

IN THE MATTER OF AN OPPOSITION by Realestate World Services  
(1978) Ltd. to application No. 683,462, for the trade-mark REAL WORLD  
filed by Marvin Steffin

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On June 5, 1991, the applicant, Marvin Steffin, filed an application to register the trade-mark REAL WORLD based on intent to use in Canada in association with the following wares “song material, namely records, C.D.’s and tapes and sales promotional material, namely T-shirts, caps, buttons and programs” and the following services “performing live musical shows, radio shows and tv shows”. The application was advertised for opposition purposes in the Trade-Marks Journal of January 1, 1992, and the opponent, Realestate World Services, filed a statement of opposition on May 1, 1992. The opponent requested and was subsequently granted leave to file an amended statement of opposition on June 22, 1993. The applicant filed an amended application dated December 12, 1994, in which it re-defined the wares as “song material associated with a musical group, namely records, C.D.’s, tapes and sales promotional material associated with the same musical group, namely T-shirts, caps, buttons and programs” and the services as “performing live musical shows, radio shows, and TV shows associated with a musical group”.

The first ground of opposition is that under s.38 (2)(a) of the Trade-Marks Act, R.S.C. 1985 c. T-13 (hereinafter the Act), the application does not comply with the requirements of s.30 in that: i) it does not contain a statement in ordinary commercial terms of the specific wares and services with which the mark is proposed to be used; and ii) the applicant could not have been satisfied at the date of application that it is or was entitled to use the trade-mark in Canada in association with the wares and services described therein in view of the prior extensive use and reputation of the opponent in its family of registered and applied for trade-marks:

| Trade-Mark                    | Registration No.                      |
|-------------------------------|---------------------------------------|
| REALTY WORLD                  | 204,110; 208,226; 257,784 and 319,452 |
| REALTY WORLD &<br>Design      | 204,873; 208,227                      |
| REALSCOPE                     | 206,126                               |
| REALFAX                       | 349,060                               |
| REALINE                       | 349,061                               |
| REALOAN                       | 309,178                               |
| REALNEWS                      | 386,343                               |
| A WORLD OF DIFFERENCE         | 281,545; 326,123                      |
| OUR WORLD REVOLVES AROUND YOU | 293,809                               |

| Trade-Mark  | Registration No.                |
|---|---------------------------------|
| THE RIGHT AGENT MAKES ALL THE DIFFERENCE IN THE WORLD | 387,242                         |
| REALSAFE  | Pending Application No. 683,142 |
| REALSTART   | Pending Application No. 684,467 |
| REALACTION  | Pending Application No. 708,220 |
| REALCOMP  | Pending Application No. 714,330 |

Each of the above listed marks are used in association with real estate and ancillary services.

As its second ground of opposition, the opponent maintains that the trade-mark is not registrable pursuant to s.38(2)(b) and s.12(1)(d) of the Act as it was and is confusing with the registered trade-marks of the opponent listed above. The opponent alleges as its third ground of opposition that the applicant is not the person entitled to registration under s.38(2)(c) and s.16(3)(a) & (b) because the proposed mark was confusing with the opponent's trade-marks REALTY WORLD, REALSCOPE, REALFAX, REALINE, REALOAN, REALNEWS, REALSAFE, A WORLD OF DIFFERENCE, OUR WORLD REVOLVES AROUND YOU, THE RIGHT AGENT MAKES ALL THE DIFFERENCE IN THE WORLD, REALSTART, REALACTION and REAL COMP which have been previously used in Canada by the opponent. As its final ground of opposition, the opponent has claimed that under s.38(2)(d), the applied for trade-mark was and is not able to distinguish the wares and services of the applicant from the services of the opponent in view of the opponent's trade-marks incorporating the words REAL and WORLD.

The applicant filed and served a counterstatement on June 30, 1992, in which it denied the allegations asserted by the opponent in its statement of opposition. As its evidence, the opponent filed the affidavit of Art Breyer on April 8, 1994. The applicant did not file any evidence. Both the opponent and the applicant filed written arguments, and only the opponent was represented at an oral hearing.

With respect to the first ground of opposition, although the material time for considering the circumstances respecting a ground of non-compliance with Section 30 of the Act is as of the applicant's filing date, it has been held that an amendment to the statement of wares or services subsequent to the filing date can satisfy s.30(a) of the Act (see Thomas J. Lipton Inc. v. Ideation Plus (1984) Inc. (1992), 44 C.P.R. (3d) 556 (T.M.O.B.)). In my view, by defining the wares as “song material associated with a musical group, namely records, C.D.’s, tapes and sales promotional material associated with the same musical group, namely T-shirts, caps, buttons and programs” and the services as “performing live musical shows, radio shows, and TV shows associated with a musical group”, the applicant has clearly stated in ordinary commercial terms the specific wares and services with which the mark is proposed to be used under s.30(a) of the Act.

