

**IN THE MATTER OF AN OPPOSITION by  
Horn Abbot Ltd. to application no. 1258291 for  
the trade-mark MEANINGFUL PURSUIT  
filed by John Orlicky**

On May 20, 2005, John Orlicky filed an application to register the trade-mark MEANINGFUL PURSUIT based on use of the mark since April 1, 2005, in association with printed educational tool namely question cards and accompanying rules of use.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated June 14, 2006, and was opposed by Horn Abbot Ltd. on October 4, 2006. A copy of the statement of opposition was forwarded by the Registrar of Trade-marks to the applicant on October 31, 2006, as required by Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement.

The opponent's evidence consists of the affidavit of James G. Ware, President of the opponent company. The applicant John Orlicky submitted an affidavit on his own behalf. Both parties submitted written arguments. Neither party requested an oral hearing.

After receiving the applicant's written argument, the opponent objected that certain portions of the applicant's submissions are in fact in the nature of evidence. I agree and therefore I have not had regard to those portions of paragraphs 2, 5 and 7 of the applicant's written argument which are in the nature of evidence.

## STATEMENT OF OPPOSITION

Various grounds of opposition are pleaded, including grounds based on Section 30(a) and 12(1)(d) of the *Trade-marks Act*, reproduced below:

(i) Subsection 30(a): The applicant has deliberately omitted games in its statement of wares despite the fact the product on which the applicant intends to use the trade-mark is a question and answer game. The applicant is thereby obfuscating his true intent to use the mark in association with question and answer games. The statement of wares is neither specific nor are the wares described in ordinary commercial terms, and as such the application does not conform with the requirements of subsection 30(a).

(b) The opponent further bases its opposition on the ground set forth in section 38(2)(b), namely the trade-mark MEANINGFUL PURSUIT is not registrable in that contrary to the provisions of Section 12(1)(d), the trade-mark is confusing within the meaning of section 6 with the family of TRIVIAL PURSUIT trade-marks registered by the opponent as set out in Appendix "A" attached hereto. The opponent's trade-marks, particularly the TRIVIAL PURSUIT marks are famous trade-marks and have a high level of distinctiveness.

The marks cited in Appendix A, referred to above, are TRIVIAL PURSUIT, TRIVIAL PURSUIT ONLINE, TRIVIAL PURSUIT & Design, PARTY PURSUIT, POINT PURSUIT and CLASSIC PURSUIT. The wares covered by the opponent's mark TRIVIAL PURSUIT includes:

board game and equipment, namely playing board, die, rules of play, question and answer cards, card boxes, player tokens and scoring wedges sold both as a unit and separately for playing a board game.

*Section 30(a) Ground of Opposition*

The legal onus is on the applicant to show that his application complies with Section 30(a), that is, the applicant must show that the specification of wares is factually correct and described in ordinary commercial terms. There is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegation that the wares described in the application are not in ordinary commercial terms or factually incorrect. The presence of an evidential burden on a party with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. The evidential burden on the opponent with respect to Section 30(a) is lighter than in the ordinary case: see, for example, *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at pp. 298-300 (F.C.T.D.) The material time for considering the circumstances respecting the issue of non-compliance with Section 30(a) is the filing date of the application: see *Thomas J. Lipton Inc. v. Primo Foods Ltd.* (1992), 44 C.P.R.(3d) 556 at p. 560 (TMOB); *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 468 at p. 475 (TMOB).

The opponent's evidence includes a description of the applicant's product as well as exhibits comprised of photographs of the product sold under the applied for mark MEANINGFUL PURSUIT. The evidence establishes that the applicant's product includes about 50 cards with a question on one side of the card. Some of the questions on the cards are:

If I could choose any job, what would it be?  
How do I limit myself in life?  
Do I spend more time regretting the past or worrying about the future?  
What was my best trip or vacation like?

The directions for the product may be summarized as follows: the cards are first shuffled, a person takes a card, reads the question out loud and answers honestly. The next person takes a new card and the process is repeated. Reproduced below is a portion of the rule sheet for the applicant's product:

### WHAT IS MEANINGFUL PURSUIT

MEANINGFUL PURSUIT is new and different. It focuses on co-operative enjoyment by you answering questions about yourself that are both meaningful and revealing. Some questions are simple and fun and some are challenging and exploring. There are no right or wrong answers only honest ones. Have fun with this; no one is judging your answers.

MEANINGFUL PURSUIT provides a social setting for quality time with family or friends. It is different from most games. There are no boards, no pieces, no big boxes, no scoring system and no losers. Everybody wins quality time together in a fun and entertaining way.

## HOW TO PLAY

First read aloud to everyone WHAT IS MEANINGFUL PURSUIT and then these directions.

