



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

Citation: 2010 TMOB 209
Date of Decision: 2010-11-30

**IN THE MATTER OF AN OPPOSITION
by Executors of the Estate of Francisco
Coll Monge (Estate), Francisco David
Coll Executor, a Puerto Rico Estate, to
application Nos. 1,257,129 for the trade-
mark INNER PEACE MOVEMENT OF
CANADA in the name of Inner Peace
Movement of Canada Limited.**

[1] On May 10, 2005 Inner Peace Movement of Canada Limited (the Applicant) filed an application to register the trade-mark INNER PEACE MOVEMENT OF CANADA 1,257,129 (the Mark) based on use of the Mark in Canada since at least as early as September 27, 1977 on wares and January 1976 on services.

Wares: Pre-recorded CDs, audio tapes and video tapes featuring religious teachings, leadership, spiritual guidance, healing, counselling, prayer and meditation; printed instructional, educational and teaching materials namely, course materials and instructor notes, work books, group study books, monthly newsletters and magazines, promotional flyers, registration and order forms, brochures, and posters featuring religious teachings, leadership, spiritual guidance, healing, counselling, prayer and meditation.

Services: Providing religious teachings, leadership, spiritual guidance, healing, counselling, prayer and meditation; training services namely training in the practices of the church; fellowship and leadership services related to religious teachings, spiritual

guidance, healing, counselling, prayer and meditation, church services; live musical performances.

[2] The application was advertised for opposition purposes in the Trade-marks Journal of February 15, 2006. A statement of opposition was filed on May 14, 2006 by Executors of the Estate of Francisco Coll Monge, Francisco David Coll Executor, a Puerto Rico Estate (the Opponent). The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[3] The Opponent filed the affidavits of Victoria Shrieves, Francisco David Coll, Maria Coll, and Janet Hill. The Applicant filed the affidavit of Reta Bunbury. Both parties filed written arguments; an oral hearing was not held.

[4] At the outset it must be noted that the Applicant objected in its written argument to the lack of clarity in the statement of opposition and asserted that no valid ground of opposition was raised and that the statement of opposition did not set out the grounds of opposition in sufficient detail to enable to the Applicant to reply. I agree with the Applicant that the grounds of opposition are not clearly delineated; the facts are somewhat confusing and often mixed with opinion, personal comments and conjecture. On balance however, I find that the statement of opposition does raise some valid grounds of opposition, albeit in a somewhat confusing manner. I would add that the written argument stage is not the appropriate stage to first raise the issue of valid grounds of opposition, particularly where evidence has been filed by both parties.

[5] The statement of opposition appears to raise grounds of non-entitlement pursuant to s.16(1)(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), based on confusion with the trade-mark INNER PEACE MOVEMENT used or made known in Canada by the Opponent and/or others prior to Applicant's claimed date of first use. The essential facts supporting the pleading are as follows (as summarized):

Use of the Mark by the Applicant will cause confusion unless the Applicant cooperates with the Opponent and other licensees in Canada. A similar mark INNER PEACE MOVEMENT was made known in Canada on or before December 1979 by Dr. Francisco Coll or under his direction and control.

[6] The Opponent also pleaded that the Mark is not distinctive in view of the fact that it is based on a similar trade-mark that has been used in Canada since at least 1972.

Summary of the Opponent's Evidence

Affidavit of Victoria Shrieves

[7] Ms. Shrieves identifies herself as one of the Directors and the Vice President of Americana Leadership College (ALC Canada). Since 1972 she has been involved in numerous Inner Peace Movement sponsored programs, in Canada, the United States and Puerto Rico. The affiant states that she was a director and a board member of the Inner Peace Movement in the 1980's. It appears from the context of the affidavit as a whole that the reference in this case to Inner Peace Movement is to the U.S. non-profit organization.

[8] The evidence of Ms. Shrieves relates to the history of the Opponent, the relationships between organizations in the United States all founded and directed by Dr. Coll Monge (known as Dr. Coll), the establishment of an organization(s) in Canada, the death of the founder, and the division between some United States organizations and the Estate of Dr. Coll (the Opponent); and the division between the Opponent and the Applicant. Much of the evidence relating to recent history has not been summarized, as it is irrelevant to the determinations that will be made in view of the fact that the primary grounds of opposition are founded on the state of affairs at the claimed dates of first use of the application, namely September 27, 1979 on the wares and January 1976 on the services.

