



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

Citation: 2014 TMOB 171
Date of Decision: 2014-08-21

**IN THE MATTER OF AN OPPOSITION
by John Zachman to application
Nos. 1,485,468 and 1,485,469 for the
trade-marks ZACHMAN and
ZACHMAN INTERNATIONAL in the
name of Metadata Systems Software Inc.**

[1] On June 17, 2010, Metadata Systems Software Inc. (the Applicant) filed application to register the trade-marks ZACHMAN (1,485,468) and ZACHMAN INTERNATIONAL (1,485,469) (the Marks) in association with the following wares and services:

Wares:

- (1) Books, written articles, handouts and worksheets in the field of business planning, development and management.
- (2) Educational publications, namely, workbooks, handouts, guidebooks, and posters in the fields of business planning, development and management.
- (3) Instructional, educational, and teaching materials in the field of business planning, development and management, namely, posters, printed charts and graphic prints, books, CDs, computer graphics, flash drives, electronic books, and web pages.

Services:

- (1) Information, advisory and consultancy services in the fields of business management and business administration.
- (2) Business consultation in the fields of enterprise architecture, organizational change management, product distribution, operations management services, logistics, reverse logistics, supply chain, and production systems and distribution solutions.
- (3) Education services, namely, providing classes, seminars and workshops in the fields

of business planning, development, management and enterprise architecture with distribution of printed learning materials therewith.

(the Wares and Services)

[2] Application No. 1,485,468 for the trade-mark ZACHMAN is based on use in Canada since 2005 and application No. 1,485,469 for the trade-mark ZACHMAN INTERNATIONAL is based on use in Canada since 2003.

[3] The applications were advertised for opposition purposes in the *Trade-marks Journal* of August 31, 2011.

[4] On October 31, 2011, John Zachman (the Opponent) filed a statement of opposition against each of the applications. The statements of opposition are essentially identical and claim the grounds of opposition, summarized below:

- pursuant to sections 38(2)(a) and 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) the application does not comply with section 30(b) of the Act because the Applicant has not used the Marks in association with the Wares and Services since the date of first use indicated in the applications. To the extent that the Applicant may have used the Marks in Canada prior to the filing date, such use was under license from the Opponent and therefore deemed to be that of the Opponent, not the Applicant.
- Pursuant to sections 38(2)(c) and 16(1)(a) and (c) of the Act, the Applicant is not the person entitled to registration of the Marks because, as of the alleged date of first use, the Mark was confusing with the Opponent's trade-marks ZACHMAN and ZACHMAN INTERNATIONAL and the Opponent's trade-name Zachman International – all of which had been previously used in Canada by the Opponent in association with “publications in the field of business and management and business administration, in the nature of workbooks, handbooks, articles, handouts, guidebooks, posters, worksheets, charts, graphic prints, CDs, flash drives, electronic books and web pages; information, advisory and consultancy services relating to business, business management and business administration, including such services as provided online or via the Internet; providing information about the corporate world, corporate culture, and the corporate sector; business consulting in the fields of enterprise architecture, organizational change management, product distribution, operations management services, logistics, reverse logistics, supply chain, and production systems and distribution solution; and education services, namely providing classes, seminars and workshops in the fields of business planning, development, management and enterprise architecture with distribution of printed learning materials therewith”;

- Pursuant to section 38(2)(d), the Marks are not distinctive in that they do not distinguish and are not adapted to distinguish, the Wares and Services from the wares and services of others, including those of the Opponent.

[5] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[6] In support of each of its oppositions, the Opponent filed an affidavit of John A. Zachman (the Opponent himself), as well as two affidavits of Kelsey L. Bittner (a litigation paralegal employed by the Opponent's agent).

[7] In support of each of its applications, the Applicant filed an affidavit of Stan Locke, the Managing Director of the Applicant.

[8] None of the affiants was cross-examined.

[9] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply 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 CPR (3d) 293 (FCTD) at 298].

[11] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 - the date of filing the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)].
- sections 38(2)(c)/16(1) - the claimed date of first use [section 16(1) of the Act].
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Issues

[12] As I pointed out at the oral hearing, there are a number of issues which have cluttered up the parties' submissions which do not directly relate to any of the pleaded grounds of opposition.

[13] Firstly, the Applicant submits that the Zachman affidavit filed by the Opponent in support of application No. 1,485,468 should be struck on account of handmade amendments to the affidavit which appear to have been made at the date of signing. Specifically, the word INTERNATIONAL was struck out and the application number was manually changed from 1,485,469 to 1,485,468. The change to the application number was accompanied by Mr. Zachman's initials, but the strikethrough of the word INTERNATIONAL was not.

