



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

Citation: 2014 TMOB 97
Date of Decision: 2014-05-08

**IN THE MATTER OF AN OPPOSITION
by The Knot, Inc. and The Bump Media,
Inc. to application No. 1,402,224 for the
trade-mark the bump in the name of
Kenneth Alan Maclean**

[1] Kenneth Alan Maclean has applied to register the trade-mark “the bump” in association with operating a website and providing information in the field of family planning, conception, pregnancy, childbirth and parenting and printed materials relating to health, pregnancy, parenting and childcare.

[2] The Knot, Inc. and its subsidiary The Bump Media, Inc. have opposed the application primarily on the basis that there is a reasonable likelihood of confusion between this trade-mark and the trade-mark THE BUMP, previously used in association with online publications in the nature of resource guides for pregnant women and new moms in the field of pregnancy and printed resource guides for pregnant women and new moms in the field of pregnancy and newborn/infant parenting. The application has also been opposed on the ground that it does not comply with various requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] For the reasons that follow, I have found that this application should be refused.

Background

[4] On July 4, 2008, Kenneth Alan Maclean (the Applicant) filed application No. 1,402,224 for the registration of the applied-for mark, the bump (the Mark) based on proposed use in association with the following wares:

WARES:

(1) Printed material, namely, magazines, books and pamphlets relating to health, pregnancy, parenting and child care,

and on use since July 3, 2008, in association with the following services:

SERVICES:

(1) Operating a website, an Internet blog, and online discussion forums in the fields of family planning, conception, pregnancy, childbirth, and parenting; providing information via website in the fields of family planning, conception, pregnancy, childbirth, and parenting.

[5] The application was advertised on October 20, 2010, and The Knot, Inc. and its subsidiary The Bump Media, Inc. (collectively referred to as the Opponent) filed a Statement of Opposition on March 21, 2011, based on the following grounds of opposition set out in under section 38 of the Act:

(i) the application does not comply with section 30(i) of the Act because the Applicant could not have been satisfied that he was entitled to use the Mark in Canada because he was or should have been aware of the Opponent's trade-mark THE BUMP when he filed the application;

(ii) the application does not comply with section 30(b) of the Act because the Applicant did not use the Mark as a trade-mark in association with the applied for services as of the claimed date of first use;

(iii) the application does not comply with section 30(e) of the Act because the Applicant did not and does not intend to use the Mark in association with the applied for wares or,

in the alternative, has previously used the Mark as a trade-mark in association with some or all of those wares as of the filing date of the application;

(iv) the Applicant is not the person entitled to the registration of the Mark as the Mark is confusing with the Opponent's mark which had been used in Canada prior to both the Applicant's claimed date of first use and prior to the filing date of the application; and

(v) the Mark does not distinguish the Applicant's wares and services from Opponent's wares and services.

[6] In support of its opposition, the Opponent filed the affidavit of Jeremy Lechtzin, Senior Vice-President and General Counsel of The Knot, Inc. As its evidence, the Applicant filed his own affidavit and identifies himself as Founder and Owner of the website The Bump, located at the web address *www.thebump.ca*. Neither party's affiant was cross-examined.

[7] Both parties filed a written argument and both were represented a hearing.

Onus and Material Dates

[8] 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 present 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)].

[9] 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)(c)/Section 16(1)(a) – the Applicant's date of first use [section 16(1)]; and
- Section 38(2)(c)/Section 16(3)(a) – the filing date of the Applicant's application [section 16(3)]; and

- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Summary of the Opponent's Evidence

[10] The evidence of Mr. Lechtzin may be summarized as follows.

[11] In 2008, The Knot acquired The Bump Media, Inc., a publisher of local print guides that feature pregnancy, maternity and baby resources in association with the mark THE BUMP. The Bump Media, Inc. has provided printed an online resource guides for pregnant women and new moms in the field of pregnancy and newborn/infant parenting since 2006, including through a website operated in association with the domain name "*thebump.com*". As a result of the acquisition of The Bump Media, Inc., The Knot became the owner of The Bump website, as well as the trade-mark THE BUMP.

