

**IN THE MATTER OF AN OPPOSITION by Gold Club Travel
Limited to application No. 704,006 for the trade-mark TD GOLD
TRAVEL CLUB filed by The Toronto-Dominion Bank**

On April 29, 1992, the applicant, The Toronto-Dominion Bank, filed an application to register the trade-mark TD GOLD TRAVEL CLUB based on proposed use in association with "travel services". The applicant later filed an amended application in which it disclaimed the right to the exclusive use of the words TRAVEL and CLUB apart from its trade-mark.

The application was advertised for opposition purposes in the *Trade-marks Journal* of March 3, 1993 and the opponent, Gold Club Travel Limited, filed a statement of opposition on April 2, 1993 which was objected to by the Opposition Board as not being in compliance with Section 38 (3)(a) of the *Trade-marks Act*. The opponent therefore submitted a revised statement of opposition on June 25, 1993, a copy of which was forwarded to the applicant on July 21, 1993.

The first ground of opposition is that the trade-mark TD GOLD TRAVEL CLUB is not distinctive within the meaning of Section 2 of the *Trade-marks Act* as it is confusing with the opponent's trade-name which has been widely used and made known in Canada. The second ground of opposition is based on Section 16(3) of the Act, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark TD GOLD TRAVEL CLUB in that the opponent has used the trade-names "Gold Club" and "Gold Club Travel Limited" since at least March 1, 1982 in association with a variety of travel agency services. As its third ground of opposition, the opponent alleged that the applicant's application does not comply with Section 30 of the Act as the applicant knew, or should have known, of the opponent's prior use of its trade-name as of the filing date of the present application. The fourth ground is that the applicant is not the person entitled to registration in view of Section 16(3) of the *Trade-marks Act* in that, as of the filing date of the present application, the trade-mark TD GOLD TRAVEL CLUB was confusing with the opponent's trade-name and its GOLD CLUB trade-marks as applied to various travel related services for which applications had been previously filed in Canada on March 23, 1992 under Serial Nos. 701,315 and 701,316. As its fifth ground of opposition, the opponent alleged that the applicant's trade-mark is

not registrable pursuant to Section 12(1)(e) of the *Trade-marks Act* as it does not comply with Section 10 of the Act.

The opponent submitted as its evidence the affidavit of its President, Charles Baptist-Smith, while the applicant filed certified copies of 36 trade-marks registrations, together with the affidavits of Suzanne Deuel, National Marketing Manager for TD Visa cards and Carol Luciani, a trade-mark searcher. The applicant alone filed a written argument and no oral hearing was conducted.

Section 38(3)(a) of the *Trade-marks Act* requires that an opponent set out its grounds of opposition in sufficient detail to enable the applicant to reply thereto. As the opponent has not set out any material facts in support of its Section 12(1)(e) ground of opposition, that ground is contrary to Section 38(3)(a) of the *Trade-marks Act*. In any event, no evidence has been adduced by the opponent in support of that ground. Accordingly, I have dismissed the fifth ground.

The material date for considering the non-entitlement grounds of opposition is the filing date of the present application [April 29, 1992]. According to the Baptist-Smith affidavit, the opponent has been providing travel related services principally to exclusive Caribbean resorts to consumers in Ontario since 1982. However, Mr. Baptist-Smith has not provided any details as to the manner in which the opponent's trade-name has been associated with its business activities since that time. Further, while Mr. Baptist-Smith states that at least two price lists and a brochure of his company's current destinations and resorts are prepared annually, he does not provide evidence of the manner in which his company's trade-name is associated with the brochures and price lists. Rather, the affiant has annexed to his affidavit a "1993" brochure and a "SUMMER 1993" price list relating to the resorts described in the brochure, together with photocopies of two "recent" advertisements which are not identified as to date or the publication in which they appeared. Having regard to the deficiencies in the opponent's evidence, I find that the opponent has failed to establish its use of its trade-name(s) prior to the applicant's filing date [April 29, 1992]. As a result, the opponent has failed to meet the burden upon it in respect of the second ground of opposition which I have therefore rejected.

As its third ground, the opponent alleged that the present application does not comply with

Section 30 of the *Trade-marks Act* as the applicant knew or should have known of the opponent's prior use of its trade-name at the time of filing its application. The onus or legal burden is on the applicant to show compliance with the provisions of Section 30 of the Act [see *Joseph Seagram & Sons v. Seagram Real Estate*, 3 C.P.R.(3d) 325, at pp 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293]. There is, however, an initial evidential burden on the opponent respecting its allegations of fact in support of that ground. As no evidence has been filed by the opponent in support of its allegations that the applicant could not have been satisfied that it was entitled to use the trade-mark TD GOLD TRAVEL CLUB in Canada, it has failed to meet the evidentiary burden upon it in respect of this ground. In any event, and even had the applicant been aware of the opponent's trade-name prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark TD GOLD TRAVEL CLUB in Canada on the basis *inter alia* that its mark is not confusing with the opponent's trade-name [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at pg. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at pg. 155].

The material date for considering the first ground of opposition relating to the alleged non-distinctiveness of the applicant's trade-mark is the date of opposition [April 2, 1993]. However, as discussed above, the opponent has not demonstrated any use of its trade-name prior to 1993 and, while the opponent adduced some evidence of use of the trade-name in 1993, it is not clear when in 1993 such use of the trade-name occurred. Accordingly, the opponent has failed to meet the evidential burden upon it in respect of this ground which is also rejected.

