

**IN THE MATTER OF AN OPPOSITION
by Screenlife Productions Limited to
Application No. 1010728 for the Trade-
mark FLIGHTPATH filed by Rock
Whitney, dba Flightpath Film, Video &
Stills**

I The Pleadings

On April 1st, 1999, Rock Whitney, dba Flightpath Film, Video & Stills (the “Applicant”) filed an application to register the trade-mark FLIGHTPATH (the “Mark”), application number 1010728, based on use since at least August 1995, in association with the services of producing videos and still photographs for and about the aviation and aerospace industries (the “Services”). The present application was advertised on February 20, 2002 in the Trade-Marks Journal for opposition purposes.

Screenlife Productions Limited (the “Opponent”) filed, on June 25, 2002, a statement of opposition raising the following grounds of opposition:

- 1) The application does not conform to the requirements of s. 30 of the *Trade-marks Act* R.S.C. 1985, c. T-13, (the “Act”) in that at the date of filing of the application, namely April 1, 1999, the Applicant could not have been satisfied that it was entitled to the use and registration of the Mark in view of the prior use of the Opponent’s trade-mark FLIGHTPATH in association with “the services of production of cable television programs and videos; distribution of television programs; entertainment in the nature of an on-going television series” and the wares “ pre-recorded video cassettes, television programs and videos”, and, the Applicant was aware of the Opponent’s trade-mark rights in the mark FLIGHTPATH at least because the same applicant had previously filed an application to register the same mark FLIGHTPATH, which application was granted application number 814157, and, which application was abandoned by the Applicant after the Opponent’s predecessor-in-title, namely Screenlife Incorporated, (“Screenlife”) commenced an opposition against application serial number 814157;
- 2) Pursuant to s. 38(2)(a), the application does not conform to the requirements of s. 30 of the Act in that the Applicant did not use the Mark in association with the Services since the date of first use alleged in the application, namely August 1995;
- 3) Pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration under s. 16(1) of the Act, in that at the date of alleged first use in Canada, the Applicant’s Mark was confusing with the trade-mark FLIGHTPATH that had been previously used in Canada by the Opponent and Screenlife, in association with the services of “production of cable television programs and videos; distribution of television programs; entertainment in the

nature of an ongoing television series” and in association with the wares of “pre-recorded videocassettes, television programs and videos”;

- 4) Pursuant to s. 38(2)(d), the Applicant’s Mark is not distinctive of the Applicant’s Services having regard to s. 2 of the Act in that the Mark does not, and is not, adapted to distinguish the Applicant’s Services from the wares and services of others, including particularly, the wares and services of the Opponent, which has been used, advertised and/or performed in Canada in association with the trade-mark FLIGHTPATH in association with the services of “production of cable television programs and videos; distribution of television programs; entertainment in the nature of an ongoing television series” and in association with the wares of “pre-recorded videocassettes, television programs and videos”.

The appropriate subsections of the sections of the Act for each of the first three grounds of opposition have not been identified. However the Opponent has provided enough details in the allegations contained in those paragraphs that the Applicant knew what it was facing and did in fact answer through a detailed counter statement. A reading of those grounds of opposition makes it obvious that the Opponent was relying on s. 30(i), 30(b) and 16(1)(a) of the Act, respectively.

The Opponent’s evidence consists of the affidavit of Micheal Feheley while the Applicant filed the affidavit of Rock Whitney. Only the Opponent filed a written submission and no oral hearing was held.

