



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

Citation: 2011 TMOB 123
Date of Decision: 2011-07-18

**IN THE MATTER OF AN OPPOSITION
by Missionfest Manitoba Inc.;
MissionFest Toronto; Missions Festival
(Missions fest) Society-Edmonton
(operating as Missions Fest Alberta);
Jesus to the Nations Association and
Missions en fête to application
No. 1,240,779 for the trade-mark
MISSIONS FEST in the name of Missions
Fest International Association**

[1] On December 15, 2004, Missions Festival (Missions Fest) Society (the Original Applicant) filed an application to register the trade-mark MISSIONS FEST (the Mark). The right to the exclusive use of the word FEST has been disclaimed apart from the trade-mark.

[2] The application is based on use in association with a number of wares and services, as follows:

wares:

- (1) Pre-recorded audio cassettes and printed matter namely brochures all in the field of religion based on use in Canada since at least as early as January 1984.
- (2) Pre-recorded video cassettes in the field of religion based on use in Canada since at least as early as January 1986.
- (3) Printed publications namely magazines in the field of religion based on use in Canada since at least as early as January 1988.
- (4) Printed publications namely newsletters in the field of religion based on use in Canada since at least as early as February 1991.

(5) Printed publications namely newspapers in the field of religion based on use in Canada since at least as early as February 2001.

(6) Pre-recorded CD-Roms and DVDs featuring information in the field of religion based on use in Canada since at least as early as January 2004.

services:

(1) Charitable fundraising services; International personnel recruiting services in the field of religion; Educational conferences, seminars and workshops all in the field of religion based on use in Canada since at least as early as January 1984.

(2) Seminars for church leaders based on use in Canada since at least as early as October 1993.

(3) Youth rallies in the field of religion based on use in Canada since at least as early as October 1999.

[3] On September 12, 2006, an assignment was recorded in favour of Missions Fest International Association (the Applicant).

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 2, 2007.

[5] On October 2, 2007, Missionfest Manitoba Inc.; MissionFest Toronto; Missions Festival (Missions fest) Society-Edmonton (operating as Missions Fest Alberta); Jesus to the Nations Association and Missions en fête (collectively the Joint Opponents) 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. 38(2)(b)/12(1)(b): the Mark is not registrable because it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares and/or services covered by the application;

2. s. 38(2)(c)/16(1)(a): the Applicant is not the person entitled to registration of the Mark because at the claimed dates of first use the Mark was confusing with one or both of the trade-marks MISSIONFEST and/or MISSIONSFEST, which had been previously used in Canada by one or more of the Joint Opponents in association with a wide range of wares including print and electronic publications in the field of religion and a wide range of services including charitable fundraising services,

personnel and volunteer recruiting services in the field of religion, educational conferences, seminars and workshops all in the field of religion, seminars for church leaders and youth rallies in the field of religion;

3. s. 38(2)(c)/16(1)(c): the Applicant is not the person entitled to registration of the Mark because at the claimed dates of first use the Mark was confusing with one or more of the trade-names MISSIONFEST, MISSIONSFEST, Missionfest Manitoba Inc., Missionfest Manitoba, MissionFest Toronto, Missions Festival (Missions fest) Society-Edmonton (operating as Missions Fest Alberta), Missions en fête which had been previously used in Canada by one or more of the Joint Opponents in association with a wide range of wares including print and electronic publications in the field of religion and a wide range of services including charitable fundraising services, personnel and volunteer recruiting services in the field of religion, educational conferences, seminars and workshops all in the field of religion, seminars for church leaders and youth rallies in the field of religion;

4. s. 38(2)(d): the Mark is not distinctive because it does not distinguish and is not adapted to distinguish the wares and services of the Applicant from the wares and services of others, including each of the Joint Opponents.

[6] The Applicant filed and served a counter statement in which it denied the Joint Opponents' allegations.

[7] Pursuant to r. 41 of the *Trade-marks Regulations*, the Joint Opponents filed an affidavit of Gordon Gilbey, sworn May 21, 2008. Mr. Gilbey is Executive Director of Missionfest Manitoba Inc.

[8] Pursuant to r. 42, the Applicant filed the affidavits of Richard Dodding and Dulce Campos, both sworn December 23, 2008. Mr. Dodding is the Applicant's Chief Executive Officer and a founder and past Chief Executive Officer of the Original Applicant. Ms. Campos is a trade-mark researcher.