[14] The Applicant submits that these two modifications render the affidavit inadmissible in support of application No. 1,485,468.

[15] I disagree. Firstly, I note that as a quasi-judicial administrative tribunal, the Registrar is the master of its own proceedings and is not strictly bound by the Federal Court Rules with respect to the rules of evidence. Furthermore, I note that the Applicant had the opportunity to cross-examine Mr. Zachman if it had any concerns regarding the affidavit. I have no reasons to suspect anything nefarious with respect to these manual amendments to the affidavit. Furthermore, it would be a rare case for the Registrar to strike an affidavit on a technical deficiency where such deficiency was raised so late in the proceeding that the party filing the affidavit has little opportunity to rectify the error. Based on the foregoing, I refuse to strike out the affidavit of Mr. Zachman filed in support of application No. 1,485,468.

[16] The Applicant also made submissions to the effect that the Opponent is not "registered to provide services in Canada" and as a result, it should not be permitted to oppose the applications for the Marks. As was rightly pointed out by the Opponent's agent at the oral hearing, this issue is not relevant to a determination of whether the Opponent has met its evidential burden under the non-entitlement and non-distinctiveness grounds of opposition.

[17] Finally, I note that, while I have considered all of the evidence and submissions of record, my decision will only specifically address the evidence and submissions which are directly relevant to my ultimate findings on each of the pleaded grounds of opposition.

Section 30(b) Ground of Opposition

[18] While the legal burden is upon the Applicant to show that the application complies with section 30 of the Act, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of its section 30 ground of opposition. However, the evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with section 30(b) is a light one [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD)].

[19] In support of the section 30(b) ground of opposition the Opponent relies on Mr. Zachman's evidence of an oral license allegedly in place between Zachman International (a sole proprietorship owned by the Opponent) and Mr. Locke from January 2000 to 2009. The Opponent submits that by virtue of this license agreement any alleged use by the Applicant in this period would have accrued to the Opponent.

[20] Mr. Zachman states that the oral license granted Mr. Locke rights to offer "follow-on seminars"; operate under the Zachman Frameworks trade-name; use the Opponent's copyrighted seminar materials; maintain the Zachman International websites (commencing in 2003); manage and administer an online store for the sale of the Opponent's book "The Zachman Framework for Enterprise Architecture: A Primer" (commencing in 2003); and manage and administer subscriptions to an online database of "Framework for Enterprise Architecture" (commencing in 2005).

[21] I note that, in setting out the details of this alleged oral license, Mr. Zachman makes no specific reference to the Marks or to activities which would amount to use of the Marks in accordance with section 4 of the Act. However, later in his affidavit, Mr. Zachman makes the sworn statement that "Locke's use in Canada and elsewhere of Zachman International's trade-marks, was, and always had been, undertaken with the authorization and license of Zachman International for Zachman International's benefit [...]".

[22] In his affidavit, Mr. Locke disputes Mr. Zachman's sworn statements regarding the existence of an oral license agreement between the parties for use of the Marks in Canada. While Mr. Locke concedes to the presence of an oral agreement between himself and Mr. Zachman, he denies that the agreement concerned the trade-marks or trade-names at issue.

[23] Neither party was cross-examined on their affidavits. Thus I am left with conflicting evidence as to whether or not there was a license in place between the parties with respect to use of the Marks. As a result, I am unable to conclude whether any alleged use of the Marks by the Applicant between January 2000 and 2009 would have accrued to the Opponent.

[24] Based on the foregoing, I find that the Opponent has failed to meet its evidential burden and the ground of opposition based on section 30(b) is dismissed.

Non-entitlement Grounds – Sections 16(1)(a) and (c) of the Act

[25] The Opponent is under an initial evidential burden of establishing that one or more of its pleaded trade-marks (ZACHMAN and ZACHMAN INTERNATIONAL) and trade-name (Zachman International) was used prior to the claimed dates of first use (2003 for ZACHMAN INTERNATIONAL and 2005 for ZACHMAN) and had not been abandoned at the date of advertisement for the Mark (August 31, 2011).