II The Legal Issues and the Relevant Evidence

The legal onus is upon the Applicant to show that its application complies with the provisions of s. 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of such grounds of opposition. Once this initial onus is met, the burden shifts to the Applicant who must prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the mark applied for. [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293, *Christian Dior, S.A. and Dion Neckwear Ltd* (2002), 20 C.P.R. (4th) 155]

With respect to grounds of opposition based on s. 30 of the Act, even though the Opponent has an evidential onus, it is a light one [See *Tune Masters c. Mr. P’s Mastertune Ignition Services Ltd.*

(1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Labatt Brewing Co. c. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) *et Williams Telecommunications Corp. c. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107 (T.M.O.B)]. Reference to the evidence adduced by the Applicant can be made to meet such initial onus. [See *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co.* (1999), 1 C.P.R. (4th) 263]

The material time for considering the issue of non-entitlement to the registration of the Mark is the date of first use alleged in the application [See s. 16(1) of the Act]. The critical date for assessing the issue of non-compliance with the provisions of s. 30 of the Act is the filing date of the application [See *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (TMOB) and *Dic Dac Holdings (Canada) Ltd, supra*]. Finally it is generally accepted that the date of filing of the statement of opposition is the critical date to assess the distinctiveness of the Mark as a ground of opposition [See *Andres Wines Ltd. and E&J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

I will describe hereinafter the relevant evidence filed by both parties in the context of each ground of opposition raised.

The Opponent, in its written argument, has not discussed the merit of its third ground of opposition. Screenlife assigned to the Opponent on June 2, 2002 all the rights, title and interests in the trade-mark FLIGHTPATH, including the right to pursue this opposition. Suffice to say at this stage, that the Opponent has not adduced any evidence of use of the trade-mark FLIGHTPATH by its predecessor-in-title as of the date of advertisement of the application. In fact there is no evidence of use of the Opponent's trade-mark FLIGHTPATH after March 1998 by itself or Screenlife. There is a broad statement made by Mr. Feheley in his affidavit that the television series FLIGHTPATH continued to be broadcasted and viewed in Canada without any supporting evidence of use as defined in s. 4(2) of the Act. We have no information as to when and by which means the television series FLIGHTPATH was broadcasted after March 1998 in Canada.

In virtue of s.16 (5) of the Act, the right of the Applicant to secure registration of the Mark is not affected by the prior use of a confusing trade-mark or trade-name, if such confusing trade-mark or trade-name has been abandoned at the date of advertisement of the Applicant's application. Therefore the Opponent had the burden to prove that Screenlife had not abandoned the use of its trade-mark FLIGHTPATH on or about February 20, 2002. [See *Wilson Laboratories Inc. v. Chipman Inc.* (1984), 2 C.P.R. (3d) 117 (TMOB)] In view of the absence of any evidence of use of the Opponent's trade-mark FLIGHTPATH on or about February 20, 2002, the Opponent failed to meet its evidential onus with respect to the third ground of opposition and is therefore dismissed.

As for the first ground of opposition, the Opponent filed the following evidence: A copy of an extract of Strategis database with respect to application number 814157. The Applicant filed it on June 3, 1996 for the registration of the Mark. It was based on proposed use for a list of wares that included, films, photographs and pre-recorded videos and interactive educational and gaming computer software for and about the aviation, travel and tourism industries, as well as for the services of producing television programs for and about the aviation, aerospace, travel and tourism industries and based on use in Canada since August 1994 in association with the services of producing motion picture film, video and still photographs for and about the aviation, travel and tourism industries.

As alleged by Mr. Feheley, the extract reveals that the application was advertised on July 30, 1997 in the Canadian Trade-marks Journal. It also shows that Screenlife was identified as the opponent to such application and filed a statement of opposition on October 8, 1997. Finally the extract evidences that application 814157 was declared abandoned as per the provisions of s. 38(7.2) of the Act. However, it does not mention if it resulted from the Applicant's failure to file a counter statement or its evidence. The affiant alleges that it was caused by the Applicant's failure to file its evidence after Screenlife had filed its evidence. As it will appear from my decision on this ground of opposition, what caused the application to be deemed abandoned would not be a determining factor in my reasoning.

