IN THE MATTER OF AN OPPOSITION by Mica Management Resources Corp. to application No. 688,166 for the trade-mark MICA filed by Lutz Brode and Michale Brode, a partnership

On August 22, 1991, the applicant, Lutz Brode and Michale Brode, a partnership, filed an application to register the trade-mark MICA based on proposed use with the following wares:

> **sportswear, leisure wear and water wear, namely: waterski suits, sailing suits, kayak suits, canoeing suits, diving suits, windsurfing suits, t-shirts, shorts, hats, boots, gloves, sweatshirts, sweat pants, jackets, and bags, wallets and pouches.**

The application was advertised for opposition purposes on December 23, 1992.

The opponent, Mica Management Resources Corp., filed a statement of opposition on February 23, 1993, a copy of which was forwarded to the applicant on March 30, 1993. 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-marks MICA, MICA MANAGEMENT CENTRE and MICA MANAGEMENT RESOURCES registered under Nos. 245,033; 344,439 and 399,523 respectively. The second ground is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's filing date, the applied for mark was confusing with the opponent's trade-marks and trade-names previously used and made known in Canada by the opponent in association with consulting, management consulting and educational services and with printed matter, t-shirts, turtleneck shirts, shorts, sweatshirts, hats, aprons and sports bags. The third ground is that the applicant's trade-mark is not distinctive because it is confusing with the trade-marks and trade-names used and made known by the opponent. The fourth ground is that the applicant's application does not comply with the provisions of Section 30(I) of the Act because use of the applicant's mark "...would violate the opponent's rights under its registered trade marks..." and "...would also violate the opponent's rights under Section 7 of the Trade-marks Act...."

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of its Vice-President of Client Services, Frank Huggins. As its evidence, the

applicant filed an affidavit of one of its partners, Lutz Brode. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to Section 12(1)(d) of the Trade-marks Act 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.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, 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.

The most relevant of the opponent's registrations is No. 245,033 for the trade-mark MICA. Thus, a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the outcome of the first ground of opposition. Registration No. 245,033 covers the following services:

> **(1) management consulting services, and educational services namely providing training and education for business personnel (2) educational services concerning the nature, application and use of computers, data processing and computer software; and consulting services relating to computers, data processing and computer software.**

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive since MICA has no readily apparent meaning that is suggestive or descriptive in relation to the applicant's wares or the opponent's services. In his affidavit, Mr. Brode states that the applicant commenced use of its mark in the fall of 1991. Mr. Brode states that total sales of MICA wares have been in excess of $2 million and that MICA wares have been sold to over 200 retailers across Canada. It would appear that the sales to date have been primarily of wetsuits and the like. As noted by the opponent, all of the sales and advertising activities evidenced by Mr. Brode appear to be by an entity called Mica Sportswear Inc. Although Mr. Brode identifies that entity as the applicant's licensee, he does not provide particulars from which I could conclude that the licensed use and advertising qualifies as the applicant's use

and advertising pursuant to Section 50(1) of the Act: see the Section 45 decision in Finlayson and Singlehurst v. Hollywood Star Knitting Mills Ltd. (1996), 66 C.P.R.(3d) 570 at 573. Thus, I must conclude that the applicant's mark has not become known at all in Canada.

The opponent has used its trade-mark for a number of years in association with the services of conducting seminars and workshops primarily for government and corporate clients. According to Mr. Huggins, the opponent conducted more than 500 seminars per year for the period 1988-1992, the seminars having more than 20,000 participants on an annual basis. The opponent's annual advertising budget is more than $750,000 although most of that money is spent on direct mail advertising sent to prospective clients. Thus, although the opponent's mark MICA has become known to some extent, the mark's reputation would appear to be limited to the opponent's corporate and government client base and the employees of those organizations who participated in the opponent's seminars.

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 the opponent's statement of services in registration No. 245,033 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 page 3 of the unreported decision of the Federal Court of Appeal in McDonald's Corporation v. Coffee Hut Stores Ltd. (Court No. A-278-94; June 5, 1996).

The applicant's wares differ from the opponent's services and the trades of the parties also differ. The applicant's application covers various specialized wearing apparel items as well as ordinary clothing items such as t-shirts, shorts, etc. The applicant's proposed trade (as evidenced by the activities of its licensee) consists of selling its wares to retailers who in turn sell the wares to consumers.

The opponent's registration covers various educational and consulting services directed to business personnel. The Huggins affidavit evidences use of the trade-mark MICA with a wide variety of seminars offered by the opponent, most of them dealing with management skills and specific business skills. The opponent's trade consists of offering its services primarily through direct mail advertising and performing its services by conducting seminars and workshops at various locations.

The opponent contends that there is a connection between the wares, services and trades of the parties because the opponent spends about $5,000 a year on items such as hats, t-shirts, sports bags and the like bearing the trade-mark MICA which it distributes to some of the participants of its seminars. However, those items are given out as essentially promotional items. The opponent is not in the business of manufacturing or selling clothing wares and would not be perceived as a source of such goods. Furthermore, the promotional items bearing the trade-mark MICA evidenced by the Huggins affidavit invariably include additional reading matter (e.g. - "Strategic People Development") which points to the opponent and its seminars.