[9] In order to correct a typographical error, the Applicant obtained leave pursuant to r. 44(1) to file a further affidavit of Richard Dodding, sworn February 11, 2009.

[10] Pursuant to r. 43, the Joint Opponents filed as reply evidence a second affidavit of Gordon Gilbey, sworn May 21, 2009. I agree with the Applicant that those portions of the reply evidence that detail conversations that Mr. Gilbey had with representatives of the other opponents are not admissible for the truth of their contents.

[11] No cross-examinations were conducted.

[12] Both parties filed a written argument. An oral hearing was not requested.

Onus and Material Dates

[13] 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 Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

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

- s. 38(2)(b)/12(1)(b) - the filing date of the application [see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.)];
- s. 38(2)(c)/16(1)(a)/(c) - the dates of first use claimed in the application;
- s. 38(2)(d) - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 16 Grounds of Opposition

[15] The s. 16 grounds of opposition are dismissed because the Joint Opponents have not met their initial onus in regard thereto; there is no evidence that any of the Joint Opponents used the pleaded marks or names prior to the Applicant's first use.

Distinctiveness

[16] It is not contested that the various Joint Opponents have been using MISSIONS FEST, or variations thereof, in Canada. What is contested is whether the Applicant controlled such use pursuant to an unwritten license. Although the parties have not referred to s. 50 of the Act, I must decide if the facts result in the Joint Opponents' use accruing to the benefit of the Applicant pursuant to s. 50. If they do, then the distinctiveness ground of opposition cannot succeed.

[17] Section 50 reads:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

[18] Section 50(2) does not apply to the present case. Section 50(1) sets out two requirements: that there be a license; and that pursuant to that license, the licensor controls the character or quality of the licensed wares or services.

[19] I will focus my analysis on the use of MISSIONS FEST by the single opponent Missionfest Manitoba Inc. (MF Manitoba) because this is the only opponent who has filed evidence concerning its use. There is some evidence concerning use by the remaining opponents, filed either by the Applicant or by the Executive Director of MF Manitoba, but the Joint Opponents' strongest case is based on MF Manitoba's use.

[20] MF Manitoba has actually been using MISSIONFEST, not MISSIONS FEST, but the differences between MISSIONFEST and MISSIONS FEST are so minor that they may be considered to be one and the same trade-mark [see Principle 2 of *Nightingale Interloc Ltd. v.*

Prodesign Ltd. (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)). I will use MISSIONS FEST and MISSIONFEST interchangeably below.

[21] The evidence makes it clear that MISSIONS FEST was used by the Original Applicant prior to the first use of those words by any of the Joint Opponents. The parties agree that the Joint Opponents adopted the use of MISSIONS FEST with the Original Applicant's knowledge and co-operation, but they do not agree that such use was under the license and control of the Applicant. I must therefore assess the facts on this point. A summary of the use of MISSIONS FEST by the Applicant and MF Manitoba follows.

[22] There is some evidence that historically others have used the words "mission fest", "mission festival" and the like in the United States or Germany as well as a reference to a three day Missionfest held in Nova Scotia around 1982 [see Exhibit D of first Gilbey affidavit; paragraphs 10-11 and Exhibits F and G of second Gilbey affidavit]. However, the evidence of the Applicant is that its first MISSIONS FEST conference took place in January, 1984 in Burnaby, British Columbia [see Exhibit 4, Dodding affidavit]. As the Original Applicant was incorporated January 21, 1987 [Exhibit 1], the application for the Mark refers to a predecessor-in-title, Missions Fest (a partnership). Mr. Dodding states in paragraph 1: "Prior to incorporation, we operated as a partnership using the tradename Missions Fest from February, 1983 to January 1987." He does not say who "we" are, but he does say, in paragraph 6: "The vision to develop MISSIONS FEST was borne by a small church missions committee, of which I was a member, in Burnaby, British Columbia." He does not identify what church this committee belonged to, but he does say: "The committee sent an invitation to local churches, representing a variety of denominational backgrounds, to consider working together to plan a 'world missions' conference... Since at least as early as February 1983, eight churches began working together to plan the first MISSIONS FEST conference to take place during the third week of January, 1984."

