IN THE MATTER OF AN OPPOSITION by Discovery Communications, Inc. to application No. 764,522 for the trade-mark LEARNING AND SKILLS TELEVISION OF ALBERTA filed by CHUM Limited

On September 27, 1994, the applicant, CHUM Limited, filed an application to register the trade-mark LEARNING AND SKILLS TELEVISION OF ALBERTA based on proposed use in Canada for the following wares:

> keychains, purse size mirrors, balloons, plastic shopping bags, canvas shopping bags, pens, magnetic memo boards, umbrellas, aprons, lighters, beach balls, visors, flying discs, keepmates, namely plastic carrying containers for wearing around the neck, beach towels, mugs, ballcaps, hat visors, t-shirts, sweatshirts, turtle necks, sweaters, jackets, music casettes, rulers, clocks, calculators, lapel pins, novelty buttons, stickers, postcards, banners, ice scrapers, oven mitts, infant sleepers, letter openers, beach mats, record keeping kits, namely monthly fillers and record forms

and for the following services:

> producing, broadcasting, recording and marketing of television programs and informing and entertainment through the medium of television; entertainment services, namely the development, production, broadcast and distribution of television programs.

The application was amended to include a disclaimer to the words TELEVISION OF ALBERTA and was subsequently advertised for opposition purposes on May 17, 1995.

The opponent, Discovery Communications, Inc., filed a statement of opposition on October 17, 1995, a copy of which was forwarded to the applicant on November 20, 1995. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark THE LEARNING CHANNEL registered under No. 416,825 for "broadcasting and television entertainment services." The second ground is that the applicant is not the person entitled to registration of the applied for mark pursuant to Section 16(3)(a) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark THE LEARNING CHANNEL previously used and made known in Canada by the opponent and/or its controlled licensees. The third ground is one of prior entitlement pursuant to Section 16(3)(c) of the Act based on prior use of the opponent's trade-name The Learning Channel.

The fourth ground of opposition is that the applied for trade-mark is not distinctive in view of the opponent's use of its trade-mark and trade-name. The fifth ground is that the applicant's application does not conform to the requirements of Section 30(i) of the Trade-marks Act because the applicant could not have been satisfied that it was entitled to use its applied for mark.

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of William Goodwyn and Laura M. Chapman. As its evidence, the applicant submitted the affidavits of Peter Palframan and Petra J. McDonald. Both parties filed a written argument but no oral hearing was conducted.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the opponent's trade-mark is highly suggestive, if not descriptive, of the nature of the opponent's registered services. The trade-mark THE LEARNING CHANNEL suggests a television broadcast service that provides educational programming. Thus, the opponent's mark is inherently weak.

The opponent's evidence establishes that the opponent has operated a cable network in Canada in association with the trade-mark THE LEARNING CHANNEL since 1984. In his affidavit, Mr. Goodwyn states that the number of subscribers to the opponent's service has increased to over 4.5 million households in 1996. However, Mr. Goodwyn did not provide any figures as to the viewership of the opponent's network. Nevertheless, given the large number

of subscribers, it is reasonable to assume that a large number of Canadians are aware of the opponent's registered mark. Thus, I am able to conclude that the opponent's mark has become well known in Canada.

The applicant's mark is highly suggestive, if not descriptive, of its applied for services and is therefore inherently weak. It is not suggestive of the applied for wares although it would appear that those wares are simply promotional items used in conjunction with the applicant's services.

The applicant claims that its applied for trade-mark has become well known throughout Alberta but the evidence does not support that conclusion. The applicant operates an educational television service under the trade-mark ACCESS - THE EDUCATION STATION in Alberta through its licensee Learning & Skills Television of Alberta Limited. Prior to 1995, the service was provided under the trade-mark ACCESS NETWORK by an Alberta crown corporation. Although the evidence shows fairly extensive use of the trade-mark ACCESS, there is no evidence of any use of the applied for mark and only minimal use of the trade-name of the applicant's licensee. Thus, the applicant's mark has not become known to any extent in Canada.

