

**IN THE MATTER OF AN OPPOSITION
by Advance Magazine Publishers Inc.
to application no. 1114349 for the
trade-mark WIRED WOMEN filed by
The Wired Women Society**

[1] On August 30, 2001, The Wired Women Society filed an application to register the mark WIRED WOMEN based on use of the mark since at least as early as November 30, 1996, in association with the following wares and services:

wares

printed materials and publications namely newsletters, articles, guides, pamphlets and brochures in the field of information technology.

services

a professional association providing its members information, networking opportunities, career resources, community and academic presentations, role-modelling and mentoring, all related to Information Technology, namely through the organization of forums, conferences and discussions; provision and management of a website giving access to the society's resources.

The application disclaims the exclusive use of the word WOMAN apart from the mark as a whole.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated May 7, 2003, and was opposed by Advance Magazine Publishers Inc. on October 6, 2003. The Registrar forwarded a copy of the statement of opposition to the applicant on October 23, 2003, as required by Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement.

STATEMENT OF OPPOSITION

[3] The statement of opposition alleges that the applied for mark WIRED WOMEN is not registrable nor is the applicant entitled to registration pursuant to Sections 12(1)(d) and 16(1)(a) and (c) of the *Trade-marks Act*. In this regard, the opponent relies on its registered marks GET WIRED, HARDWIRED, and WIRED (regn. nos. 530862, 513643, 447332 and 576325, respectively), and its use of the above cited marks since a date prior to the date of filing the application or prior to the applicant's alleged date of first use.

[4] The opponent next alleges that the applicant could not have been satisfied under Section 30(i) of its entitlement to use the applied for mark WIRED WOMEN because the applicant was aware of or should have been aware of the opponent's use of its marks in Canada.

The opponent next alleges that the applied for mark is not distinctive nor capable of becoming distinctive.

Lastly, the opponent alleges that the applied for mark WIRED WOMEN "has not been used by the applicant since the date of first use alleged or at all."

FILINGS

[5] The opponent filed as its evidence (i) the affidavit of Elenita Anastacio, and (ii) certified documents relating to the applicant company issued by the Registrar of Companies for the Province of British Columbia. The applicant's evidence consists of the affidavit of Lynda Brown.

Ms. Brown was cross-examined on her affidavit. The transcript of her cross-examination and Exhibit 1 thereto was filed as evidence. Only the applicant filed a written argument, however, both parties were represented at an aural hearing held on April 30, 2009.

OPPONENT’S EVIDENCE

[6] The Anastacio affidavit serves to introduce into evidence copies of the opponent’s trademark registrations, an internet search as to the use of the mark WIRED WOMEN, and a corporate registry search concerning the applicant. The particulars of the opponent’s registrations are summarized below:

Mark & Regn. no.	Wares & Services
GET WIRED 530862	<p>Periodicals, namely magazines about cultural and lifestyle, as embodied in electronic, optical, video, audio, film or printed media; clothing, namely t-shirts, jackets, sweatshirts, sweaters, shirts, pants, shorts, hats, scarves, shoes.</p> <p>Electronic transmission of messages, documents and data via networks, television, radio and other broadcasting means.</p>
HARDWIRED 513643	Books and magazines published on tape, disk and CD-ROM in the fields of culture, lifestyle and technology; books and magazines in the fields of culture, lifestyle and technology.
WIRED 447332	<p>Magazines published in either printed, analog or digital format and directed towards the digital, computer and multimedia interest sectors. Stationery, namely writing paper, cards and pens.</p> <p>On-line computer interactive communications, subscription, bulletin board, distribution and publication services; television, audio, video and cable programming services and magazine publishing services.</p>

WIRED 576325	Online magazines and publications distributed in electronic format via the internet; operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet.
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[7] Ms. Anastacio testifies that the only use of WIRED WOMEN that she could locate was use as of the year 2004 and newsletters which date back to 2001. Attached as Exhibit B to Ms. Anastacio's affidavit is a copy of incorporation details for the applicant. The exhibit appears to indicate that the applicant was incorporated on December 23, 1996, that is, about three weeks *after* the applicant's date of first use of the mark as claimed in the subject application.