[23] Mr. Dodding explains that the conference was first perceived as a means to inform church congregations about "world missions" and consisted "of a panel of plenary speakers involved in mission organizations worldwide, educational seminars, exhibitors from mission agencies around the world, cultural entertainment and food." [paragraph 6, Dodding affidavit]

[24] MISSIONS FEST conferences have taken place annually in British Columbia in the Vancouver area since 1984. Mr. Dodding attests at paragraph 2 that, as CEO, he was responsible for overseeing all aspects of the planning and execution of MISSIONS FEST conferences from 1984 to 2007.

[25] Paragraph 14 of Mr. Dodding's affidavit reads:

As the MISSIONS FEST conference developed over the years and the reputation grew, we began receiving inquiries from other church organizations with respect to developing MISSIONS FEST conferences in other cities in Canada. I also began to contact other church organizations with whom I was acquainted to initiate discussions with them to hold MISSIONS FEST conferences. To date, Missions Fest Vancouver has assisted the following Canadian cities to develop MISSIONS FEST conferences and it has given these cities permission to use the MISSIONS FEST trade-mark: (a) Winnipeg, Manitoba; (b) Edmonton, Alberta; (c) Toronto, Ontario; (d) Montreal, Quebec; (e) Halifax, Nova Scotia.

[26] The first Winnipeg MISSIONFEST conference took place in 1989 [see paragraph 4 and Exhibit A, first Gilbey affidavit].

[27] Exhibit 8 to Mr. Dodding's affidavit is a copy of his letter dated April 7, 1988 to the chairman of the Winnipeg committee. I reproduce below certain portions of that letter:

It was good to hear from you this week and to hear that you are planning toward next January for your Missions Fest conference.

In giving you a reply to your question, "May we use our Missions fest logo?", I gave you some general principles to follow over the phone if you are to use it. After speaking with Dave Mannings, we felt it wise to put something in writing for the records.

First of all, you should know that "Missions Fest" is a registered name and our logo is copyrighted. So, it is important to know that ahead of time. I am sure that I am speaking on behalf of the Directors when I say that we would be pleased to know that every province across Canada had a Missions Fest to which their people could attend. We would be happy to assist in whatever way we can.

When thinking of assistance, one could think of several practical things we could do...

However, I know that there are some general guidelines that we would appreciate your following if you were to use our resources so that when we heard of

“Missions Fest” in your province, it would have the same vision as the first one that started here in Vancouver. When saying that, I realize that each province has its own distinctives [sic] and each conference would still be unique.

Here are some of the guidelines we would ask you to follow if you plan to identify with our name and style of conference:

...

Please give this your consideration and let us know your response. I will look forward to hearing from you.

[28] There is no evidence of what MF Manitoba’s response was to that letter. Although the Applicant’s MISSIONS FEST Logo appears on MF Manitoba’s letterhead in 1990 [Exhibit 10, Dodding affidavit], it does not appear on any of the subsequent materials used by MF Manitoba that are in evidence [see for example materials dated 1992 and onward in first Gilbey affidavit]. I am assuming that the registration for “Missions Fest” referred to in Mr. Dodding’s letter was some sort of business registration. I further note that MF Manitoba has evidenced that effective January 1, 1989, MF Manitoba was registered as a charity under the name “Mission Fest” [see paragraph 4 and Exhibit A, first Gilbey affidavit].

[29] MF Manitoba has held MISSIONFEST conferences in Winnipeg every two years from 1989 to 2004 and annually since 2004 [paragraph 4, first Gilbey affidavit].

[30] On September 9, 2004, the Original Applicant obtained a trade-mark registration for its MISSIONS FEST Logo [see Exhibit 3 of Dodding affidavit]. That mark is shown below:



[31] On July 18, 2006, the Applicant was incorporated and the Original Applicant assigned its MISSIONS FEST Logo and the Mark to the Applicant on August 6, 2006. It is not clear to me if it is the Original Applicant or the Applicant who has subsequently used those marks in association with the conferences held in Vancouver.

[32] The Applicant/Original Applicant and the leaders of the various city organization groups have met annually “to share information and address any particular concerns that any group members are having in the development of the MISSIONS FEST conferences” from 1999 to 2008 [see paragraph 15, Dodding affidavit].