The Opponent failed to introduce as evidence a copy of the statement of opposition, the counterstatement and the evidence, if any, filed in application 814157. The absence of such

evidence precludes me from ruling in favor of the Opponent on its first ground of opposition for the following reasons. It could be that the Applicant had to prove its date of first use of the Mark in association with the services described above and determined that it would not be in a position to do so. Therefore it might have decided to file a fresh application with a later date of first use that it could substantiate. In the absence of the statement of opposition and the evidence filed by Screenlife, I'm not in a position to presume that the Applicant was well aware of the latter's prior rights, if any. In any event I have no evidence that the prior rights alleged in the statement of opposition filed against application number 814157 by Screenlife would constitute an absolute bar to the registration of the Mark by the Applicant on the basis of the allegations contained in the present application.

Therefore, I cannot rule that the Applicant could not have been satisfied at the filing date of the present application, that it was entitled to the registration of the Mark, and as such I also dismiss the first ground of opposition.

The second ground of opposition turns on the Applicant's allegation, in its application, that it has used the Mark in association with the Services since at least August 1995. The Opponent has not filed any evidence to challenge such date of first use. It does however rely on the evidence filed by the Applicant to argue that such evidence is sufficient to meet the low threshold of its onus and as such the burden has shifted to the Applicant. It must be kept in mind that in such a situation the Applicant's evidence must be clearly inconsistent with the claimed date of first use alleged in the application. [See *Dic Dac Holdings (Canada) Ltd.*, op. cit.]

The Applicant filed over 30 exhibits and physical exhibits in support of the allegations contained in Mr. Whitney's affidavit. For the purpose of this ground of opposition, I shall concentrate on the evidence filed by the Applicant with respect to its allegation of use of the Mark between August 1994 and July 1st 1996. The fact that the Applicant has used the Mark prior to the claimed date of first use has no fatal consequences on the present application. [See *Marineland Inc v. Marine Wonderland & Animal Park Ltd.* (1974), 16 C.P.R. (2d) 97] The most relevant allegations appear in paragraphs 3 to 6 to Mr. Whitney's affidavit. Without concluding that they constitute proper evidence of use of the Mark, the allegations contained in the subsequent paragraphs of his affidavit

relate to facts that occurred after the alleged date of first use of the Mark and are not as relevant for the purpose of this ground of opposition.

I reproduce the relevant paragraphs:

3. Marked and shown to me as Exhibit "A" to this affidavit is a copy of Flightpath Film, Video and Stills demonstration videotape (VHS format) containing examples of video work *provided by the applicant in association with the trade-mark FLIGHTPATH* (italicized as it appears in handwritten form on the original affidavit) from 1994 to 2003. The video is broadcast (sic) on the website www.flightpath.ca and given directly to prospective clients.

4. Marked and shown to me as Exhibit "B" to this affidavit is a videotape (VHS format) upon which is recorded "Flightpath Aviation Video Magazine". The video consists of three video segments. The segment titled "Visions of Flight" was photographed August 6, 1994 at the Boundary Bay Airshow. The segment "Cessna's Affordable Classic" was photographed Feb. 9, 1995 and May 6, 1995. The segment "In Tight and Thrilling" was photographed July 1, 1996.

5. Marked and shown to me as Exhibit "C1" to this affidavit is an authorization and release form dated February 9, 1995. This release form is signed by Cheryl Wyers who was the pilot and owner on the Aircraft CF-QJD profiled in Flightpath Aviations (sic) Video Magazines video segment "Cessna's Affordable Classic".

Marked and shown to me as Exhibit "C2" to this affidavit is an authorization and release form dated May 6, 1995. This release form is signed by Cheryl Wyers who was the pilot and owner on the Aircraft CF-QJD profiled in Flightpath Aviation Video Magazines video segment "Cessna's Affordable Classic".

Marked and shown to me as Exhibit "C3" to this affidavit is an authorization and release form dated July 1, 1995. This release form is signed by Michel Rouch, Sheldon Pohl, Clive Barrat and Charles Pym who were (sic) the pilots profiled in Flightpath Aviation Video Magazines video segment "In Tight and Thrilling".

