



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

Citation: 2010 TMOB 188
Date of Decision: 2010-11-09

**IN THE MATTER OF AN OPPOSITION by
St. Joseph Media Inc. to Application
No. 1,294,190 for the trade-mark WISH
WORKSHOPS filed by Starwood Hotels &
Resorts Worldwide, Inc.**

[1] On March 17, 2006, Starwood Hotels & Resorts Worldwide, Inc. (the Applicant) filed an application to register the trade-mark WISH WORKSHOPS (the Mark) based upon use of the Mark in Canada since at least as early as January 2006, in association with the following services: “hotel services, motel services, resort services, motor inn services, restaurant, lounge and bar services, providing meeting and conference facilities, arranging meetings, conferences and social functions, arranging seminars/classes in the field of arts, crafts, wine, food, travel culinary arts, sports, yoga and physical fitness” (the Services). The application includes a disclaimer of the right to the exclusive use of the word WORKSHOPS apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 20, 2006.

[3] On May 9, 2007, St. Joseph Media Inc. (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(i); 12(1)(d); 16(1)(a) and (b) and 38(2)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), in view of the fact that the Mark is confusing with the trade-mark WISH used in Canada by the Opponent and its predecessors since a date well prior to the date of first use claimed by the Applicant and that is

registered under No. TMA670,565 in association with among other wares and services, magazines and electronic publishing and information services. The statement of opposition also claims that the application does not conform to the requirements of s. 30(b) of the Act in that the Applicant has not used the Mark since the date of first use alleged or at all in Canada.

[4] The Applicant filed and served a counter statement in which it denies the Opponent's allegations. The Applicant further represents that there are many marks including the word WISH on the register. To the extent that such representations pertain to argument rather than statements of facts, they have been disregarded.

[5] In support of its opposition, the Opponent filed a first affidavit of Elenita Anastacio, a trade-mark searcher at the employ of the law firm representing the Opponent in this proceeding, sworn October 12, 2007. In support of its application, the Applicant filed the affidavit of Jane Buckingham, a trade-mark searcher at the employ of the law firm representing the Applicant in this proceeding, sworn May 9, 2008; the affidavit of Susan Burkhardt, a law clerk at the employ of the same law firm, sworn May 7, 2008; and the affidavit of Lisa Saltzman, director of the trade-mark searching department with Onscope, a division of Marque d'or Inc., sworn May 2, 2008. Ms. Saltzman was cross-examined on her affidavit and the transcript of her cross-examination forms part of the record. The Opponent filed as reply evidence, a second affidavit of Ms. Anastacio, sworn November 26, 2008.

[6] Only the Applicant filed a written argument. Only the Opponent was represented at an oral hearing.

Onus and relevant dates

[7] 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 C.P.R. (3d) 293 (F.C.T.D.) and *Dion Neckwear Ltd. v.*

Christian Dior, S.A. et al. (2002), 20 C.P.R. (4th) 155 (F.C.A.)). The presence of an onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant [see *John Labatt supra*].

[8] The relevant dates for considering the circumstances in regard to each of the grounds of opposition in the instant proceeding are the following:

- Grounds based on s. 30(b) and (i) of the Act: the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- Ground based on s. 12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Grounds based on s. 16(1)(a) and (b) of the Act: the date of first use of the Mark claimed in the application; and
- Ground based on non-distinctiveness of the Mark: generally accepted as being the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Analysis

Section 30(b) ground of opposition

[9] The Opponent has pleaded that “[t]he Applicant has not used [the Mark] since the date of first use alleged or at all in Canada and/or if there has been use, such use is contrary to [s.] 30(b) and [s.] 50 of the Act”.

[10] To the extent that the relevant facts pertaining to a ground of opposition based upon s. 30(b) of the Act are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to such a ground of opposition is lower [see *Tune Masters v. Mr. P. 's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. Also, the Opponent may rely upon the Applicant’s evidence provided however that such evidence is clearly inconsistent with the Applicant’s claim [see *York Barbell Holdings Ltd. v. ICON Health &*

Fitness, Inc. (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)). In this regard, s. 30(b) of the Act requires that there be continuous use of the trade-mark applied for since the date claimed [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.)].

[11] The Opponent has filed through the two affidavits of Ms. Anastacio, the results of searches conducted over the Internet in respect of the Applicant's Mark.

