



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

Citation: 2013 TMOB 10
Date of Decision: 2013-01-15

**IN THE MATTER OF AN OPPOSITION
by Couples for Christ Ontario, Inc. to
application No. 1,460,593 for the trade-
mark COUPLES FOR CHRIST
FOUNDATION FOR FAMILY AND
LIFE in the name of Couples for Christ
Foundation for Family and Life
(CFCFFL)**

File History

[1] On November 26, 2009, Couples for Christ Foundation for Family and Life (CFCFFL) (the Applicant) filed an application to register the trade-mark COUPLES FOR CHRIST FOUNDATION FOR FAMILY AND LIFE (the Mark), based on its use in Canada since at least as early as 2007 with the following:

Religious counselling services; counselling services, namely, spiritual advice and guidance to couples, children, youth, single parents, divorced persons, separated persons and individuals through seminars and meetings; social clubs (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 22, 2010.

[3] On October 12, 2010, Couples for Christ, Ontario Inc. (the Opponent) filed a statement of opposition. 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 Artemio

Pangilinan. In support of its application, the Applicant filed the affidavit of Dante Lingatong de Leon. The Opponent filed a written argument.

Ruling at the Oral Hearing

[4] In this case, the Applicant alone requested a hearing which was set for December 12, 2012. As required by the Practice Notice *Practice in Trade-mark Opposition Proceedings* the Applicant confirmed its attendance in advance. Because the Opponent had not requested a hearing, nor confirmed its attendance, and the Applicant had arrived early, I convened the hearing early. At the time originally set for the hearing the Opponent arrived. The Opponent indicated that it had confirmed with the Registrar its attendance at the hearing either by letter or telephone. My review of the file did not show the Opponent having done so but I had no reason to doubt the Opponent's submission. In the circumstances and given that the Registrar's letter of August 29, 2012 appears to provide for attendance by the Opponent at the hearing where it states "Neither party has requested simultaneous translation. If required, simultaneous translation in French and English can be provided upon request by either party", I permitted the Opponent to make representations and indicated that the hearing would recommence with the Applicant beginning its submissions anew. As a last point, I note that the Registrar has been unable to confirm receipt of any such letter or phone call from the Opponent, nor has a copy of any such letter been subsequently provided despite this being requested at the hearing.

Summary of Grounds of Opposition

[5] The Opponent's statement of opposition includes the grounds summarized below:

- (a) contrary to section 30 of the *Trade-marks Act*, RSC 1985, ch T-13 (the Act), the Applicant has not used the Mark in Canada since at least as early as 2007;
- (b) contrary to section 30(i) of the Act, the Applicant could not have been satisfied it was entitled to use the Mark given its knowledge of the previous use and making known of the Opponent's trade-marks COUPLES FOR CHRIST and COUPLES FOR CHRIST & design.
- (c) contrary to section 12(1)(b) of the Act, the Mark is clearly descriptive of the character or quality of the Services;

(d) contrary to section 16(1)(a) of the Act, the Applicant is not the person entitled to registration, since at the filing date the Mark was confusing with the trade-mark COUPLES FOR CHRIST, which had previously been used in Canada in association with counseling services, namely spiritual advice and guidance provided to couples, children, youth, single parents and separated/divorced individuals (the Opponent's Services); and

(e) contrary to section 2 of the Act, the Mark is not distinctive since it cannot distinguish, and is not adapted to distinguish the services of the Applicant from the services of others including those of the Opponent provided in association with the trade-marks COUPLES FOR CHRIST and COUPLES FOR CHRIST & Design.

At the hearing, the agent for the Opponent withdrew the section 12(1)(b) ground of opposition. Therefore, this ground will not be considered. I further note that leave was not sought to amend the statement of opposition to strike this ground.

Material Dates

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

- sections 38(2)(a)/30 – November 26, 2009; the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];

- sections 38(2)(c)/16(1)(a) – 2007; the date of first use alleged in the application;

- sections 38(2)(d)/2 – October 12, 2010; the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC) at para 8].

Onus

[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 support each ground of opposition [*John Labatt Ltd v Molson Companies Ltd*, (1990), 30 CPR (3d) 293 (FCTD)].