The length of time the marks have been in use favors the opponent. As for the wares, services and trades of the parties, it is the applicant's statement of wares and services and the opponent's statement of services in registration No. 416,825 that govern: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.). However, those statements must be read with a view to determining the probable type of business or trade intended by the applicant rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).

The applicant sought to distinguish the services of the parties on the basis that its programming is strictly educational in nature whereas the opponent's programming is more in the nature of entertainment. However, as noted, it is the statements of services that govern. In the present case, the applied for services and the opponent's registered services are very similar. The applicant's wares differ from the opponent's services although, as noted, those wares appear to be more in the nature of promotional items.

As for Section 6(5)(e) of the Act, I find that there is little resemblance between the marks at issue either visually or phonetically. The only similarity is the common use of the word LEARNING which is descriptive in the context of educational television services and cannot be monopolized by any one trader. There is some similarity in the ideas suggested by both marks since they both suggest educational television. Again, however, that is not an idea that can be appropriated by only one trader.

The applicant contended that the state of the register as evidenced by the McDonald affidavit is a relevant surrounding circumstance in the present case. However, Ms. McDonald's search revealed only three third party trade-marks including the word LEARNING registered for telecommunications-related services. In the absence of evidence of active use of those marks, I am not prepared to infer that there has been common adoption of the word LEARNING as part of trade-marks in the industry.

Ms. McDonald also states that she located 106 "records" containing the word LEARNING for education or entertainment services. However, Ms. McDonald did not provide any details of those records and thus I can give little weight to her findings. At most, I can conclude that it is not uncommon for traders to adopt the word LEARNING as a portion of trade-marks in general. But I am unable to make a similar finding respecting the particular industry populated by the applicant and the opponent.

The applicant also contended that the absence of incidents of actual confusion between the marks at issue should weigh in its favor. However, it is not clear from the evidence that

the marks at issue have even been used contemporaneously in the same geographic area. More importantly, there is no evidence of any use of the applied for mark in Canada and only minimal evidence of use of the trade-name of the applicant's licensee. Thus, the absence of actual confusion would not be surprising or noteworthy.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the inherent weakness of both marks and the low degree of resemblance, I find that the applicant's mark is not confusing with the opponent's registered mark notwithstanding the overlap in the parties' services and the reputation that the opponent's mark has acquired to date. Thus, the first ground of opposition is unsuccessful.

As for the second ground of opposition, the opponent has not evidenced prior making known of its trade-mark THE LEARNING CHANNEL but it has evidenced prior use of that mark and non-abandonment of the mark as of the applicant's advertisement date. Thus, the second ground remains to be decided on the issue of confusion as of the applicant's filing date of September 27, 1994. My conclusions above respecting the first ground are equally applicable for the second ground. Thus, I find that the marks at issue are not confusing as of the applicant's filing date and the second ground is also unsuccessful.

The third ground turns on the issue of confusion between the applied for mark and the opponent's previously used trade-name The Learning Channel. My conclusions respecting the first ground are also applicable here. Thus, the third ground is also unsuccessful.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - October 17, 1995): see Re 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) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

The fourth ground essentially turns on the issue of confusion between the applicant's mark and the opponent's trade-mark. Given my conclusions above respecting the issue of confusion for the first ground, it also follows that the applicant's mark is not confusing with the opponent's mark as of the filing of the present opposition. Thus, the fourth ground is also unsuccessful.

As for the fifth ground of opposition, it does not raise a proper ground since the opponent did not allege that its mark was confusing with the applicant's mark or that the applicant was aware of such confusion. Thus, the fifth ground is unsuccessful. If I am wrong in this conclusion, the success or failure of the fifth ground would have been contingent on a finding of confusion between the marks at issue and would therefore have been unsuccessful, in any event.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 20th DAY OF OCTOBER, 1998.

David J. Martin,
Member,
Trade Marks Opposition Board.