

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

**Citation: 2014 TMOB 178
Date of Decision: 2014-08-27**

**IN THE MATTER OF AN OPPOSITION
by Provent Holdings Ltd. to application
No. 1,415,931 for the trade-mark M
Design in the name of Star Island
Entertainment, LLC**

[1] On October 27, 2008, Star Island Entertainment, LLC (the Applicant or Star Island) filed an application to register the trade-mark M Design (the Mark) set out below.



[2] The application covers the following services (as amended):

(1) Reservation services for bars and night clubs.

(2) Night club, bar, restaurant services and entertainment, namely live musical concerts.

(3) Night club and bar services.

Services (1) are based on use in Canada since 2004. Services (2) are based on proposed use. Services (3) are based on use and registration of the Mark in the United States.

Collectively services (1), (2) and (3) are referred to as the Services.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 28, 2010.

[4] On December 21, 2010, Provent Holdings Ltd. (the Opponent) filed a statement of opposition. The statement of opposition was amended on July 26, 2011. The grounds of opposition as amended are summarized below:

(a) The application does not comply with section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) since:

1. “night services” does not constitute a statement in ordinary commercial terms;
2. “reservation services for bars and night clubs” does not constitute a service since, to the extent that any services are offered, they do not constitute a separate service;

(b) The application does not comply with section 30(b) of the Act since the Applicant has not used the Mark since at least as early as 2004 in association with “reservation services for bars and night clubs”;

(c) The application does not comply with section 30(e) of the Act since the Applicant did not have a *bona fide* intention to use the Mark;

- (d) The Mark is not registrable within the meaning of section 12(1)(d) of the Act since it is confusing with registration Nos. TMA800,002 and TMA799,706;
- (e) The Applicant is not the person entitled to registration of the Mark pursuant to sections 16(2)(b) and 16(3)(b) of the Act since at the date of filing it was confusing with the Opponent's application Nos. 1,294,265; 1,292,450; and 1,292,463; and
- (f) The Mark is not distinctive of the Applicant.

A chart setting out the trade-mark registrations relied upon by the Opponent is attached as Schedule A to this decision.

[5] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[6] The Opponent filed as its evidence the affidavit of William Boyer and a certified copy of each of its relied upon applications and registrations. The Applicant filed as its evidence the affidavit of Dane Penney.

[7] Both parties filed a written argument and were represented at a hearing held on April 28, 2014.

Material Dates and Onus

[8] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475] however, where an application is amended after filing, the wares and services as amended are to be considered when assessing the ground of opposition [*Ipex Inc v Royal Group Inc* (2009), 77 CPR (4th) 297 (TMOB) at para 34]

- sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];

- sections 38(2)(c)/16(2)(b) and 16(3)(b) of the Act – the date of filing of the application; and

- sections 38(2)(d) of the Act - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[9] Before considering each of the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an 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 an 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 an opponent with respect to a particular issue means that in order for the issue to be considered at all, 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 an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an 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.

Summary of the Evidence

Affidavit of William Boyer

[11] The Opponent's affiant William Boyer, a student-at-law employed by the Opponent's agent, attaches the text portion and two exhibits of the affidavit of Mitchell Rubinson filed in support of oppositions to six applications filed by Provent Holdings Ltd. (the Opponent in the subject opposition). The six applications have been opposed by Star Island (the Applicant in the subject opposition). The affidavit of Mr. Rubinson includes the following evidence (paragraph and exhibit references correspond to those in Mr. Rubinson's affidavit):

- Mr. Rubinson is the Managing Member of Star Island (para 1).

