

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

Citation: 2014 TMOB 240
Date of Decision: 2014-11-06

**IN THE MATTER OF AN OPPOSITION
by Canadian Broadcasting
Corporation/Société Radio-Canada to
application No. 1,571,291 for the trade-
mark COFFEE NIGHT IN CANADA in
the name of Big Mountain Coffee House
& Roasters Ltd.**

[1] On April 2, 2012, Big Mountain Coffee House & Roasters Ltd. (the Applicant) filed an application to register the trade-mark COFFEE NIGHT IN CANADA based on proposed use. By way of revised application accepted March 11, 2014, the Applicant deleted all wares from the application with the exception of “coffee”.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 28, 2012.

[3] On January 2, 2013, Canadian Broadcasting Corporation/Société Radio-Canada (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- pursuant to sections 38(2)(a) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the applied for wares since at the date of filing the application the Mark was confusing with one or more of the Opponent’s registered HOCKEY NIGHT IN CANADA trade-marks or NIGHT IN CANADA official marks (identified below) of which the Applicant was or ought to have been aware in view of the long term and widespread use of said marks in Canada by the Opponent and/or its predecessors in title;

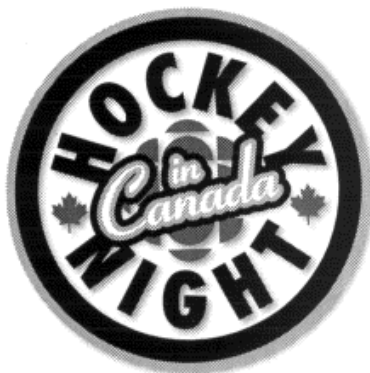
- pursuant to sections 38(2)(b) and 12(1)(d), the Mark is not registrable as it is and was at all material times, confusing with the Opponent's registered HOCKEY NIGHT IN CANADA trade-marks, outlined below, none of which have been abandoned:

- i. HOCKEY NIGHT IN CANADA – TMA227,771
- ii. HOCKEY NIGHT IN CANADA & Design – TMA227,772



- pursuant to sections 38(2)(b) and 12(1)(e), the Mark is not registrable in that the adoption of the Mark is prohibited by section 9 of the Act. The Mark so nearly resembles as to be likely to be mistaken for one or more of the Opponent's NIGHT IN CANADA official marks, outlined below, in respect of which public notice was given pursuant to section 9(1)(n)(iii) in the *Trade-marks Journal*:

- i. Hockey Night in Canada – 0909885
- ii. HOCKEY NIGHT IN CANADA LOGO DESIGN – 0911707



- iii. HOCKEY NIGHT IN CANADA BIO – 0918748
- iv. HOCKEY NIGHT IN TORONTO – 0919541
- v. HOCKEY NIGHT IN EDMONTON – 0919542

- vi. HOCKEY NIGHT IN OTTAWA – 0919543
 - vii. HOCKEY NIGHT IN CALGARY – 0919544
 - viii. HOCKEY NIGHT IN VANCOUVER – 0919545
 - ix. HOCKEY NIGHT IN MONTREAL – 0919546
 - x. FOOTBALL NIGHT IN CANADA – 0918202
- pursuant to sections 38(2)(d) and 2, the Mark is not distinctive within the meaning of section 2 because it does not distinguish and is not adapted to distinguish the Applicant's wares from the wares of others including the wares and services of the Opponent.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed affidavits of:

- a. David Masse, the Senior Director of TV Network Sports for the Opponent;
- b. Barbara Gallagher, a law clerk employed by the Opponent's agent;
- c. James Haggerty, a trade-mark searcher employed by the Opponent's agent; and
- d. Glenda O'Brien, a library reference technician employed by the Opponent's agent.

[6] None of the Opponent's affiants was cross-examined.

[7] The Applicant did not file any evidence in support of its application.