The opponent submitted that it had shown use of its trade-mark for clothing items because those items were transferred to seminar participants as part of the seminar package purchased by the opponent's clients. However, the evidence does not establish that such items were advertised as part of the seminars offered or that clients gave any consideration to the availability of such items when purchasing the opponent's services. Furthermore, the evidence only points to the distribution of such items to a limited number of clients and seminar participants in respect of a limited number of seminars. At most, the occasional distribution of these clothing items to clients and seminar participants constitutes advertising of the opponent's services.

The opponent made a number of other submissions seeking to establish a connection between the wares, services and trades of the parties. For example, one of the opponent's many seminars is an outdoor program and the opponent submits that the participants might

use the applicant's wetsuits in participating in some of the activities of that program. In my view, the opponent's contention is speculative. Furthermore, even if such a situation arose, I doubt that consumers would be confused given the wide disparity between the wares, services and trades of the parties.

The opponent also contended that since the applicant uses water sports champions to endorse its products, consumers could be confused since it would be logical for the opponent to use sports champions to endorse its services. Again, this contention is speculative. In any event, such a practice by the opponent would not necessarily lead to confusion since it is undoubtedly common practice in all industries to use sports figures as spokespersons.

As for Section 6(5)(e) of the Act, the marks of the parties are identical in all respects.

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 wide disparity between the wares, services and trades of the parties and the fact that the opponent's mark is not well known, I find that the marks at issue are not confusing. The first ground is therefore unsuccessful.

As for the second ground of opposition, it was incumbent on the opponent to evidence use or making known of its trade-marks or use of its trade-names prior to the applicant's filing date. Given the minimal level of activities evidenced by the Huggins affidavit that would qualify under Section 5 of the Act, I cannot conclude that the opponent had established prior making known of its marks as of the applicant's filing date. However, the opponent has evidenced prior use of its trade-marks and trade-names in association with consulting, management consulting and educational services. On the other hand, the opponent failed to evidence prior use of its marks and names in association with clothing items. As discussed, the opponent does distribute t-shirts, hats and the like bearing its mark MICA to some of its seminar participants. But those articles are distributed as promotional items only. Such activities do not, in my view, support a finding of trade-mark use with those wares.

The second ground therefore remains to be decided on the issue of confusion. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion. The material time for considering the circumstances respecting this issue is the filing date of the applicant's application. As with the first ground, the most relevant of the opponent's marks and names is the trade-mark MICA. Thus, a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the outcome of the second ground. For the most part, my conclusions respecting the first ground are applicable to 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 has been restricted to an allegation that the applicant's mark is not distinctive because it is confusing with the opponent's trade-marks and trade-names which have been used and made known in association with various consulting, management consulting and educational services and with various clothing items. As discussed, the opponent has not evidenced use of its marks or names in association with clothing items. Thus, the third ground turns on a consideration of the issue of confusion between the opponent's most relevant mark (i.e. - MICA) as used for services and the applicant's mark as of the filing of the opposition, that being the material time respecting a ground of non-distinctiveness. In view of my conclusions above, I find that the marks are not confusing and the third ground is also unsuccessful.

The opponent contended that the third ground should be broadly interpreted to include the opponent's distribution of clothing items and the like whether or not such distribution qualified as trade-mark use. Even if I adopted the opponent's approach, the third ground would still have been unsuccessful since the reputation associated with the opponent's clothing items bearing the trade-mark MICA is limited and any such reputation has been associated with the opponent as a provider of seminars and consulting services and not with the opponent as a source of clothing items and the like.

The opponent relied on the unreported opposition decision in V&S Vin & Spirit Aktiebolag v. Raphael Maroquinerie Inc. (S.N. 661,168; March 22, 1996) wherein an

application for the trade-mark LES ABSOLUS for various small leather goods was refused in view of the opponent's use of its trade-mark ABSOLUT for vodka and its advertising and promotional activities performed in association with that mark. Although that case bears some similarities to the present case, it is, in my view, distinguishable. Unlike in the present case, in the V&S case the opponent had evidenced an extensive reputation for its trade-mark. Furthermore, it had widely advertised its mark in magazines and at sporting events. One minor aspect of its promotional activities was the distribution of a relatively small number of items such as T-shirts. Of more importance in that case, however, was the fact that the opponent had engaged in activities which gave it a reputation in the fashion industry (see page four of the unreported reasons) which suggested a potential connection with the applicant's LES ABSOLUS wares. No such reputation has been evidenced by the opponent in the present case.

As for the fourth ground, it does not appear to be a proper ground of opposition in that the opponent did not even allege that the applicant was aware of the opponent's trade-marks and trade-names. To the extent that it is a proper ground, its success is contingent on a finding of confusion between the applicant's mark and one or more of the opponent's marks and names. In view of my findings respecting the issue of confusion for the other three grounds, the fourth ground would therefore also be unsuccessful.

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 26th DAY OF AUGUST 1996.

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