



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

Citation: 2011 TMOB 63
Date of Decision: 2011-04-18

**IN THE MATTER OF AN OPPOSITION
by 1772887 Ontario Limited to
application No. 1,351,921 for the trade-
mark WHERE DO YOU STAND? in the
name of GeoAdvice Engineering Inc.**

[1] On June 15, 2007, GeoAdvice Engineering Inc. (the Applicant) filed an application to register the trade-mark WHERE DO YOU STAND? (the Mark) based on proposed use in Canada in association with the following wares and services:

Wares: publications, namely reports containing content and analysis of content of an interactive website for social networking; and electronic publications, namely reports containing content and analysis of content of an interactive website for social networking.

Services: interactive electronic communication services, namely, the operation of an interactive website for social networking, including the operation of an interactive website permitting users to exchange and share information, ideas and data on a number of topics; interactive electronic communication services, namely, the operation of an interactive website permitting users to submit questions and associated responses on a number of topics; interactive electronic communication services, namely, the operation of an interactive website permitting users to perform comparative analyses of responses and data submitted in response to questions on a number of topics; interactive electronic communication services, namely, the operation of an interactive website for performing surveys and analyzing survey results, publishing questionnaires, soliciting responses to questionnaires and analyzing questionnaire responses; interactive electronic communication services, namely, the operation of an interactive website for gathering and collating information and data submitted by users on a number of topics so as to produce an organized representation of collective intelligence; and preparing business reports, including preparing business reports containing content and analysis of content of an interactive website for social networking.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of January 30, 2008.

[3] On June 30, 2008, 1742280 Ontario Limited, trading as WHERE CANADA (the Opponent), filed a statement of opposition. The grounds of opposition pleaded pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) are summarized below.

1. s. 12(1)(d): the Mark is not registrable because it is confusing with the Opponent's registered trade-marks WHERE (Nos. TMA368,571 and TMA496,282), WHERE MAGAZINES INTERNATIONAL (No. TMA408,695), WHERE FAMILY (No. TMA463,529), WHERE ON-LINE (No. TMA520,864), WHERE LOCALS HIKE (No. TMA674,494) and WHERE THE FINDS ARE (No. TMA677,534) (collectively the Registered Marks).
2. s. 16(3)(a): the Applicant is not the person entitled to register the Mark because the Mark is confusing with the Registered Marks previously used by the Opponent and its predecessors.
3. s. 16(3)(b): the Applicant is not the person entitled to register the Mark because the Mark is confusing with the Opponent's pending applications for the trade-marks WHERE TELEVISION & Design (No. 1,223,990), WHERE TELEVISION (No. 1,223,991) and WHERE Design (No. 1,343,807) (collectively the Pending Marks).
4. s. 16(3)(c): the Applicant is not the person entitled to register the Mark because the Mark is confusing with the following trade-names previously used by the Opponent: Where Alaska & Yukon, Where Edmonton, Where Canadian Rockies, Where Calgary, Where Canada Media, Where Victoria Media, Where Vancouver Magazine, Where Alaska & Yukon Magazine, Where Winnipeg, Where Halifax, Where Vancouver, Where Ottawa, Where TV, Where Toronto, Where Muskoka, Where Victoria, Where Canada, Where International, Where Magazines International and Where On-Line.
5. s. 2: the Mark is not distinctive in view of the foregoing.
6. s. 30(i): the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because it was or ought to have been aware of the Opponent's trade-marks and trade-names.

[4] The Applicant filed and served a counter statement essentially denying each allegation contained in the statement of opposition.

[5] In support of its opposition, the Opponent filed an affidavit of Elenita Anastacio, sworn January 16, 2009. Ms. Anastacio, a trade-mark searcher employed by the Opponent's trade-mark agent, was not cross-examined. She files printouts of nine registrations and one application, which she downloaded from the *CD Name Search* Canadian trade-marks database, for the trade-marks referenced in the statement of opposition. The owner of the trade-marks is shown as 1772887 Ontario Limited further to an amalgamation of July 1, 2008 recorded by the Canadian Intellectual Property Office (CIPO).

