



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

**Citation: 2013 TMOB 114**  
**Date of Decision: 2013-06-28**

**IN THE MATTER OF AN OPPOSITION  
by Starbucks (HK) Limited to application  
No. 1,272,769 for the trade-mark NOW  
TV in the name of Rogers Broadcasting  
Limited**

Background

[1] Rogers Broadcasting Limited (the Applicant), applied to register the trade-mark NOW TV based upon use of the Mark in Canada since at least as early as 2001. The statement of wares and services currently reads:

**WARES:**

Print and on-line publications, namely television program guides, newsletters, brochures, books; water bottles; videotapes containing pre-recorded television programming; watches; clothing, namely vests, jackets and t-shirts; decorative posters for hanging on wall; calendars; address labels.

**SERVICES:**

Television broadcasting; television programming; production of television programs; operation of an Internet website featuring information on television programming, community events and activities, contests, advertising for third parties; sponsorship of festivals and fundraising/public

awareness events and campaigns for the benefit of local communities. Provision of on-line publications via an internet website.

[2] The Applicant disclaimed the right to the exclusive use of TV apart from the trade-mark as a whole in respect of television program guides, video tapes containing pre-recorded television programming, television broadcasting; television programming; production of television programs; operation of an internet website featuring non-television programming. Trinity Television Inc., (the Applicant's predecessor-in-title) and also the owner of the official mark NOWTV, application No. 913106 consented to the Applicant's adoption, use and registration of NOW TV as a trade-mark pursuant to section 9(2) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), and that consent is of record.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 24, 2006.

[4] Starbucks (HK) Limited (the Opponent), opposed the application on February 19, 2008. The Applicant requested an interlocutory ruling regarding certain alleged deficiencies in the pleadings. In response, the Opponent requested leave to amend its statement of opposition. By Office Letter dated October 28, 2008, leave was granted to the Opponent to file its amended statement of opposition and a ruling issued striking certain of the deficiencies in the statement of opposition.

[5] The application has been opposed on the following grounds: (i) the Applicant did not use the Mark in Canada in association with the wares and/or services since the claimed date of first use; (ii) the Applicant is not the person entitled to registration because, at the Applicant's date of first use, the Mark was confusing with the Opponent's trade-mark application Nos. 1038510 and 1015895 for the trade-marks NOW and Design, and NOW NETWORK OF THE WORLD and Design (both shown below); and (iii) the Mark does not distinguish the Applicant's services from the wares and services of the Opponent due to the prior use in Hong Kong and the United Kingdom and making and/or becoming known in Canada of NOW, NOW NETWORK OF THE WORLD and Design, NOW and Design, and NOW TV and Design, by the Opponent in association with similar or related wares and services.



Application No. 1038510



Application No. 1015895

[6] The Applicant filed and served a counter statement in which it generally denied the Opponent's allegations. The Applicant also stated in its counter statement that, in accordance with section 9(1)(n)(iii) and 3 of the Act, the Opponent is prohibited from adopting in Canada any mark that so nearly resembles as to be likely to be mistaken for the official mark that is the subject of Application No. 913106 (NOWTV). Essentially, the Applicant has pled that the Opponent is prohibited from relying on its trade-marks (and in particular its NOW and Design mark) to support any grounds of opposition. I will comment on this pleading further in the analysis of the non-entitlement ground of opposition below.

[7] The Opponent did not file any evidence. As its evidence, the Applicant filed a certified copy of the file wrapper for application No. 1,272,769 (i.e. the Mark). Both parties filed a written argument and were represented at an oral hearing.

[8] At the oral hearing, the Opponent withdrew the ground of opposition based on section 38(2)(d) of the Act.

#### Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 16(1)(b) – the Applicant’s date of first use [section 16(1)].

#### Section 30(b) Ground of Opposition

[11] The section 30(b) ground, as pleaded, is that the Applicant did not use the Mark in Canada in association with the wares and/or services since the claimed date of first use. The date of first use claimed for the wares and services is 2001, which is interpreted as December 31, 2001. At the oral hearing, the Opponent submitted that it is not contesting the Applicant’s claimed date of first use but is alleging that neither the Applicant nor its predecessor-in-title Trinity Television Inc. had used the Mark continuously from the date claimed until the filing date of the application.

[12] Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262].