- Star Island opened the MANSION nightclub in Miami, Florida in February 2004 which attracts over 10,000 customers weekly from the United States, Canada and other countries (para 4).
- Since February 2004, Star Island has been providing reservation services in Canada on its website *www.mansionmiami.com* from which customers and potential customers can reserve tables and purchase tickets to special events at the MANSION night club (para 8).
- Star Island also does business under the name “The Opium Group” which has a website *www.theopiumgroup.com* which also features advertisements for the Mansion nightclub (paras 2-3;Exhibit H).
- Star Island’s website traffic data shows that tens of thousands of Internet users with a Canadian ISP address have accessed the website. Approximately 10% of reservation requests and inquiries made through the *www.mansionmiami.com* website since January 2009 derive from Canada (para 10).
- Since 2004, Star Island has taken reservations from more than 4000 customers with Canadian addresses (para 15).
- Exhibits E and H of Mr. Rubinson’s affidavit which consist of print-outs of the *www.mansionmiami.com* and *www.theopiumgroup.com* websites show that the M Design mark appears as follows (or in the reverse colours with the M and mansion being white on a black background).



[12] The Applicant submits that the evidence attached to Mr. Boyer's affidavit is hearsay. As the Opponent has challenged the Applicant's first use date, I consider it necessary for the Opponent to file such evidence and further, I find that the evidence is reliable since the Applicant, being a party, had an opportunity to address it [*Blistex Inc v Smiths Medical ASD, Inc*, 2012 TMOB 184].

Affidavit of Dane Penney

[13] The Applicant filed as its evidence the affidavit of Dane Penney, a trade-mark searcher employed by its agent who performed various trade-mark searches for the letter M alone or in combination with a design element. While Mr. Penney's search identified over 80 trade-marks, only five of these marks are for use with bar, restaurant, night club services or the like. As such, I do not consider the state of the Register evidence introduced by Mr. Penney to be of any persuasive value as insufficient relevant registrations were located to enable me to draw any inferences concerning the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

Analysis of the Grounds of Opposition

Section 30(b) Ground of Opposition

[14] The section 30(b) ground of opposition alleges that the Mark has not been used in Canada in association with the services "Reservation services for bars and night clubs." The Opponent alleges that it is not clear whether these services are available to Canadian consumers or that the Mark *per se* is used (rather the Opponent alleges that the Applicant uses the M MANSION Design set out below or a variant).



[15] Section 30(b) requires that there be continuous use of the applied-for trade-mark in the normal course of trade from the date claimed to the filing date of the application [*Benson & Hedges (Canada) Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD) at 262]. The requirements for use are set out in section 4 of the Act. With respect to services, a trade-mark is deemed to be used in association with services if it used or displayed in the performance and advertising of those services. The services do not necessarily have to have been performed or sold for there to have been use, so long as they are offered to prospective customers in association with the mark and the services are available to be performed [*Modis Inc v Modis Communications Inc.*; 2004 CarswellNat 4627 (TMOB) at para 24].

[16] The legal onus is on the Applicant to show that its application complies with section 30(b) of the Act. To meet its evidential burden, the Opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [*John Labatt Ltd, supra*]. The Opponent's burden is, however, lighter with respect to the issue of non-compliance with section 30(b) because the facts supporting use of the Mark are particularly within the knowledge of the Applicant [*Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89].

[17] There is no evidence from which an inference can be made that the Mark has not been used in Canada since 2004 in association with reservation services for bars and night clubs. Mr. Rubinson's affidavit (which was attached to Mr. Boyer's affidavit filed in this proceeding) provides the following:

- Para 8 Continuously, since February 2004, my company has been providing reservation services in Canada in association with the MANSION Marks on its website at *www.mansionmiami.com*, from which customers and potential customers can reserve tables and purchase tickets to special events at the MANSION nightclub
- Para 9 Attached hereto collectively as Exhibit E are additional printouts from my company's *www.mansionmiami.com* website showing how the MANSION Marks appear in connection with Star Island's reservation services. Although the various events referred to on the website change, these printouts are representative samples of the manner in which the MANSION Marks have appears on that website since February 2004.
- Para 12 My company also provides reservation services in connection with the MANSION Marks on its website accessible at *www.theopiumgroup*, from which customers and potential customers can reserve tickets to events at the MANSION nightclub and my company's other nightclubs. Attached ... as Exhibit H ... are ... printouts ... showing how the MANSION Marks have been displayed ... since December 2003.
- Para 15 Since 2004, my company has taken reservations for more than 4,000 Canadians (customers with Canadian addresses) in association with the MANSION Marks.