[6] The Applicant elected to file no evidence in support of its application.

[7] The parties did not file written arguments.

[8] An oral hearing was conducted at the request of the Opponent. Only the Opponent was represented at the oral hearing where its agent requested that the record be amended to reflect 1772887 Ontario Limited as the Opponent in the present proceeding.

[9] Clearly, the request for the amendment of the Opponent's name was made at a very late stage and could have been made earlier; the change for the owner of the trade-marks referenced in the statement of opposition was recorded by CIPO on July 17, 2008. Nevertheless, there appears to be no prejudice to the Applicant in granting the request pursuant to r. 40 of the *Trade-marks Regulations*, SOR/96-195. Accordingly, the record is hereby amended to reflect 1772887 Ontario Limited as the Opponent in the present proceeding.

Onus

[10] The Applicant bears the legal onus of establishing on a balance of probabilities that the application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial onus is satisfied, the Applicant has the burden to prove that the particular grounds of opposition should not prevent registration of the Mark [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20

C.P.R. (4th) 155 (F.C.A.); and *Wrangler Apparel Corp. v. The Timberland Company* (2005), 41 C.P.R. (4th) 223 (F.C.).

Registrability pursuant to s. 12(1)(d) of the Act

[11] The material date for assessing confusion under s. 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

[12] I have to remark that even though the Anastacio affidavit discloses that application Nos. 1,223,990 and 1,223,991 matured to registration in October 2008 under Nos. TMA725,344 and TMA727,342 respectively, the Opponent did not seek leave to amend the statement of opposition to plead these two registrations in support of the registrability ground of opposition.

[13] I have exercised the Registrar's discretion to confirm that the pleaded registrations are in good standing as of today's date. Since the Opponent has discharged its evidential burden with respect to this ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks at issue.

[14] The statement of wares and services for the pleaded registrations are set out below:

- WHERE (TMA368,571): printed publications, namely books, magazines and periodicals.
- WHERE FAMILY (TMA463,529): printed publications, namely, magazines, directories, brochures, pamphlets, newsletters and maps.
- WHERE MAGAZINES INTERNATIONAL (TMA408,695): assembling, arranging, production, publication and dissemination of magazines, books and periodicals.
- WHERE (TMA496,282):

Wares: computer software used to store, search, retrieve and archive editorial content, photos, illustrations, advertisements and customer information; and communications software for voice, text, video and imaging, namely audio-text that allow customers to call a central telephone number for access to 24 hour information and advertisers; pre-recorded audio video tapes; CD-ROM's; and kiosks.

Services: Internet services; digital feed services; multi-level interactive information storage; retrieval and delivery services, namely a service that retrieves and delivers stored editorial content, images and advertising content; reservation and transaction services relating to travel, entertainment, attractions, accommodations, cuisine and related travel and destination specific information and services, namely a service that retrieves and delivers custom editorial and/or advertising products whether print or electronic; communications services for voice, text, video and imaging, namely audio-text services which allow customers to call a central telephone number for access to 24 hour information on advertisers.

- WHERE ON-LINE (TMA520,864):

Wares: computer software, hardware and firmware.

Services: electronic publishing, interactive computer and information services, namely the provision of information accessible to businesses and consumers through the use of computer equipped with modems.

- WHERE LOCAL HIKES (TMA674,494): printed publications, namely hiking and outdoor guidebooks and postcards.
- WHERE THE FINDS ARE (TMA677,534): operation, management, leasing and marketing of retail stores, restaurants and entertainment services.

[15] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[16] In my view, the Opponent's case is strongest when considering the trade-mark WHERE of registration Nos. TMA368,571 and TMA496,282. Thus, the determination of the issue of confusion between the Mark and the registered trade-mark WHERE will effectively decide the ground of opposition.