History of the Parties

[8] As a preliminary matter, I note that the parties have an intertwined history beginning in the Philippines. Both parties trace their origin to Couples for Christ Foundation, Inc. (Couples for Christ Foundation (Philippines)) registered in the Philippines (Pangilinan affidavit, para 5; de Leon affidavit, paras 6-7). In March 1993, Couples for Christ Global Missions Foundation Inc. (CFC-Global) was incorporated breaking away from the Couples for Christ Foundation (Philippines) (Pangilinan affidavit, para 6; de Leon affidavit, para 9). It appears that the Couples for Christ Foundation (Philippines) was not in good standing and/or was largely inactive for several years before being resurrected on June 5, 2008 (de Leon affidavit para 7; Exhibit 5). In 2007, Frank Padilla, founder of the Couples for Christ Foundation (Philippines), and others agreed to separate ways with CFC-Global and formed the Couples for Christ Foundation for Family and Life as a diocesan association (de Leon affidavit, Exhibit 27). The Couples for Christ Foundation has direct links to Couples for Christ Foundation (Philippines) (de Leon affidavit, para 9). In contrast, the Opponent has direct links with CFC-Global (Pangilinan affidavit, para 15).

Section 30(b) Ground of Opposition

[9] The Opponent alleges that the Applicant has not used the Mark in Canada since at least as early as 2007. The application for the Mark claims a first use date of 2007 which is interpreted as December 31, 2007. Section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing of the application [*Benson & Hedges (Canada) Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[10] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. This burden may be met by reference not only to the opponent's evidence but also to an applicant's [*Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230]. While an opponent may rely upon an applicant's evidence to meet its evidential burden in relation to this ground, an opponent must

show that the applicant's evidence is "clearly" inconsistent with the claims in the application [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB) at 565-6, aff'd (2001), 11 CPR (4th) 489 (FCTD)].

[11] The requirements for use are set out in section 4 of the Act. With respect to services, a trade-mark is deemed to be used in association with services if it used or displayed in the performance and advertising of those services. The services do not necessarily have to have been performed or sold for there to have been use, so long as they are offered to prospective customers in association with the mark and the services are available to be performed [*Modis Inc v Modis Communications Inc*; 2004 CarswellNat 4627 (TMOB) at para 24].

[12] Mr. de Leon, the President and Country Servant of the Applicant, states the following in his affidavit:

13	Since at least as early as the first week of December 2007, the Applicant has used the Mark through Canada in association with the [Services] at least as follows:
a)	Commencing on February 29, 2008, the Applicant held a series of Christian Life Seminars at the St. Andrew Catholic Church in Etobicoke, ON. These seminars included religious counselling services; counselling services, namely, spiritual advice and guidance to couples, children, youth, single parents, divorced persons, separated persons and individuals through seminars and meetings, as well as providing a social club. A copy of the brochure for the seminar was circulated on or about the first week of December 2007 across various churches in the Etobicoke, ON area. A copy of the brochure and the information sheet that participants would have used at the seminar is attached as Exhibit 12.

[13] Having regard to the foregoing, the Applicant's evidence is clearly inconsistent with section 30(b) of the Act and the Opponent has met its burden. While Mr. de Leon states that a brochure was distributed in 2007 it does not appear that the Services were available to be performed until February 2008 at which point the seminars commenced. Unlike the *Bedwell Management Systems Inc v Mayflower Transit, Inc* (1999), 2 CPR (4th) 543 (TMOB) case, there is no documentary evidence or statement from Mr. de Leon leading to the inference that the Services were available since at least as early as December 31, 2007. As such, Mr. de Leon's

evidence is clearly inconsistent with the Applicant's first use date of 2007. Therefore, the Applicant has the onus of showing use of the Mark with the Services from December 31, 2007 until November 26, 2009. The Applicant has not met its onus as there is no evidence showing use as of December 31, 2007. Accordingly, this ground of opposition is successful.

Reasons and Decision: Change of Name Ordered for the Applicant

[14] The Applicant incorporated as Couples for Christ Foundation for Family and Life (CFCFFL) on September 17, 2007 (de Leon Affidavit Exhibit 2). The Applicant subsequently changed its name to Community for Christ Foundation for Family and Life after receiving an order from the Ontario Ministry of the Attorney General based on a decision that there was a high probability of confusion between the Applicant's name Couples for Christ Foundation for Family and Life (CFCFFL) and the Opponent's name Couples for Christ, Ontario Inc. (de Leon Affidavit, Exhibit 1; Pangilinan Affidavit, Exhibit A).

