



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

Citation: 2014 TMOB 198
Date of Decision: 2014-09-23

**IN THE MATTER OF AN OPPOSITION
by Canadian Junior Golf Association
/L'association Canadienne de Golf Junior
to application No. 1,542,349 for the trade-
mark THE MBA TOUR YOUR FUTURE
BEGINS HERE & Design in the name of
The MBA Tour, Inc.**

FILE RECORD

[1] On August 26, 2011, The MBA Tour, Inc. filed an application to register the mark THE MBA TOUR YOUR FUTURE BEGINS HERE & Design, shown below, based on (i) use in Canada, and (ii) use and registration of a corresponding trade-mark application in the United States of America, in association with the following services:



used in Canada since at least as early as March 2003

(1) Promoting graduate school business programs; Organization of travel packages for business school representatives; Providing on-line information in the field of graduate business school programs and admissions; Providing on-line newsletters in the field of graduate business school programs and admissions.

used in Canada since at least as early as November 2006

(2) Event planning and management for promoting graduate school business programs; Arranging and organizing educational conferences, panels, workshops, and presentations in the field of business school programs and admissions.

used in Canada since at least as early as May 2010

(3) Matching graduate business schools with potential school applicants by means of conducting surveys.

used and registered in the United States

(4) Promoting graduate school business programs; event planning and management for promoting graduate school business programs; matching graduate business schools with potential school applicants by means of conducting surveys; organization of travel packages for business school representatives; arranging and organizing educational conferences, panels, workshops, and presentations in the field of business school programs and admissions; providing on-line information in the field of graduate business school programs and admissions; providing on-line newsletters in the field of graduate business school programs and admissions.

[2] For ease of reference I will refer to the applied-for mark simply as THE MBA TOUR, that is, the dominant part of the mark.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 18, 2012 and was opposed by Canadian Junior Golf Association/L'association Canadienne de Golf Junior on September 18, 2012. The Registrar forwarded a copy of the statement of opposition to the applicant on September 25, 2012, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] Only the opponent filed evidence namely, the affidavit of Elenita Anastacio. Her affidavit serves to introduce into evidence (i) particulars of the opponent's registered mark that it is relying on in the statement of opposition, (ii) particulars of the subject application, and (iii) the history of the applicant's website from September 15, 1998 to June 6, 2003 obtained through a Wayback Machine Internet Archive search. The search indicates that the applied-for mark THE MBA TOUR first appeared on the applicant's website on June 6, 2003.

[5] Neither party submitted written arguments. Only the opponent was represented at an oral hearing held on August 21, 2014.

STATEMENT OF OPPOSITION

[6] Various grounds of opposition are pleaded, however, the only grounds supported by evidence are the first and third grounds of opposition, summarized below.

[7] 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 registered mark YOUR FUTURE STARTS HERE, which registration covers (i) various items of merchandise, including promotional type items, all of which explicitly, or presumably, relate to the sport of golf, and (ii) the services listed below:

internet services, namely, online interactive publications, interactive computer services, allowing information **all relating to golf** to be accessible to businesses and consumers through the worldwide web;

educational services, namely interactive website services, through the worldwide web, and face to face instructions and lessons **relating to golf and golf tournaments and events**;

electronic commerce, namely interactive website services through the worldwide web for the purposes of online selling of retail products and services **relating to sports**;

retail services, namely the operation of a retail outlet selling **golf products and supplies**;

arranging, promoting and the staging of provincial, national and international **golf tournaments** and events, namely, **golf banquets, golf fundraisers, golf clinics, golf camps**, longest drive fundraisers and closest to the hold[sic] fundraisers.

(emphasis added)

[8] Of course, a non-dominant component of the applied-for mark, namely the portion *Your future begins here*, may be viewed as a variant of the opponent's mark YOUR FUTURE STARTS HERE, that is, essentially the same as the opponent's mark. The material date for considering the first ground of opposition based on s.12(1)(d) is the date of my decision: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at (FCTD) pp. 206 – 209.

[9] The third ground of opposition, pursuant to s.30(b) of the *Act*, alleges that the applicant has not used the applied-for mark THE MBA TOUR in Canada “as of the date of first use alleged or at any time.”

LEGAL ONUS AND EVIDENTIAL BURDEN

[10] Before addressing the grounds of opposition, I will first review (i) the evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove that its application ought to proceed to registration.