[12] Considering more particularly the first affidavit of Ms. Anastacio, Ms. Anastacio states in paragraph 4 of her affidavit that "[she] conducted a [W]eb search in Google to retrieve and cite the exact terms WISH WORKSHOPS with STARWOOD. These parameters are the [Mark] and [Applicant] which is the subject in this [o]pposition. Google is the largest search engine in the world and, a tool for finding resources and information on the World Wide Web. It is one of the most popular Web search engines and receives over 200 million queries each day through its various services". Ms. Anastacio further attaches as Exhibit B to her affidavit the result of that search which she says she downloaded from the Google database search and states in paragraph 5 of her affidavit that "[she] could not locate any reference to use in Canada of the [Mark] as of January, 2006."

[13] Upon reviewing Exhibit B, I note that it refers to the Applicant's hotels and resorts, and more particularly to its W Hotels in New York, Seattle and San Francisco cities in the United States. On the Web pages printed on 18/09/2007 pertaining to the W Seattle hotel (at www.starwoodhotels.com), "WISH WORKSHOPS" is described as follows:

When mid-day doldrums strike, take a pause to learn a new skill or uncover a hidden talent with Wish Workshops. Gain hands-on experience with any of our expertly taught instructionals or work with our meetings specialists to customize a program your group will love. An educational aside and a refreshing respite from the workday. Wish Workshops offer your attendees a chance to fulfill their passions before getting back to the work at hand. Remember, the possibilities are endless.

Cheese Louise

[...] Learn about cheeses from a Maître Fromager. [...]

Meet your (wine) maker

[...] Learn liquid knowledge at your customized wine tasting class with Earth & Ocean

Sommelier [...]

Shat it like a ...

[...] Learn how to shake and stir our W Seattle signature cocktails and be the coolest cat at your next party.[...]

Scratch that itch

[...] Become a master musical mixologist with a spinning and a scratching lesson taught by W Seattle's resident DJ MB. [...]

[14] The Web pages attached as Exhibit B also include an extract from the website *www.corporatemeetings.com* printed on 18/09/2007 featuring an article written by a reporter by the name of Adam Jones for the magazine "Meetings | South" covering "the Southern U.S., the Caribbean and the Islands" in June 2005. The article entitled "Hip Hotels" includes the following passage:

Accordingly, W Hotels recently launched a new set of meetings programs that include W Hotels' Recess menus for lunches and breaks and Wish Workshops for receptions, dinners and events. The Recess menus are available in three categories – Entertain, Inspire and Revive – and include a variety of products, from Etch A Sketch drawing toys (Entertainment) and lottery tickets (Inspire) to blasts of pure oxygen (Revive). Wish Workshops, meanwhile, include a selection of pre-designed concepts that allow attendees to experience different discernibly hip trades."

[15] The mere fact that Ms. Anastacio could not locate any reference to use in Canada of the Mark does not necessarily lead to the assumption that the Applicant never used the Mark or did not use it continuously between its claimed date of first use and the filing of its application. This brings me to consider the second affidavit of Ms. Anastacio.

[16] Ms. Anastacio explains in her second affidavit that she has reviewed the affidavit of Lisa Saltzman dated May 2, 2008 filed in this opposition. In particular, Ms. Anastacio examined Exhibits D and E to Ms. Saltzman's affidavit. This second affidavit of Ms. Anastacio has been filed as reply evidence and purports to thwart the Applicant's evidence pertaining to its use of the Mark in Canada. More particularly, Ms. Anastacio conducted searches on the W Hotel in Montreal revealed by Ms. Saltzman's affidavit and which had not been found by Ms. Anastacio's previous searches. I am satisfied that this second affidavit of Ms. Anastacio qualifies as proper

evidence in reply pursuant to r. 43 of the *Trade-marks Regulations*, SOR/96-195. For the ease of commenting this second affidavit of Ms. Anastacio, I will briefly go over Ms. Saltzman's affidavit.

[17] Ms. Saltzman states in paragraph 2 of her affidavit that she conducted an online search at *www.google.ca* for "WISH WORKSHOPS" and "STARWOOD" on May 1, 2008 and she attaches as Exhibit A to her affidavit a printout of the Web page showing the first 11 results of the search. Ms. Saltzman continues her affidavit by stating in paragraph 3 that she clicked on the eighth link on the results page, which links to the Web address *www.welcomewhotels.com*. By clicking on this result, she was brought to a Web page advertising W Hotels Meetings. A printout of this Web page is attached as Exhibit B to her affidavit. On the left hand side of the Web page there is a menu listing "WISH WORKSHOPS".