[15] In its written argument, the Opponent states that it:

further opposes the application on the basis that since the commencement of the Applicant, Applicant has lost any entitlement to use the corporate name 'Couples for Christ Foundation for Family and Life' pursuant to a decision of the Legal Services Branch of the Ontario Ministry of Government Services, dated February 3, 2011, under section 13(2) of the Ontario *Corporation Act*.

[16] If the Opponent had wished to oppose the application on the basis of this decision, it would have had to request and been granted leave to amend its statement of opposition. As no such request was made, the Opponent's allegation cannot be considered a separate ground of opposition [*Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC)]. I also note that I do not consider the decision issued on February 3, 2011 to be relevant to any of the grounds of opposition alleged by the Opponent as it post-dates the material date for each ground. Finally, I note that this decision was decided on the basis of the corporate name of the Opponent and in the subject opposition the Opponent can only rely on the use of its trade-marks as it did not include use of its trade-name in the statement of opposition.

Section 30(i) Ground of Opposition

[17] The Opponent alleges that the Applicant could not state it was entitled to use the Mark because it had prior knowledge of the Opponent's trade-marks previously used in Canada. Section 30(i) of the Act requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark in Canada. The jurisprudence suggests that non-compliance with section 30(i) can be found where there are exceptional circumstances such as bad faith which render the applicant's statement untrue [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Cerverceria Modelo, SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB), at 369]. In view of the intertwined history of the parties, I do not find that the evidence results in the inference that there was bad faith on the part of the Applicant with respect to its statement. Accordingly, this ground of opposition is rejected as the Opponent has failed to meet its burden.

Section 16(1)(a) Ground

[18] The Opponent has also pleaded that the Applicant is not the person entitled to registration because the Mark is confusing with the “trade-mark COUPLES FOR CHRIST that had been previously used in Canada and continues to be used in Canada by the Opponent” in association with the Opponent’s Services. The Opponent has an initial evidential burden to prove that it had used or made known in Canada the COUPLES FOR CHRIST trade-mark with the Opponent’s Services prior to 2007, the date of first use alleged in the subject application. The Opponent must also demonstrate that it had not abandoned its trade-mark at the date of advertisement of the Mark, September 22, 2010. Furthermore, section 17 of the Act states that no application for the registration of a trade-mark shall be refused due to previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant or his predecessor-in-title, except at the instance of that other person or his successor-in-title. Therefore, an opponent can only rely upon prior use or making known of its own trade-marks or trade-names.

[19] The evidence of Mr. Pangilinan, Director of the Opponent, includes the following:

- Mr. Pangilinan explains the relationship between the various Couples for Christ branches and organizations (para 14) as follows:

Where I refer to ‘Couples for Christ’, I am referring to the Couples for Christ organization including the international, Canadian, provincial and local Couples for Christ branches, unless I specifically refer to ‘Couples for Christ (Canada)’ in which case I am referring only to the Canadian branch. Finally, where I refer to the Opponent, I am referring to the corporate body which administers the affairs of Couples for Christ in Canada and uses the *Couples for Christ* trade-mark in Canada.

From this I infer that Couples for Christ (Canada) is the Canadian branch of the Couples for Christ organization and that this entity is not the same as the Opponent.

- Mr. Pangilinan states at para 25 that “*Couples for Christ* has been used as a trade-mark by Couples for Christ (Canada) and the Opponent continuously since at least as early 1997.”
- Mr. Pangilinan identifies the *www.couplesforchristcanada.org* website which features both the trade-marks COUPLES FOR CHRIST and COUPLES FOR CHRIST design as the home page of Couples for Christ (Canada) (paras 10 and 22; Exhibits D and M).
- Mr. Pangilinan identifies Couples for Christ (Canada) as the organizer of Christian Life Programs which have been held at over 145 parishes (para 26).
- Mr. Pangilinan identifies the Opponent as the organizer of regular regional, national and international conferences (para 27, Exhibits P and Q). The 2000 conference brochure attached to his affidavit does not appear to reference the Opponent (Exhibit Q).
- Mr. Pangilinan attaches as Exhibit K to his affidavit the International Statutes of Couples for Christ. These statutes states the following:

- 5.1 COUPLES FOR CHRIST in a particular territorial area is divided into chapters, units and households.
- 5.5 ... a National Council may be established. It is the task of the National Council to oversee and promote the life and mission of CFC in a particular country.
- 5.7 CFC groups in a particular country or area may establish COUPLES FOR CHRIST as a foundation or corporation of formal association, in accordance with local and/or national laws, for purposes of conducting transactions as a juridical entity.

