

IN THE MATTER OF AN OPPOSITION by National Broadcasting
Company Inc. to application No. 710,242 for the trade-mark MBC
filed by Middle East Broadcasting Corporation

On August 4 1992, Middle East Broadcasting Corporation filed an application to register the trade-mark MBC based upon proposed use of the trade-mark in Canada in association with "production, reproduction, distribution and broadcast of radio and television programmes".

The present application was advertised for opposition purposes in the Trade-marks Journal of May 31, 1993 and the opponent, National Broadcasting Company Inc., filed a statement of opposition on April 28, 1993 in which it alleged, inter alia, that the applicant's trade-mark MBC is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the trade-mark MBC is confusing with the opponent's registered trade-mark NBC, registration No. 116,523, covering radio, wireless and television broadcasting and communication services. The opponent also alleged that the applicant's trade-mark is not registrable in view of the provisions of Section 10 of the Trade-marks Act in that the applicant's trade-mark so closely resembles the opponent's trade-mark NBC that use of the applicant's mark is likely to be mistaken for the trade-mark NBC which has achieved wide bona fide commercial usage in Canada for production, reproduction, distribution and broadcast of radio and television programmes.

The opponent filed as its evidence the affidavits of Mitchell Salem and Craig Wilson while the applicant filed and served a statement pursuant to Rule 42(1) [formerly Rule 44] of the Trade-marks Regulations advising that it did not wish to file evidence in this opposition. Both parties submitted written arguments and the opponent alone was represented at an oral hearing.

With respect to the ground of opposition based on Section 12(1)(d) of the *Trade-marks Act*, the material date is 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 (FCA)]. The material dates with respect to the non-entitlement and non-distinctiveness grounds are, respectively, the applicant's filing date (August 4, 1992) and the date of opposition (April 29, 1993).

Moreover, in determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark MBC and the registered trade-mark NBC, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the *Trade-marks Act*. As well, 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 material dates.

While the opponent did not file a copy of its registration as evidence, the agent for the opponent submitted a certified copy of registration No. 116,523 for my consideration at the oral hearing but indicated that the opponent did not wish to file the certified copy as evidence pursuant to Rule 44(1) [formerly Rule 46(1)] of the Regulations. In any event, the Registrar does have the discretion to check the register in order to confirm the existence of the registration relied upon by the opponent [see *Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410]. Accordingly, I would note that registration No.116,523, which stands in the name of the opponent, is still in force and covers 'radio, wireless and television broadcasting and communication services'.

Considering initially the inherent distinctiveness of the trade-marks MBC and NBC, both marks comprise initials and, as such, are weak marks possessing little inherent distinctiveness. As no evidence has been furnished by the applicant, its trade-mark MBC must be considered as not having become known in Canada. On the other hand, the opponent's evidence establishes that its trade-mark NBC has become well known in Canada in association with television broadcasting and communications services. Further, the opponent's evidence establishes that it has used its trade-mark NBC in Canada in association with its television broadcasting services for over fifty years. As a result, both the extent to which the trade-marks at issue have become known and the length of use of the trade-marks weigh in the opponent's favour.

The applicant's services relating to the production, reproduction, distribution and broadcast of radio and television programmes overlap the opponent's television broadcasting and communications services. Further, and in the absence of any evidence to the contrary, I would

assume that the channels of trade associated with these services would likewise overlap.

The trade-marks MBC and NBC are similar both in appearance and sounding. While the opponent's trade-mark NBC is an acronym for its corporate name and would be perceived as such by the average user of its services, the applicant's trade-mark is not an acronym for its name, Middle East Broadcasting Corporation, even though it might be perceived as an acronym. As a result, there is some similarity in the ideas suggested by the trade-marks MBC and NBC.

Having regard to the degree of resemblance both in appearance and sounding between the trade-marks MBC and NBC and considering the overlap in the services and in the channels of trade associated with the services of the parties, and even bearing in mind the inherent weakness of the trade-marks at issue, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark MBC as applied to "production, reproduction, distribution and broadcast of radio and television programmes" and the opponent's registered trade-mark NBC as applied to 'radio, wireless and television broadcasting and communication services'. 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 10th DAY OF MAY, 1996.

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