[18] Amongst the print-outs included in Exhibits E and H of Mr. Rubinson's affidavit (attached to Mr. Boyer's affidavit filed in this proceeding) are print-outs where there is a "buy now" button beside a concert listing for the "Yoshitoshi with Sharam and friends at Mansion" concert at Mansion, Miami Beach FL on Friday, March 11, 2011. On these printouts there is a space where consumers can choose the type of tickets they would like to purchase (General Admission, VIP table for 6, 8 or 10). These print-outs also show at least one instance of the Mark without the word MANSION but in reverse colours (M is white, background is black). I consider the use of this trade-mark to be use of the Mark [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. As the evidence fails to support an inference that the Applicant has not used the Mark in Canada

since 2004, the Opponent has not met its evidential burden and the section 30(b) ground of opposition is rejected.

Section 30(a) Ground of Opposition

[19] The services based on proposed use were described as “night, bar, restaurant services and entertainment, namely live musical concerts” when the application was filed. The Applicant subsequently amended these services to “night club, bar, restaurant services and entertainment, namely live musical concerts”. The section 30(a) ground of opposition alleges in part that “night services” does not constitute a statement in ordinary commercial terms. I am satisfied that the amendment to night club services successfully overcomes the Opponent's objection.

[20] The section 30(a) ground of opposition further alleges that “reservation services for bars and night clubs” does not constitute a service within section 30(a) of the Act since they are part of the Applicant's bar and night club services. I note that this ground of opposition may have been more appropriately pleaded under section 30(b). Nevertheless, as the Opponent's allegations were clear to the Applicant, I will consider it.

[21] In this case, the Applicant offers a service on its websites *www.mansionmiami.com* and *www.theopiumgroup.com* wherein a party can purchase tickets for a table of 6, 8 or 10 people (Exhibits E and H to the Rubinson affidavit). I consider that when a person does so they are effectively reserving a table at a particular concert on a particular night. I may refer to a dictionary to determine the meaning of words [*Molson Canada 2005 v Labatt Brewing Co/Brasserie Labatt Co* (2009), 72 CPR (4th) 269 at para 12]. The *www.dictionary.com* website defines “reservation” in part as “an arrangement to secure accommodations at a restaurant or hotel, on a boat or plane, etc.”

[22] The Opponent argues that the application does not comply with section 30(a) because the reservation services are ancillary to the Applicant's primary services of operating a bar and nightclub. The Act, however, makes no distinction between primary, incidental or ancillary services so long as the public is receiving a benefit from the service offered [*TSA Stores, Inc v Canada (Registrar of Trade-marks)* (2011), 91 CPR (4th) 324 at para 17 (FC)]. Further, services are generally granted a generous or broad interpretation [*Aird & Berlis LLP v Virgin Enterprises*

Ltd (2009), 78 CPR (4th) 306 (TMOB)] and statements of services may contain overlapping or redundant terms in the sense that the performance of one service necessarily implies the performance of another [*Gowling Lafleur Henderson LLP v Key Publishers Co*, 2010 CarswellNat 579 (TMOB) at para 15; *Sim & McBurney v Parts Now! LLC* 2012 TMOB 262 at para 12].

[23] Further the Canadian Trade-marks Office’s Wares and Services Manual includes a representative list of acceptable wares and services under section 30(a) of the Act. I have exercised my discretion to check it [*Johnson & Johnson v Integra Lifesciences Corp* (2011), 98 CPR (4th) 429 (TMOB)] and note that it includes a similar description “reservation of restaurants”.