[12] Attached to Mr. Lechtzin's affidavit are copies of the home page from The Bump website obtained from an Internet Archive service as it appeared on November 2, 2008, February 27, 2009, March 7, 2009 and November 21, 2011 [Lechtzin, Exhibits A,E, F,G]. Mr. Lechtzin states that the manner in which the trade-mark is depicted on these pages is consistent with the manner in which it was depicted on The Bump website in 2008 and 2009.

[13] The Knot also publishes THE BUMP magazine, a pocket-sized magazine for first time moms designed to connect first time parents with the information and resources they need to prepare for a baby. THE BUMP magazine is published semi-annually but was only published annually before 2010 [Lechtzin, para. 9]. In 2010, the Opponent released THE BABY BUMP, a comprehensive, modern guide to pregnancy under THE BUMP brand. Attached as Exhibit B to Mr. Lechtzin's affidavit is a printout of the listing page for THE BABY BUMP from the website for Chapters/Indigo as it appeared November 21, 2011.

[14] Mr. Lechtzin further states that, given the nature of the Internet, The Bump website and the services *were accessible* to Canadians since 2006. He provides a chart which sets out the number of hits to The Bump website from persons located in Canada from October 2010 to

October 2011. The number of hits each month during this time frame ranged from 148,527 to 238,853 per month.

[15] Mr. Lechtzin explains that Internet users are also able to register on The Bump website to access the “community” area of the website which includes message boards, blogs and personalized interactive services. Registration is done on-line over the Internet by the customer visiting the website and inputting the required information into the specific fields. Attached as Exhibit C is a printout of a registration page of The Bump website as it appeared on November 21, 2011. In preparing his affidavit, he reviewed the database and identified the registered users whose address information indicated that they were located in Canada. A chart setting out by year since 2008 the number of registered users or “members” of The Bump website from Canada is provided at paragraph 17. The number of members from Canada ranged from 1607 in 2008 to 16,345 in 2011.

[16] With respect to advertising, Mr. Lechtzin states that since 2008 the Opponent has received over \$45,000 for advertising related to Canada. This relates to campaigns where advertisements for The Bump website were geo-targeted to Canada. Attached as Exhibit H to his affidavit is a true copy of a Canadian geo-targeted advertisement from The Bump website.

Summary of the Applicant’s Evidence

[17] Mr. Maclean states that The Bump is a Canadian guide and online community for expecting and new parents. It was launched to fill what he and his wife believed was a void in pregnancy and newborn/infant parenting advice tailored exclusively to Canadians. The domain name *www.thebump.ca* was registered with the Canadian Internet Registration Authority on April 7, 2008, and the website was officially launched on or about June 15, 2008. Since its launch date, The Bump website has been a resource for expecting and new parents who live in Canada and has featured editorial and user-generated content related to a wide range of topics including family planning, conception, pregnancy, childbirth and parenting. The Bump website has included social networking and community publishing modules since its launch date.

[18] Users who complete the online registration process at *thebump.ca* and become members have and had the ability to be active participants in content creation and conversations happening

in the community. At the date of Mr. Maclean's affidavit, his website had over 600 registered members. He estimates from a review of his members public profile information that at least half of the members have identified themselves as living in provinces, cities and towns across Canada.

[19] Mr. Maclean explains that the site generates revenue primarily from display advertising, special offers links and enhanced product listings. Attached as Exhibit F is a screen capture of the current special offers area that local Canadian and online advertisers typically purchase.

[20] Mr. Maclean then provides a response to the evidence provided by the Opponent. In this regard, Mr. Maclean states that he accessed pages and screen captures related to *thebump.com* through the Internet Archive service, available at *www.archive.org*. Attached as Exhibit I to his affidavit is a print out of *thebump.com* on February 8, 2007, indicating that The Bump was a series of local guides in select US cities and highlighted some cities that would be launching in the future, none of which were Canadian. Attached as Exhibit J to his affidavit is a print out of *thebump.com* on July 8, 2008, and a limited amount of general pregnancy related content related to various US cities in which the website stated that The Bump Print Guides exist. Mr. Maclean submits that since the print out of the member registration form does not provide for province or postal code in the geo-related data fields, it would not have been possible for Canadians to register as members on this website. Attached as Exhibit L to his affidavit is a press release from XO Group, whom he states is the parent company of the Knot and The Bump Media, which announces the official launch of *thebump.com* on November 18, 2008.

