



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

Citation: 2015 TMOB 101
Date of Decision: 2015-06-04

**IN THE MATTER OF AN OPPOSITION
by Orange Brand Services Limited to
application No. 1,536,850 for the trade-
mark NETWORK ORANGE in the name
of Tangerine Bank**

[1] On July 22, 2011 ING Bank of Canada (now “Tangerine Bank” by virtue of a change of name) (the Applicant) filed an application to register the trade-mark NETWORK ORANGE (the Mark). The application was filed on the basis of the Applicant’s use in Canada since May, 2011 with the following Services (as amended):

Business networking services namely, providing an innovative space for entrepreneurs and business owners where they can discuss and share business/financial/banking related ideas and problems and share business/financial/banking information; providing business and support services to entrepreneurs, small business and other corporate entities upon request, namely providing office space for use and facilities for such things as meetings, seminars, and/or events.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 21, 2012.

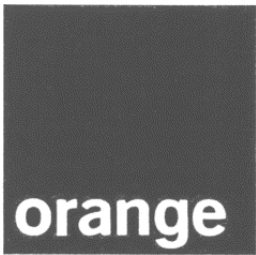
[3] On April 22, 2013, Orange Brand Services Limited (the Opponent) filed a statement of opposition pleading the grounds summarized below:

(a) the application does not conform to the requirements of section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the statement of services is not set out in ordinary commercial terms and is ambiguous and vague;

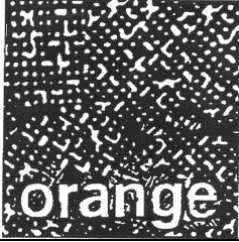
(b) the application does not conform to the requirements of section 30(b) of the Act as the Applicant has not used the Mark in association with the Services;

(c) the application does not conform to section 30(i) of the Act, as the Applicant could not have been satisfied that it is or was entitled to use the Mark;

(d) contrary to section 12(1)(d) of the Act, the Mark is not registrable because it is confusing with the Opponent's trade-marks set out below:

Appl No or Reg. No.	Trade-mark
TMA773,863	ORANGE
TMA822,267	
TMA823,193	ORANGE

(e) the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(b) of the Act given that at the date of first use it was confusing with one or more of the Opponent's trade-marks set out in paragraph 3(d) and those set out below;

1,266,386	
1,468,367	ORANGE PARTNER

- (f) the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act given the Opponent's previous use of one or more of its trade-marks set out in paragraphs 3(d) and (e); and
- (g) contrary to section 2 of the Act, the Mark is not distinctive of the Applicant.

I note that the statement of opposition contained a typographical error whereby the applied-for services were referred to as Wares. Since the Opponent's meaning was clear, I do not consider this to be of any consequence.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations. In support of its opposition, the Opponent filed the affidavit of Helen Jane Stanwell-Smith. The Applicant did not file any evidence in support of its application. The Opponent alone filed a written argument and made representations at a hearing on February 3, 2015. While the Opponent's evidence was voluminous (totaling over 4000 pages), only the portions of evidence directly relevant to my findings will be discussed in the decision.

Onus and Material Dates

[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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

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

-sections 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

-sections 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];

-sections 38(2)(c)/16(1) of the Act - the date of first use alleged in the application; and

- sections 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Section 16(1)(b) Ground of Opposition

[7] With respect to the section 16(1)(b) ground of opposition, the Opponent has an initial burden of establishing that one or more of its applications set out in the statement of opposition was filed prior to the date of first use alleged in the subject application (May 2011), and that they were not abandoned at the date of advertisement (November 21, 2012) [section 16(4) of the Act]. In its submissions, the Opponent made specific submissions on the likelihood of confusion between the Mark and its application for the trade-mark ORANGE PARTNER. Accordingly, I will focus my analysis on this trade-mark.

[8] The Registrar has the discretion to check the Register in order to confirm the existence of the applications relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I have exercised that discretion and confirm that the Opponent's application No. 1,468,367 for ORANGE PARTNER was filed prior to the date of first use claimed in the Applicant's application and was pending as of its advertisement. The most relevant services to determining a likelihood of confusion between the Mark and application No. 1,468,367 are set out below (the Opponent's Education Services):

Educational services, namely developing, arranging and conducting educational conferences, seminars and workshops in the fields of information technology, telecommunications and computing...

[9] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of the date of first use in the Applicant's application, namely, May 2011, there was not a reasonable likelihood of confusion between its Mark and the Opponent's trade-mark ORANGE PARTNER.

[10] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[11] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

inherent distinctiveness

[12] Both parties' trade-marks possess inherent distinctiveness to the extent that they both include the word ORANGE which has no obvious meaning in relation to either the Services or the Opponent's Educational Services. The first part of the Mark, NETWORK, does not impact the inherent distinctiveness of the trade-mark since it is descriptive of the networking aspect of the Services. The second part of the Opponent's trade-mark, PARTNER, does not significantly

impact the degree of its inherent distinctiveness as it suggests that the Opponent “partners” and works together with others as part of the Opponent’s Educational Services.

extent known and length of time in use

[13] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The affidavit of Helen Jane Stanwell-Smith, Senior Legal Counsel of an affiliate of the Opponent, discusses the Opponent’s use of the trade-mark ORANGE PARTNER in Canada:

- The Opponent licenses its ORANGE trade-marks to all members of the Orange Group of affiliated companies (para 9) and exercises direct control over the character and quality of the services provided by its licensees including through Brand License Agreements (para 33).
- The Opponent and its licensees offer mobile telephony, fixed line and broadband internet services and IT communications and networks. In 2011, these services were offered in association with its ORANGE trade-marks in 33 countries with a consumer base of 147 million customers and over 3000 multinational corporate clients (para 26).
- In June 2004, the Orange Group created a division called “Orange Partner” which has the responsibility of developing relationships with and creating a network of software developers, technology and service partners, content providers, telecommunications industry professionals, academia and individuals on a worldwide basis (para 86). The goal of the Orange Partner division is to help developers create, finalise and commercialize their apps (Ex 44, page 002442). Developers do so by becoming members of Orange Partner which permits them to visit developer centres around the world which include Orange mobile devices, WiFi internet connections and meeting rooms (Ex 44, page 002438). At developer centres members can test the following: over the air loading, vibration, sound, Bluetooth connectivity, image accuracy and real time performance of their apps (Ex 44, page 002438-002439).