7.221 Concretely, CFC groups are expected to do the following:

- Bear the name “Couples for Christ”. A local translation of this name may also be used.
- Adopt the same logo...

7.262 The CFC Council accredits CFC groups as officially part of the international CFC community, and may remove such accreditation for any valid reason or just cause.

[20] In addition, Exhibit 7 to Mr. de Leon’s affidavit includes a Secretary’s Certificate from CFC-Global authorizing Couples in Christ to use its trade-name and display, print and reproduce its logos.

[21] The Opponent has not discharged its evidential burden to prove that it owns and has used either the COUPLES FOR CHRIST trade-mark or the COUPLES FOR CHRIST design trade-mark prior to December 31, 2007. Mr. Pangilinan describes the Opponent as administering the affairs of Couples for Christ in Canada and using the COUPLES FOR CHRIST trade-mark. He, however, is silent about which entity owns the COUPLES FOR CHRIST trade-mark. It appears from the evidence that it may be one of the Phillipines groups that owns this trade-mark in Canada. Finally, it is not clear whether it is the Opponent, the entity defined as Couples for Christ (Canada) or any of the various local branches referenced in Mr. Pangilinan’s affidavit that provide the counseling services referenced in the statement of opposition. Since there is no evidence that a license agreement exists between the Opponent and any of the other branches referred to in Mr. Pangilinan’s affidavit, the evidence of use by other entities does not enure to the benefit of the Opponent. As the Opponent has not met its evidential burden this ground of opposition is rejected.

Distinctiveness Ground of Opposition

[22] The Opponent has alleged that the Mark is not distinctive of the Services in that the Mark does not distinguish, nor is it adapted to distinguish, the Applicant’s Services from those of others, including the Opponent, provided in association with the COUPLES FOR CHRIST and COUPLES FOR CHRIST & design trade-marks.

[23] There is an initial burden on the Opponent to establish that as of October 12, 2010 the COUPLES FOR CHRIST trade-mark was known to such an extent that it could negate the distinctiveness of the Mark. In *Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at para 33, the Federal Court provided that a mark could negate another mark's distinctiveness if it was known to some extent in Canada or if it is well known in a specific area of Canada. Finally, an attack based on non-distinctiveness is not restricted to the advertising or performance of services or sales of goods in Canada. It may also be based on evidence of knowledge or reputation of the relied upon trade-mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58-59]. Since the Opponent has not limited this ground of opposition to only its use, there is no requirement for it to prove that the use of the COUPLES FOR CHRIST trade-mark enures to it to be successful. This can be distinguished from the *Ecosmart Foundation Inc v SJ Electro Systems Inc* (2012), 102 CPR (4th) 401 (TMOB) at para 6 case where the statement of opposition is described as only referencing the opponent's use of its marks.

[24] The evidence relevant to the Opponent's initial burden can be summarized as follows.

- Mr. Pangilinan states that COUPLES FOR CHRIST has been used as a trade-mark by Couples for Christ (Canada) and the Opponent since at least as early as 1997 (para 25).
- The Opponent has organized 14 different Couples for Christ conferences in Canada since 1999 including one in Markham in July 2010 (Exhibit P).
- The 2nd CFC Canada and Family Ministries Conference program (June 30-July 2, 2000, Toronto, Canada) includes use of the COUPLES FOR CHRIST trade-mark and includes congratulations and well wishes from various church officials and households (Exhibit Q) and is an example of a typical conference package (para 28);
- Testimonial letters addressed to or referencing Couples for Christ dated June 11, 1997 onwards from clergy in Toronto and the surrounding area (Exhibit R).
- The June 6, 2009 newsletter of Couples for Christ Manitoba (Exhibit S); and

- The Couples for Christ advertisement in the 2005 Catholic Directory for British Columbia and the Yukon (Exhibit T).

[25] Given the extent of the reputation shown in Exhibits Q and R, I find that the Opponent has met its burden of proving that the trade-mark COUPLES FOR CHRIST was sufficiently known in the Toronto area as of the material date. As such, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to create confusion with the COUPLES FOR CHRIST trade-mark such that it was adapted at the relevant date to distinguish or actually distinguished throughout Canada the Services from the services of others [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272].