[24] In this case, given the statement of services in the application and evidence in Mr. Rubinson’s affidavit, I find that the providing of reservation services for bars and night clubs provides a benefit for consumers and may be considered a separate service. Finally, the Registrar has previously found that a trade-mark is used with reservation and booking services where a customer makes a reservation in Canada for services outside Canada [*Mallis v Mirage Resorts, Incorporated*, 2012 TMOB 220; *Aird & Berliss LLP v Virgin Enterprises Ltd, supra* at para 33]. Accordingly, the Opponent has not met its burden and the section 30(a) ground is rejected.

Section 30(e) Ground of Opposition

[25] The Opponent opposes the services “night club, bar, restaurant services and entertainment, namely live musical concerts” on the basis that the Applicant does not have a *bona fide* intention to use the Mark in Canada. As there is no evidence that supports such an allegation, the section 30(e) ground is rejected on the basis that the Opponent has not satisfied its initial burden.

Section 12(1)(d) Ground of Opposition

[26] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent’s trade-mark registration Nos. TMA800,002 and

TMA799,706. I consider that the Opponent has the best chance of success in comparing the Mark with the Opponent's trade-mark registration No. TMA800,002 for M Design set out below (along with the most relevant services described therein).

Trade-mark



Wares and Services

... Providing casino facilities for gambling, namely live gambling and online gambling; Gambling services, namely the operation of a casino; Gambling services, namely live gambling and on-line gambling; Entertainment services, namely providing access to gaming machines; bingo hall services; Educational club services, namely providing [facilities] for movies, [shows], plays, music or educational training; ...

[27] 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 with respect to this ground.

[28] 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.

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. As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

Inherent Distinctiveness

[29] Neither mark has a high degree of inherent distinctiveness as each consists of a stylized letter M [*GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. Both parties' marks owe what small degree of inherent distinctiveness they do have to their stylizations [*General Motors Corp v Gunn & Moore Ltd* (1998), 84 CPR (3d) 114 (TMOB) at para 13].

Degree of Resemblance Between the Trade-marks

[30] There is a low degree of resemblance between the Mark and the Opponent's M Design trade-mark. Insofar as there is visual similarity, it solely resides in the use of the letter M by each party as there are significant differences in the stylization of the marks [*Anamet, Inc v Acklands Ltd.* (1996), 67 CPR (3d) 478 (FCTD) at 483-484; *Cerruti 1881 SA v Conte of Florence SPA* (1990), 34 CPR (3d) 452 (TMOB) at 456]. Because the letter "M" is common to both marks, they resemble each other as sounded, and there is overlap in the ideas suggested by each, namely the letter "M". However, in the absence of evidence of extensive use, the importance of the idea or sound of the letter M is greatly reduced because of the lack of distinctiveness of this component.

[31] At the hearing and in its written argument, the Opponent argued that the degree of resemblance was significant because the idea suggested by each party's mark is MANSION. The test of confusion is from the viewpoint of an ordinary Canadian consumer and the evidence in this proceeding is not sufficient to demonstrate that the ordinary Canadian consumer upon seeing the Mark would think of the word MANSION.

Extent Known and Length of Time in Use

[32] This factor slightly favours the Applicant. While declarations of use have been filed with respect to the Opponent's registrations, this only entitles me to assume de minimis use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. De minimis use does not support a conclusion that a mark has become known to any significant extent, nor that it has been used continuously since the date stated.

[33] The evidence suggests that the Mark has been used in association with reservation services. Since 2004, the Applicant has taken reservations for more than 4000 customers with Canadian addresses (para 15 of Mr. Rubinson's affidavit attached to Mr. Boyer's affidavit) and since January 2009 10% of on-line reservations and inquiries are from Canada (para 10) suggesting that the Mark is known to at least these consumers in Canada.

Nature of the Wares, Services and Trade

[34] This factor very slightly favours the Opponent. Although the nature of the services of the parties differs, the services described as "entertainment, namely live musical concerts" and "Educational club services, namely providing [facilities] for movies, [shows], plays, music" may both relate to the provision of live music albeit for different purposes (entertainment vs educational). While the remaining services also fall under the umbrella of hospitality services, I do not consider this sufficient to form the basis for overlap in the nature of the services since hospitality services are very broad and encompass many different and distinct services.