[8] Only the Opponent filed a written argument but both parties were represented at an oral hearing.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- section 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]
- section 38(2)(b)/12(1)(e) – the date of my decision [see *Canadian Council of Professional Engineers v Groupegénie Inc* (2009), 78 CPR (4th) 126 (TMOB) and *Canadian Olympic Assn v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Non-compliance with section 30(i) of the Act

[11] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the section 30(i) ground is accordingly dismissed.

Non-registrability Grounds

Section 12(1)(d) of the Act

[12] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if the registration(s) relied upon is in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have

exercised that discretion and note that the registrations for the Opponent's registered HOCKEY NIGHT IN CANADA trade-marks remain extant. Thus the Opponent has met its evidential burden. I must now assess whether the Applicant has met its legal onus.

[13] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[14] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[15] The Mark and the Opponent's registered HOCKEY NIGHT IN CANADA word mark are phrases made up of common dictionary words which have some degree of relation to the associated wares and services. None of the marks at issue are particularly inherently strong. The Opponent's registered HOCKEY NIGHT IN CANADA & Design mark possesses a slightly higher degree of inherent distinctiveness by virtue of the additional design features.

[16] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[17] The application for the Mark is based on proposed use and the Applicant has not provided any evidence of use of the Mark in Canada. As a result, I am unable to infer that the Mark has become known to any extent in Canada.

[18] By contrast, the Opponent has provided significant evidence establishing the use of the registered HOCKEY NIGHT IN CANADA trade-marks in association with the provision and promotion of television and radio programs, specifically relating to the television broadcast of National Hockey League games and related features. For example, Exhibit D to the Masse affidavit consists of DVDs featuring sample television broadcasts from 2004, 2006 and 2008. Exhibit E to the Masse affidavit consists of printouts from the HOCKEY NIGHT IN CANADA section of the Opponent's website demonstrating the ways the Opponent's registered HOCKEY NIGHT IN CANADA marks have been used in association with the registered services. For the 2012/2013 season, the HOCKEY NIGHT IN CANADA portion of the Opponent's website had approximately 223,000 unique visitors. Exhibit F to the Masse affidavit consists of sample promotional materials displaying the registered HOCKEY NIGHT IN CANADA marks. Mr. Masse makes the sworn statement that the documents attached as Exhibits E and F are representative of the manner in which the HOCKEY NIGHT IN CANADA marks have been extensively advertised and promoted in Canada for many decades.

[19] The Opponent also provides evidence, through the O'Brien affidavit, of references to the Opponent's HOCKEY NIGHT IN CANADA trade-marks in various major daily newspapers in Canada including *The Calgary Herald*, *The Gazette*, *The Ottawa Citizen*, and *The Globe and Mail* from 2007 – 2013 (Exhibit A, tabs 1-28). I am prepared to take judicial notice that major daily newspapers such as those in the O'Brien affidavit, have significant circulation in Canada [*Northern Telecom Ltd v Nortel Communications* (1987), 15 CPR (3d) 540 at 543 (TMOB)].

[20] The Opponent has also provided evidence of use of the HOCKEY NIGHT IN CANADA trade-marks in association with various promotional merchandise, including "mugs, glasses, stainless steel bottles, clothing, caps, books and DVDs" largely through the operation of licensees (Exhibit H and I to the Masse affidavit). Mr. Masse makes it clear that at all times the Opponent has, under license, retained direct or indirect control of the character and quality of the merchandise sold in association with the HOCKEY NIGHT IN CANADA trade-marks

(paragraphs 29-31). I note that the Opponent's registered wares include only "interactive video cassette and board games".

[21] I am satisfied that the evidence of record supports a finding that the Opponent's trade-marks have become known to a significant extent in Canada in association with the registered wares and services. Furthermore, I note that at the oral hearing the Applicant conceded that the Opponent's HOCKEY NIGHT IN CANADA trade-marks had become well known in Canada for broadcasting services but stopped short of conceding that they were "famous marks".

[22] Based on the foregoing, this factor favours the Opponent.

