



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

**Citation: 2014 TMOB 82**  
**Date of Decision: 2014-04-15**

**IN THE MATTER OF AN OPPOSITION  
by Blumberg Segal LLP to application  
No. 1,381,298 for the trade-mark  
GLOBAL PHILANTHROPIC Design in  
the name of Global Philanthropic  
International Ltd.**

[1] Global Philanthropic International Ltd. (the Applicant) has applied-for the trade-mark GLOBAL PHILANTHROPIC Design for use in association with consultancy, research and advice services in the field of fundraising. Blumberg Segal LLP (the Opponent) is a law firm which provides legal services and advice to non-profits and charities. It has opposed this application on the basis that the GLOBAL PHILANTHROPIC Design trade-mark is confusing with the Opponent's GLOBALPHILANTHROPY.CA trade-mark registered and used in association with legal services and the operation of a web-site offering information on legal, ethical and practical issues for charities and non-profit organizations.

[2] For the reasons that follow, I find that this application should be refused.

## Background

[3] On January 30, 2008, the Applicant filed an application to register the trade-mark GLOBAL PHILANTHROPIC Design (the Mark) set out below on the basis of its proposed use and its use and registration abroad.



[4] The services, as revised, are:

- (1) consultancy services for others in the field of the management of fund raising
- (2) consultancy services for others in the field of the management of fund raising; consultancy, research and advice for others in the field of fund raising; conferences and presentations for others in the field of fund raising

Services (1) are based on use and registration abroad; services (2) are based on proposed use.

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 27, 2011.

[6] On June 27, 2011, the Opponent opposed the application. The Opponent has pleaded non-compliance with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the basis of one of its grounds of opposition. The remaining grounds turn on the determination of the likelihood of confusion between the Mark and the Opponent's registration No. TMA743,039 for GLOBALPHILANTHROPY.CA for legal services; operation of a website providing information on legal, ethical and practical issues for charities and non-profit organizations and its previous use of this trade-mark (these grounds of opposition correspond to sections 2, 12(1)(d) and 16(2) of the Act). The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[7] The Opponent filed as its evidence the affidavit of Mark Blumberg (sworn March 14, 2012), one of its partners. The Applicant filed as its evidence the affidavit of Guy Mallabone, the President and Chief Executive Officer of its Canadian affiliate. In response, the Opponent filed the reply affidavit of Mark Blumberg (sworn November 14, 2012). Both parties filed written arguments and attended a hearing on March 25, 2014.

#### Material Dates and Onus

[8] The determinative issue for decision is whether the Mark is confusing with the Opponent's trade-mark GLOBALPHILANTHROPY.CA. The earliest material date to assess the issue of confusion is the date the application was filed, January 30, 2008, while the latest material date is the date of my decision: for a review of material dates in opposition proceedings see *American Assn of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206 - 208.

[9] Before considering the issue of confusion between the parties' marks, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

[10] With respect to (i) above, there is an evidential burden on the opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by the opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

## Preliminary Issues

### *Representations by Mark Blumberg*

[11] As a preliminary matter, the Applicant objected to Mark Blumberg making representations at the hearing on the basis that he had sworn the two affidavits submitted by the Opponent. While the Applicant ultimately withdrew its objection, in any event, it would have been overruled as Mr. Blumberg was entitled to make representations by virtue of his position with the Opponent.

### *Reply Evidence*

[12] The Applicant objects to the reply affidavit of Mark Blumberg on the basis that it is not proper reply. Pursuant to section 43 of the *Trade-marks Regulations* SOR/96-195, reply evidence must be “strictly confined to matters in reply”. The Applicant submits that the reply affidavit of Mr. Blumberg is improper since it includes evidence which could have been included in his first affidavit. With the exception of paragraphs 10, 13, 14 and 18, which reply to Mr. Mallabone’s evidence pertaining to the use of the GLOBALPHILANTHROPY.CA trade-mark by the Opponent, the remaining evidence could have been filed as part of the Opponent’s case in chief and is not proper [*Halford v Seed Hawk Inc* (2003), 24 CPR (4th) 220 (FCTD) at paras 14-15]. If my finding that these paragraphs are admissible is incorrect, I note that excluding this evidence would not have affected my disposition of the case.