I have not had regard to the certified documents filed as evidence as those documents are not included as exhibits in an affidavit or statutory declaration as required by Section 42(1)(a) of the *Trade-marks Regulations* nor are the documents admissible into evidence under Section 54 of the *Trade-marks Act*.

APPLICANT'S EVIDENCE

[8] Ms. Brown's affidavit evidence and testimony on cross-examination generally confirm that the applicant does in fact provide the wares and services specified in the subject application. Attached as Exhibit D to her affidavit is a copy of the Certificate of Incorporation of the applicant issued by the Registrar of Companies for the Province of British Columbia. Exhibit D establishes that the applicant was incorporated in December 23, 1996, that is, about three weeks

after the applicant's date of first use of the mark as claimed in the subject application.

[9] The opponent objects that the portion of Ms. Brown's transcript of cross-examination (including Exhibit 1) which is identified as "further examination" should not form part of the evidence of record. I agree. The "further examination" portion is in fact re-examination of Ms. Brown by counsel for the applicant. However, as noted by the opponent, the re-examination is improper because the subject matter of the questioning does not arise out of the cross-examination. Further, Exhibit 1 introduced by the applicant constitutes new evidence which might have been submitted during the evidence stage or submitted after the evidence stage as additional evidence pursuant to Section 44 of the *Trade-marks Regulations*. Accordingly, I have not had regard to the "further examination" portion of the transcript of cross-examination nor to Exhibit 1. I have, however, had regard to answers to questions taken under advisement at the cross-examination. In this regard, although the submission of the answers by the applicant was not in strict compliance with Board procedures, the opponent did not object to the evidence.

DETERMINATIVE ISSUE

[10] The last ground of opposition which alleges that the applied for mark WIRED WOMEN was not used by the applicant since the date of first use claimed in the application is pleaded pursuant to Section 30(b) of the *Trade-marks Act* which reads as follows:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing . . .

(b) in the case of a trade-mark that has been used in Canada, *the date from which* the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of wares or services

described in the application
(*emphasis added*)

[11] The material time for considering a ground of opposition based on Section 30(b) is as of the applicant's filing date. The legal onus is on the applicant to show its compliance with the provisions of Section 30(b): see the opposition decision in *Joseph Seagram & Sons v. Seagram Real Estate* (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293. However, as with all grounds of opposition, there is an evidential burden on the opponent to put its allegation into issue. The evidential burden is relatively light respecting the issue of non-compliance with Section 30(b): see the opposition decision in *Tune Masters v. Mr. P's Mastertune* (1986), 10 C.P.R.(3d) 84 at 89. Further, the opponent's evidential burden can be met by reference to the applicant's own evidence: see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R.(3d) 216 at 230.

[12] In the instant case the applicant has formally complied with Section 30(b) by including a date of first use in its application namely, since at least as early as November 30, 1996. The issue then becomes whether the applicant has substantively complied with Section 30(b), that is, is the date correct? The evidence of record shows that the date of first use cannot be correct as the applicant did not become extant as a corporate body until December 23, 1996. The application is therefore in non-compliance with Section 30(b) and must be refused: see, for example *Voxson Australia Pty. Ltd v. Voxson Canada Limited* (1983) 80 C.P.R. (2d) 286 (TMOB).

Given the paucity of the opponent's evidence, and that the term "wired" is suggestive of information technology, it is unlikely that the opponent would have succeeded on any of the other grounds of opposition.

DISPOSITION

[13] In view of the foregoing, the application is refused for non-compliance with Section 30(b). This decision has been made pursuant to a delegation of authority under Section 63(3) of the *Trade-marks Act*.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 14th DAY OF MAY, 2009.

Myer Herzig,
Member, Trade-marks Opposition Board