- From October 2010 to April 2013, the Orange Group ran a facility for members of the Orange Partner program in Vancouver, British Columbia through the offices of Wavefront (a centre for wireless commercialization run by the Government of Canada) (para 139, Exhibit 44). Wavefront’s website *www.wavefrontac.com* includes the following description (Exhibit 73):

The Orange Partner Developer Centre located at the Wavefront Accelerator Centre in downtown Vancouver, is the first of its kind in Canada. The facility is open exclusively to Orange Partner Premium members, offering valuable resources for “last mile” app testing and development...

- The Orange Partner development centre in Vancouver offered Canadian members of the Orange Partner program a space to meet and network with other members and Orange Group personnel in Vancouver (para 139). The ORANGE PARTNER trade-mark was displayed prominently on the website *www.orangepartner.com* which promotes all of the Orange developer centres including the centre in Vancouver, Canada (Exhibit 44). In 2010 and 2011 this website received over 1200 hits per year from those in Canada (para 142).
- Orange Partner also held an event to celebrate the launch of the Orange Partner development centre in Vancouver. An article about the launch event held on October 8, 2010 described it as follows (Exhibit 72, page 003202):

... local developers and technology representatives from 11 companies had the opportunity to discuss business opportunities face-to-face ... They presented their activities and shared the commercial opportunities of working with Orange as well as the practical essentials of taking their applications to market with us.

Based on the above, I conclude that the Opponent’s ORANGE PARTNER trade-mark was known to at least some extent in Vancouver, Canada. In contrast, there is no evidence that the Mark has become known to any extent in Canada. As such, this factor favours the Opponent.

the degree of resemblance

[14] There is a significant degree of resemblance between the trade-marks NETWORK

ORANGE and ORANGE PARTNER in appearance, sound and idea suggested. The most striking part of the trade-marks is the word ORANGE which appears prominently in both trade-marks. Finally, as the other component of each trade-mark NETWORK and PARTNER suggests or describes the associated services, they do not serve to significantly diminish the resemblance between the parties' trade-marks.

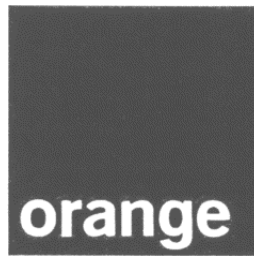
nature of the goods, services, business or trade

[15] This factor favours the Opponent as the nature of the Services overlaps with the Opponent's Educational Services. The parties' services both involve providing space where problems and ideas can be discussed and shared. While the target audience of the parties appears to be different (mobile application developers versus entrepreneurs and business owners), this alone is not sufficient for me to conclude that the nature of the services is different. Furthermore, in the absence of evidence or argument from the Applicant, I have no basis on which to infer that there would be no overlap in the channels of trade.

family of trade-marks

[16] In its written argument, the Opponent relies on its family of trade-marks. In order to rely on a family of trade-marks an opponent must prove use of each mark of the alleged family [*McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB)]. In addition, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered or used by others [*Thomas J Lipton Inc v Fletcher's Fine Foods Ltd* (1992), 44 CPR (3d) 279 (TMOB.) at 286 -7]. In this case, there is no evidence of use of ORANGE by any other party.

[17] While I would not characterize the use of the Opponent's trade-marks ORANGE Design and ORANGE NETWORK as constituting a family, I am prepared to consider the use of the trade-mark ORANGE Design as an additional surrounding circumstance. I find that the fact that the Opponent has also evidenced use of the trade-mark ORANGE design set out below which appeared on signage at the Orange Partner developer centre and on Wavefront's website www.wavefrontact.com in the sponsors section (Exhibits 71,73) to slightly increase the likelihood of confusion.



Conclusion

[18] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's ORANGE PARTNER trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin, supra*].

[19] For the reasons explained above, in particular the similarity between the parties' trade-marks and the overlap in the nature of the services and in view of the fact that the Applicant did not file any evidence or make any submissions, I conclude that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the Opponent's trade-marks. This ground of opposition is successful.

Section 16(1)(a) Ground of Opposition

[20] The evidence of use of the ORANGE PARTNER trade-mark discussed with respect to the section 16(1)(b) ground of opposition is sufficient to meet the Opponent's burden of proving that this trade-mark was being used at the Applicant's claimed date of first use and had not been abandoned at the date of advertisement of the application [section 16(5) of the Act]. For the reasons set out with respect to the section 16(1)(b) ground of opposition, the Applicant has failed to meet its legal onus of proving that there is no likelihood of confusion between the Mark and the ORANGE NETWORK trade-mark. This ground of opposition succeeds.

Remaining Grounds of Opposition

[21] Having already refused the application under two grounds, I will not discuss the remaining grounds of opposition with respect to this application.

Disposition

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

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office