

**IN THE MATTER OF AN OPPOSITION  
by Universal City Studios, Inc.; Universal  
Studios Canada Ltd. and Universal Concerts,  
a Partnership to application No. 839,145 for the  
trade-mark UNIVERSAL CONCERTS filed by  
Brad Brickner, trading as Universal Concerts**

**On March 12, 1997, the applicant, Brad Brickner, trading as Universal Concerts, filed an application to register the trade-mark UNIVERSAL CONCERTS based on proposed use in Canada. The applicant amended his application to include a disclaimer to the word CONCERTS and the application was advertised for opposition purposes on March 4, 1998.**

**The application as advertised covers the following services:**

promote the attendance of people at all types of concerts, namely arranging for concert performances by various musical artists and groups at venues across Canada, concert promotion by way of arranging radio, television and newspaper advertising, arranging for corporate sponsors for concerts, and soliciting travel services suppliers for the assembling of tour packages which include transportation, accommodation and concert tickets.

**The opponents, Universal City Studios, Inc. (“Universal City”); Universal Studios Canada Ltd. (“Universal Canada”) and Universal Concerts, a Partnership (“Universal Concerts”), filed a statement of opposition on August 4, 1998, a copy of which was forwarded to the applicant on August 27, 1998. The statement of opposition contains ten grounds of opposition. One of them is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Trade-marks Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the trade-mark UNIVERSAL CONCERTS previously used in Canada by the opponent Universal Concerts for the identical services covered by the applicant’s application. Another ground is that the applied for trade-mark is not distinctive**

**in view of the use of the trade-marks and trade-names UNIVERSAL, UNIVERSAL STUDIOS, UNIVERSAL STUDIOS CANADA LTD. and UNIVERSAL CONCERTS by the opponents.**

**The applicant filed and served a counter statement. As their evidence, the opponents submitted an affidavit of Chris HARRIS, the Vice President of Business Affairs of Universal Canada. The applicant chose not to submit evidence. Only the opponents filed a written argument and no oral hearing was conducted.**

**In his affidavit, Mr. HARRIS describes the businesses and interrelationships of the three opponents. Universal City is a diversified entertainment company which is involved in the production and distribution of movies and television shows, the operation of theme parks and the creation, manufacture, distribution and sale of audio recordings. It owns a number of trade-mark registrations in Canada for trade-marks comprising or including the word UNIVERSAL, primarily for motion pictures.**

**Universal Canada is an affiliate of Universal City and has been licensed by Universal City to use the family of UNIVERSAL trade-marks in Canada. Universal Canada operates an audio record division and, over the years, has effected billions of dollars of sales. More recently (i.e. - since December 9, 1996), Universal Canada has operated that division under the name Universal Music. Universal Canada, through its film division, has also distributed thousands of films in Canada and has displayed one or more UNIVERSAL trade-marks or trade-names in the advertisement and performance of those distribution services. Universal Canada has also distributed television shows in Canada in association with one or more of the**

**UNIVERSAL marks and names.**

**Universal Concerts is a two-member partnership, one of the partners being Universal Canada. Universal Concerts is in the business of organizing, promoting and managing concerts at Canadian venues in association with the trade-marks and trade-names UNIVERSAL, UNIVERSAL CONCERTS and UNIVERSAL CONCERTS CANADA. Those marks and names are used under license from Universal City with its agent, Universal Canada, exercising control over the character or quality of the services performed by Universal Concerts.**

**Universal Concerts has been conducting its business since December 9, 1996. Various exhibits to the Hars affidavit illustrate the manner in which Universal Concerts displays the trade-marks or trade-names UNIVERSAL, UNIVERSAL CONCERTS and UNIVERSAL CONCERTS CANADA in the performance of its concert-related services. Revenues generated by those services in the four month period prior to the applicant's filing date exceeded \$10 million. Exhibit P comprises a number of newspaper ads for concerts featuring one of the trade-marks or trade-names UNIVERSAL, UNIVERSAL CONCERTS and UNIVERSAL CONCERTS CANADA. Some of those ads predate the applicant's filing date.**

**As for the ground of opposition based on Section 16(3)(a) of the Act, the opponents have evidenced use of the trade-mark UNIVERSAL CONCERTS for concert-related services prior to the applicant's filing date. Furthermore, the evidence shows that this mark was not abandoned as of the applicant's advertisement date. Thus, this ground remains to be decided**

**on the issue of confusion between the marks at issue.**

**The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the two marks. Furthermore, the material time for considering the circumstances respecting this issue is as of the applicant's filing date (i.e. - March 12, 1997) in accordance with the wording of Section 16(3) of the Act. Finally, in applying the test for confusion set out in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set out in Section 6(5) of the Act.**

**As for Section 6(5)(a) of the Act, the trade-mark UNIVERSAL CONCERTS is inherently distinctive in relation to the services of the applicant and the opponent Universal Concerts. However, the component CONCERTS is descriptive of those services and the component UNIVERSAL is slightly laudatory since it suggests that the services are available everywhere. Thus, the mark is not an inherently strong mark.**

**Since the applicant failed to submit evidence, I must conclude that his mark had not become known at all in Canada as of the material time. As of that date, the opponents' mark had only been used for several months. Thus, I am only able to conclude that it had become known to some extent in Canada.**

**The length of time the marks have been in use is not a significant circumstance in the present case. As for Sections 6(5)(c) and 6(5)(d) of the Act, the services of the parties are virtually identical. Thus, I must conclude that the trades of the parties would be very similar.**

As for Section 6(5)(e) of the Act, the marks are identical in all respects.

As an additional surrounding circumstance, I have considered the extensive use of the related marks UNIVERSAL, UNIVERSAL STUDIOS, UNIVERSAL RECORDS, UNIVERSAL MUSIC and the like by Universal Canada under license from Universal City. In accordance with the decision in McDonald's Corp. v. Yogi Yogurt Ltd. (1982), 66 C.P.R.(2d) 101 (F.C.T.D.), the opponent Universal City has established a family or series of UNIVERSAL marks in the entertainment industry. This fact increases the likelihood that consumers would assume that the applicant's proposed mark is associated with one of the opponents or their affiliated or related companies.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the high degree of resemblance between the marks, services and trades of the parties, I find that the applicant has failed to satisfy the onus on him to show that his proposed mark was not confusing with the previously used trade-mark UNIVERSAL CONCERTS. Thus, the ground of prior entitlement based on the mark UNIVERSAL CONCERTS is successful.

As for the ground of non-distinctiveness, the onus or legal burden is on the applicant to show that his mark is adapted to distinguish or actually distinguishes his services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - August 4, 1998):

see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).

As of the filing of the opposition, the evidence establishes that the trade-mark UNIVERSAL CONCERTS had acquired a greater reputation across Canada than it had as of the applicant's filing date. Likewise, the other UNIVERSAL trade-marks and trade-names had further solidified their reputations in Canada in the movie, television and music industries. Thus, my conclusions respecting the issue of confusion regarding the prior entitlement ground apply with even greater force respecting the ground of non-distinctiveness. The non-distinctiveness ground is therefore also successful and the remaining grounds of opposition need not be considered.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT GATINEAU, QUEBEC, THIS 30<sup>th</sup> DAY OF APRIL, 2002.

David J. Martin,  
Member,  
Trade Marks Opposition Board.