

Onus

[13] 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 30(b) Ground of Opposition

[14] The Opponent's initial burden under s. 30(b) 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) 216 (F.C.T.D.) 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.

[15] In *Coca-Cola Ltd. v. Compagnie Française de Commerce* (1991), 35 C.P.R. (3d) 406, Board Member Martin noted that the Opponent can rely upon the cross-examination of the

Applicant's affiant to meet the evidential burden upon it. In the present case, the Opponent has met its initial burden through the cross-examination of Mr. Rowe for the reasons set out below.

[16] As mentioned earlier, Mr. Rowe attested in his affidavit that the Applicant “has used the phrase ‘where visions become reality’ in a continuous manner, from web site to printed brochures and advertising since March, 2001. (See Schedule “A”, attached.)” Schedule “A” to Mr. Rowe’s affidavit includes a copy of a letter from the owners/operators of Tosca Art & Design Studios, which reads in part that it created both a website and print materials for the Applicant, both of which included the Mark. The letter states that the website was officially launched on April 1, 2001 and that the printed materials were published on November 1, 2001. Clearly the contents of this third party’s letter are inadmissible hearsay in the hands of Mr. Rowe.

[17] During the cross-examination of Mr. Rowe on March 26, 2008, there were the following questions and answers:

Q 19: ...There is no product that bears the trademark at this time?

A No.

Q 20: Has there ever been a product that had the trademark, “Where Visions Become Reality” on it?

A We have been using the name on our brochures and other materials for...since at least 2001. So, for seven or eight years we have been doing that.

Q 21: Right, but is there an actual product or item that actually has the mark on it, as opposed to, say, promotional material or your website?

A No.

Q 22: And that has always been the case?

A Yes.

...

Q 38: Do you actually make Internet sales over the Internet off your website?

A Yes.

Q 39: In other words, somebody can throw it in a shopping basket?

A No.

Q 40: Okay. So you use it as a tool to get people to come to you and then buy the product?

A That is right.

Q 41: That has always been the case?

A It has.

Q 42: Do you have a copy of the original website page that is referred to in, I guess, your Exhibit A?

A A copy of the original website page? No. I don't have a copy of it here.

Q 43: Could you produce the copy of the original launch page that is referred to by the Bennetts?

A Well, I certainly hope we still have a record of it, and I certainly will provide it to you if it is available.

...

Q 45: Well, okay. Are they [brochures that Mr. Rowe was holding up earlier] typical of the kinds of brochures you used?

A Yes.

Q 46: And that would be true from November 1st, 2001, the date that they state there?

A I think so, yes.

Q 47: That was the first time you started to use printed material?

A I believe so.

Q 48: Do you know whether the go live website date for your website was April 1st, 2001?

A I thought it was actually before that, but it appears that the website was complete in March and officially launched on April 1st, 2001 and I believe that is correct.

Q 49: That is based ..your belief is based on?

A Well, I have been associated with the company when I was working with Bank of Montreal and they were doing work for me. And I know that the company had been in operation since '96. So, I just assume that there would have been something before that. But I am looking at the information provided by Chris Bennett and Bisa Bennett. I believe it to be true. And because I was associated with the company.

...

Q 53: Okay. Are you familiar with a webcrawler program which fixes and times time [sic] website pages and websites so that you can go back and look at them?

A No.

Q 54: I just show you for your interest, this is a printout of your website from the Wayback Machine and you will see the first date that anything shows up. And does that ring a bell for you?

A No. The first date that anything shows up in here is May 20, 2001, which is not consistent with the date that the site might have gone up. But you are suggesting that these activities were somebody going to visit the website?

Q 55: The Wayback Machine is, like I say, a webcrawler that crawls the Internet and actually takes snapshots of all different websites to keep historical data on when websites had whatever they had on them. And if you look at the ones that are asterisked, a little asterisk beside a certain dates [sic], and that means that is when a website was changed.

A Oh, so there has been lots of changes.