[18] Ms. Saltzman continues her affidavit and states in paragraph 4 that by clicking on the link for "WISHWORKSHOPS", she was brought to a Web page advertising "WISH WORKSHOPS" at W Hotels. A printout of this Web page is also attached to her affidavit as Exhibit C. In the middle of this Web page there is a drop-down menu inviting the user to "Select a W to plan your meeting". By clicking on the drown-down menu, Ms. Saltzman states that she was presented with a listing of W Hotels. A printout of the Web page showing the drop-down menu is attached as Exhibit D. One of the hotels listed in the drop-down menu is the W Montreal. By clicking on the link to the W Montreal from the drop-down menu, Ms. Saltzman states in paragraph 5 of her affidavit that she was brought to a Web page which had "WISH WORKSHOPS - What do you want to learn?" displayed across the top and containing the address and telephone number of the W Montreal hotel together with some general information on that hotel and she attaches as Exhibit E to her affidavit a printout of that Web page. Ms. Saltzman then concludes her affidavit by stating in paragraph 6 that she made her affidavit in support of the instant opposition and for no other or improper purpose.

[19] I note that on Exhibit E to Ms. Saltzman's affidavit, the following description is provided under the heading "WISH WORKSHOPS - What do you want to learn?":

When mid-day doldrums strike, take a pause to learn a new skill or uncover talents with Wish Workshops at W Hotels.

Ben and bow and turn twist with yoga lessons.

Take a cooking class, and try your hand at preparing the tastiest treats.

Learn to spin like the best DJs, and mix it up at your next work soiree.

Or work with our meetings specialists to customize a Wish Workshop program your group will love! An educational aside and a refreshing respite from the workday, Wish Workshops offer your attendees a chance to fulfill their passions before getting back to the work at hand.

[20] As per the above reproduction, the Mark appears to be associated with part of the Services only, namely those pertaining to “arranging meetings, conferences and social functions, arranging seminars/classes in the field of arts, crafts, wine, food, travel culinary arts, sports, yoga and physical fitness”. Ms. Saltzman’s affidavit consists of the only evidence filed by the Applicant purporting to the use of the Mark.

[21] Now, reverting to Ms. Anastacio’s second affidavit, Ms. Anastacio notes that the only Canadian W Hotel listed on the drop-down menu depicted in Exhibit D to Ms. Saltzman’s affidavit is W Montreal and that the reference to WISH WORKSHOPS and the W Montreal in the capture is dated May 1, 2008, that is after the material date. Ms. Anastacio states that on November 11, 2008, she conducted a Wayback Machine Internet Archive search. She explains that the Wayback Machine Internet Archive (*archive.org*) archives historical snapshots of websites throughout the World Wide Web. Ms. Anastacio used the Wayback Machine services to view the history of W Montreal’s Web address *www.starwoodhotels.com*.

[22] More particularly, Ms. Anastacio attaches as Exhibit D to her affidavit, all archive captures of the Meetings and Events links for W Montreal for the period November 11, 2006 up to and including May 30, 2007, the most recently archived captures available. She states that she found no reference to “WISH WORKSHOPS” on any capture and she attaches as Exhibit D to her affidavit a copy of those captures that she personally downloaded on November 11, 2008.

[23] Ms. Anastacio concludes her affidavit by stating that she also viewed other archived pages of the W Montreal website through the Wayback Machine and could find no mention of “WISH WORKSHOPS” in association with W Montreal in the period November 11, 2006 to and

including May 30, 2007.

[24] The evidence produced by the WayBack Machine indicating the state of websites in the past has been found to be generally reliable [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.); reversed on other grounds 2008 F.C.A. 100; and *ITV Technologies, Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4th) 182 at 192 (F.C.T.D.), affirmed (2005), 38 C.P.R. (4th) 481 (F.C.A.)]. More particularly, the admissibility of such evidence in support of an opponent's s. 30(b) ground of opposition has been commented as follows by Board Member Bradbury in *Royal Canadian Golf Assn. v O.R.C.G.A.* (2009), 72 C.P.R. (4th) 59 (T.M.O.B.), at pages 64-65:

I appreciate that there be limitations to the accuracy of the Wayback Machine, including but not limited to possible hearsay issues. However, for the purpose of meeting the Opponent's light initial burden under s. 30(b), I find that the search results are sufficient to raise a doubt concerning the correctness of the Applicant's claimed date of first use [...]. The Applicant had the opportunity to file evidence to rebut the results of the Wayback Machine search but chose not to.

