IN THE MATTER OF AN OPPOSITION by CTV Inc. to application No. 1,017,977 for the trade-mark ETV in the name of Thomson Multimedia Inc.

On June 7, 1999, Thomson Consumer Electronics, Inc. filed an application to register the trade-mark ETV. The application, which was assigned serial number 1,017,977, is based upon proposed use of the trade-mark in Canada in association with the following wares and services:

WARES:

(1) Television receivers incorporating access to auxiliary information and programming.

SERVICES:

(1) Education and entertainment services in the nature of providing interactive information and programming via a television receiver.

On August 24, 2001, Thomson Multimedia Inc. (hereinafter the applicant) was recorded as the owner of application No. 1,017,977.

The application was advertised for opposition purposes in the Trade-marks Journal of November 6, 2002. On April 4, 2003, the opponent, CTV Inc., filed a statement of opposition against the application, which pled various grounds of opposition under the *Trade-marks Act*, specifically non-compliance with section 30, non-registrability under subsection 12(1), non-entitlement under subsection 16(3) and non-distinctiveness. The applicant filed and served a counter statement, which denied the opponent's allegations.

As rule 41 evidence, the opponent filed the affidavit of Roderick Brace. The applicant elected to not file any rule 42 evidence.

Only the opponent filed a written argument. An oral hearing was not requested.

Onus

Although 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,* there is 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 Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Material Dates

The material dates with respect to the grounds of opposition are as follows: section 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475]; paragraph 12(1)(b) - the filing date of the application [see *Shell Canada Limited v. P.T. Sari Incofood* Corporation, 2005 FC 1040; Fiesta *Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]; paragraph 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]; entitlement under subsection 16(3) - the date of filing of the application; non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

Opponent's Evidence – Brace Affidavit

I will summarize below those portions of the evidence that I consider to be the most pertinent.

Mr. Brace is the opponent's President. He sets out the nature and history of the opponent's operations. The opponent was established in 1961 and, at the time of Mr. Brace's affidavit, it owned and operated 21 conventional television stations across Canada. Mr. Braces states that the CTV network signal is available to 99 percent of English speaking Canadian households and that it offers a wide range of quality news, sports, information and entertainment programming.

The opponent owns a number of Canadian trade-mark registrations and applications for CTV, alone and in combination with other words. The most significant of these are listed below:

1. **CTV registered under No. TMA 197,826 on March 1, 1974 for various transmission and broadcast services;**
2. **CTV Design (shown below) registered under No. TMA 573,964 on January 17, 2003 for "entertainment services namely the production, broadcast, recording, transmission and distribution of television programs and the operation of a television network, and Internet services, namely the provision of entertainment, news, sports and information to the public offered through the medium of the Internet", plus a variety of wares.**

The opponent also owns registration No. TMA 573,962 for the CTV Design that claims colour as a feature. I will refer to both the "black and white" and colour versions of this design mark collectively as the CTV Design mark hereinafter. Furthermore, I wish to note that it is my view that use of the CTV Design mark also qualifies as use of the CTV mark.

The CTV Design is "commonly featured prominently on the television screen" whenever a television program is aired on the CTV network. Videotapes have been provided as exhibits showing the use of the mark on broadcasts televised September 1, 1966, September 24, 1996, June 4, 1998 and 1999-2003.

Advertising expenditures relating to the promotion in Canada of broadcast services in respect of which the CTV mark is used have exceeded $11 million in each of the years 1999 through 2003. Representative samples of advertisements have been provided.

Mr. Brace has also provided a "small representative sample" of articles written about CTV and the CTV network since the 1960's.

In addition, Mr. Brace advises that the opponent owns the Internet web site www.ctv.ca, which since 1999 has provided news, sports and entertainment related information via headlines, chat-lines, information updates, interactive communications, stories, and editorials. "Viewers of the CTV Web Site are continuously exposed to the CTV Marks which are depicted throughout the web pages of the site." Representative web pages have been provided.

Subsection 30(a) Ground of Opposition

The first ground of opposition fails because there is no basis on which I may conclude that the application does not contain a statement in ordinary commercial terms of the specific wares or services in association with which the mark is proposed to be used. The opponent has therefore not met its initial burden.

Subsection 30(e) Ground of Opposition

The second ground of opposition fails because there is no evidence that the applicant had and has no intention to use the mark in Canada as a trade-mark. Accordingly, the opponent has not met its initial burden.

Subsection 30(i) Ground of Opposition

The opponent has not pleaded that the applicant was aware of the existence of the opponent's trade-marks when it filed its application. In any event, being aware of the opponent's marks would not necessarily prevent the applicant from being satisfied that it was entitled to use its mark, on the basis that the applicant did not believe that the marks were confusing. I therefore dismiss this ground of opposition.

Paragraph 12(1)(b) Ground of Opposition

This ground of opposition fails because the opponent has not explained how the mark might be considered to be clearly descriptive or deceptively misdescriptive and it is not self-evident to me.

Paragraph 12(1)(d) Ground of Opposition

This ground pleads that the applicant's mark is confusing with the opponent's registered trade-marks CTV and CTV Design. The opponent has met its initial burden with respect to this ground by the provision by Mr. Brace of copies of its registrations Nos. TMA 197,826, 573,964 and 573,962.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act,* the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

I will first consider the likelihood of confusion between ETV and CTV.

I consider each of the marks ETV and CTV to have the same degree of inherent distinctiveness, given that they each consist of a letter of the alphabet followed by the letters TV. Only the opponent has shown that its mark has acquired distinctiveness.

The length of time that each mark has been used favours the opponent.

The parties' wares and services are closely related, if not identical. The channels of trade presumably overlap.

There is a high degree of resemblance between the two marks in appearance and a very high degree of resemblance between the two marks in sound. Both marks clearly suggest the idea of "television".

I note that there is no evidence that others have adopted a trade-mark in the field of the parties comprising a letter followed by TV.

A consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between CTV and ETV. After all, the marks are highly similar, as are their related services, and the opponent's mark has been used extensively and for a lengthy period of time.

Although there are greater differences between ETV and CTV Design than there are between ETV and CTV, overall I do not find these differences to be sufficient to result in a different conclusion concerning the likelihood of confusion.

For the foregoing reasons, this paragraph 12(1)(d) ground of opposition succeeds.

Paragraph 16(3)(a) Ground of Opposition

The opponent has met its evidential burden with respect to this ground by providing videotapes containing broadcasts that aired in association with the CTV and CTV Design marks prior to the filing of application No. 1,017,977. Although the opponent's evidence as of June 7, 1999 is not as strong as it is as of today's date, this ground of opposition also succeeds for reasons similar to those set out in my discussion of the paragraph 12(1)(d) ground.

Distinctiveness Ground of Opposition

This ground pleads that the applicant's trade-mark is not adapted to distinguish and does not actually distinguish the applicant's wares and services from the opponent's services. In order for this distinctiveness ground of opposition to succeed, the opponent need only have shown that as of April 4, 2003, its CTV trade-mark had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd*. (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)]. The opponent's evidence does satisfy this initial burden and, because the facts have not changed significantly between April 4, 2003 and today's date, this ground also succeeds for reasons similar to those set out with respect to the paragraph 12(1)(d) ground of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act,* I refuse application No. 1,017,977 pursuant to subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 12th DAY OF AUGUST 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board