Surrounding Circumstance: Use of the Mark in association with the Mansion Night Club

[35] The fact that the Mark is used in association with a night club named MANSION in the United States and appears with the MANSION trade-mark on the *www.mansionmiami.com* website is not a surrounding circumstance which leads to an increase in the likelihood of confusion. It is the effect of the Mark itself that must be considered, not of other indicia that may appear together with the mark since the other indicia is not part of the mark [see *PEI Licensing Inc v Disney Online Studios Canada Inc*, 2012 TMOB 49 at para 26; see also *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 11 (FCA) where the Court

held that appearances of the marks as actually used are irrelevant considerations for the issue of confusion].




Conclusion

[36] While the trade-marks must be assessed in their entirety, it is still possible to focus on particular features that may be a determinative influence on the public's perception [see *Pink Panther Beauty Corp v United Pictures Corp* (1998), 80 CPR (3d) 247 (FCA) at para 34; *Masterpiece, supra* at para 64]. In the case of weak letter marks, differences in design features may suffice to distinguish one mark from the other [*Cerruti 1881 SA v Conte of Florence SPA, supra*]. Given the lack of acquired distinctiveness of the trade-marks, even though the Mark and the Opponent's registrations all cover hospitality services, I am satisfied that the very different stylizations of each mark means that confusion between the marks as a whole is not likely. As such, this ground of opposition is rejected.

Section 16(2) and 16(3) Grounds of Opposition

[37] The Opponent alleges that the Applicant is not the person entitled to registration of the Mark in association with Services (2) and Services (3), pursuant to sections 16(2)(b) and 16(3)(b), since at the date of filing it was confusing with the Opponent's application Nos. 1,294,265; 1,292,450; and 1,292,463. The material date is the filing date of the subject application, October 27, 2008. I have assessed confusion with respect to the wares and services as of the material date [*Starbucks (HK) Limited v Rogers Broadcasting Limited*, 2013 TMOB 114 at paras 18-23] having exercised my discretion to check the Registrar's records [*Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB) at 529]. If I had not exercised my discretion in this matter, it would not have effected the outcome of this ground of opposition. The outcome would have been the same whether I assessed the wares and services shown in the certified copies of the Opponent's applications or as they appeared at the material date.

[38] The particulars of the Opponent's applications along with the most relevant services (the Opponent's Hospitality Services") as of October 27, 2008 are set out below.

| | |
|--|--|
| <p>1,292,450</p>  | <p>Educational club services, namely providing facilities for movies, shows, plays, music or educational training; ... night clubs; entertainment night club services;...provision of entertainment facilities, namely providing facilities for movies, shows, plays or music;... management of entertainment services, namely management of nightclubs, live music venues for entertainment, entertainers, restaurants... Club [dining] facilities (provision of -); club services for the provision of food and drink; ... night club services [provision of food]; ... cocktail lounge services; bar services; restaurant services incorporating licensed bar facilities...</p> |
| <p>1,292,463</p>  | <p>Educational club services, namely providing facilities for movies, shows, plays, music or educational training; ... night clubs; entertainment night club services;...provision of entertainment facilities, namely providing facilities for movies, shows, plays or music;... management of entertainment services, namely management of nightclubs, live music venues for entertainment, entertainers, restaurants... Club [dining] facilities (provision of -); club services for the provision of food and drink; ... night club services [provision of food]; ... cocktail lounge services; bar services; restaurant services incorporating licensed bar facilities...</p> |
| <p>1,294,265</p>  | <p>Entertainment services, namely providing access to gaming machines; bingo hall services; Educational club services, namely providing facilities for movies, shows, plays, music or educational training; ... night clubs; night club services;...provision of entertainment facilities, namely providing facilities for movies, shows, plays or music;... management of entertainment services, namely management of nightclubs, live music venues for entertainment, entertainers, restaurants... Club [dining] facilities (provision of -); club services for the provision of food and drink; ... night club services [provision of food]; ... cocktail lounge services; bar services; restaurant services incorporating licensed bar facilities...</p> |