6. Marked and shown to me as Exhibit "D1" to this affidavit is a proposal for a Series of Three Promotional Videos for Skys of Un-Limited Air Services *prepared on or about* (italicized as it appears in handwritten form on the original affidavit) July 28, 1995.

Marked and shown to me as Exhibit "D2" to this affidavit are four invoices from Skys Unlimited to Flightpath, dated July 17, July 19, August 1 and August 20, 1995.

If I come to the conclusion that those allegations do not raise any serious doubts on the allegation of first use of the Mark in association with the Services in August 1995, made by the Applicant in its application, the first ground of opposition must fail. On the other hand if these allegations create such a serious doubt, I will have to maintain this ground of opposition as there is no other evidence the Applicant can rely on to substantiate its date of first use of the Mark in Canada in association with the Services.

It is important to describe the features of each exhibit referred thereto keeping in mind the Mark applied for and the description of the Services. Exhibit A consists of a videocassette box on which there is a sticker with the following inscription:

Flightpath film, video & stills
DEMO REEL
NTSC-6:30 min. approx.
ph. 604-312-3598
www.flightpath.ca

Inside the box there is a videocassette on which there is a sticker with the same information described above. At no time does the Mark appear in the video. At the bottom of the images appearing on the screen, we see the phrase “Flightnet.com”. There is at the end of the video a reference to “FLIGHTPATH films, video, stills” all written on the same line. The size of the letters comprising the word FLIGHTPATH are much larger than the letters used for the other words. There are no dates on the box and the videocassette. I consider that such display is use of the Mark. The addition of the descriptive words “films”, “video” and “stills” does not alter substantially the Mark to a point where an unaware consumer would be likely to infer that such trade-mark identifies goods or services of different origin. [See *Canada (Registrar of Trade-marks) v. Cie. Internationale pour l’informatique CII Honeywell Bull, S.A.* (1985), C.P.R. (3d) 523].

There is no mention of a date in the video itself. However the affiant in paragraph 3 of his affidavit alleges that such video represents work provided by the Applicant from 1994 to 2003.

The Opponent argues that the affiant does not allege that these sample videos represent work done for third parties. As a consequence, according to the Opponent, we can infer that these samples were not filmed as a result of any services performed for third parties but, rather, were for the Applicant’s own purposes to obtain footage for his demonstration video. The fact that Mr. Whitney did not state for whom those videos were produced does not necessarily imply that they were produced for its own benefit. If there was some ambiguity in the Opponent’s mind, it could have clarified the situation through a cross-examination of the affiant. This video could have been used to promote the Applicant’s Services, and does not constitute a clear contradiction with the Applicant’s allegations in his application.

Exhibit B is another videocassette and its packaging. The front-cover of the packaging bears the Applicant's trade-name Flightpath Film Video & Stills and design as illustrated hereinafter:



The symbol “™” appears beside the word “Flightpath” which is written in much larger characters. The Mark also appears alone on the side of the packaging. The Opponent argues that, because there is a copyright notice “© 1996 Flightpath film, video & stills” at the end of the video, it clearly shows that the videocassette could not have been on the Canadian market before 1996, thus subsequent to the claimed date of first use of the Mark. However one cannot isolate such exhibit from the content of paragraphs 4 and 5 of Mr. Whitney's affidavit and Exhibits C1 and C2. Mr. Whitney alleges in those paragraphs that the videos were produced in February 1995, May 1995 and July 1996. Those allegations are corroborated by the content of Exhibits C1 and C2 that are authorization forms signed by individuals on or about those dates.