Q 56: Right. Now, I don't know how extensive they have to be for it to catch them, but they do do it.

A So, does it give the date when the website was originally set up?

Q 57: Right. The first date in the schedule would indicate the date that it was first set up, first went live.

A First went live.

Q 58: So, it is...May is the date that is in there.

A As opposed to April. When we put websites together they are created first, and then signed off and you could say they are created today, but not live until next month.

Q 59: Right. And what I am asking you is, do you know specifically when the website actually went live?

A No, I am relying on the information that appears in the affidavit or statement of Chris and Bisa Bennett. And I believe that it was correct, insofar as the creation of the website, but then I can't argue with your webcrawler saying May 20th. The following month might have been the actual date that it was live.

Q 60: In terms of the website that you created...well, they say they created it in, I think March, but it didn't go live until later. I take it it was the same website that was the subject of application 1,110,101?

A Yes.

[18] Among the foregoing questions, there was one undertaking given (Q 43), but nothing has been filed further to that undertaking. There were also two documents presented to Mr. Rowe during the cross-examination, which were identified as Exhibits 1 and 2, namely 1: "database download of abandoned application 1,110,101 for the trade-mark 'Where Visions Become Reality'" and 2: "Wayback Machine webcrawler summary". These exhibits were not filed by the Opponent when it filed the copy of the transcript for cross-examination. At the oral hearing, the Opponent sought to file them but I declined to accept them in view of the lateness of this request and the objection voiced orally by the Applicant.

[19] Based on the foregoing excerpts from the cross-examination, I find that the Opponent has raised sufficient doubt concerning the claim of first use set out in the application, namely April 1, 2001 for both wares and services. Regarding wares, s. 4 requires that the Mark be associated with the wares such that notice of the association is given to the person to whom the property or possession is transferred at the time of such transfer. According to Mr. Rowe's statements during his cross-examination on March 26, 2008, there had never been a product that has the Mark on it. In addition, he attested that the Applicant's products cannot be purchased directly over the Applicant's website. Even if they could be, it is clear that the claim in Mr. Rowe's affidavit that the Mark was first used in March 2001 is dubious as he very readily accepted during cross-examination that the website might not have appeared on the Internet until after April 1, 2001; in addition, he did not follow through with an answer to the undertaking to provide a copy of the

original website. Such a copy might have borne an access date. I agree with the Opponent's submission that the failure to respond to the undertaking should result in a negative inference being drawn. Moreover, while I accept that parties do not always keep old materials or records, the Applicant did not respond that this was the case. In any event, an applicant should only rely upon a date of first use that is provable given that the inability to support a claimed date can result in the refusal of its application.

[20] Use with services is shown when the mark is used or displayed in the performance or advertising of the services (s. 4(2)). Here, Mr. Rowe initially alleged that the Mark appeared both on the Internet and printed materials. The printed materials cannot show use of the Mark as of April 1, 2001 as the evidence is that they were not even printed before November 1, 2001. If the Mark appeared on the Applicant's website, that could qualify as use of the Mark with services but the evidence does not show that the Mark appeared in Internet advertisements at any time and Mr. Rowe clearly waffled on cross-examination concerning the date when any such advertisements might have been accessible through the Internet. It is to be remembered that use of a trade-mark does not occur at the point of time that materials are created; materials cannot qualify as use for the advertised services unless they have been distributed.

[21] Overall, I consider the cross-examination to have raised sufficient inconsistencies and doubts to meet the Opponent's light initial burden under s. 30(b).

[22] The application is refused pursuant to the s. 30(b) ground of opposition due to the Applicant's failure to satisfy its legal onus. The Applicant put forward the evidence of an individual who purported to support the claimed date of first use but his cross-examination revealed that he was uncertain about the matters to which he attested. In these circumstances, the Applicant was obliged to prove its claimed date of first use with acceptable evidence and this has not been done.

Section 12(1)(d) Grounds of Opposition

[23] The material date for assessing confusion under s. 12(1)(d) is today's date. [*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.)]

