

**IN THE MATTER OF AN OPPOSITION
by Reach, Equality and Justice for People
with Disabilities to trade-mark application
no. 878,359 for the mark REACH filed by
Regional Cablesystems Inc.**

On May 13, 1998, the applicant Regional Cablesystems Inc. filed an application to register the trade-mark REACH, based on use in Canada since January 1998, in association with services relating to the operation of a cable television company. Several objections to the application were raised by the Examination Section of the Trade-marks Office. In response to one of the objections, the applicant deleted all but one of the services namely,

sponsorship and funding of community capital projects.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 12, 1999. The opponent received extensions of time to file its statement of opposition, which it effected on February 15, 2000. An issue arose concerning the proper identification of the opponent with the result that the statement of opposition was not forwarded by the Registrar to the applicant until May 16, 2000. The applicant responded by filing and serving a counter statement.

The statement of opposition pleads that the opponent is a charitable organization known throughout Canada by the trade-name Reach. As a charitable organization, it often goes to the public to seek funding. The opponent is the owner of three registered trade-marks namely, the word mark REACH and two word & design marks, shown below.

All three registrations cover the following services:

Arranging and conduction of seminars, conferences and educational courses and services and the lobbying for improved legal services all dedicated to protect the legal, health and social rights and interests of persons with disabilities; the provision of a Speaker's Bureau composed of lawyers who participate in panels, speaking engagements and television interviews dealing with the legal rights of persons with disabilities, the provision of consultation and legal services to persons with disabilities.

The grounds of opposition are shown below:

- (a) The trade-mark REACH sought to be registered by the applicant, is not registrable in view of Section 12(1)(d) of the *Trade-marks Act* because it is confusing with the trade-marks referred to in paragraph 2 herein, in the name of the opponent herein, for use in association with aforementioned services. Accordingly, the application for registration should be refused pursuant to Section 38(2)(b) of the *Trade-marks Act*.
- (b) The applicant is not the person entitled to registration in view of Section 16(1) of the *Trade-marks Act* since, at the date on which the applicant first so used the trade-mark, applicant's trade-mark REACH was confusing with
 - i) opponent's trade-mark registrations referred to I paragraph 2 herein which had been previously registered and used in Canada and continued to be so used, by the opponent in association with the aforementioned services;
 - ii) opponent's trade name REACH which had been previously used in Canada and continues to be so used in association with the services identified in paragraph 2 herein.

Accordingly, the application for registration should be refused pursuant to Section 38(2)(c) of the *Trade-marks Act*:

- (c) Applicant's proposed mark REACH is not distinctive in Canada of the applicant's services, in that it does not serve to distinguish applicant's services from the services of others and in particular the services of the opponent, in association with which the application for registration should be refused pursuant to Section 38(2)(d) of the *Trade-marks Act*;
- (d) Applicant's trade-mark application does not comply with the requirements of Section 30(i) of the *Trade-marks Act* in that at the date of filing of the application, the applicant could not have been satisfied that it was entitled to use the trade-mark REACH in association with the services set out in the application in question because it was aware of the prior

trade-mark rights of the opponent's trade-marks described in paragraph 2 above. Accordingly, the application for registration should be refused pursuant to Section 38(2)(a) of the *Trade-marks Act*.

The determinative issue in this proceeding is whether the applied for mark REACH, used in association with sponsorship and funding of community capital projects, is confusing with the opponent's mark and trade-mark REACH used in association with services directed at promoting the interests of persons with disabilities. The material times to consider the issue of confusion are (i) the date of my decision with respect to the first ground of opposition alleging that the applied for mark is not registrable, (ii) the date of first use of the applied for mark, that is, January 31, 1998, with respect to the second ground of opposition alleging that the applicant is not entitled to register the mark REACH, (iii) the date of filing the statement of opposition, that is, February 15, 2000, with respect to the third ground of opposition alleging that the applied for mark is not distinctive of the applicant's services: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206-209 (F.C.T.D.). The last ground of opposition pursuant to Section 30 (i) of the *Act*, as pleaded, does not stand independently of the other grounds of opposition and therefore does not require separate consideration.

The opponent's evidence is comprised of the affidavit of Paula Agulnik, Director of the opponent organization, sworn on January 3, 2001. Ms. Agulnik's affidavit testimony, supported by documentary evidence by way of exhibits to her affidavit, may be summarized as follows. The opponent is a charitable organization incorporated in 1981

under the laws of Ontario. A common theme in the opponent's advertising and promotion of its services is that "Reach as a self-funded non-profit organization providing equality and justice for people with disabilities." In this regard, it appears that one of the essential aims of the opponent is to provide disabled persons with access to legal counsel to protect their rights. The opponent goes to the public to seek most of its funding and the opponent's charitable services are advertised in connection with fund-raising events. The opponent spends about \$8,000 annually on such advertising and receives about \$12,000 annually in advertising from goods-in-kind donations. In 1998 and in 1999 the opponent raised about \$86,000 annually through a running competition fund-raising event. The running event has been held annually since 1989; it draws about 1600 participants and 200 volunteers. About 18,000 brochures and posters are distributed annually in Canada to promote the event. In November 1999 the opponent launched its web site at "www.reach.ca". An associated entity, under license from the opponent, operates in Nova Scotia. The Nova Scotia organization launched its web-site at "www.reachns.ns.ca" in June 2000. The opponent's mark is prominently featured on the opponent's solicitation letters and other stationary. Paragraph 10 of Ms. Agulnik's affidavit is shown below.