[26] In his affidavit, Mr. Zachman states that he began offering educational seminars in Canada using the ZACHMAN INTERNATIONAL trade-name since at least as early as July 2, 1992. In support of this statement, Mr. Zachman attaches a selection of documents, all of which display the Zachman International trade-name in a manner that would be considered trade-name use (e.g. at the top of invoices in the same size font as the Opponent's address; in copyright notices as referring to "John A Zachman and Zachman International" as owners of the copyright in the seminar materials, etc.):

- a. copies of correspondence he sent to Canadian business leaders who attended his seminars (Exhibit B);
- b. brochures advertising the public seminars he hosted in Canada from 1996, 1997, 1998 and 1999 (Exhibits C, D, E, F, G);
- c. seminar materials distributed at seminars he hosted in 1992, 1998, 2003, 2012 (Exhibits H, I, J, K, L); and
- d. sample correspondence and invoices from October 10, 1998 to November 27, 1999 (Exhibit M).

[27] Mr. Zachman explains that the seminars he hosted were put on by the Intervista Institute which he states is a Montreal, Quebec based Seminar Company that sponsors seminars in various major Canadian cities.

[28] Mr. Zachman provides approximate revenues relating to the seminars he offered in association with his Zachman International trade-name, and hosted by Intervista. Specifically, he provides sales figures for the years 1998 – 2012 which range from a low of \$6000 (2012) to a high of \$61,000 (1999). In support of these sales figures, Mr. Zachman provides supporting invoices (Exhibit T).

[29] I agree with the Applicant that the Opponent's evidence does not demonstrate use of the ZACHMAN trade-mark. Rather, the only references to ZACHMAN not in association with the word INTERNATIONAL are Mr. Zachman's comments regarding "his JOHN A. ZACHMAN Name", none of which amounts to trade-mark use in compliance with section 4 of the Act. I also agree with the Applicant that the evidence does not demonstrate use of the ZACHMAN INTERNATIONAL trade-mark in compliance with section 4 of the Act. As a result, I dismiss the ground of opposition based on section 16(1)(a) of the Act on the basis that the Opponent has failed to evidence use of the pleaded trade-marks in advance of the claimed dates of first use.

[30] With respect to the section 16(1)(c) ground of opposition, I am satisfied that the evidence supports a finding that the evidence discussed above establishes use of the trade-name Zachman International prior to the claimed date of first use and non-abandonment at the date of advertisement for the Marks. The Opponent has thus met its evidential burden with respect to the ground of opposition based on section 16(1)(c) of the Act. I must now assess whether the Applicant has met its legal onus.

[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 specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and or trade-name and the extent to which they have become known; (b) the length of time each has 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 and/or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC).]

[33] The Applicant's trade-mark ZACHMAN INTERNATIONAL (1,485,469) is identical to the Opponent's Zachman International trade-name. The nature of the parties' wares, services, business and trade are also essentially identical. In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular these factors which overwhelmingly favour the Opponent, I find that the Applicant has failed to satisfy its onus of establishing no likelihood of confusion as between the ZACHMAN INTERNATIONAL trade-mark and the Opponent's Zachman International trade-name.

[34] With respect to the Applicant's trade-mark ZACHMAN (1,485,468), it is identical to the dominant component of the Opponent's Zachman International trade-name, Zachman. The additional element, International, being a common dictionary word is not sufficient to create any significant difference between the ZACHMAN trade-mark and the Opponent's trade-name when the mark and name are considered as a whole. As with application No. 1,485,469, the parties' wares, services, business and trade are essentially identical. In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular these factors which overwhelmingly favour the Opponent, I find that the Applicant has failed to satisfy its onus of establishing no likelihood of confusion as between the ZACHMAN trade-mark and the Opponent's Zachman International trade-name.

[35] Based on the foregoing, the ground of opposition based on section 16(1)(c) is successful with respect to both applications.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[36] While there is a legal onus on the Applicant to show that the Marks are adapted to distinguish or actually distinguish its Wares and Services from those of others throughout Canada [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[37] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of its pleaded trade-marks and trade-name had become known sufficiently to negate the distinctiveness of the Marks [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[38] As discussed in more detail above in the analysis of the non-entitlement grounds of opposition, the Opponent has established use and reputation for the Zachman International trade-name as of the material date. I am satisfied that the level of reputation evidenced by the Opponent for its Zachman International trade-name is sufficient to meet its evidential burden. The difference in material dates is not significant and as a result my finding under the ground of opposition based on section 16(1)(c) of the Act is equally applicable here. The non-distinctiveness ground of opposition is therefore also successful with respect to the Opponent's trade-name Zachman International.

Disposition

[39] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,485,468 (ZACHMAN) and 1,485,469 (ZACHMAN INTERNATIONAL) pursuant to section 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office