The opponent, in its written argument, submits that the applicant has failed to describe the true nature of the applicant's product, namely that it is a question and answer game. The opponent further submits that "what is notably absent from the description of the wares is the word 'game' which appears on all of the opponent's registrations." The applicant, in his written argument, submits that his product is not a game because a game "requires a scoring system, competition and a winner and losers." The applicant further submits that his product "is an educational communication tool for eliciting personal insights ... " intended to strengthen relationships among family, friends and business associates.

I note that (i) the applicant's product includes the header "HOW TO PLAY"(indicating that the product is a game) above the directions for the product, (ii) the product itself is described as "different from most games" (implying that the product is a type of game) and (iii) the applicant's business card includes the phrase "Different games that make a difference" (indicating that the applicant is in the business of selling games).

I agree with the applicant that his product does not fall within the narrow meaning of a game, namely a competitive activity played according to well defined rules. However, it appears to me that the applicant's product does fall into the broader meaning of a game, namely an activity engaged in for amusement. Regardless of the precise categorization of the applicant's product, the evidence of record indicates that from a business perspective the product is intended to be marketed as an adult parlour game rather than as an educational tool. Accordingly, I find that the applicant has not established, on a balance of probabilities, that he has provided a

statement in ordinary commercial terms of the wares in association with which the mark has been or is proposed to be used. The application is therefore refused for non-compliance with Section 30(a).

*Section 12(1)( d) Ground of Opposition*

The main issue raised by the ground of opposition pursuant to Section 12(1)( d) is whether the applied for mark MEANINGFUL PURSUIT, for use in association with a product comprised of question cards and rules for use, is confusing with the opponent's mark TRIVIAL PURSUIT for use in association with a board game. The material time to assess the issue of confusion is the date of my decision: 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 legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark MEANINGFUL PURSUIT and the opponent's mark TRIVIAL PURSUIT. The presence of a legal burden 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.*, above, at 297-298.

The test for confusion is one of first impression and imperfect recollection. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to

all the surrounding circumstances, including those enumerated in Section 6(5) of the *Act*, namely: 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 the 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.).

#### *Consideration of Section 6(5) Factors*

The opponent's mark TRIVIAL PURSUIT possesses a relatively high degree of inherent distinctiveness as it has no descriptive connotation of the nature of the opponent's board game. The applicant does not contest that the opponent's mark TRIVIAL PURSUIT, and the opponent's family of trade-marks cited in Appendix A referred to earlier, are famous in Canada. The applied for mark MEANINGFUL PURSUIT possesses a somewhat lower degree of inherent distinctiveness than the opponent's mark. In this regard, although the applied for mark has no descriptive connotation of the nature of the applicant's wares, the component MEANINGFUL does convey a somewhat laudatory suggestion, that is, significant or important outcomes will ensue from use of the applicant's product. There is no evidence showing that the applied for mark has acquired any distinctiveness in Canada through sales under the mark or advertising. With respect to the length of time that the marks in issue have been in use, the opponent has evidenced use of its mark in Canada since 1981 while the subject application is based on use

since April, 2005. The nature of the parties' wares overlap at least to the extent that they are both comprised in part of question cards. As discussed earlier, it appears from the evidence that the applicant's wares would be marketed as a parlour game and therefore I would expect that the parties' wares would be sold through essentially the same or overlapping channels of trade.

The resemblance between the marks in issue is discussed in the opponent's written argument as shown below:

Both the words TRIVIAL PURSUIT® and MEANINGFUL PURSUIT share the following similarities:

- ~ Both consist of two words;
- ~ Both share the same second word, PURSUIT;
- ~ Both first words have three syllables; and,
- ~ Both describe the same product, thus leading the consumer to reasonably infer that both originate from the same source.

The name and appearance of the name "Meaningful Pursuit" for a question and answer game gives the immediate impression that it is one of the family of TRIVIAL PURSUIT® games or that it is sponsored by or associated with the TRIVIAL PURSUIT® games.

Given that the public is well acquainted with the opponent's mark TRIVIAL PURSUIT, that the term MEANINGFUL is related to the term TRIVIAL by being its antonym, and that the applied for mark is for use in association with a product marketed as a parlour game, I consider



that there is merit to the opponent's concern that the average consumer will believe that the applicant's wares are sponsored by or licensed by or otherwise associated with the opponent. In view of the above, I find that the applicant has not made out a case to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the marks TRIVIAL PURSUIT and MEANINGFUL PURSUIT.

DISPOSITION

The subject application is refused as the opponent has succeeded on two grounds of opposition. Accordingly, it is not necessary to consider the remaining grounds.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 20th DAY OF AUGUST, 2008.

MyerHerzig,  
Member,  
Trade-marks Opposition Board