Section 6(5)(b) – the length of time each has been in use

[23] As discussed in greater detail above in the analysis of the section 6(5)(a) factor, the Applicant has not established any use of the Mark, whereas the Opponent has established significant use of its registered HOCKEY NIGHT IN CANADA trade-marks by itself and its predecessors in title since at least the year 2000 in association with the registered wares and services.

[24] Based on the foregoing, this factor favours the Opponent.

Section 6(5)(c) and (d) – the nature of wares, services or business and trade

[25] The application for the Mark covers only the wares "coffee".

[26] The Opponent's registrations for the HOCKEY NIGHT IN CANADA trade-marks cover:

- a. TMA277,771 (word mark) - "interactive video cassette and board games; providing radio and television programs"
- b. TMA277,772 (design mark) - "services of providing radio and television programs"

[27] The Applicant submits, and I agree, that there is no overlap between the parties' wares and services as outlined in the application and registrations.

[28] As outlined above in the analysis of the section 6(5)(a) factor, the Opponent has provided evidence of use of its HOCKEY NIGHT IN CANADA trade-marks in association with additional types of promotional merchandise which are not captured in the registered wares. The jurisprudence is clear that the analysis under section 6(5)(c) is limited to an assessment of the wares and/or services covered in the Applicant's application and the Opponent's registration see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. The use of the Opponent's marks in association with wares other than those claimed in the registrations pleaded under this ground of opposition could only be relevant as an additional surrounding circumstance.

[29] In the absence of any overlap in the nature of the parties' wares and services, I find that there would also be no overlap in the nature of the parties' trades.

6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[30] The parties' marks share the words NIGHT IN CANADA with only the first word differing as between them. In the case of the Mark, the first word "COFFEE" is descriptive of the associated wares (coffee). Thus, the more striking and unique element of the Mark is the phrase "NIGHT IN CANADA" which for the same reasons is the striking and unique element of the Opponent's HOCKEY NIGHT IN CANADA trade-mark as well.

[31] The parties' marks share similarities in sound, appearance and ideas suggested by virtue shared NIGHT IN CANADA element. That being said, the inclusion of the words COFFEE and HOCKEY creates differences between the parties' marks, particularly in appearance and in ideas suggested. I note, however, that the words HOCKEY and COFFEE do share some degree of similarity in sound – thus creating similarity in sound between the parties' marks.

[32] When considered as a whole, I find that the section 6(5)(e) factor favours the Opponent.

State of the Register

[33] The Opponent has provided state of the register evidence for the phrase NIGHT IN CANADA. In his affidavit, Mr. Haggerty provides the results of his search of the register for

active trade-marks including the element NIGHT IN CANADA. As shown in the results attached to his affidavit as Exhibits A and B, the Opponent is the sole owner of all active NIGHT IN CANADA trade-marks on the register.

[34] At the oral hearing, the Applicant referred to an abandoned (inactive) registration for POKER NIGHT IN CANADA not owned by the Opponent. I refuse to place any weight on this submission as it is not supported by the evidence of record.

Licensing of HOCKEY NIGHT IN CANADA trade-marks for merchandise

[35] The Applicant submits that the Opponent, as a public broadcaster, is not in the business of providing food and beverages. While this is true, the evidence is clear that the Opponent has engaged in a merchandise licensing program for the provision of promotional goods in association with the HOCKEY NIGHT IN CANADA trade-marks. Furthermore, as pointed out in the analysis of the section 6(5)(a) factor above, the evidence is clear that these licenses comply with section 50 of the Act.

[36] Through this extensive licensing program the Opponent engages in merchandise licenses for the sale of various promotional wares, including some which share some degree of similarity with the Applicant's coffee wares as they would likely be used in association with coffee – such as coffee mugs, thermal mugs, beverage woolies and varsity mugs (Exhibit I). Mr. Masse makes the sworn statement that the promotional merchandise found in Exhibits H and I to his affidavit, is representative of how the HOCKEY NIGHT IN CANADA trade-marks have been used for many years in association with consumer merchandise (para 35). The Opponent also provides substantial sales figures for the HOCKEY NIGHT IN CANADA merchandise for the years 2007 – 2013. Specifically, Mr. Masse states that total sales over this period amounted to \$17 million, ranging from a high of \$4.8 million in 2007/08 to a low of \$1.8 million in 2010/11 (para 36).