[25] In the present case, the results of the Wayback Machine postdate the material date. Indeed, if I read the search results attached as Exhibit B to Ms. Anastacio's second affidavit correctly, the Web pages pertaining to the Applicant's W Hotel in Montreal were seemingly first set up on November 11, 2006. The mere fact that these Web pages only appeared for the first time on the Applicant's website at *www.starwoodhotels.com* on that date and did not include any reference to the Mark is insufficient to cast doubt on the correctness of the Applicant's claimed date of first use of the Mark. It is not because the Applicant did not promote the Services on the Web pages pertaining to its W Hotel in Montreal that the Applicant never used the Mark in Canada or did not use it continuously between its claimed date of first use and the filing of its application.

[26] That being said, I wish to revert to Ms. Saltzman's affidavit.

[27] While the Applicant was under no obligation to positively evidence use of the Mark since the date of first use claimed in its application, the Applicant elected to file evidence. While

Ms. Saltzman's affidavit appears to have been filed to rebut Ms. Anastacio's first affidavit and establish that Ms. Anastacio had not searched the proper site for WISH WORKSHOPS, namely the site of the W Hotel in Montreal at the time she subscribed her first affidavit, the Applicant is seemingly relying on the results of Ms. Saltzman's searches to evidence use of the Mark in Canada. I appreciate that these searches do not aim to evidence use of the Mark as of the date of first use claimed in the application *per se*. However, when reviewing the Web pages attached as Exhibits B to E to Ms. Saltzman's affidavit discussed above, I find that they are clearly inconsistent with the Applicant's claimed date of first use of the Mark in respect of part of the Services listed in the application described as "hotel services, motel services, resort services, motor inn services, restaurant, lounge and bar services, providing meeting and conference facilities". Indeed, as per my review of these exhibits, there is no reference whatsoever to such services being offered in association with the Mark. The advertising of the Mark is directed only to the services pertaining to "arranging meetings, conferences and social functions, arranging seminars/classes in the field of arts, crafts, wine, food, travel culinary arts, sports, yoga and physical fitness". That being so, the Applicant's evidence casts doubt on the correctness of its claimed date of first use of the Mark. Thus, I find the Opponent has satisfied the light evidentiary burden upon it.

[28] In view of the foregoing, I conclude that the s. 30(b) ground of opposition succeeds in respect of the services described as "hotel services, motel services, resort services, motor inn services, restaurant, lounge and bar services, providing meeting and conference facilities" on the basis that the Applicant has not met its burden.

Section 12(1)(d) ground of opposition

[29] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-mark WISH identified above. The Opponent has provided through the first Anastacio affidavit a computer-generated copy of Canadian trade-mark registration No. TMA670,565 for the trade-mark WISH relied upon in support of its s. 12(1)(d) ground of opposition. I have exercised the Registrar's discretion to review the register of trade-marks and confirm the details of this

registration. More particularly, the Opponent's mark was registered on August 21, 2006 in association with the following wares and services:

Printed publications, namely, magazines of general interest; Internet services, namely, informational services in the nature of electronic magazines and publishing services through the use of the worldwide web; Broadcast, television and entertainment services, namely, the creation and production of consumer television and radio broadcast shows and pre-recorded CD and DVD media for purchase by the consumer.

A declaration of use of the mark was filed on July 26, 2006. As this registration is extant, the Opponent's evidentiary burden has been satisfied.

[30] The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

[31] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[32] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Clicquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

(a) The inherent distinctiveness of the trade-marks and the extent to which they have become known

[33] Both marks are relatively inherently distinctive. They both share the dictionary word WISH, which cannot be said to be descriptive in the context of the parties' wares or services. The Applicant submits in its written argument that the Opponent's mark "is somewhat less inherently distinctive than the Applicant's" having regard to the fact that it co-exists on the register of trade-marks with other trade-marks that include the component WISH, including the trade-mark WISH BOOK of registration No. TMA409,399 [Buckingham affidavit, Exhibits A and B]. I disagree with the Applicant. To the contrary, I find the Applicant's Mark to be somewhat less inherently distinctive than the Opponent's having regard to the descriptive character of the component "WORKSHOPS" in the context of the Services, as acknowledged by the Applicant's disclaimer of the right to the exclusive use of that word apart from the Mark.