[33] At least as early as 2005, the Original Applicant began to be concerned that the other city groups were making changes to the appearance or content of their conferences. As noted above, in 2004, the Original Applicant obtained a trade-mark registration for MISSIONS FEST & Design. In 2005, the Original Applicant orally informed the other city groups that they would have to enter into formal license agreements in order to protect the distinctiveness of the mark, taking the position that the local groups had been previously using MISSIONS FEST under a verbal agreement. (A copy of the proposed formal license agreement has not been filed in evidence.) By letter dated July 17, 2006, the other city groups declined to sign a formal license agreement, stating that they had each been operating independently for many years and advising that they did not believe that they should be bound in any way to follow another’s guideline or policy; instead, they wanted “to continue to assist, encourage and pray for one another, and to share our experiences, internal policies and best practices in a collegial take-it-or-leave-it manner” [see Exhibit A, second Gilbey affidavit]. On September 25, 2006, the Chair of the Board of Directors of the Original Applicant wrote many, if not all, of the other city groups, informing them that if they did not sign the license agreement, then they would have to change the name of their conference without delay [see Exhibits 15, 20, 25, Dodding affidavit]; I note that the letter also says that the purpose of a license agreement is not to impose control. There is no evidence of further correspondence concerning a license, but there is evidence that MF Manitoba’s use of MISSIONFEST was continuing in 2008 in the absence of a signed license [see Exhibit A, first Gilbey affidavit; paragraph 5, second Gilbey affidavit].

[34] It seems to me that an unfortunate situation has arisen. The parties have worked together amicably for a number of years towards a commonly shared altruistic goal. Although the Original Applicant may have been the first among the group to use MISSIONS FEST, it not only allowed but encouraged others to use those words for many years. The Applicant argues that all such use was pursuant to an oral license agreement but that is not clear from the evidence.

[35] The facts as I understand them do not amount to the Applicant having had control of the character or quality of the various opponent's wares or services. Instead, it appears that the various opponents were encouraged to follow certain leads of the Applicant, but they were not obliged to. In 2005, the Original Applicant appears to have concluded that a different approach was required; when it articulated this to the other city groups, it was rebuffed, resulting in the "demand letter" of September 25, 2006. I am inclined to think that just because the Original Applicant thought (either at the time or retroactively) that it was giving the other city groups a license, a license cannot be a one way street i.e. if the various opponents were unaware that the use of MISSIONS FEST was subject to certain terms, then they might legitimately not be of the view that they had entered into any oral agreement, especially with respect to the use of words that apparently do have some history in the religious world as indicating a certain sort of gathering. It is true that the Original Applicant shared its approach for running a successful conference, but that does not necessarily amount to a trade-mark license.

[36] Overall, I am unable to conclude that there was an enforceable license between the parties, nor that the Applicant/Original Applicant controlled the character or quality of MF Manitoba's use of the Mark pursuant to any such license. In this regard, I emphasize that the Applicant bears the legal burden.

[37] It is perhaps interesting to note that in 1994 the Original Applicant wrote the then-fledgling Toronto group to inform them that the name that the Original Applicant had maintained was "Missions Fest", with the word "Missions" plural and separate from "Fest" [see Exhibit 21, Dodding affidavit]. There is no evidence that the Original Applicant similarly advised MF Manitoba. Moreover, I note that according to the materials before me, both the Toronto and Winnipeg groups continued to use "MISSIONFEST". I mention this, not because MISSIONS FEST and MISSIONFEST differ significantly, but because it perhaps underlines that the various city groups did not feel obliged to conform to the Applicant's approach. Mr. Dodding again wrote the Toronto group about the spelling of the name in 1995 [see Exhibit 23] but, as evidenced by the materials in Exhibit B of the first Gilbey affidavit, the Toronto group used Missionfest and MissionFest in 1999 and 2000, not MISSIONS FEST.

[38] Ultimately the issue is whether the Applicant should be granted the monopoly to use the words MISSIONS FEST, including slight variations thereto, across Canada in association with what might be described as a conference or festival promoting religious missions. This is not a monopoly that should be lightly granted, which is why there is an onus on the Applicant to demonstrate that the Mark is distinctive of only a single source, namely the Applicant. As of the material date, MF Manitoba had been using a slight variation of the Mark for 18 years. I cannot conclude based on the evidence before me that such use accrued to the benefit of the Applicant or its predecessor under s. 50. Therefore I find that the Applicant has failed to meet the legal onus on it to satisfy me on a balance of probabilities that the Mark was distinctive of the Applicant's wares and services as of the material date. The distinctiveness ground of opposition therefore succeeds.

Descriptiveness Ground of Opposition

[39] As I have already refused the application under the distinctiveness ground of opposition, I do not consider it necessary to decide the descriptiveness ground.

Disposition

[40] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application, pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office