Grounds of Opposition Summarily Dismissed

Non-compliance – Section 30(e)

[21] Under this ground of opposition, the Opponent pleads that the application does not comply with section 30(e) of the Act because the Applicant did not and does not intend to use the Mark in association with the applied for wares, in the alternative, has previously used the Mark as a trade-mark in association with some or all of those wares as of the filing date of the application. The Opponent did not, however, file any supporting evidence or make any written or oral submissions with respect to this ground of opposition. The section 30(e) ground of

opposition can therefore be summarily dismissed on the basis that the Opponent has not met its initial evidentiary burden in respect thereof.

Non-compliance – Section 30(i)

[22] Under this ground of opposition, the Opponent pleads that the application does not comply with section 30(i) of the Act because the Applicant could not have been satisfied that he was entitled to use the Mark in Canada in association with the applied for wares and services. The Opponent submits that the Applicant was or should have been aware of the Opponent's trade-mark THE BUMP at the date of filing its application.

[23] Section 30(i) of the Act merely requires that an Applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of the opponent's trade-mark or trade-name or a third party's trade-mark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[24] As there is no evidence of bad faith in the present case, the section 30(i) ground is dismissed.

Analysis of Remaining Grounds of Opposition

Non-compliance - Section 30(b)

[25] Under this ground, the Opponent pleads that the application does not comply with section 30(b) because the Applicant had previously used the Mark in association with the services described in the application as of the claimed date.

[26] In the application, the Applicant claims that he has used the Mark in Canada in association with the services since July 3, 2008. The Opponent submits that use of the word

“since” as opposed to the phrases “since at least” or “since at least as early as” is significant because it indicates that the Mark was not in use prior to July 3, 2008.

[27] The evidence filed by the Applicant, however, shows that the Applicant has used the Mark in Canada in association with the services since June 15, 2008, which is prior to July 3, 2008. The Opponent submits that since the claimed date of first use is false, the application contravenes section 30 of the Act.

[28] While there may be some merit in the Opponent's position, I am bound by the line of decisions that are directly on point. The case law recognizes that an applicant may claim a date subsequent to the actual date of first use "out of an abundance of caution" and "in the interest of greater certainty [see *Marineland v Marine Wonderland and Animal Park* (1974), 16 CPR (2d) 97 (FCTD)]. An applicant is not required to identify its earliest date of use in its application.

[29] As I am satisfied that the Applicant has shown use of his Mark in association with the applied for services as of his claimed date of first use or earlier, this ground of opposition is not successful.

Non-entitlement based upon Opponent's prior use of its trade-mark - Section 16(1)(a) and Section 16(3)(a)

[30] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the Opponent's prior use of its trade-mark THE BUMP which had been used in Canada by the Opponent in association with “online publications in the nature of resource guides for pregnant women and new moms in the field of pregnancy and newborn/infant parenting; providing an online business directory featuring information regarding pregnancy and newborn/infant parenting, pregnant women, pre maternity and post maternity” and “printed resource guides for pregnant women and new moms in the field of pregnancy and newborn/infant parenting”.

[31] In order to meet its initial burden with respect to its section 16(1)(a) and section 16(3)(a) grounds of opposition, the Opponent must show that its mark had been used in Canada prior to either the Applicant's claimed date of first use (i.e. July 3, 2008) for the section 16(1)(a) ground

or the Applicant's filing date (i.e. July 4, 2008) for the section 16(3)(a) ground, and had not been abandoned as at the date of advertisement of the application for the Mark, namely, October 20, 2010 [section 16(5) of the Act].

[32] From the evidence furnished, I am not satisfied that the Opponent has met its burden under either of these grounds. While the evidence may show that the Opponent or its predecessor-in-title had operated its U.S. website since at least as early as 2008, I am not satisfied that the Opponent has shown use of its mark *in Canada* in association with its wares or services prior to either of the material dates for these grounds.