[9] The Opponent is the Estate of the founder (Dr. Coll) of a spiritual movement and related group of organizations, including both not-for-profit and business corporations in the United States. The relevant United States not-for-profit organization is the Inner Peace Movement (IPM) founded in January 1964.

[10] The U. S. corporation, American Leadership College, Inc. (ALC Inc.) is a business corporation founded in 1967 by Dr. Coll, in part to license, distribute and oversee the workshops/programs and related program materials delivered under various trade-marks including INNER PEACE MOVEMENT, and created by Dr. Coll in furtherance of his spiritual

movement. The affiant explains that ALC Inc. became the umbrella and director of all the other organizations that had been founded by Dr. Coll, including the Inner Peace Movement (IPM) whose headquarters were in Washington D.C.

[11] Ms. Shrieves explains that IPM expanded and set up offices across the United States as well as in selected countries. The branch and national offices were all directed ultimately by ALC Inc., under the direction of Dr. Coll. In January 1976 ALC Inc. authorized the opening of its Canadian branch which was incorporated on January 8, 1976 as a non-profit corporation called the Inner Peace Movement of Canada, (IPM Canada). Among the directors of the first corporation were Dr. Coll, and the affiant for the Applicant, Reta Bunbury. I note that this Canadian not-for-profit corporation is not identified as Inner Peace Movement of Canada *Limited* (the named Applicant of the subject application).

[12] It appears that IPM Canada was the sole office in Canada, and all materials, training aids, policies, directions, guidance and staffing were received from or directed by the Washington D.C. headquarters. Ms. Shrieves provides that IPM Canada members and directors regularly attended conferences, seminars and other programs throughout the world especially in Canada and the United States. All these programs were directed and organized by ALC and IPM in the United States.

[13] In September 1996 the affiant, Ms. Shrieves met with two other Canadian leaders and Dr. Coll to discuss setting up a mini office for IPM in Calgary, Alberta. Further to a subsequent meeting in November 1996, Dr. Coll directed that IPM Alberta work with and report to IPM Canada. The affiant was a staff member of IPM Alberta until it ceased to do business with IPM Canada in April, 2000.

[14] Subsequent to Dr. Coll's death, IPM Canada was advised by telephone in April 2000 and finally by correspondence that IPM Canada was deviating from the procedures and guidelines of ALC; it was informed that ALC revoked the licence of IPM Canada to deal with any of the programs, materials, logos and names, founded by Dr. Coll.

[15] On June 30, 2000 (IPM Alberta became ALC Canada) and was incorporated under the Canada Business Corporations Act, the sole shareholder being Francisco David Coll, heir to the Estate of Dr. Coll.

[16] Ms. Shrieves provides evidence that ALC Canada was given permission by ALC in the United States, by letter dated June 29, 2000 to use its trade-marks. By letter dated September 30, 2000, from Alley, ALC Canada was given permission to use the copyrighted course materials. It seems apparent from this evidence that concurrent use began in Canada of programs and courses based on Dr. Coll's spiritual teachings.

[17] Ms. Shrieves states that IPM Canada, its directors and members were sent numerous cease and desist letters from the Estate of Francisco Coll, ALC and Alley requesting them to cease and desist the use of copyrighted materials including related names, logos and program materials.

[18] On September 26, 2000, IPM Canada filed a Statement of Claim against ALC Canada in the Court of Queen's Bench of Alberta, claiming among other things, that IPM Canada was the rightful owner of certain trade marks and trade names in Canada including the Mark. It appears that Ms. Shrieves in her capacity as a Director of ALC Canada attended the cross-examination of Ms. Susan Scott, President and a Director of IPM Canada on her affidavit with respect to this court action. Excerpts of the official transcript are attached as Exhibit H. Ms. Shrieves points out that under cross-examination Ms Scott stated that the course materials were numbered and created by Alley Incorporated in the United States, and that royalties are paid to Alley when the materials are used. Attached as Exhibit J are the financial statements provided by Ms. Scott for IPM Canada as of June 30, 1999, showing that IPM Canada owed Alley \$85,449.83 for merchandise purchased from Alley and \$93,362.94 for "course royalties".

The Affidavit of Janet Hill

[19] The affidavit of Janet Hill is a personal history of her involvement with the Inner Peace Movement in Canada since 1974. She provides information regarding her experiences, her knowledge of the source of the course materials and the relationship of IPM Canada to ALC. The

affidavit is largely commentary making personal observations that are irrelevant to the issues at hand.