[17] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in

appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.)].

- *The inherent distinctiveness of the trade-marks and the extent to which they have become known*

[18] The parties' marks possess some degree of inherent distinctiveness.

[19] There is no evidence that the Mark has become known to any extent in Canada. Also, there is no evidence to show the extent to which the Opponent's registered trade-mark might have become known in Canada. The mere existence of registration Nos. TMA368,571 and TMA496,282 can establish no more than *de minimis* use of the trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[20] Based on the foregoing, the s. 6(5)(a) factor is of no significance in this case.

- *The length of time the trade-marks have been in use*

[21] The Mark was applied for registration on the basis of proposed use and there is no evidence that the Applicant has ever used the Mark. The trade-mark WHERE was registered under No. TMA368,571 further to the filing of a Declaration of Use on January 24, 1990 and under No. TMA 496,282 on the basis of use in Canada since at least as early as March 15, 1996.

[22] If one accepts that the trade-mark WHERE has been used in Canada as stated in the registrations, this factor would favour the Opponent. However, there is no evidence directed to the use of the trade-mark WHERE, which as a result is assumed to be only *de minimis*. Hence, I find the length of time the trade-marks have been in use to be of no significance in this case.

- *The nature of the wares, services or business and the nature of the trade*

[23] When considering the nature of the parties' wares, services and business and the nature of the parties' trade, it is the statement of wares and services in the application and the statement of wares and services in the Opponent's registrations that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*

(1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)). However, those statements must be read with a view to determining the probable type of business or trade intended by the parties 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, particularly where there is ambiguity as to the wares or services covered in the application or registration at issue [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[24] The Opponent submits that the applied-for wares “publications, namely reports containing content and analysis of content of an interactive website for social networking; and electronic publications, namely reports containing content and analysis of content of an interactive website for social networking” overlap with the wares stated in registration No. TMA368,571. The Opponent makes the same submission with respect to the applied-for services “preparing business reports, including preparing business reports containing content and analysis of content of an interactive website for social networking”. Further, the Opponent submits that the applied-for services stated as corresponding to interactive electronic communication services overlap with its internet services and its communication services of registration No. TMA496,282.

[25] To the extent that the parties’ wares fall within the category of publications, I agree with the Opponent that they overlap. Also, I find it reasonable to conclude to a relationship between the wares of registration No. TMA368,571 and the services of preparing business reports, in that business reports qualify as publications. However, as discussed hereafter, I am not prepared to conclude that the interactive electronic communication services stated in the application overlap with or are related to the Opponent’s internet and communication services.

[26] For one thing, the trade-mark WHERE was registered at a time when the terms “internet services” were considered sufficiently specific for registration purposes. However, CIPO now considers “internet services” too broad for registration purposes as these could encompass several different services. In other words, “internet services” is ambiguous. Moreover, there is no

evidence to interpret the registered services “internet services” as being related to the operation of an interactive website, which seems to be the focus of the interactive electronic communication services stated in the application. As for the Opponent’s communication services, they are stated in registration No. TMA496,282 as “communications services for voice, text, video and imaging, namely audio-text services which allow customers to call a central telephone number for access to 24 hour information on advertisers”. In my view, the communication services stated in the registration are distinguishable from the applied-for services corresponding to interactive electronic communication services.

[27] In the absence of evidence as to the nature of trade of the parties, for the purpose of determining the likelihood of confusion, I find it reasonable to conclude that the channels of trade associated with the trade-marks could be identical or overlapping when considering the applied-for wares and the applied-for services “preparing business reports, including preparing business reports containing content and analysis of content of an interactive website for social networking”.

- *The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[28] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.); aff’d 60 C.P.R. (2d) 70 (F.C.A.)].

[29] Although the Mark incorporates the registered mark in its entirety, I find that there are significant differences between the parties’ marks in appearance, sound and ideas suggested.