[37] As pointed out in the analysis of the sections 6(5)(c) and (d) factors, the wares other than “interactive video cassette and board games” are not captured in the registrations for the HOCKEY NIGHT IN CANADA trade-marks and thus this can only be considered as an additional surrounding circumstance.

[38] I find that this additional surrounding circumstance favours the Opponent.

Conclusion

[39] I have considered the issue of confusion as a matter of first impression based on all the surrounding circumstances. While the nature of the parties' wares and services differs, the significant extent to which the Opponent's registered HOCKEY NIGHT IN CANADA marks have become known and the significant degree of resemblance between the parties' marks created by the inclusion of the NIGHT IN CANADA element in the Mark, shifts the balance of probabilities in favour of the Opponent such that I find that the public would likely infer that the use of COFFEE NIGHT IN CANADA as a trade-mark for coffee was approved, licensed or sponsored by the Opponent or that there was some kind of business connection between the Applicant and the Opponent. I am thus not satisfied that the Applicant has satisfied its onus and the ground of opposition based on section 12(1)(d) is successful.

Section 12(1)(e) and 9(1)(n)(iii) of the Act

[40] The Opponent has provided particulars of its official marks and I have no reason to doubt the validity thereof. Furthermore, I acknowledge that the Opponent even provided evidence clearly establishing its status as a public authority in Canada.

[41] The test under section 9(1)(n)(iii) is whether a person, on a first impression, knowing the Opponent's official marks only and having an imperfect recollection of them, would likely be deceived or confused by the Mark. This is not a test of straight comparison, and if, as is the case in the present opposition, the marks are not identical, then there must be consideration of whether the Mark so nearly resembles as to be likely to be mistaken for one or more of the Opponent's official marks. In assessing the degree of resemblance under section 9(1)(n)(iii), the test is not restricted to visual comparison. Regard may be had to the factors set out in section 6(5)(e) of the Act, namely the degree of resemblance between the marks in appearance, sound or in the ideas suggested by them [see *Techniquip Ltd v Canadian Olympic Assn* (1998), 80 CPR (3d) 225 at 230 (FCTD), aff'd 3 CPR (4th) 298 (FCA); *Big Sisters Association of Ontario v Big Brothers of Canada* (1999), 86 CPR (3d) 504 (FCA); *Hope International Development Agency v Aga Khan Foundation Canada* (1996), 71 CPR (3d) 407 at 413 (TMOB) at 413].

[42] It is important to note that the test under section 9(1)(n)(iii) differs from a standard confusion analysis such that in order to be successful there must be a likelihood that consumers will be mistaken as between the marks themselves not a likelihood that consumers will infer an association between the source of the services.

[43] My finding under the non-registrability ground of opposition was largely based on the extensive reputation established by the Opponent for its registered HOCKEY NIGHT IN CANADA trade-marks. This is not a factor which is considered in the context of a section 12(1)(e)/9(1)(n)(iii) analysis.

[44] When the parties' marks are compared based on degree of resemblance alone, I am not convinced that the average consumer would be mistaken as between the Mark and the Opponent's NIGHT IN CANADA official marks themselves.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[45] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[46] The Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its pleaded HOCKEY NIGHT IN CANADA and/or NIGHT IN CANADA official marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[47] As discussed in further detail above in the analysis of the section 12(1)(d) ground of opposition, I am satisfied that the Opponent has established sufficient reputation for the HOCKEY NIGHT IN CANADA marks at the material dates in order to meet its evidential burden.

[48] The difference in the material dates is not significant enough to materially affect the conclusions made under the section 12(1)(d) ground above. Based on the foregoing, the non-distinctiveness ground of opposition is also successful.

Disposition

[49] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office