[39] I reach the same conclusion with respect to lack of confusion with respect to application No. 1,294,265 as in the section 12(1)(d) ground. The fact that the services are the same is not sufficient for a likelihood of confusion given the lack of inherent distinctiveness and acquired distinctiveness of the Opponent's trade-mark and the low degree of visual resemblance between

the trade-marks. As such, the section 16(2)(b) and 16(3)(b) grounds of opposition are rejected with respect to application No. 1,294,265.

[40] I will now consider whether there is a likelihood of confusion with application Nos. 1,292,450 for the trade-mark M Design and MANSION.COM and 1,292,463 for M Design and MANSIONPOKER.COM.

Inherent Distinctiveness

[41] The Opponent's trade-marks M Design and MANSION.COM and M Design and MANSIONPOKER.COM have a higher degree of inherent distinctiveness than the Opponent's M Design mark since there is no clear direct meaning of the word Mansion when used in association with the Opponent's Hospitality Services. As explained above, with respect to the section 12(1)(d) ground, the Mark does not have a high degree of inherent distinctiveness as it consists primarily of a stylized version of the letter M.

Degree of Resemblance

[42] As discussed with respect to the section 12(1)(d) ground of opposition, the most striking feature of the Mark is its stylization. The most striking portion of the Opponent's marks is the word components MANSION and MANSIONPOKER.COM due to the prominence of these components in the Opponent's marks. I find that the parties' marks look different, sound different and suggest different ideas to consumers (the letter M for the Mark vs mansion for the Opponent's trade-marks: M Design and MANSION.COM and M Design and MANSIONPOKER.COM) In particular, I note that there is no evidence of record to suggest that the ordinary Canadian consumer would understand the Mark to suggest the word MANSION.

Extent Known and Length of Time in Use

[43] These factors slightly favour the Applicant as its evidence suggests that the Mark may be known to some Canadians who have made a reservation with the Applicant's nightclub in Miami, Florida. In contrast, there is no evidence that there has been any use of the Opponent's

trade-marks M Design and MANSION.COM or M Design and MANSIONPOKER.COM, nor that these trade-marks are known to any extent.

Nature of the Wares, Services and Trade

[44] This factor favours the Opponent, as some of the Opponent's Hospitality Services are identical or almost identical to the Applicant's Services (2) and Services (3).

Conclusion

[45] It has previously been held that confusion will be unlikely in situations where marks share common features but also feature dominant differences [*Chalet Bar-B-Q (Canada) Inc v Foodcorp Ltd* (1982), 66 CPR (2d) 56 (FCA) at 73]. In this case, the use of the word MANSION in the Opponent's trade-marks is such a dominant difference. As such, there is no reasonable likelihood of confusion between the Mark with respect to Services (2) and Services (3) and the Opponent's trade-mark which is the subject of application Nos. 1,292,450 and 1,292,463. The sections 16(2)(b) and 16(3)(b) grounds of opposition based on these applications are therefore rejected.

Distinctiveness


[46] The section 2 ground of opposition is rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its trade-marks were used or known in Canada as of the applicable material date. Although the Opponent's registrations for its trade-marks refer to use, that is not sufficient for the Opponent to meet its burden for this grounds of opposition [*Roosx, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].


