

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

**Citation: 2011 TMOB 126**  
**Date of Decision: 2011-07-26**

**IN THE MATTER OF AN  
OPPOSITION by 1742280 Ontario  
Limited t/a Where Canada to  
application No. 1,274,047 for the trade-  
mark WHERE CHILDREN HAVE  
FUN LEARNING TO READ in the  
name of Pancil, LLC**

FILE RECORD

[1] On September 29, 2005, Pancil, LLC filed an application to register the trade-mark WHERE CHILDREN HAVE FUN LEARNING TO READ, based on proposed use of the mark in Canada, in association with the wares and services shown below:

*wares*

children's books, children's storybooks

*services*

(1) educational services namely, conducting programs in the field of literacy, numeracy and learning to read; on-line publication of children's books, (2) on-line computer services providing access to children's games and activities and educational materials.

[2] The right to the exclusive use of the words CHILDREN and LEARNING TO READ is disclaimed apart from the mark as a whole. The applicant claims a priority filing date of September 24, 2005, pursuant to s.34 of the *Trade-marks Act*, R.S.C. 1985,

c. T-13, based on the filing of a corresponding trade-mark application in the United States of America.


[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated September 27, 2007 and was opposed by 1742280 Ontario Limited t/a Where Canada on November 20, 2007. The Registrar forwarded a copy of the statement of opposition to the applicant on December 4, 2007 as required by s.38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The opponent's evidence consists of the affidavit of Elenita Anastacio. The applicant's evidence consists of the affidavit of Dr. Frank Maurer. Dr. Maurer was cross-examined on his affidavit, the transcript thereof forming part of the evidence of record. Only the applicant filed a written argument, however, both parties attended at an oral hearing held on June 21, 2011.

STATEMENT OF OPPOSITION

[5] The opponent pleads that it is the owner of the marks listed below:

REGISTERED MARK	WARES/SERVICES
WHERE	books, magazines . . .
WHERE	computer software for editorial content . . . travel services . . .
WHERE MAGAZINES INTERNATIONAL	publication of books, magazines . . .
WHERE FAMILY	magazines, newsletters, maps . . .
WHERE ON-LINE	computer software, hardware . . . electronic publishing . . .
WHERE THE FINDS ARE	operation of retail stores, restaurants . . . entertainment services
WHERE LOCALS HIKE	hiking and outdoor guidebooks, postcards

APPLIED FOR MARK	SERVICES
WHERE TELEVISION	information and education services relating to visitors and tourists . . .
	information and education services relating to visitors and tourists . . .

[6] The first ground of opposition, pursuant to s.12(1)(d) of the *Trade-marks Act*, alleges that the applied for mark is not registrable because it is confusing with the opponent’s above mentioned registered marks.

[7] The second ground of opposition, pursuant to s.16(3) of the *Act*, alleges that the applicant is not entitled to register the applied for mark because, at the filing date of the application (that is, the priority filing date), the applied for mark was confusing with the opponent’s above mentioned marks, and trade-name, previously used in Canada.

[8] The third ground, pursuant to s.30(i), alleges that the applicant was aware of the opponent’s use of its marks and trade-name and therefore the applicant could not have been satisfied of its entitlement to use the applied for mark.

[9] The fourth ground, pursuant to s.30(d), alleges that “the U.S. registration relied upon is invalid and not properly relied upon” because the applicant never used its mark in the United States in association with the wares and services set out in the subject application.

[10] The fifth and final ground, pursuant to s.2, alleges that the applied for mark is not distinctive of the applicant nor capable of becoming distinctive of the applicant.

OPPONENT’S EVIDENCE

*Elenita Anastacio*

[11] Ms. Anastacio identifies herself as a trade-marks searcher employed by the agents for the opponent. Her affidavit serves to introduce into evidence, by way of exhibit material, particulars of the opponent’s trade-mark registrations and applications relied on in the statement of opposition.

#### APPLICANT'S EVIDENCE

*Dr. Frank Maurer*

[12] Dr. Maurer identifies himself as a professor of computer science at the University of Calgary. He was asked to “analyze the likelihood that Internet users would confuse the web site of [www.starfall.com](http://www.starfall.com) [the applicant’s web site] and [www.where.ca](http://www.where.ca) [the opponent’s web site] and their respective trade-marks.” He concludes that it is unlikely an Internet search engine user will confuse the sites because (1) the purpose, contents and graphical design of the sites are substantially different, and (2) an Internet search, based on targeted keywords, would not list both sites on the first results page of the search.