There remain Exhibits D1 and D2. Exhibit D1 is “a proposal for a series of three promotional videos for Skys Un-Limited.... by Flightpath Cinematography.... Prepared by Rock Whitney Flightpath Cinematography” as it appears from the proposal itself. It does describe the script of three videos and the budget for each one of them. In paragraph 6 of his affidavit, Mr. Whitney does state that it was prepared on July 28, 1995 and because he was not cross-examined on this issue I have no reason to question such date. It establishes that the Applicant was offering the Services to prospective customers in July 1995.

The Opponent argues that Flightpath Cinematography and not the Applicant made the proposal. This is ignoring the fact that Mr. Whitney prepared it and if there was any ambiguity with respect to the business name or trade-name used by the Applicant, it could have been clarified through cross-examination.

Exhibit D2 includes invoices issued by Skys Un-limited Air Services to “Flightpath” dated in July and August 1995 for the rental of “VFG” and “ATC 710 simulator”. I do not see those invoices creating inconsistencies with the allegations contained in the present application.

For all these reasons I conclude that the Applicant’s evidence is not clearly inconsistent with the statements in its application. Therefore the Opponent failed to discharge its initial onus with respect to its second ground of opposition. It is also dismissed.

The Opponent is alleging that the Mark is not distinctive nor is it adapted to distinguish the Applicant’s Services from the wares and services of the Opponent in association with the trade-mark FLIGHTPATH, which has been used, advertised and/or performed in Canada in association with the services of “production of cable television programs and videos; distribution of television programs; entertainment in the nature of an ongoing television series” and in association with the wares of “pre-recorded videocassettes, television programs and videos”. In order to be successful under such ground of opposition, the Opponent must prove that its trade-mark FLIGHTPATH was known in Canada at the relevant date, namely June 22, 2002. [See *Motel 6, Inc. v. No. 6 Motel Ltd et al.* (1981), 56 C.P.R. 44 and *Andres Wines op. cit.*] The ground of opposition, as drafted, did not specify that the Opponent was relying on Screenlife’s prior use of the trade-mark FLIGHTPATH to attack the distinctiveness of the Mark at the relevant date. For the purpose of disposing of all the queries raised by this ground of opposition, I will assume that the Opponent intended to rely on such prior use.

The evidence filed by the Opponent on the use of the trade-mark FLIGHTPATH in Canada can be summarized as follow:

- Screenlife began advertising in the late summer and fall 1996 its television series FLIGHTPATH to be aired on the Discovery Channel in Canada;
- Samples of advertisement published in program guides and marketing kits distributed as early as June 1996 were filed into the record;
- Articles published in September 1996 in the Ottawa Sun and in the Starweek magazine were also produced into the record.
- An article published in the Globe and Mail was filed but we have no date of publication;
- Neilson Marketing Research ratings showing the average minute audience for the FLIGHTPATH series on the Discovery Channel have been provided for various periods between August 1996 and March 1998 but we have no explanation as to what those numbers mean and what conclusion can be drawn from them;
- Samples of advertisements published between January 1998 and March 1998 were also filed, without however being provided with the extent of the circulation of those ads;
- Finally samples of episodes of the FLIGHTPATH Series I were filed.

The Opponent's trade-mark FLIGHTPATH may have been used and known to some extent in Canada between the summer 1996 to the spring of 1998. However, the evidence filed on the use of the trade-mark FLIGHTPATH in association with Screenlife's services during that period of time does not enable me to conclude that it was so well known during that time that the Canadian consumers would have in mind Screenlife as the source of the Services provided by the Applicant in association with the Mark some four or five years later. We have actually no evidence of use of the trade-mark FLIGHTPATH by Screenlife after March 1998.

I conclude that the Opponent failed to prove, on the balance of probabilities, that its trade-mark FLIGHTPATH was known in Canada in June 2002 to such an extent to negate the distinctiveness of the Applicant's Mark. Therefore I also dismiss the last ground of opposition.

III Conclusion

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the Opponent's opposition to the registration of the Mark pursuant to s. 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 6th DAY OF FEBRUARY 2006.

Jean Carrière,
Member of the Trade-marks Opposition Board