[13] The initial evidential burden on an opponent respecting the issue of the applicant's non-compliance with section 30(b) of the Act is light because the facts regarding an applicant's first use are particularly within the knowledge of the applicant.[see *Tune Masters v Mr P's Mastertune Ignition Services Ltd.* (1986), 10 CPR (3d) 84 (TMHO) at p. 89]. This burden may be met by reference not only to the opponent's evidence but also to the applicant's [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1986), 10 CPR (3d) 84 (TMOB) at 89]. However, while an opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, in order to do so, it must show that the applicant's evidence is "clearly" inconsistent with the applicant's claims set forth in its application [see *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)].

[14] In the present case, the Opponent is relying on the Applicant's evidence to support its section 30(b) ground of opposition. The Opponent points to a letter in the file wrapper dated May 31, 2005, addressed to the Applicant from the Applicant's predecessor-in-title wherein the Applicant's predecessor-in-title provides consent to the Applicant's adoption, use and registration of the official mark NOWTV, effective June 1, 2005. The Opponent submits that if the Applicant or its predecessor-in-title had in fact used the Mark continuously from 2001 to the date of filing (i.e. Sept. 20, 2005), they should have provided evidence of such use.

[15] The ground of opposition, as pleaded, does not allege that the Applicant's *predecessor-in-title* did not use the Mark in Canada since the claimed date of first use. The ground as pleaded is that the *Applicant* did not use the Mark in Canada in association with the wares and/or services since the claimed date of first use. Where an opponent has pleaded that the application fails to comply with a section of the Act based on a particular set of circumstances, it is not permissible to refuse it on the basis that it does not comply with that section of the Act for reasons different than those pleaded [see *Le Massif Inc and Station Touristique Massif du Sud* (1993) Inc, 95 CPR (4th) 249 (FCTD)].

[16] Even if the Opponent can rely on this ground of opposition as pleaded, I would not have been satisfied that the Opponent has met its initial burden. In this regard, the application is based on use by the Applicant or the Applicant's predecessor-in-title since at least as early as 2001. In my view, there is nothing clearly inconsistent with the letter dated May 31, 2005 which suggests that the Mark was used by the Applicant's predecessor-in-title until May 31, 2005, and then used by the Applicant from that date on.

[17] This ground of opposition is therefore unsuccessful.

#### Sections 16(1)(b) Ground of Opposition

[18] The Opponent also pleads that the Applicant is not the person entitled to registration pursuant to section 16(1)(b) on the basis that the Mark is confusing with application No. 1038510 for the mark NOW and Design filed December 6, 1999, and application No. 1015895 for the mark NOW NETWORK OF THE WORLD and Design filed in Canada May 18, 1999.

[19] The Opponent did not evidence either of its applications. The Applicant submits that, by not filing certified copies of its applications, the Opponent has not met its burden under this ground. The Applicant further submits that I should not exercise my discretion to check the Trade-mark Office Records to confirm the existence of the Opponent's applications as they could have changed considerably in the 12 year period since the material date of December 31, 2001.

[20] The Opponent argues that even if it had filed certified copies of its applications as its evidence pursuant to section 41 of the *Trade-mark Regulations*, SOR/96/195 (the Regulations) (i.e. on or before September 10, 2010), any such certified copies would merely have shown the state of the Opponent's applications as of that date, and not as of the material date of December 31, 2001.

[21] The only way I could have verified the content of the Opponent's applications as of the material date would have been if I had been provided with certified copies of the Opponent's file wrappers for those applications as evidence. That being said, in my view, any amendments the Opponent could have made to its applications prior to the material date would not likely have affected the issue of confusion in the present case [see section 31 of the Regulations].

[22] Therefore, having regard to the potential public interest in assessing a section 16(1)(b) ground, I have exercised my discretion to check the Trade-marks Office records to confirm the existence of the Opponent's pending applications being relied upon in support of this ground [see *Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB) at 529]. I confirm the existence of the Opponent's application No. 1038510 and note that it was filed prior to the Applicant's date of first use and was pending as of the Applicant's date of advertisement (i.e. May 24, 2006).

[23] The Opponent's application No. 1015895 was also filed prior to the Applicant's date of first use and was pending as of the advertisement of the Applicant's application. The Opponent has therefore also met its burden under section 16(1)(b) with respect to this trade-mark even though this application was subsequently abandoned on October 7, 2009 [see *ConAgra, Inc v McCain Foods Ltd* (2001), 14 CPR (4th) 288 (FCTD) and section 16(4)].

[24] I consider that the Opponent's NOW and Design mark presents the Opponent's strongest case because I find it more similar to the Mark than the Opponent's NOW NETWORK OF THE WORLD and Design mark. Therefore, if the Opponent does not succeed under this ground with respect to this mark, it will also not succeed with respect to its other mark.

