

IN THE MATTER OF AN OPPOSITION by Venture Inns Inc. to
application No. 640,118 for the trade-mark INNVENTURES filed by
Innventures Management Corporation

On September 8, 1989, Innventures Management Corporation filed an application to register the trade-mark INNVENTURES based upon proposed use of the trade-mark in Canada in association with "providing management, promotion, and negotiating services for hotels, motels, resorts, restaurants and inns for others".

The opponent, Venture Inns Inc., filed a statement of opposition on June 4, 1990 in which it alleged the following grounds of opposition:

(a) That the present application does not comply with Section 30 of the Trade-marks Act and, more particularly, with:

(i) subsection 30(a) as the application does not contain a statement in ordinary commercial terms of the specific services in association with which the mark is proposed to be used;

(ii) subsection 30(i) as the application does not contain a statement that the applicant is satisfied as to its entitlement to use the mark in Canada as required, and as the applicant could not be satisfied that it is entitled to use the mark in Canada in association with the services described in the application since at the date of filing of the present application, the applicant was aware of the opponent's trade-marks and trade-name;

(b) That the applicant's trade-mark is not registrable in that it is confusing with the following registered trade-marks of the opponent:

<u>Trade-mark</u>	<u>Regn. No.</u>
VENTURE INN	289,434
VENTURE INNS & Design	289,440
VENTURE INN Design	311,541
VENTURE INN Design	311,904
AUBERGE VENTURE	341,812

(c) That the applicant is not the person entitled to registration in that, as of the filing date of the present application, the applicant's trade-mark INNVENTURES was confusing with:

(i) application Nos. 627,008 and 627,007 for the trade-marks VENTURE SUITES and SUITES VENTURE in association with hotel and motel services which had been previously filed by the opponent;

(ii) the trade-name Venture Inns Inc. that had been previously used by the opponent since at least as early as November 26, 1986 in association with hotel and motel services;

(d) That the trade-mark INNVENTURES is not distinctive in that it is not adapted to distinguish nor is it capable of distinguishing the applicant's services from the services of the opponent in association with which the opponent has used its trade-marks and trade-name in Canada.

The applicant filed a counter statement in which it asserted that its application complies with

Section 30 of the Trade-marks Act and that its trade-mark INNVENTURES is registrable and distinctive, and that it is the person entitled to its registration.

The opponent filed as its evidence the affidavit of Leon Manning while the applicant submitted as its evidence the affidavit of Jonathan Zwickel. As evidence in reply, the opponent filed the affidavit of Michael Jackson.

The opponent alone submitted a written argument and neither party requested an oral hearing.

Considering initially the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the opponent has alleged that the applicant's trade-mark INNVENTURES is not registrable in that the applicant's mark is confusing with the registered trade-marks: VENTURE INN, registration No. 289,434; VENTURE INNS & Design, registration No. 289,440; VENTURE INN Design, registration No. 311,541; VENTURE INN Design, registration No. 311,904 and AUBERGE VENTURE, registration No. 341,812.

In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark INNVENTURES and one, or more, of the registered trade-marks relied upon by the opponent, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date with respect to the Section 12(1)(d) ground (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

With respect to the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark INNVENTURES as applied to "providing management, promotion, and negotiating services for hotels, motels, resorts, restaurants and inns for others" and the registered trade-marks VENTURE INN, VENTURE INN Design and VENTURE INNS & Design as applied to "hotel and motel services" are inherently distinctive.

The opponent's evidence establishes that its VENTURE INN trade-marks have become known in Canada in association with its hotel and motel services with total revenues in 1989 alone

exceeding \$22,000,000. On the other hand, while the applicant's evidence establishes that it has commenced use of its proposed trade-mark INNVENTURES in Canada in association with its services, the Zwickel affidavit is far from clear in so far as establishing the extent to which the applicant's trade-mark has become known to date in this country. Thus, the extent to which the trade-marks at issue have become known, as well as the length of use of the trade-marks of the parties, both weigh in the opponent's favour in this proceeding.

In assessing the likelihood of confusion between trade-marks in respect of a Section 12(1)(d) ground of opposition, the Registrar must have regard to the services covered in the applicant's application and the opponent's registration(s), as well as the potential channels of trade that might reasonably be expected to be associated with these services, as opposed to the actual services provided by the parties in association with their respective marks (see Henkel Kommanditgesellschaft Auf Aktien v. Super Dragon Import Export Inc., 2 C.P.R. (3d) 361, at page 372 (F.C.T.D.), 12 C.P.R. (3d) 110, at page 112 (F.C.A.)). In the present case, the applicant's services, that is, "providing management, promotion, and negotiating services for hotels, motels, resorts, restaurants and inns for others" appear to fall within the scope of the services covered in the opponent's registrations, namely, "hotel and motel services". In this regard, the opponent's registrations do not limit in any manner the nature of its hotel and motel services, such that its hotel services could include hotel management services which would encompass the provision of management services to hotels. Similarly, in Spectrum Foods Inc. v. Campbell Soup Co., 15 C.P.R. (3d) 358, at page 361, the Member of the Opposition Board pointed out that "restaurant services" is a "very broad term that could include not only the operation of restaurants but also such restaurant-related services as the provision of food and supplies to restaurants". Further, the channels of trade associated with the respective services of the parties could potentially overlap.

The only remaining criterion for consideration under Section 6(5) of the Trade-marks Act is the degree of resemblance between the trade-marks at issue in appearance, sounding and ideas suggested. In this regard, the trade-marks INNVENTURES and VENTURE INN are similar in appearance and bear some degree of similarity both in sounding and in the ideas suggested by them.

Having regard to the degree of resemblance in appearance between the trade-marks INNVENTURES and VENTURE INN as applied to services which overlap, I have concluded that the applicant has failed to meet the legal burden upon it of satisfying me that there would be no reasonable likelihood of confusion between its trade-mark INNVENTURES and the registered trade-mark VENTURE INN. As a result, the applicant's trade-mark is not registrable in view of the

provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 29th DAY OF December, 1993.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.