The fourth and final ground of opposition is that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the trade-mark TD GOLD TRAVEL CLUB was confusing with the opponent's earlier filed applications for registration of the trade-marks GOLD CLUB (application No. 701,315) and GOLD CLUB & Design (application No. 701,316). Both applications were filed [March 23, 1992] prior to the filing date of the present application [April 29, 1992] and both were pending at the date of advertisement of the subject application [March 3, 1993]. As a result, the opponent has met the burden upon it under Section 16(4) of the *Trade-marks Act*.

Accordingly, this ground of opposition remains to be decided on the issue of confusion between the applicant's trade-mark TD GOLD TRAVEL CLUB and one or both of the opponent's GOLD CLUB trade-marks covered in its applications. In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark TD GOLD TRAVEL CLUB and the opponent's trade-marks GOLD CLUB and GOLD CLUB & Design, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

6 (5)(a): Inherent distinctiveness of the trade-marks or trade names including the extent to which they have become known:

The opponent's trade-marks GOLD CLUB and GOLD CLUB & Design possess a minor degree of inherent distinctiveness when considered in their entirety even though they are composed of words which individually possess relatively little inherent distinctiveness as applied to travel related services. In particular, the word GOLD is somewhat laudatory of the quality of the opponent's travel services while the word CLUB is descriptive of the entity providing travel services to its members. Moreover, the state of the register evidence shows that there are a fairly significant number of trade-marks on the register including the words GOLD and CLUB as applied to such services, thus confirming that these marks are not entitled to a broad ambit of protection. In this regard, the Luciani affidavit points to the existence of twenty-two registered trade-marks which include the word GOLD and eighty-one registered trade-marks which include the word CLUB, all for use in association with travel related services. State of the register evidence has been held to be relevant only insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.*, 41 C.P.R.(3d) 432; and *Del Monte Corporation v. Welch Foods Inc.*, 44 C.P.R.(3d) 205]. Further, the decision of the Federal Court of Appeal in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.*, 43 C.P.R.(3d) 349 supports the proposition that inferences concerning the state of the marketplace can be drawn from state of the register evidence where large numbers of relevant registrations are located. In the present case, I have inferred that at least some of the trade-marks disclosed by the state of the register searches are in use in the marketplace.

The applicant's trade-mark is also composed of elements which individually possess little inherent distinctiveness. In addition to the words GOLD and CLUB, the word TRAVEL is descriptive of travel services and the initials TD add little inherent distinctiveness to the applicant's mark. However, the applicant has evidenced the existence of thirty-six registered trade-marks standing in its name all of which include the letters TD and the Deuel affidavit shows use of a number of the applicant's TD marks. This evidence supports the applicant's position that it has a family of TD trade-marks and that the letters TD serve as an identifier of its services.

The Baptist-Smith affidavit fails to establish that the opponent's trade-marks have become known or have even been used to any measurable extent in Canada. On the other hand, the Deuel affidavit attests to relatively extensive use by the applicant of its trade-mark TD GOLD TRAVEL CARD. However, such use occurred between May of 1992 and April of 1994 and therefore subsequent to the material date for considering the fourth ground of opposition. Thus, I find that the extent to which the trade-marks at issue have become known does not weigh in favour of either party in this opposition.

6(5)(b): The length of time the trade-marks or trade name have been in use

As noted above, the opponent has not demonstrated any measurable use of its trade-marks or trade-name prior to 1993 and only limited use of its trade-marks and name since that time. Furthermore, the applicant has not evidenced use of its proposed use trade-mark prior to May of 1992. As a result, the length of use of the trade-marks at issue does not favour either party in this opposition.

6(5)(c) and (d): The nature of the services and the nature of the trade

In view of the Federal Court of Appeal decisions in *Mr. Submarine Ltd. v. Amandista Ltd.*, 19 C.P.R.(3d) 3, at pp. 10-11 and *Miss Universe, Inc. v. Dale Bohna*, 58 C.P.R.(3d) 381, at pp. 390-392, it is the services listed in the applications which govern. As the present application and the opponent's applications cover travel services, the fact that applicant is a bank which offers a package of travel services by mail exclusively to its select Visa cardholders is of little relevance when

assessing the issue of confusion in relation to a Section 16(3)(b) ground of opposition. Thus, the services and the respective channels of trade of the parties must be considered as overlapping in this instance.

6(5)(e): The degree of resemblance between the marks

The applicant's trade-mark TD GOLD TRAVEL CLUB and the opponent's trade-marks GOLD CLUB and GOLD CLUB & Design are similar in appearance, in sounding, and in the ideas suggested by them.

As noted above, the common elements of the trade-marks at issue are the words GOLD and CLUB which are fairly common in the travel services field. Moreover, the applicant's trade-mark is prefaced by the letters TD which serve to distinguish the applicant's travel services from the opponent's GOLD CLUB travel services. Consequently, I do not consider that the degree of resemblance between the trade-marks is such that the average consumer of travel services would believe that the services emanate from the same source. I have therefore concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark TD GOLD TRAVEL CLUB and the opponent's trade-marks GOLD CLUB and GOLD CLUB & Design. I have rejected this ground of opposition

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to the provisions of Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC this 4th day of December, 1996.

G.W. Partington
Chairman
Trade-marks Opposition Board