[33] Mr. Lechtzin states that he reviewed the Opponent's The Bump database and identified the registered users whose address information indicated that they were located in Canada. He then provides a chart which sets out by year since 2008 the number of registered users or "members" of The Bump website from Canada [Lechtzin, para. 17]. The print-out of a registration page of The Bump website as it appeared on November 21, 2011, shows that it was possible for Canadians to register as members as the data fields on the registration page allowed members to enter a valid province, postal code and country [Lechtzin, Exhibit C]. Mr. Maclean's evidence, on the other hand, is that on July 8, 2008, the Opponent's registration page (accessed by Mr. Maclean through the internet archive service www.archive.org) did not contain data fields which allowed for Canadians to register on the Opponent's website as members (Maclean, Exhibit J). Further, Exhibit I to Mr. Maclean's affidavit shows the Opponent's website on February 8, 2007, which indicates that The Bump was a series of local guides in select U.S. cities and would soon be launching in some other cities, none of which were Canadian.

[34] In view that Mr. Lechtzin did not provide a specific date in 2008 when his website began registering members from Canada, I must consider the date that the Opponent's website began registering members to be the last day of the year, i.e. December 31, 2008, which is after the relevant date for this ground. Even if I could assume the date was earlier in 2008, the evidence of Mr. Maclean contradicts Mr. Lechtzin's evidence that Canadians were able to register as members prior to July 8, 2008.

[35] The only other evidence relating to Canada prior to the relevant date for this ground was a chart setting out the number of posts by registered users or members of The Bump website on Canadian Bump Website message boards between 2008 and 2011. Again, the Opponent has not provided a specific date in 2008 when such posts would have been made. Further, as noted, Mr. Maclean's evidence is that it was not even possible for Canadians to register as members on the Opponent's website as of July 8, 2008.

[36] In view of the above, I am not satisfied that the Opponent has shown use of its mark in association with its wares or services as of July 3, 2008. This ground is therefore unsuccessful.

Non-distinctiveness ground – sections 38(2)(d) and 2

[37] Under this ground, the Opponent pleads that the Mark is not distinctive because it does not actually distinguish the services in association with which it has been used and the wares in association with which it is proposed to be used by the Applicant from the wares and services of the Opponent.

[38] In order to meet its initial burden with respect to this ground of opposition, the Opponent had to show that its trade-mark had become known sufficiently in Canada as of the filing date of the statement of opposition, i.e. March 21, 2011, to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC); *Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC and Bojangles Restaurants Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. The Opponent's evidence need not necessarily show trade-mark use within the scope of section 4(1) or 4(2) of the Act in order to be relied upon in challenging the distinctiveness of the Mark [see *Mutual Investco Inc v Knowledge Is Power Inc* (2001), 14 CPR (4th) 117 (TMOB) at p 123]. It may be based on any evidence of knowledge or reputation of the Opponent's trade-mark in Canada.

[39] The Opponent's evidence of making known of its trade-mark in Canada prior to the material date may be summarized as follows:

- there were approx. 1 million hits to the Opponent's website from persons located in Canada between October 2010 and March 2011;
- there were 13,638 registered users or members in 2010 and 16,345 registered users or members in 2011 of The Bump website whose address information indicated that they were located in Canada;
- 625 postings were made in 2010 and 1147 postings were made in 2011 on the Opponent's Canadian website message boards; and
- over \$45,000 US has been received by the Opponent for advertising related to Canada since 2008.

[40] With respect to the number of hits to the Opponent's website, in the absence of more information regarding what a hit to the Opponent's website represents, I am not prepared to give much weight to this evidence [see *Unicast SA v South Asian Broadcasting Corporation Inc* 2014 FC 295 at para 70].

[41] Further, as noted above at paragraph 33, it is not clear exactly when between July 8, 2008, and the material date for this ground, i.e. March 21, 2011, that Canadians were able to register as members of the Opponent's website. What we do know that is that Canadians have been able to register as members of the Opponent's website since as early as November 21, 2011 [Lechtzin, Exhibit C]. Further, Mr. Lechtzin testifies that in preparing his affidavit (including the chart which sets out by year since 2008 the number of registered users or members of the Bump website from Canada), he reviewed the computer database (which is one of the ordinary business records of The Knot, Inc.) and identified the registered users whose address information indicated that they were located in Canada [Lechtzin, para. 16 and para. 17]. In view of Mr. Lechtzin's evidence as a whole, I am prepared to infer that a sufficient number of Canadians were able to register as members of the Opponent's website prior to the material date for this ground.