Disposition

[47] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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

Schedule A

| <p>Application and/or Registration No.</p> <p>Trade-marks</p> | <p>Wares and Services</p> |
|---|---|
| <p>1,294,265 TMA800,002</p>  | <p><u>WARES:</u></p> <p>(1) Electronic publications, namely newspapers and on-line journals featuring information on sports, gambling, and entertainment matters provided online from databases or via the Internet and electronic mail; Interactive computer systems, namely software for interactive data processing of statistics and odds in the field of sports, gambling and games; computers having interactive data processing system function; Compact discs, namely pre-recorded compact discs containing movies, music, video games, computer games and instructional video on poker games.</p> <p>(2) Roulette chips; poker chips; gaming equipment, namely poker chips, tokens.</p> <p><u>SERVICES:</u></p> <p>(1) Compilation of advertisements for use on the internet, namely on-line advertising of the wares and services of others; Marketing, advertising and promotional services, namely promoting wares and services of others via print and broadcast media, posters, and the internet; arranging and conducting promotional events namely social events and contests for others</p> <p>(2) Transmission of information, namely messages, images, and information pertaining to sporting events, gaming namely gambling, and betting information namely odds, dividend and results, commentaries and reports, over a global computer network, namely the internet; Providing on-line communications links which transfer the website user to other local and global web pages; providing voice communication services via the Internet; Providing multiple user access to a global computer information network and the Internet.</p> <p>(3) Providing casino facilities for gambling, namely live gambling and online gambling; Gambling services, namely the operation of a casino; Gambling services, namely live gambling and on-line gambling; Entertainment services, namely providing access to gaming machines; bingo hall services; Educational club services, namely providing facilities for movies, showw, plays, music or educational training; Providing access to non-downloadable online publications relating to the field of sports and</p> |

| | |
|---|--|
| | <p>entertainment, namely music, movies, computer games, gambling and on-line gambling; Electronic games services, namely providing access to electronic games by means of the internet; Providing access to non-downloadable internet games; Provision of online gambling and betting services transmitted over a global computer network, namely the internet; casino services; Providing information on the field of gambling via a global computer network, namely the Internet; organising and conducting lotteries; Credit card betting services, namely, on-line gambling using a credit card to secure the funds; Organization of poker tournaments.</p> |
| <p>1,292,463 TMA799,706</p> <p> MANSIONPOKER.COM</p> | <p><u>WARES:</u></p> <p>(1) Electronic publications, namely newspapers and on-line journals featuring information on sports, gambling, and entertainment matters provided online from databases or via the Internet and electronic mail; Interactive computer systems, namely software for interactive data processing of statistics and odds in the field of sports, gambling and games; computers having interactive data processing system function; Compact discs, namely pre-recorded compact discs containing movies, music, video games, computer games and instructional video on poker games.</p> <p>(2) Counters in the form of discs for playing roulette and poker games; roulette chips; poker chips; gaming equipment, namely poker chips, tokens.</p> <p><u>SERVICES:</u></p> <p>(1) Compilation of advertisements for use on the internet, namely on-line advertising of the wares and services of others; Marketing, advertising and promotional services, namely promoting wares and services of others via print and broadcast media, posters, and the internet; arranging and conducting promotional events namely social events and contests for others.</p> <p>(2) Transmission of information, namely messages, images, and information pertaining to sporting events, gaming namely gambling, and betting information namely odds, dividend and results, commentaries and reports, over a global computer network, namely the internet; Providing on-line communications links which transfer the website user to other local and global web pages; providing voice communications services via the Internet; Providing multiple user access to a global computer information network and the Internet.</p> <p>(3) Providing casino facilities for gambling, namely live gambling and online gambling; Gambling services, namely the operation of a casino; Gambling services, namely live gambling and on-line gambling; Entertainment services, namely providing access to</p> |

| | |
|--|---|
| | <p>gaming machines; bingo hall services; Educational club services, namely providing facilities for movies, shows, plays, music or educational training; Facilities for playing card games; Providing access to non-downloadable online publications relating to the field of sports and entertainment, namely music, movies, computer games, gambling, and on-line gambling; Electronic games services, namely providing access to electronic games by means of the internet; providing access to non-downloadable internet games; Provision of online gambling and betting services transmitted over a global computer network, namely the internet; Providing information on the field of gambling via a global computer network, namely the Internet; organising and conducting lotteries; Credit card betting services, namely, on-line gambling using a credit card to secure the funds; Organization of poker tournaments.</p> |
|--|---|