[25] The long list of wares and services applied for under the Opponent's application No. 1015895 are set out in the attached Schedule A. Of particular note are the following wares and services:

**WARES:**

Apparatus for recording, transmission or reproduction of sound or images, namely, video cassettes recorders, blank audio cassettes and video cassettes;

**SERVICES:**

Telecommunication services, namely, diffusion of television programmes via the Internet, television, radio, satellite, microwave link, terrestrial cables; relaying of television programmes by satellite; ... dissemination of television programmes relayed by satellite receiver aerials by cable or by microwave link to television receivers or users; operation of television cable

networks;...cable television broadcasting, television broadcasting, video broadcasting, audio and video broadcasting programs via a global computer network.

[26] 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. 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.

[27] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them 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)]. In *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) , the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

*section 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[28] While the Supreme Court of Canada in *Masterpiece* observed that the first word of a trade-mark may be the most important for purposes of distinction [see also *Conde Nast Publications v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[29] The Applicant submits that the design of the letter O in the Opponent's mark is the mark's most distinguishing feature. I agree. The design of the letter O is indeed the focal point



of the Opponent's mark as it includes what the Applicant submits are beams of light shooting out from it.

[30] The Applicant's Mark, on the other hand, is a word mark. While the Applicant has disclaimed the exclusive use to the word TV apart from the Mark as a whole for certain wares and services that are related to television, I agree with the Opponent that the disclaimer of this word element does not remove the element from the Mark. The Mark must be considered in its totality, and the disclaimed portion forms part of the Mark as a whole.

[31] I conclude that there is a high degree of resemblance between the marks in sound as the Applicant has adopted the Opponent's word mark in its entirety and only added the non-distinctive component TV to it. In view of the distinctive design component of the Opponent's mark, I do not consider there to be a high degree of resemblance between the marks visually. Finally, I find that the ideas suggested by the marks are different as the Mark suggests immediate television while the Opponent's mark could mean anything immediate. I will add at this point that while both the Mark and the Opponent's NOW NETWORK OF THE WORLD and Design mark may suggest a broadcasting network, the differences between these marks in appearance and sound outweigh any similarity in idea suggested.

*section 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known*

[32] The Opponent's mark possesses a higher degree of inherent distinctiveness than the Mark because of its distinctive design component. With respect to the extent to which the trade-marks have become known, there is no evidence that either party's mark has been used or made known in Canada.

*section 6(5)(b) - the length of time each trade-mark has been in use*

[33] As there is no evidence of use of either the Mark or the Opponent's mark, this factor does not favour either party.

*sections 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade*

[34] The Opponent submits that the Applicant's "videotapes containing pre-recorded television programming" overlap with the Opponent's "apparatus for recording, transmission or reproduction of sound or images, namely, video cassettes recorders, blank audio cassettes and video cassettes". The Applicant, on the other hand, submits that these wares are different in that the Applicant's videotapes contain pre-recorded television programming whereas the Opponent's wares do not. I agree with the Applicant.

[35] As for the parties' services, the Applicant's television broadcasting, television programming and production of television programs clearly overlap with the Opponent's services. I do not find that the remaining applied for services are that similar to those of the Opponent.

[36] With respect to the parties' channels of trade, in the absence of evidence to the contrary, I assume that the parties' channels of trade for the overlapping services would also overlap.

*Surrounding circumstances*

[37] As a further surrounding circumstance, the Applicant relies on part of what it pleaded in its counter statement as previously noted. The Applicant submits that, under section 9(1)(n)(iii) of the Act, the Opponent should be prohibited from adopting its marks in Canada because they so nearly resemble as to be likely to be mistaken for the Applicant's predecessor-in-title's official mark NOWTV that is the subject of application No. 913106. The Applicant adds that I can take judicial notice of this official mark. As I understand it, the Applicant is arguing that the Opponent is prohibited from relying on its applied for marks because they are not registrable in view of the Applicant's predecessor-in-title's official mark.

[38] Even if I were able to take judicial notice of the official mark NOWTV, I do not see how this would assist the Applicant in this proceeding. Indeed, while I empathize with the Applicant's situation, I do not have the jurisdiction to prohibit the Opponent from relying on its applied for marks in the present proceeding.