[11] With respect to (i) above, there is 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 CPR (3d) 293 at 298 (FCTD). 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. With respect to (ii) above, 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 (for those allegations for which the opponent has met its evidential burden). The presence of a legal 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.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

First Ground – Are the Parties’ Marks Confusing?

When Are Trade-marks Confusing?

[12] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) of the *Trade-marks Act*, shown below:

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.

[13] 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 purchasers of the applicant's educational and ancillary services sold under the mark THE MBA TOUR would believe that those services were provided or authorized or licensed by the opponent who offers its golf related services, and wares, under the mark YOUR FUTURE STARTS HERE. The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

Test for Confusion

[14] 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)(a) to s.6(5)(e) 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 and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as 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 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

[15] The applied-for mark possesses a relatively low degree of inherent distinctiveness in relation to the applicant's services as the component MBA would be understood as a reference to the term “Master of Business Administration.” The secondary component of

the applied-for mark is the phrase “*Your future begins here*” which has a somewhat laudatory connotation, that is, the mark suggests that the purchaser’s future life will be different and enhanced by participating in the applicant’s services. The design component of the applied-for mark namely, the tilted ellipse feature, adds little to the inherent distinctiveness of the mark as a whole. Similarly, the opponent’s mark YOUR FUTURE STARTS HERE possesses a low degree of inherent distinctiveness owing to its laudatory connotation. Neither party has shown that its mark has acquired any distinctiveness. The first factor, which is a combination of inherent and acquired distinctiveness, therefore favours neither party.

[16] The second factor, that is, the length of time that the parties’ marks have been in use, also favours neither party. In this regard, neither party has evidenced actual use of its mark in the marketplace. The nature of the parties’ services and businesses, assessed on the basis of the services set out in the subject application and in the opponent’s registration, are quite different. In this regard, the applicant’s activities center on graduate school business programs while the opponent’s activities center on the sport of golf. In the absence of evidence to the contrary, I assume that the parties’ channels of trade would be different because the services offered by the parties are different. The third and fourth factors therefore favour the applicant.

[17] In my view, the parties’ marks are much more different than alike in all three aspects of resemblance, that is, different visually, aurally and in ideas suggested. In this regard, the dominant component of the applied-for mark is the phrase THE MBA TOUR which is quite different from the opponent’s mark YOUR FUTURE STARTS HERE. While it is true that the applicant has incorporated essentially the whole of the opponent’s mark (albeit replacing STARTS with a synonym BEGINS), nevertheless, the incorporated portion comprises a non-dominant secondary component of the applied-for mark.

[18] The visual impact of the applied-for mark is much different than the visual impact of the opponent’s mark owing to the dominant component THE MBA TOUR. The

applied-for mark would likely be sounded simply as “the M B A tour” while the opponent’s mark would be sounded as “your future starts here.” Further, the main idea suggested by the applied-for mark is the Master in Business Administration program which is quite different than the idea suggested by the opponent’s mark: see para. 15, above. The last and most important factor, resemblance, therefore favours the applicant.

[19] In view of the foregoing s.6(5) analysis, I find that the parties’ marks are not confusing. The first ground of opposition is therefore rejected.

Third Ground – Was the Applied-for Mark in Use as of the Dates Claimed?

[20] With respect to the third ground of opposition, the opponent relies on its Wayback Machine search evidence to support its allegation that the applicant did not use the applied-for mark until some time after June 6, 2003. As the evidential burden on the opponent is relatively light in respect of a s.30(b) ground of opposition, I find that such evidence suffices to put the third ground into issue: see *Corporativo de Marcas GJB, SA de CV v. Bacardi & Company Ltd.*, 2014 FC 323 (CanLII) at paragraphs 30-38. The applicant has done nothing to meet the legal onus on it, and therefore the opponent succeeds on the third ground of opposition - but only in respect of the services for which the applicant has claimed a date of first use prior to June 6, 2003. Accordingly, the third ground of opposition succeeds with respect to the services denoted by (1) in para.1, above, where March 31, 2003 is claimed as a date of first use.

DISPOSITION

[21] Having regard to the above,

- (i) the application is refused in respect of the services denoted by (1) in paragraph 1, above,

(ii) otherwise, the opposition is rejected.

[22] Authority for a divided decision is found in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD).

[23] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office