[42] In determining whether the Opponent has met its evidential burden under this ground, I have considered that the nature of the Opponent's services are online publications in the nature

of resource guides for pregnant women and new parents and the provision of an online business directory featuring information regarding pregnancy and parenting. These online publications are offered free of charge to interested consumers through the Internet. Given the nature of these services and the fact that they are offered to a targeted audience, I find that the number of Canadian members registered with the Opponent's website sufficient to show that as of March 21, 2011, the Opponent's mark had become known in Canada in association with its services to the extent necessary for the Opponent to meet its burden under this ground.

[43] In view that the Opponent has met its initial burden, I must now determine whether the Applicant has satisfied the Registrar that his Mark was adapted to distinguish his wares and services throughout Canada as of March 21, 2011. In considering whether the Mark was able to do so, I will determine on a balance of probabilities, if the Mark was likely to cause confusion with the Opponent's trade-mark at the material date.

test for confusion

[44] 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 or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them.

[45] 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)]. However, in *Masterpiece Inc v Alavida Lifestyles Inc et al* (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)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[46] I consider the inherent strength of both parties' trade-marks to be about the same as both marks are suggestive of the clientele to whom their wares and services are targeted.

[47] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. This is known as the acquired distinctiveness of a trade-mark. As discussed above, the evidence of Mr. Lechtzin shows, among other things, that there were approx. 1 million hits to the Opponent's website from persons located in Canada between October 2010 and March 2011. Further, there were 13,638 registered users or members in 2010 and 16,345 registered users or members in 2011 of The Bump website whose address information indicated that they were located in Canada. I am satisfied from this evidence that the Opponent's mark had become known to some extent in Canada by the relevant date.

[48] With respect to the extent known of the Mark, Mr. Maclean provides the following information:

- the domain name *www.thebump.ca* was registered with the Canadian Internet Registration Authority on April 7, 2008;
- the *www.thebump.ca* website was officially launched on or about June 15, 2008;
- the website generates revenue primarily from display advertising, special offers links and enhanced product listings;
- although the majority of content features on the website has always been available to unregistered visitors, visitors have been encouraged to complete registration and take advantage of additional community participation features such as blogging and social networking; and

- at the date of his affidavit (e.g. March 24, 2012) the website had over 600 registered members, of which he estimates that a minimum of 50% were from Canada.

[49] Based on the evidence furnished, and in particular the fact that Opponent had more than 13,000 Canadian members registered with its website as of the relevant date while the Applicant had only 300 Canadian members registered with its website as of the relevant date, I conclude that the Opponent's mark has become to a greater extent in Canada than the Applicant's Mark.

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

[50] The Applicant has evidenced that it began using his Mark in Canada on or about June 15, 2008. As noted, it is not clear from the Opponent's evidence when it began using its Mark in Canada but it is likely to have been after this date. This factor therefore favours the Applicant.

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

[51] It is clear from the evidence that the parties' wares, services and channels of trade are very similar. These factors therefore favour the Opponent.

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

[52] As the parties' marks are virtually identical, this factor favours the Opponent.

conclusion re likelihood of confusion

[53] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. As noted, the onus or legal burden is on the Applicant to show no reasonable likelihood of confusion on a balance of probabilities.

[54] In the present case, I have found that the parties' marks are identical. Further, the parties' wares and services are the same or overlapping, as are the channels of trade. Lastly, notwithstanding the fact that the Applicant has been using its Mark in Canada for a longer period of time than the Opponent, the evidence shows that by the material date for this ground, the Opponent's mark had become known to a greater extent in Canada.

[55] In view of the above, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's mark as of March 21, 2011. I find that the average consumer would likely assume that the Opponent had licensed, approved or otherwise sponsored the Applicant's use of the Mark in association with its website that provides information in the field of family planning, conception, pregnancy, childbirth and parenting and printed materials relating to health, pregnancy, parenting and childcare.

[56] As the Applicant has not shown that its Mark was able to distinguish its wares and services from the wares and services of the Opponent as of March 21, 2011, the section 38(2)(d) ground of opposition succeeds.

Disposition

[57] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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