### *Failure to Plead Grounds of Opposition Related to Services Based on Proposed Use*

[13] The Applicant submits that as the Opponent failed to plead section 16(3) as a ground of opposition, that the application should still be allowed on the basis of proposed use even if the other grounds of opposition are successful. I disagree. In order for the application to proceed to allowance, the Applicant must also succeed with respect to the grounds of opposition based on sections 2, 12(1)(d) and 30(i).

## Grounds Which Can be Summarily Dismissed

### *Section 30(i) Ground of Opposition*

[14] The section 30(i) ground of opposition alleges that the Applicant could not have been satisfied that it was entitled to use the Mark because it is confusing with the Opponent's trade-mark. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As this application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

### *Section 16(2)(a) Ground of Opposition*

[15] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with the Opponent's trade-mark GLOBALPHILANTHROPY.CA which had been previously used. In order to satisfy its evidential burden, the Opponent must evidence use of the GLOBALPHILANTHROPY.CA trade-mark prior to the January 30, 2008 material date. While Mr. Blumberg states that the Opponent's trade-mark has been used since at least as early as December 2007 (para 5 of the Blumberg affidavit), there is no evidence proving that its trade-mark was in use as of the material date. Accordingly, the Opponent has not met its burden and this ground of opposition is rejected.

### *Section 16(2)(b) Ground of Opposition*

[16] The section 16(2)(b) ground of opposition alleges that the Applicant is not the person entitled to registration of the Mark as it is confusing with the Opponent's prior application for GLOBALPHILANTHROPY.CA. As the Opponent's application had matured to registration and was not pending as of the Applicant's advertisement date (i.e. April 27, 2011) as required by section 16(4) of the Act, this ground of opposition is invalid.

Analysis of the Remaining Grounds of Opposition

*Section 12(1)(d) Ground of Opposition*

[17] The Opponent has pleaded that the Mark is confusing with its registration set out below:

Trade-mark (Registration No.)	Services
GLOBALPHILANTHROPY.CA (TMA743,039)	Legal services; operation of a website providing information on legal, ethical and practical issues for charities and non-profit organizations.

[18] I have exercised my discretion and checked the register to confirm that this registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

Therefore, the Opponent has met its initial burden.

[19] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and 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. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and

does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[20] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

#### *Inherent Distinctiveness*

[21] This factor does not favour either party. Neither the Opponent's, nor the Applicant's trade-mark is inherently distinctive. Both trade-marks are comprised of common English words that are highly suggestive of the associated services. While the Mark incorporates design features, those features are not significant enough to materially impact the inherent distinctiveness of the Mark.

#### *Degree of Resemblance*

[22] This factor significantly favours the Opponent. There is a high degree of resemblance in appearance, sound and idea suggested as the marks differ in very minor respects - the .CA component in the Opponent's mark and the use of PHILANTHROPIC rather than PHILANTHROPY in the Mark. In view of the overwhelming similarity in appearance, sound and idea suggested as a matter of first impression and imperfect recollection, the marks are not easily distinguished.

#### *Extent Known and Length of Time in Use*

[23] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The extent known and length of time in use favour the Applicant as its evidence of use is more robust than that of the Opponent.