The Affidavit of Francisco David Coll

[20] Mr. Francisco David Coll (D. Coll) states that his father passed away on December 15, 1999 in San Juan, Puerto Rico, and that he is the legal Executor and Administrator and sole heir of the Estate of Dr. Francisco Coll. Attached as Exhibits in this regard are documents from Puerto Rico, which appear to be government rulings to this effect. No information is provided as to Mr. D. Coll's status in other jurisdictions. Although there is some suggestion that the estate of Dr. Coll was disputed by IPM and related organizations in the United States and/or in Puerto Rico, I note that in this proceeding, the Opponent's status is not in issue.

[21] Mr. D. Coll states that his father was a leader in personal development and spiritual awareness and growth. In his 50 plus years of service he created and founded, worldwide, over ten spiritual movements, 8 non profit corporations, 11 or more profit corporations, 17 registered trademarks (USPTO), over 60 common law trade-marks over 700 registered copyrights and many conference Centers around the world, including the one in Pugwash, Nova Scotia.

[22] Mr. D. Coll further states that INNER PEACE MOVEMENT was used worldwide and in Canada prior to any use by the Applicant.

[23] Attached as Exhibit E-4 (but not referenced in the affidavit) is a 1990 summer camp catalogue listing programs presented by the ALC Inc. The trade-mark IPM Inner Peace Movement also appears on the front page. The brochure advertises a summer camp program to be delivered at 5 conference centers, including one in Canada in Pugwash, Nova Scotia. Inside the brochure there are a number of programs or "camps" listed as taking place in Pugwash, including one seven day camp called Inner Peace Movement Camp. I note that this brochure is dated subsequent to the claimed dates of first use by the Applicant.

The Affidavit of Maria Coll

[24] Maria Coll states that she is one of the founding directors of the Inner Peace Movement in the U.S. Her affidavit essentially confirms the history of these organizations,

adding that lecture tours sponsored by Inner Peace Movement started in Canada between 1969 and 1971.

[25] Exhibit MC-5 is a 1977 ALC Camp catalogue showing promotion of multiple Inner Peace Movement summer camps and retreats in the United States and including camps at three separate locations in Canada.

Summary of the Applicant's Evidence

The Affidavit of Reta Bunbury

[26] The affidavit of Ms. Bunbury sets out the organizational history of the Inner Peace Movement of Canada Limited (IPM Canada) since its incorporation in 1976; she has been Office Administrator for IPM Canada since incorporation.

[27] Exhibit A is a copy of an entry on the Corporations Canada database, demonstrating that the Inner Peace Movement of Canada was incorporated on January 8, 1976, under the Canada Corporations Act – Part II. I observe that the corporation is identified without any legal element such as “Limited or “Ltd.” The Applicant’s affidavit does not offer an explanation for this.

[28] The affiant states that the Mark was first adopted and used in 1976 in association with church services and programs and in 1979 in association with materials (the wares) to supplement such programs. Exhibit B is a spreadsheet from IPM Canada’s records showing its income from the 1976/1977 financial year to the 2006/2007 financial year.

[29] Once IPM Canada began operations it created its business stationary; Exhibit C is an example of envelopes and letterheads bearing the Mark used by IMP Canada. IPM Canada has, since its inception, continuously conducted lectures as part of its services, annual attendance statistics for years between 1984 and 2007 are provided. Exhibit F comprises sample registration promotional brochures bearing the Mark, as well as program and group enrolment sheets, all bearing the Mark.

[30] Ms. Bunbury, states clearly that at all relevant times Dr. Coll knew that IPM Canada was using the Mark; both the affiant and Dr. Coll were listed as directors for IPM Canada on the Annual Summaries as filed with Industry Canada (Exhibit H). She provides that Dr. Coll was involved in running IPM Canada, minutes of a Meeting of the Board of Directors of IPM Canada are attached which evidence his involvement in the decision making process of the organization (Exhibit I).

[31] On November 20, 2001 IPM Canada was awarded an Interlocutory Injunction by the Court of Queen's Bench of Alberta against the American Leadership College (ALC Canada) restraining the Defendant's from *inter alia* using the Mark; Exhibit J is a copy of the decision rendered. I note that the ruling is brief, and the facts upon which the decision was made are not apparent. I also observe that the Applicant named in that Court Action is Inner Peace Movement of Canada (i.e. without the addition of any legal element such as "Limited" or "Ltd."). No other information has been provided concerning this case.