[24] The Opponent has met its initial burden with respect to its s. 12(1)(d) grounds of opposition because the trade-mark registrations upon which it relies are extant.

[25] The statements of wares and services for the five pleaded registrations are set out below:

- WHERE (TMA368,571): printed publications , namely books, magazines and periodicals
- WHERE FAMILY (TMA463,529): printed publications, namely, magazines, directories, brochures, pamphlets, newsletters and maps
- WHERE MAGAZINES INTERNATIONAL (TMA408,695): assembling, arranging, production, publication and dissemination of magazines, books and periodicals
- WHERE (TMA496,282):

wares: (1) computer software used to store, search, retrieve and archive editorial content, photos, illustrations, advertisements and customer information; and communications software for voice, text, video and imaging, namely audio-text that allow customers to call a central telephone number for access to 24 hour information and advertisers; pre-recorded audio video tapes; CD-ROM's; and kiosks

services: (1) Internet services; digital feed services; multi-level interactive information storage; retrieval and delivery services, namely a service that retrieves and delivers stored editorial content, images and advertising content; reservation and transaction services relating to travel, entertainment, attractions, accommodations, cuisine and related travel and destination specific information and services, namely a service that retrieves and delivers custom editorial and/or advertising products whether print or electronic; communications services for voice, text, video and imaging, namely audio-text services which allow customers to call a central telephone number for access to 24 hour information on advertisers

- WHERE ON-LINE (TMA520,864):

wares: (1) computer software, hardware and firmware

services: (1) electronic publishing, interactive computer and information services, namely the provision of information accessible to businesses and consumers through the use of computer equipped with modems.

[26] I consider the most relevant of the Opponent's registered marks to be WHERE, registration No. TMA496,282, and WHERE ON-LINE, registration No. TMA520,864, because only those registrations refer to computer software or the Internet.

[27] 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.

[28] In applying the test for confusion, I 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.).]

[29] The parties' marks all possess some degree of inherent distinctiveness.

[30] The Opponent has not filed any evidence to show that its marks have become known to any extent. The Applicant's evidence fails to show the extent to which its Mark might have become known.

[31] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or 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.)]. 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, particularly where there is an ambiguity as to the wares or services covered in the application or registration at issue [*McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R.

(4th) 266 (T.M.O.B.); *American Optical Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[32] In the present case, some of the Opponent's registered wares, namely "computer software, hardware and firmware", are ambiguous; such terms are no longer considered by the Canadian Intellectual Property Office to be specific [see *Unisys Corp. v. Northwood Technologies Inc.* (2002), 29 C.P.R. (4th) 115 (T.M.O.B.)]. Therefore I will interpret those wares as being related to what appears from the Opponent's other registrations to be the Opponent's prime business focus, namely printed publications and publishing services.

[33] Thus, there appear to be significant differences between the nature/purpose of the parties' wares and services and there is no evidence that their trades are related.

[34] Regarding the resemblance between the parties' marks, I note that although the Applicant has incorporated the Opponent's WHERE mark in its entirety, there are significant differences between the parties' marks in appearance, sound and ideas suggested.

[35] Having considered all of the surrounding circumstances, I find that confusion is not likely between the Mark and any of the Opponent's registered marks. The s. 12(1)(d) grounds of opposition are therefore dismissed.

Section 16 Grounds of Opposition

[36] In order to meet its initial burden with respect to these grounds of opposition, the Opponent had to show that it used its marks or names prior to the Applicant's first use. As the Opponent's evidence does not do this, these grounds are dismissed.

Distinctiveness Ground of Opposition

[37] In order to meet its initial burden with respect to this ground of opposition, the Opponent had to show that as of October 4, 2005 its marks had become known sufficiently to negate the distinctiveness of the Applicant's Mark. [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.); *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.)]

[38] As the Opponent has not filed any evidence that meets its initial burden, this ground is dismissed.

Section 30(i) Ground of Opposition

[39] 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] As there is no such evidence, this ground is dismissed.

Disposition

[40] 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