[24] The Opponent filed the affidavits of one of its partners, Mr. Blumberg, who explains that the *www.globalphilanthropy.ca* web-site provides information to non-profit organizations and

charities on such topics as fundraising, receipting and compliance (para 7 of the Blumberg affidavit sworn March 14, 2012). Mr. Blumberg states that the Opponent's trade-mark has been in use since December 3, 2007 (para 5) and evidences that the trade-mark appeared on the *www.globalphilanthropy.ca* web-site as of March 13, 2012 (Exhibit C). In his reply affidavit sworn November 14, 2012, Mr. Blumberg provides a copy of his business card and a marketing leaflet featuring the GLOBALPHILANTHROPY.CA trade-mark and indicates that he lectures extensively (para 18; Exhibits 7-8). However, Mr. Blumberg does not set out details which would allow me to determine the extent or length of time the Opponent's trade-mark has been in use.

[25] As its evidence, the Applicant filed the affidavit of Guy Mallabone, the President and Chief Executive Officer of its Canadian affiliate. The Applicant provides a range of consulting services to the philanthropic, charity and non-profit sectors all in the field of fundraising (para 5 of the Mallabone affidavit). The Applicant has licensed the use of the Mark to its Canadian affiliate (para 19). Mr. Mallabone states that since June 2008 the Mark has been used in Canada (para 14). He provides the following representative examples of materials which feature the Mark: business cards (Exhibit E) and electronic brochures (Exhibits F and G). Mr. Mallabone states that the brochures attached as Exhibits F and G were sent to 15,000 Canadian fundraising professionals in each of 2010, 2011, and 2012 (para 20).

#### *Nature of the Services*

[26] This factor favours the Opponent since broadly speaking both the Applicant and Opponent offer advisory services in the field of fundraising.

[27] Mr. Blumberg's evidence is that the Opponent's web-site services assist charities understand their legal and ethical obligations (Exhibit C). For example, the following blog entries appear on the introductory page of the *www.globalphilanthropy.ca* web-site which features the GLOBALPHILANTHROPY.CA trade-mark:

- CRA's New Fundraising Guidance 2012 (February 3, 2012)
- Top Receipting Concerns for Canadian Registered Charities by Mark Blumberg



- CRA Fundraising Consultation – One giant leap forward in guidance for Canadian registered charities
- Bequests in Canada: 16 Steps to Creating a Planned Giving Program

The Opponent’s web-site also advertises its legal services. For example, in the About Us page it states “If you require legal advice with respect to non-profit and charities ... please contact Mark Blumberg”.

[28] Mr. Mallabone’s evidence is that the Applicant provides a range of consulting and advising services to the philanthropic, charity and non-profit sectors in the field of fundraising including providing advice to non-profit organizations, universities and colleges on how to obtain through fundraising the resources to meet their developmental goals (Mallabone affidavit, paras 5,7).

[29] The fact that the parties’ services can be more specifically described as legal services, consulting services or information services provided via a web-site does not make them of a different nature. While the services of the parties are not identical, they are highly related and appear to target the same audience (those in the field of fundraising).

*Nature of the Trade*

[30] This factor does not favour either party as the differences in the nature of the trade of the parties would not assist consumers distinguish between the marks as a matter of first impression when they encounter the marks in question (see *Masterpiece, supra* at paras 66-74).

[31] The Applicant argues that any likelihood of confusion is avoided because the nature of the trade is such that consumers are familiar with the source of the parties’ services.

Mr. Mallabone’s evidence is that the Applicant’s services are engaged by senior officers and Boards of Directors with extensive knowledge regarding the not-for profit sector who are “careful and methodical” when engaging the Applicant’s services (Mallabone affidavit, para 37). Mr. Mallabone further explains that the Applicant’s services are often performed by experts with existing relationships to its customers (para 38). Mr. Blumberg’s evidence shows that the GLOBALPHILANTHROPY.CA trade-mark appears in conjunction with the BLUMBERGS

trade-mark or other reference to the Opponent (see Exhibit C of the Blumberg affidavit; Exhibit L of the affidavit of Guy Mallabone).

[32] The Applicant further argues that confusion is also avoided due to the nature of the trades being different with respect to costs and points to the fact that the Opponent's *www.globalphilanthropy.ca* web-site is available free of charge (Exhibit C of the Blumberg affidavit); whereas its services are costly (paras 35, 37 of the Mallabone affidavit).