[39] A parallel can be made between the present situation and the one in *Molson Canada v Anheuser Busch Inc* (2010), 82 CPR (4th) 169 FC at p.189-190, wherein the Federal Court stated the following with respect to the Registrar's jurisdiction in an opposition proceeding:

In an opposition proceeding the Member is limited to determining if a proposed trade-mark is or is not registerable. The Registrar is not to register a new mark if there is a confusing mark on the register. If the registration of an invalid trade-mark is interfering with the registration of a new trade-mark, the applicant can take the necessary steps to have the register corrected (see *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* , [1968] 2 Ex. C.R. 22, 54 C.P.R. 49 , rev'd on other grounds, 57 C.P.R. 1 , [1969] S.C.R. 192 (S.C.C.). ...

In an opposition proceeding, based upon confusion with a registered mark, the validity of the opponent's registered trade-mark is not in issue.

[40] I find that the above reasoning equally applies to the present case even though the Opponent's marks in the present case are not registered marks. As a result, I find that I do not have the jurisdiction to prohibit the Opponent from relying on its applied for marks in this opposition.

#### *conclusion*

[41] 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 the similarities between the parties' marks in sound and the overlap between some of their services, I find that the Applicant has not discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's NOW and Design mark with respect to television broadcasting, television programming and production of television programs.

[42] However, I am dismissing the ground of opposition based on section 16(1)(b) with respect to the applied for wares and the remaining services as I find that the differences in the wares and the nature of the services is sufficient to shift the balance of probabilities in the Applicant's favour.

Disposition

[43] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application with respect to the services: television broadcasting, television programming and production of television programs. I reject the opposition with respect to wares and the remaining services pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

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Cindy R. Folz  
Member,  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## **SCHEDULE A**

**APPLICATION NO: 1038510**

**TRADE-MARK: NOW and Design**

### **WARES:**

(1) Apparatus for recording, transmission or reproduction of sound or images, namely, video cassettes recorders, blank audio cassettes and video cassettes; telecommunication apparatus, namely, telephone answering sets, automatic telephone dialing devices, electrical devices for recording, emission, transmission, reception, reproduction and processing of sounds, signals, characters and/or images, namely, devices for recording, processing, sending, transmission, switching, storage and output of messages and data, namely, radio transmitters, telephone transmitters, audio transmitters, video transmitters, radio receivers, telephone receivers, audio receivers, video receivers, stereo receivers, modems, signal amplifiers, stereo amplifiers, sound amplifiers, optical amplifiers, concentrators, multiplexers, cross connects, computer servers, video on demand servers, switching equipment; mobile radio equipment, namely radios, citizen band radios, mobile radios; television transmitters and data processors; televisions; receivers for use with computers, and computers; computer apparatus and peripherals, namely, lap tops, notebooks, devices, namely, keyboards, monitors and data transmitters, namely radio transmitters, telephone transmitters, video transmitters; modems, optical scanners, computer scanners; transmitters of electronic signals, namely radio transmitters; parts for all the aforesaid goods, none of the aforementioned goods cover sound recordings and audio visual recordings featuring musical performances, electronic transmission recordings featuring musical performances

### **SERVICES:**

(1) Telecommunication services, namely, diffusion of television programs via the Internet, television, radio, satellite, microwave link, terrestrial cables; relaying of television programs by satellite; operation of satellite-to-earth receiver aerials; frequency conversion of microwave signals relayed by satellites; dissemination of television programs relayed by satellite receiver

aerials by cable or by microwave link to television receivers or users; operation of television cable networks; provision and operation of radio, telephone, telegraph, satellite, cable network, internet, microwave link, terrestrial cables, wireless and wirelink communications systems; videotext and teletex transmissions services; time sharing services for communications apparatus in the field of telecommunications; providing telecommunication connections to the Internet or databases; telecommunication gateway services; radio broadcasting, cable television broadcasting, television broadcasting, video broadcasting, audio and video broadcasting programs via a global computer network, subscription television broadcasting; transmission of data, messages, images, sound, and video via television, microwave, radio, computer network, cable, telephone, and satellite; internal computer information networks; providing multiple user access to a global computer network; operation of earth-to-satellite television transmitters for transmission of signals to satellite; video conferencing services, paging services, wireless digital messaging services, personal communication services, telecommunication gateway services, local and long distance telephone services, mobile telephone communications services, mobile radio communication services, radio programming services, radio broadcasting services; provision of multimedia information and interactive multimedia service in the field of telecommunications; electronic mail services; facsimile communication services; rental of communication apparatus and equipment, namely computers, computer modems, two-way radios, telephones, pagers, mobile phones, audio transmitters, video transmitters, audio receivers and video receivers; and advisory services related thereto.