Analysis of the Grounds of Opposition

Non- Entitlement and Section 16(1)(a)) of the Act

[32] The material date for a determination under s. 38(2)(c) and s. 16(1)(a) is the claimed date(s) of first use, namely, September 27, 1977 on wares and January 1976 on services [see s. 16(1)]. In accordance with s. 16(1), as a preliminary matter, the applicant must establish that he or his predecessor in title has used the Mark (or made it known) in Canada at the claimed date of first use; if so, the applicant is entitled to secure registration if it is not confusing with, (in this case) a trade-mark that had been previously used or made known in Canada [s. 16(1)(a)].

[33] In my view, it appears that IPM Canada started in Canada in the 1976 as part of Dr. Coll's family of organizations, using trade-marks, trade-names and course materials under a verbal licence from ALC Inc. (including the Mark with or without the portion "of Canada") as controlled and directed by the sole shareholder Dr. Coll. The evidence demonstrates that the Mark was first used in Canada by the entity referred to as IPM Canada pursuant to the verbal agreement with ALC Inc. and Dr. Coll, sole shareholder of said corporation. IPM Canada was created as part of the overall group of organizations controlled by Dr. Coll to provide religious

and spiritual services and related materials in accordance with his teachings. This evidence is not disputed by the Applicant. On the facts as presented in this proceeding, it appears that use was commenced of INNER PEACE MOVEMENT and/or INNER PEACE MOVEMENT OF CANADA at the time of its incorporation as a not-for-profit entity, pursuant to a verbal license and under the control of Dr. Coll either directly or indirectly through ALC Inc.

[34] Accordingly, and pursuant to s. 50(1) of the Act, since use at the material dates accrues to the licensor and not the Applicant, I find that the Applicant is prevented from relying on such use to claim entitlement to registration of the Mark pursuant to s.16 (1)(a) of the Act.

[35] There is some authority for the principle that when the Opponent successfully negates the Applicant's date of first use, the material date for the determination of entitlement may become the filing date under s. 16(3)(a), namely May 10, 2005 [see *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 6 C.P.R. (2d) 278 (T.M.O.B.); *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)].

[36] Even if one proceeds to an analysis under s. 16(3)(a), the Applicant as identified in the application is not entitled to registration of the Mark since it is evident that use of the identical Mark on identical services (and related wares) was commenced in Canada, was ongoing at the date of filing and the date of advertisement, by a person (or persons) that was not the Applicant as identified in the application. As noted above in the evidence, none of the services or related materials provided under the Mark, as shown in Program/Camp brochures, publicity brochures, or described by the affiants, are shown to be provided by the named Applicant. Nor does any correspondence with Corporations Canada refer to the Applicant - Inner Peace Movement of Canada *Limited*. Therefore it must be concluded that the Applicant as named in the application is not entitled to registration of the Mark at the date of filing of the application since it was confusing under s. 6(5) with the same Mark already in use by others.

[37] In this regard I have taken judicial notice of the *Canada Corporations Act, Part 11* (1970, c. C-32) and s. 8.1.4 of the related *Name Granting Compendium* which regulates the use of legal elements by not-for-profit corporations. This provision states that the only legal elements permitted for not-for-profit corporations are "Incorporated" or "Inc." or "Corporation" or "Corp." [See *Kightley v. Canada (Registrar of Trade-marks)* (1982), 65 C.P.R. (2d) (F.C.T.D.);

Marks & Clerk V. Sparkles Photo Ltd. (2005), 41 C.P.R. (4th) 236 (F.C.T.D.); and *Crush International Ltd. v. Canada Dry Ltd.* (1979), 59 C.P.R. (2d) 82 (T.M.O.B.), where judicial notice was taken of provincial and federal regulations by the Federal Court and the T.M.O.B.]. In the absence of any explanation or evidence of the existence of the legal entity named in the application - Inner Peace Movement of Canada Limited, I must conclude, for the reasons set out above, that the Applicant cannot be the person entitled to registration of the Mark under the provisions of s. 16(1)(a) or (3)(a) of the Act.

[38] The Opponent is therefore successful on these grounds of opposition.

Additional Grounds of Opposition

[39] In view of all of the foregoing, it is unnecessary to make a determination with respect to the remaining grounds of opposition.

Disposition

[40] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to the all the wares and services pursuant to s. 38(8) of the Act.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office