[13] In my view, Dr. Maurer’s affidavit evidence and his testimony on cross-examination deal with two questions: first, would Internet users searching for the opponent’s web-site be led to the applicant’s web-site (and vice-versa), and second, would Internet users readily distinguish between the two sites? The evidence is fairly convincing that the answer to the first question is “no” (and “no”) while the answer to the second question is “yes.” However, Dr. Maurer’s evidence has a fairly low degree of probative value with respect to the question of trade-mark confusion as defined in s.6(2) of the *Trade-marks Act*, which poses a different issue than the issues addressed by Dr. Maurer. Accordingly, I give no probative value to his statement (at page 3, paragraph two, of his report) that “the likelihood of confusion is extremely low.” Further, it is clear from the transcript of cross-examination that Dr. Maurer does not employ the word “confusion” in a trade-mark sense as contemplated by s.6(2). Nevertheless, Dr. Maurer’s evidence may be considered as information of a surrounding circumstance which is relevant to the issue of trade-mark confusion, in accordance with s.6(5) of the *Trade-marks Act*.

#### LEGAL ONUS AND EVIDENTIAL BURDEN

[14] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*,

30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

#### MAIN ISSUE & MATERIAL DATES

[15] With respect to the third ground of opposition, s.30(i) applies if fraud is alleged on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark applied for: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221. In the instant case the pleadings do not support the ground of opposition pursuant to s.30(i) and it is therefore rejected. With respect to the fourth ground of opposition pursuant to s.30(d), it is not clear that the pleadings raise a valid ground of opposition. In any event, the opponent has not met its evidential burden to put the fourth ground in issue and it is therefore rejected. I would mention that, at the oral hearing, counsel for the opponent advised that he would not be addressing the third and fourth grounds of opposition although the third and fourth grounds were not being withdrawn.

[16] The main issue with respect to the remaining grounds is whether the applied for mark WHERE CHILDREN HAVE FUN LEARNING TO READ is confusing with either of the opponent's marks WHERE and WHERE FAMILY. In this regard, the opponent's two aforementioned marks resemble the applied for mark more than any other of the opponent's marks. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark and either of the opponent's marks:

The 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 . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[17] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's wares and services, which focus on the education of children, as products and services emanating from or sponsored by or approved by the opponent.

[18] The material dates to assess the issue of confusion are (i) the date of decision, with respect to the first ground of opposition alleging non-registrability; (ii) the priority filing date of the application, in this case September 24, 2005, with respect to the second ground of opposition alleging non-entitlement; and (iii) the date of filing the statement of opposition, in this case November 20, 2007, in respect of the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). However, in the circumstances of the instant case, nothing turns on whether the issue of confusion is assessed at a particular material date.

#### TEST FOR CONFUSION

[19] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

#### *Consideration of s.6(5) Factors*

[20] Neither of the opponent's marks WHERE and WHERE FAMILY possesses a high degree of inherent distinctiveness as the marks are comprised of common English

language words. Similarly, the applied for mark does not possess a high degree of inherent distinctiveness. The applied for mark is based on proposed use in Canada and there is no evidence indicating that use of the mark commenced at any time. Thus, the applied for mark would not have acquired any reputation at any material time. There is some evidence that the opponent's mark WHERE, used in association with magazines, had acquired at least some reputation at all material times: see page 5, Q 21 to page 6, Q 14 of Dr. Maurer's transcript of cross-examination. However, there is no evidence that the opponent's mark WHERE FAMILY acquired any reputation at any material time. Thus, the first factor, which is a combination of inherent and acquired distinctiveness, favours the opponent with respect to its mark WHERE, but only marginally.

[21] Based on page 6, Q 4 of Dr. Maurer's transcript of cross-examination, the opponent has established use of its mark WHERE since about 2005. Thus, the length of time that the marks have been in use is a factor that favours the opponent with respect to its mark WHERE. However, given that there is negligible evidence regarding the extent of use of the mark WHERE, and that the opponent's only evidence of use of the mark WHERE dates from about the same time that the subject application was filed, the length of time that the marks in issue have been in use is a factor that favours the opponent but only marginally.

[22] Based on the parties' wares and services as specified in their trade-mark registrations and applications, and based on Dr. Maurer's description of the content of the parties' web sites, it appears that the opponent's business focus is to provide to travelers, by various means, information about restaurants, shops, hotels and activities in Canadian cities. The applicant's business focus is children's education. Accordingly, the natures of the parties' wares, services and businesses are substantially different. In the absence of evidence to the contrary, I assume that the natures of the parties' trades are also different.

[23] The parties' marks necessarily resemble each other to some extent owing to the component WHERE which is the prefix of the applied for mark and of the opponent's mark WHERE FAMILY and which comprises the entirety of the opponent's mark WHERE. However, when the marks in issue are compared in their entireties, their visual and auditory differences outweigh any similarities. Further, the parties' marks do not suggest similar ideas.

[24] As stated in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149:

Realistically appraised it is **the degree of resemblance** between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and **is the dominant factor** and other factors play a subservient role in the over-all surrounding circumstances.

(emphasis added)

In the instant case, the principle enunciated in *Beverly Bedding*, above, is of particular import as the parties have provided little evidence to establish the significance of the other factors listed in s.6(5) which bear on the issue of confusion.

#### DISPOSITION

[25] In view of the foregoing, I find that at all material times the applicant has met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark and any of the opponent's marks.

[26] The opposition is therefore rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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Myer Herzig  
Member  
Trade-marks Opposition Board