[34] Furthermore, while state of the register evidence is one of the surrounding circumstances that may impact the analysis carried on under s. 6(5) of the Act, it does not come into play under s. 6(5)(a). The inherent distinctiveness of the trade-marks under review is to be assessed looking at the marks themselves and their associated wares or services. I will revert to the state of the register evidence introduced by the Buckingham affidavit later on in my analysis of the additional surrounding circumstances.

[35] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The Opponent has elected not to file any evidence establishing use of its trade-mark or that it has become known in Canada. As for the Applicant, Ms. Saltzman's affidavit at best arguably evidence advertising of the Mark on the Applicant's website *www.welcometowhotels.com* as of May 1, 2008 in association with part of the Services. However, in the absence of evidence that Canadians did access the Applicant's website, I am not prepared to accord significant weight to such evidence of use of the Mark. Thus, I find that the evidence in the record falls short of establishing the extent to which the Mark has become known in Canada.

[36] Having regard to the foregoing, I find that the overall consideration of this first factor

does not significantly favour one party over the other.

(b) The length of time the trade-marks have been in use

[37] In the absence of evidence supporting use of the Opponent's mark, the mere existence of a registration can establish no more than "de minimis" use and cannot give rise to an inference of significant or continuing use of the mark [see *Entre Computer Centers, Inc. c. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. As for the Applicant's Mark, while the application claims use of the Mark since as early as January 2006, the evidence in the record falls short of establishing that the Mark has been used since that time.

[38] Having regard to the foregoing, I find that the overall consideration of this second factor does not significantly favour one party over the other.

(c) The nature of the wares, services or business; and (d) the nature of the trade

[39] Considering the type of wares or services and the nature of the trade, I must compare the Applicant's statement of Services with the statement of wares and services in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.) and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optional Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[40] The Opponent submitted at the oral hearing that there is a clear overlap between the parties' wares or services by reason of the fact that the Applicant appears to promote its Services on the Internet. I disagree. The mere advertising of the Applicant's Services on the Internet is insufficient to create a link between these services and the wares and services of the Opponent or

to conclude that their channels of trade overlap. The parties' wares and services are totally different.

[41] I find that the overall consideration of these third and fourth factors significantly favours the Applicant.

(e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[42] The marks resemble one another because the Applicant's Mark incorporates the Opponent's mark. However, considering the descriptive nature of the word WORKSHOPS in the context of the Applicant's Services, the ideas suggested by the marks are somewhat different. The Mark suggests the idea of workshops aimed at fulfilling the attendees' desires or objectives whereas the Opponent's mark simply suggests the act of desiring something or a desire.

[43] I find that the overall consideration of this fifth factor tends to favour the Opponent.

Additional surrounding circumstances – state of the register evidence

[44] As indicated above, the Applicant has filed into evidence the results of searches conducted on the register of trade-marks. More particularly, Ms. Buckingham conducted a search on January 11, 2008, to locate all active trade-mark applications and registrations which contain the element WISH. She states in paragraph 5 of her affidavit that her search revealed 105 applications, registrations and s. 9 marks which incorporate WISH alone or in combination with other word or design elements.

[45] In its written argument, the Applicant draws more particularly to the attention of this Board 11 of these registrations or applications. Upon reviewing those 11 hits, I note that some of the applications listed by the Applicant have been abandoned. Considering the nature of the wares or services covered by the remaining registrations or applications in view of the parties' wares and services at issue, I find that only one of these registrations or applications is arguably pertinent to this case, namely trade-mark registration No. TMA409,399 WISH BOOK in the

name of Sears Canada Inc. in association with “general merchandise catalogues; general merchandise department store services and catalogue services”. It is to be noted that the Applicant has filed, through the affidavit of Ms. Burkhardt, evidence pertaining to the use of this trade-mark in Canada. More particularly, Ms. Burkhardt states in paragraph 2 of her affidavit that she is familiar with WISH BOOK, a catalogue distributed by Sears Canada Inc. and she says that she receives a copy on a regular basis. She further says that she has purchased items from the WISH BOOK through Sears’ telephone ordering system and she attaches as Exhibit A to her affidavit a copy of the cover page and spine of the 2007 WISH BOOK.