[33] I do not find that either of the factors submitted by the Applicant (i.e. the fact that the sources of the services are known to consumers, nor the fact that the Applicant's services are expensive versus the Opponent's web-site services which are free) diminish the potential for confusion since the test is one of first impression. Justice Sénécal of the Superior Court of Québec in *De Grandpré Joli-Coeur v De Grandpré Chait* (2011) 94 CPR (4th) 129 summarizes the Supreme Court of Canada's discussion on this point in *Masterpiece*, *supra* as follows at para 97-98:

[TRANSLATION]

In *Masterpiece*, the Supreme Court stated that it is an error to believe that, since consumers of expensive goods and services generally take considerable time to inform themselves about the source of those goods and services, there is a reduced likelihood of confusion. Confusion must instead be assessed from the perspective of the first impression of the consumer approaching a costly purchase when he or she encounters the trade-mark. ...

#### *Evidence of Actual Confusion*

[34] The Opponent points to the paragraphs of Mr. Blumberg's affidavit set out below as proving that there has been confusion.

- |    |   |
|----|---|
| 22 | On or about April 11, 2001 I gave a presentation in Calgary to a group including senior fundraisers, and the person who introduced me as a speaker to the audience asked me whether I was working with Guy Mallabone of Global Philanthropic. |
| 23 | Furthermore, at a recent Imagine Canada Conference on or about November 30, 2011 one of the attendees asked me about my connection with Global Philanthropic...   |

However, this evidence does not provide sufficient detail to allow me conclude this.

*State of the Register and State of the Marketplace Evidence*

[35] The Applicant argues that the Opponent's trade-mark should receive a very narrow scope of protection due to the use of PHILANTHROPY and GLOBAL PHILANTHROPY by others.

The Applicant points to the following evidence in support:

- Mr. Mallabone attaches print-outs of fifteen trade-marks and official marks owned by other parties including PHILANTHROPY and variants (Mallabone affidavit, Exhibit P). None of the trade-marks identified also include the component GLOBAL.
- In the file history of the application attached to the affidavit of Mark Blumberg, there is a print-out of a web-site featuring the trade-mark GLOBAL PHILANTHROPY PARTNERSHIP (Blumberg affidavit sworn March 14, 2012, Exhibit A).

This evidence is not sufficient for me to conclude that the components GLOBAL and PHILANTHROPY are so commonly used in the fundraising field that there is no likelihood of confusion between the GLOBALPHILANTRHOPY.CA trade-mark and the Mark.

*Conclusion*

[36] Having considered all of the surrounding circumstances, I am not satisfied that, on a balance of probabilities, there is no reasonable likelihood of confusion between the GLOBALPHILANTHROPY.CA and GLOBAL PHILANTHROPIC Design trade-marks based on the overwhelming resemblance between the trade-marks and the overlap in the nature of services. While I agree with the Applicant that the Opponent's trade-mark is not entitled to a broad scope of protection, if I were to find that there was no likelihood of confusion, I would be attributing the Opponent's trade-mark an overly narrow scope of protection. This ground of opposition is successful.

## Section 2

[37] The Opponent alleges that the Mark is not distinctive. There is an initial burden on the Opponent to establish that, as of June 27, 2011, the GLOBALPHILANTHROPY.CA trade-mark was known to such an extent that it could negate the distinctiveness of the Mark. The Opponent will have met its burden if its trade-mark is known in Canada to some extent and its reputation is substantial, significant or sufficient or, in the alternative, that it is well known in a part of Canada [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at paras 33-34].

[38] In the absence of evidence showing that the Opponent's trade-mark's reputation was substantial, significant or sufficient as required by *Bojangles*, the Opponent has not met its initial burden. Therefore, this ground of opposition is dismissed.

### Disposition

[39] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Natalie de Paulsen  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office