

**IN THE MATTER OF AN OPPOSITION  
by Viacom International Inc. to application  
No. 1,050,076 for the trade-mark REAL  
WORLD filed by Crossroads Publications  
Inc.**

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On March 8, 2000, Crossroads Publications Inc. (the “Applicant”) filed an application to register the trade-mark REAL WORLD (the “Mark”) based upon use of the Mark in Canada since at least as early as 1990 in association with the following services:

Creative consultancy services in relation to advertising and promotion, all forms of entertainment, webcasts, and the dissemination of information to targeted individuals, businesses, organizations and governments using interactive and non-interactive media; and production and post-production services in relation to films, videos, animation, audio recordings, web sites, broadcasts, webcasts and e-commerce.

The application was advertised for opposition purposes in the Trade-marks Journal of August 1, 2001.

On December 8, 2003, Viacom International Inc. (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it both denied the Opponent’s allegations and submitted that the statement of opposition did not raise a valid ground of opposition having regard to the facts and lack of facts alleged.

The Opponent’s evidence consists of the affidavit of Barbara Gallagher. The Applicant obtained an order for the cross-examination of Ms. Gallagher but did not cross-examine her.

The Applicant elected to not file any evidence.

Only the Opponent filed a written argument and only the Opponent participated in 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. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

### Section 30 Grounds of Opposition

The material date with respect to s. 30 is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475].

The legal burden on the Applicant to show that its application complies with s. 30 includes both the question as to whether or not the Applicant has filed an application which formally complies with the requirements of s. 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the Opponent relies on allegations of fact in support of its s. 30 grounds, there is an evidential burden on the Opponent to prove those allegations. [*Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.), *affd* 33 C.P.R. (3d) 454]

#### *Section 30(a)*

The Opponent has pleaded that the application does not comply with the requirements of s. 30(a) because the application does not contain a statement in ordinary commercial terms of the specific services in association with which the Mark has been used. As the Opponent has not provided any evidence or argument in support of this ground, it has not met its initial burden. The ground is accordingly dismissed.

#### *Section 30(b)*

The Opponent has pleaded that the application does not comply with s. 30(b) of the Act because the Applicant has not used the Mark in association with each of the general classes of services described in the application as of the stated date of first use of 1990.

The initial burden on the Opponent is lighter respecting the issue of non-conformance with s. 30(b), because the facts regarding the Applicant's first use are particularly within the knowledge of 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 has evidenced that the Applicant was not incorporated until January 8, 1999, *i.e.* nine years after its claimed date of first use. [Exhibit "A", Gallagher affidavit] This satisfies the Opponent's light initial burden with respect to its claim that the Applicant did not commence use at least as early as 1990.

The Applicant did not refer to any predecessors-in-title in its application and it has not filed any evidence to address the inconsistency raised by the Opponent's evidence. The Applicant has therefore not met its legal burden and the s. 30(b) ground succeeds.

#### *Section 30(i)*

The Opponent has pleaded that the application does not conform to the requirements of s. 30(i) because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada. 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] The evidence that supported the s. 30(b) ground is not evidence of the type of bad faith that would support a s. 30(i) ground. I am therefore dismissing the s. 30(i) ground.

#### Distinctiveness Ground of Opposition

The Opponent has also pleaded that the Mark is not distinctive of the Applicant's services.

In order to meet its initial burden with respect to this ground, the Opponent must show that as of the filing of the opposition (December 8, 2003), other trade-marks/names 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.)]

In its written argument, the Opponent has submitted that this ground should succeed on the basis of evidence that there were two companies using REAL WORLD as a component of their names in 2001, namely Real World Media Inc. and Real World Films Inc.

Since Ms. Gallagher's Exhibit "A" shows that the Applicant changed its name to Real World Media Inc. on September 15, 2000, that entity's use of REAL WORLD is not of concern.

Ms. Gallagher also provides copies of archived websites for [www.realworldmedia.tv](http://www.realworldmedia.tv), dated February 23, 2001 and May 19, 2001 [Exhibit "D"]. Although there is a reference in these archived websites to Real World Films Inc., this evidence does not show that Real World Films Inc. had become sufficiently known as of December 8, 2003 to satisfy the Opponent's initial burden. In fact there is no evidence that anyone in Canada ever saw the websites that have been provided. I therefore need not address the question of whether the archived websites should be accepted as reliable evidence [see *ITV Technologies, Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4<sup>th</sup>) 182 (F.C.T.D.) where evidence of this nature was found to be reliable].

The distinctiveness ground of opposition is accordingly dismissed on the basis that the Opponent has not met its initial burden.

#### Disposition

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

DATED AT TORONTO, ONTARIO, THIS 6th DAY OF FEBRUARY 2008.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board