[26] 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.

[27] The test for confusion is one of first impression and imperfect recollection. 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 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 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), *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

the inherent distinctiveness of the marks

[28] Neither the Mark or the COUPLES FOR CHRIST trade-mark is strong because they both are composed of ordinary dictionary words which are suggestive of their associated services. The Applicant's evidence that "FOR CHRIST" appears in various trade-marks or on

various websites supports this finding (affidavit of Mr. de Leon, Exhibits 22 and 23). It, however, does not go so far as to show that COUPLES FOR CHRIST lacks any inherent distinctiveness.

length of time in use; extent to which each mark has become known

[29] The length of time and extent to which each mark has become known appears to slightly favour the Opponent as the evidence shows testimonials dating from 1997 and referencing Couples for Christ (Exhibit R). By way of contrast, use of the Mark did not begin until ten years later.

nature of services and trade

[30] The services and nature of the trade of the Applicant and users of the COUPLES FOR CHRIST trade-mark are identical. These entities are charities that promote Catholicism and family and provide services through meetings, seminars and conferences.

degree of resemblance

[31] The Applicant argues that the ending of the Mark FOUNDATION FOR FAMILY AND LIFE serves to distinguish its Services from those of the Opponent and others. While FOUNDATION FOR FAMILY AND LIFE may assist some consumers to distinguish between the Applicant's Services and the services of others, it may not do so for many. This finding is supported by the Applicant's own website which explains that Couples for Christ Foundation for Family and Life was formed in Manila, Philippines on July 30, 2007 by Frank Padilla, who many regard as the founder of the Couples for Christ Foundation (Philippines).

[32] In *Masterpiece*, the Supreme Court of Canada states that a likelihood of confusion cannot be discounted even where subsequent research may remedy confusion (paras 71-74). Rather, confusion is to be assessed by asking what a consumer upon encountering the second trade-mark with an imperfect recollection of the first trade-mark would be likely to think. Even if a consumer knowing or learning of the history of the Applicant, the Opponent and related entities would be able to distinguish between COUPLES FOR CHRIST and the Mark, I am left in a state of doubt as to whether a consumer upon encountering the Mark for the first time would

be able to distinguish between the Mark and the COUPLES FOR CHRIST trade-mark without the benefit of further research or clarification.

lack of confusion

[33] An adverse inference concerning the likelihood of confusion may be drawn when concurrent use is extensive and no evidence of confusion has been given by an opponent [*Christian Dior SA v. Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA) at para 19]. While there is evidence of concurrent use as the Applicant and Couples for Christ conducted classes in a school on the same dates in association with their respective marks there is no evidence showing confusion. I note that I do not accept the issuance of the building permit showing the Opponent's name to the Applicant (Pangilinan affidavit, Exhibit Z) as evidence of source confusion as opposed to clerical error [*385229 Ontario Ltd v ServiceMaster Co* (2012), 101 CPR (4th) 380 (TMOB) at para 44]. The lack of evidence showing confusion is not sufficient for me to find the Mark distinctive as it is not clear to me that the consumers exposed to concurrent use of the Mark and the COUPLES FOR CHRIST trade-mark had not remedied confusion through obtaining further information regarding source. One example of the type of research undertaken by consumers can be seen in an email from Bernardo Consul to Sonny Bautista at Exhibit AA to the Pangilinan affidavit.

conclusion

[34] I find in this case the ultimate issue is whether the Applicant should be granted the monopoly to use the Mark, including slight variations thereto, across Canada in association with the Services. Although I agree with the Applicant that various entities were using COUPLES FOR CHRIST as of the material date and no one party appears to have a monopoly over the use of this phrase, the use of COUPLES FOR CHRIST was not so widespread that it can be said that the Mark distinguishes the Services of the Applicant from those of others [*Petro-Canada v Air Miles International Holdings NV* (1998), 83 CPR (3d) 111 (TMOB) 119-120]. Based on all of the surrounding circumstances, including that the Applicant and various entities using the COUPLES FOR CHRIST trade-mark appear to educate and clarify to consumers the specific source of their respective services, I find that the Applicant has failed to meet the legal onus on it

to prove on balance of probabilities that the Mark was distinctive of the Applicant's Services at the material date. The distinctiveness ground of opposition therefore succeeds.

Disposition

[35] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,460,593 pursuant to section 38(8) of the Act.

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