10. The Organization spends approximately 140,000 dollars CDN per year overall in performing and promoting its services in association with its trade-marks in Canada through advertising, fund-raising activities, educational publications and seminars, and web-site development.

Without the benefit for further details that might have been elicited by cross-examination, I will assume that the \$140,000 figure mentioned by Ms. Agulnik in paragraph 10 of her affidavit relates to a period of several years prior to the execution of her affidavit.

The applicant's evidence is comprised of the affidavit of Fred Hosker, a senior executive with the applicant company. Mr. Hosker's affidavit testimony, supported by documentary

evidence by way of exhibits to his affidavit, may be summarized as follows. The applicant is Canada's 6th largest cable television provider, offering services to about 250,000 customers in 1100 communities across Canada. The opponent has been operation for 12 years. The applicant's REACH program is one of three community programs sponsored by the applicant, the others being a University Scholarships Program and a Youth Merit Awards Program. The REACH program grants \$1000,000 annually for community based capital works projects that benefit the towns and people served by the applicant. The applicant's REACH program is advertised and promoted in a customer newsletter and by letters send directly to town officers or administrators inviting them to circulate applications to various groups in their community. Project descriptions listed at paragraph 10 of Mr. Hosker's affidavit include "construction of access ramp for the disabled," " construction of bus shelters," "training equipment for volunteer care givers service," "equipment for therapeutic Riding Assoc.," "purchase of computer for adult education," " installation and purchase of handicap railing," " tilt/reclining chair for Neurosurgery Program," "installation of roof over entrance to O'Conner Park Community Centre and make repairs to wheelchair," and " helipad for faster medical response to local hospital in Sudbury."

I will first consider the ground of opposition denoted by paragraph (b) (i) of the statement of opposition, above. As noted earlier, the determinative issue is whether the applied fir mark REACH is confusing with the opponent's mark REACH, and the material date to consider the issue of confusion arising pursuant to Section 16(1) of the *Trade-marks Act* is the date on which the applicant first used the applied for mark, that is, January 31, 1998.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark REACH and the opponent's mark REACH. The presence of a legal onus on the 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: see *John Labatt Ltd. V. Molson Companies Ltd.* (1990) 30 C.P.R. (3d) 293 at 297-298 (F.C.T.D.). The test for confusion is fairly set out at paragraph 32 of the opponent's written argument:

32. The test for likelihood of confusion between trade-marks is one of first impression and imperfect recollection. One must ask whether an ordinary consumer of the wares or services, with a general recollection of the prior trade-mark, would be likely to be confused as to the source of the wares or services when encountering the subsequent trade-mark.

British Drug house Ltd. V. Battle Pharmaceuticals (1945), 4 C.P.R. 48 at 57 (EX.CT); aff'd (1945), 5 C.P.R. 71 at 75 (S.C.C.)

Of course, in the instant case, the opponent's mark REACH is the "prior trade-mark" and the applicant's mark REACH is the "subsequent trade-mark."

Factors to be considered, in making an assessment as to whether two marks are confusing,

are set out in Section 6(5) of the *Trade-marks Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.).

The parties' marks possess a fair degree of inherent distinctiveness as there is no direct nexus between the parties' services and the word "reach," other than the mildly suggestive laudatory connotation of "achievement." At the material date January 31, 1998, the applicant's mark REACH was not known to any extent, while opponent's mark had become known to some extent through the promotion of its mark, particularly through fundraising events. The nature of the parties' services, as set out in the opponent's trade-mark registration and in the subject application, overlap to some extent. That is, some of the community projects sponsored by the applicant are directed to assist persons with disability. The nature of the parties' "trades" also overlap in relation to the applicant's use of its mark REACH. In this regard, while the applicant is not a charitable organization, the service that the applicant performs under the mark REACH is clearly philanthropic. Lastly, the parties' marks are identical.

In my view, at the time when the opponent first began to use its mark REACH in January 1998, the balance of probabilities favours the finding that the public would have assumed that the applicant's philanthropic undertakings were approved, licensed, or connected with the opponent. It follows that the trade-marks are confusing: see *Glen-Warren Productions Ltd. V. Gertex Hosiery Ltd.* (1990), 29 C.P.R. (3d) 7 at 12 (F.C.T.D.)

With respect to the issue of confusion at the later material dates, that is, (i) February 15, 2000 and (ii) the date of my decision, I find that the balance of probability between a reasonable likelihood of confusion and no reasonable likelihood of confusion is even. As the legal onus is on the applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the applicant on the grounds of opposition pleading non-registrability and non-distinctiveness.

In view of the above, the subject application is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 12TH DAY OF JUNE, 2003