



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

Citation: 2012 TMOB 149
Date of Decision: 2012-08-03

**IN THE MATTER OF AN OPPOSITION
by Gideons International in Canada to
application No. 1,470,622 for the trade-
mark tgiGlobal in the name of tgiGlobal**

[1] On February 23, 2010, tgiGlobal (the Applicant) filed an application to register the trade-mark tgiGlobal (the Mark). The application is based on proposed use of the Mark in Canada in association with the following wares and services:

Wares: bibles, testaments, magazines.

Services: dissemination of bibles, testaments, and literature to individuals, hotels, schools, universities, colleges, hospitals, penal institutions, armed forces, medical personnel, motels, airplanes, trains, steamships, attorney offices, retirement homes, assisted living facilities, and nursing homes.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 4, 2010.

[3] Gideons International in Canada (the Opponent) filed a statement of opposition on December 9, 2010. Further to preliminary objections raised by the Registrar with respect to the original statement of opposition, the Opponent filed an amended statement of opposition on January 19, 2011. The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(a), (c) and (d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[4] The Applicant filed and served a counter statement. Both the Opponent and the Applicant elected to file no evidence. Only the Applicant filed a written argument. An oral hearing was not held.

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[5] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 288].

Material Dates

[6] The material dates with respect to the grounds of opposition are as follows:

- sections 38(2)(a)/30(i) – the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- sections 38(2)(c)/16(3)(a) and (c) – the filing date of the application; and
- sections 38(2)(d)/2– the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Analysis of the Grounds of Opposition

[7] The allegation of prior use or making known of the Opponent's trade-mark TGI does not raise a proper ground of opposition pursuant to section 16(3)(c) of the Act. Therefore, I dismiss the non-entitlement ground of opposition based upon section 16(3)(c) of the Act for having been improperly pleaded. Alternatively, I dismiss the ground of opposition on the basis that the Opponent has not met its initial burden to show that it had used the trade-name TGI in Canada prior to February 23, 2010.

[8] For the reasons set out below, I am dismissing each of the other grounds of opposition on the basis that the Opponent has not met its initial burden in respect thereof.

[9] Where an applicant has provided the statement required by section 30(i) of the Act, a section 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 CPR (2d) 152 (TMOB) at 155]; there is no such evidence here.

[10] In order to meet its initial burden in support of the non-entitlement ground of opposition based upon section 16(3)(a) of the Act, the Opponent was required to show that its trade-mark TGI had been used or made known in Canada prior to February 23, 2010; it has not done so.

[11] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that its trade-mark TGI was known to some extent at least as of December 9, 2010 [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]; it has not done so.

Disposition

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

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