- *Additional surrounding circumstance: family of trade-marks*

[30] At the oral hearing, the agent for the Opponent raised the ownership of a family of WHERE trade-marks as an additional circumstance supporting a finding of confusion.

[31] A party seeking to take advantage of the wider scope of protection afforded to a family of trade-marks must first establish use of the trade-marks that comprise the family [see

MacDonald's Corporation v. Yogi Yogurt Ltd. (1982), 66 C.P.R. (2d) 101 (F.C.T.D.)). As the Opponent failed to provide evidence directed to the use of any of its Registered Marks and Pending Marks, I do not consider this to be a case where the Opponent may assert a family of trade-marks.

Conclusion on the likelihood of confusion

[32] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In weighing all of the factors and their relative importance together, I arrive at the conclusion that there is not a reasonable likelihood that the Mark will prompt the consumers to think that the applied-for wares and the applied-for services come from the same source as those covered by the Opponent's registration Nos. TMA368,571 and TMA496,282 or are otherwise associated with the Opponent. Therefore, I find that the Applicant has discharged its burden of showing, on a balance of probabilities, that the Mark is not confusing with the Opponent registered trade-mark WHERE.

[33] Since the determination of the issue of confusion between the Mark and the registered trade-mark WHERE effectively decides the s. 12(1)(d) ground of opposition, I dismiss this ground of opposition.

Non-entitlement pursuant to s. 16(3) of the Act

Non-entitlement pursuant to s. 16(3)(a) of the Act.

[34] Despite the onus resting on the Applicant, the Opponent has the initial burden of proving that its Registered Marks were used prior to the filing date of the application for the Mark and had not been abandoned at the date of its advertisement [s. 16(5) of the Act].

[35] As the Opponent has failed to evidence of use of its Registered Marks, within the meaning of s. 4 of the Act, I find that the Opponent has not discharged its evidentiary burden. Accordingly, I dismiss this ground of opposition.

Non-entitlement pursuant to s. 16(3)(b) of the Act

[36] The Opponent has met its initial evidentiary burden to show that the applications for the Pending Marks were filed prior to the filing date of the application for the Mark and were pending at the date of its advertisement [s. 16(4) of the Act].

[37] The printouts of the applications filed with the Anastacio affidavit show the following statements of wares and services for the Pending Marks:

- WHERE TELEVISION & Design (No. 1,223,990) and WHERE TELEVISION (No. 1,223,991): informational and educational services relating to visitor and tourist information; entertainment and advertising services, namely promotional and advertising services promoting local entertainment events and the wares and services of others; television and customized audio visual services relating to local events and services and visitor and tourist information; electronic and DVD guidebook services relating to local events and services and visitor and tourist information; electronic magazine services, namely interactive and information services relating to local events and services and visitor and tourist information.
- WHERE Design (No. 1,343,807)

Wares: (1) printed publications; online publications; (2) books and booklets of all kinds, magazines, periodicals, brochures, pamphlets, newspapers, manuals, maps, posters, pictures and photographs relating to activities in specified locations in Canada; (3) computer software used to store, search, retrieve and archive editorial content, photos, illustrations, advertisements and customer information; communications software for voice, text, video and imaging, namely audio-text that allow customers to call a central telephone number for access to 24 hour information and advertisers; pre-recorded audio video tapes; CD-ROM's namely pre-recorded interactive compact disks; and kiosks.