With respect to the ground of opposition pleaded under Section 30(i), the opponent did not allege that the applicant was aware of the opponent's marks. Even if the applicant had been aware of the opponent's trade-marks prior to filing, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the mark in Canada in association with its wares and that its mark is not confusing with other marks. Thus, the success of this ground is contingent upon a finding that the trade-marks at issue are confusing (see Consumer Distributing Co. Ltd. v. Toy World Ltd., 30 C.P.R. (3d) 191 and Sapodilla Co. Ltd. v. Bristol-Myers Co., 15 C.P.R. (2d) 152).

The remaining grounds of opposition under Section 12(1)(d), Section 16(3) and Section 38(2)(d) are also contingent upon a finding of confusion. As the opponent's strongest case would appear to be under Section 12(1)(d), a finding under this ground will effectively decide the other grounds of opposition.

The material time for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to s.12(1)(d) of the Act is the date of my decision (Park Avenue Furniture Corporation v. Wickes/ Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (F.C.A.)). Further, 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 the following specifically set forth in s.6(5) of the Act: a) the inherent distinctiveness of the trade-mark and the extent to which the trade-marks 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. I will review the evidence in light of these criteria and any other surrounding circumstances.

The more relevant of the opponent's trade-marks is the mark REALTY WORLD, registered under no. TMA 204,110, for "the services of real estate brokerage business, such as assessing and selling real estate". Thus, a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the first ground of opposition.

#### **A) the inherent distinctiveness of the trade-mark**

In my view, the opponent's mark is not inherently distinctive since the component REALTY is suggestive of the associated real estate services. The applicant's mark, however, does possess some measure of inherent distinctiveness in that the components REAL and WORLD have no meaning in association with the applicant's wares and services.

The extent to which the trade-marks have become known in Canada favours the opponent. The opponent has evidenced fairly extensive use of its mark REALTY WORLD in association with the registered services. The applicant has based its application on proposed use of the mark in Canada and has not adduced any evidence of use. Therefore, I conclude that the applicant's mark has not become known in Canada.

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

The length of time the trade-marks have been in use also favours the opponent. The Bayer affidavit establishes extensive use in Canada by the opponent of its REALTY WORLD mark in association with real estate services since 1978 while the applicant's application is based on proposed use in Canada.

**C) the nature of the wares, services, or business**

In assessing the issue of confusion under s.12(1)(d), that which is relevant is the applicant's statement of wares and the opponent's registered wares and services covered in the application. In the present case, the applicant's revised application is restricted to the wares "song material associated with a musical group, namely records, C.D.'s, tapes and sales promotional material associated with the same musical group, namely T-shirts, caps, buttons and programs" and the services "performing live musical shows, radio shows, and TV shows associated with a musical group". In my view, the applicant's wares and services associated with a musical group are quite different in nature from the opponent's real estate and ancillary services.

**D) the nature of the trade**

When considering the issue of confusion, the Registrar must have regard to the channels of trade as would normally be considered by the average consumer as being associated with those wares and services. In the present case, the opponent claims that a musical group trade-mark may have as its primary purpose the promotion of the real estate services of a competitor of the opponent. I disagree. In my view, the channels of trade are so different that the average purchaser would not associate the mark REALTY WORLD for real estate services with the mark REAL WORLD for the wares and services of a musical group. Further, I am not convinced that the average consumer would expect a musical group to perform promotional services for a real

estate agency.

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

The applicant's trade-mark is quite similar in appearance and sounding to the opponent's trade-mark. However, I find that the ideas suggested by the marks are different. In my view, the primary idea suggested by the mark REALTY WORLD is a place or business associated with real property or real estate. On the other hand, the applicant's mark REAL WORLD suggests a type of place where activities and/or people are actual or authentic.

As a further surrounding circumstance, I have considered the use of the opponent's other marks in association with real-estate and ancillary services. I am able to conclude to some extent that Canadians have been conditioned to associate REAL-prefixed marks for real estate services with the opponent's licensees. However, the fact that the applicant's mark will not be used in association with real estate services decreases the likelihood of confusion between the marks at issue in my view.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Having regard to the absence of any similarity in the wares, services or businesses of the parties or in the channels of trade associated with them, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's trade-mark.

In view of the above, I reject the opponent's opposition pursuant to s.38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 11<sup>th</sup> DAY OF JULY 1996.

Cindy R. Vandenakker  
Hearing Officer  
Trade-Marks Opposition Board