[46] As explained by Board Member Tremblay in *Advance Magazine Publishers inc. v. Vogue Sculptured Nail Systems Inc.*, 2010 T.M.O.B. 129:

State of the register evidence is usually introduced to show the commonality of a trade-mark or a portion of a trade-mark in relation to the register as a whole. Since it is only relevant insofar as one can make inferences from it about the state of the marketplace, it should be comprised of trade-marks which include both the applied for mark or portion of the applied for mark and that are used with wares or services similar to those at issue [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Inferences about the state of the marketplace can only be drawn from the state of the register evidence where large numbers of relevant registrations are located [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[47] The mere existence of Sears Canada Inc.’ trade-mark WISH BOOK on the register of trade-marks and in the marketplace is insufficient by itself to infer the commonality of the word WISH in the Opponent’s field of activities so as to put into issue the distinctiveness of the Opponent’s mark. Thus, I find that the Buckingham and Burkhardt affidavits do not put forward additional surrounding circumstances pertinent to this case.

Conclusion regarding the likelihood of confusion

[48] As indicated above, the test for confusion is whether someone who has an imperfect recollection of the Opponent’s mark might conclude upon seeing the Applicant’s Mark as a matter of first impression that the source of the Opponent’s wares and services and the source of the Applicant’s Services are either the same or somehow related.

[49] Having considered all of the surrounding circumstances, and particularly in view of the differences existing between the nature of the wares or services and the nature of the trade, I am satisfied that the Applicant has met its burden to show that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark.

[50] Accordingly, the s. 12(1)(d) ground of opposition fails.

Non-distinctiveness ground of opposition

[51] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act in that it does not distinguish and is not adapted to distinguish the Applicant's Services from the wares and services of the Opponent sold in association with the trade-mark WISH of registration No. TMA670,565.

[52] An opponent meets its evidentiary burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. In the absence of evidence directed to the use or promotion of the Opponent's trade-mark, I find that the Opponent has failed to satisfy its evidentiary burden. The mere filing of a copy of the Opponent's trade-mark registration (re assumption of *de minimis* use mentioned above) does not satisfy the Opponent's evidentiary burden with respect to a distinctiveness ground of opposition. Accordingly, the non-distinctiveness ground of opposition fails.

Section 16(1)(a) and (b) grounds of opposition

[53] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(1)(a) of the Act in that at the date of first use of the Mark claimed by the Applicant, the Mark was confusing with the above-mentioned trade-

mark of the Opponent, which had been previously used in Canada by the Opponent (and its predecessors) and continue to be so used by the Opponent.

[54] An opponent meets its evidentiary burden with respect to a s. 16(1)(a) ground if it shows that as of the date of first use claimed in the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [s. 16(5) of the Act]. In the absence of any evidence of use of its alleged trade-mark within the meaning of s. 4 of the Act, I find that the Opponent has failed to satisfy its evidentiary burden. Accordingly, the s. 16(1)(a) ground of opposition fails.

[55] The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(1)(b) of the Act in that at the date of first use of the Mark claimed by the Applicant, the Mark was confusing with the above-mentioned trade-mark of the Opponent, in respect of which an application for registration had been previously filed in Canada by the Opponent.

[56] An opponent meets its evidentiary burden with respect to a s. 16(1)(b) ground if it shows that its previously filed application was pending at the date of advertisement of the applicant's application [s. 16(4) of the Act]. As the Opponent's application Serial No. 1,212,742 matured to registration on August 21, 2006, it was no longer pending at the date of advertisement of the Applicant's application [see *Governor and co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.)]. Thus, the Opponent has failed to satisfy its evidentiary burden. Accordingly, the s. 16(1)(b) ground of opposition fails.

Section 30(i) ground of opposition

[57] The Opponent has pleaded that the application does not conform to the requirements of s. 30(i) of the Act in that the Applicant cannot have been satisfied that it was entitled to use the Mark in Canada in association with the Services because "the Applicant was well aware or ought to have been aware of the existence of the Opponent, and the use and notoriety of its trade-mark

as well as its trade-mark application in Canada.”

[58] This ground, as pleaded, does not raise a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of the Opponent’s prior filed application for the trade-mark WISH (that matured to registration No. TMA670,565) does not preclude it from making the statement in its application required by s. 30(i) of the Act. Even if the ground had been properly pleaded, where an Applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the Applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the instant case. Accordingly, the s. 30(i) ground of opposition fails.

Disposition

[59] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to the services described as “hotel services, motel services, resort services, motor inn services, restaurant, lounge and bar services, providing meeting and conference facilities” and I reject the opposition with respect to the services described as “arranging meetings, conferences and social functions, arranging seminars/classes in the field of arts, crafts, wine, food, travel culinary arts, sports, yoga and physical fitness” pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

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