Services: (1) internet services; website services, broadcast and entertainment services, electronic information services, online services, internet services, electronic publication services; (2) informational services in the nature of electronic magazines; publishing services; publishing services through the use of the worldwide web; (3) digital feed services, namely broadcast and television services and electronic magazine services; multi-level interactive information storage; retrieval and delivery services, namely a service that retrieves and delivers stored editorial content, images and advertising content; reservation and transaction services relating to travel, entertainment, attractions, accommodations, cuisine and related travel and destination specific information and services, namely a service that retrieves and delivers custom editorial and/or advertising products whether print or electronic; communications services for voice, text, video and imaging, namely audio-text services which allow customers to call a central telephone number for access to 24 hour information on

advertisers; (4) provision of information and advisory services relating to activities by providing information and advice regarding specific entertainment and educational services to promote and inform and advise on specified available activities and entertainment services through printed publications, print advertising, tourist information booths, point of purchase signage, promotions contests and cooperative promotional efforts with content providers, in specified locations in Canada. (5) broadcast, television and entertainment services, namely, the creation and production of consumer television and radio broadcast shows, and pre-recorded CD and DVD media for purchase by the consumer.

[38] As I am of the view that the Opponent's case is strongest when considering the trade-mark WHERE Design of application No 1,343,807, the determination of the issue of confusion between the latter and the Mark will effectively decide the s. 16(3)(b) ground of opposition.

[39] Though the statement of services of the application for the trade-mark WHERE Design includes "website services", these are broad terms. In the absence of evidence directed to the Opponent's "website services", I am prepared to interpret them as being related to the services "publishing services through the use of the worldwide web", which are also stated in the Opponent's application. Hence, I am not satisfied that it may be concluded that the services "website services" stated in application No 1,343,807 involve an interactive website.

[40] In any event, I find that the Opponent's case is no stronger under the non-entitlement ground of opposition, than it is when considering the Opponent's word mark WHERE under the registrability ground opposition. For one thing, the design feature of the trade-mark WHERE Design does not increase its inherent distinctiveness since the script and the font employed are intrinsic to the word forming the mark [see *Canadian Jewish Review Ltd. v. The Registrar of Trade Marks* (1961), 37 C.P.R. 89 (Ex. C.)]. In addition, the trade-mark WHERE Design was applied for registration on April 4, 2007 based on proposed use in Canada. There is no evidence to conclude on the extent to which it might have become known at the material date, nor can *de minimis* use of the trade-mark WHERE Design be presumed from the mere existence of the application. Finally, there are significant differences between the Mark and the trade-mark WHERE Design in appearance, sound and ideas suggested.

[41] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In weighing all of the factors and their relative importance together, I arrive at the conclusion that there is not a reasonable likelihood that the Mark will prompt the

consumers to think that the applied-for wares and services come from the same source as the wares and services covered by the Opponent's application No. 1,343,807 or are otherwise associated with the Opponent. Therefore, I find that the Applicant has discharged its burden of showing, on a balance of probabilities, that the Mark was not confusing with the Opponent's trade-mark WHERE Design of application No. 1,343,807 as of June 15, 2007.

[42] Since the determination of the issue of confusion between the Mark and the trade-mark WHERE Design of application No 1,343,807 effectively decides the non-entitlement ground of opposition based upon s. 16(3)(b) of the Act, I dismiss this ground of opposition.

Non-entitlement pursuant to s. 16(3)(c) of the Act

[43] Despite the onus resting on the Applicant, the Opponent has the initial burden of proving that the alleged trade-names were used prior to the filing date of the application for the Mark and had not been abandoned at the date of its advertisement [s. 16(5) of the Act].

[44] As the Opponent did not file any evidence of use of its alleged trade-names, it has failed to discharge its evidentiary burden. Accordingly, this ground of opposition is dismissed.

Non-distinctiveness

[45] In order to meet its initial burden with respect to this ground of opposition, the Opponent had to show that its alleged trade-marks or trade-names had become known sufficiently as of June 30, 2008 to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.); *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[46] As the Opponent has not filed any evidence that meets its initial burden, this ground of opposition is dismissed.

Non-conformity to s. 30(i) of the Act

[47] Where an applicant has provided the statement required by s. 30(i) of the Act, a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. As there is no such evidence, this ground of opposition is dismissed.

Disposition

[48] Having regard to the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office