



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

Citation: 2018 TMOB 10

Date of Decision: 2018-01-29

IN THE MATTER OF AN OPPOSITION

Advance Magazine Publishers Inc.

Opponent

and

NASDAQ CORPORATE SOLUTIONS

Applicant

CANADA ULC

1,620,446 for MARKETWIRED

Application

INTRODUCTION

[1] Advance Magazine Publishers Inc.(the Opponent) opposes registration of the trade-mark MARKETWIRED (the Mark), filed by Marketwired L.P. The application is presently owned by NASDAQ CORPORATE SOLUTIONS CANADA ULC (Marketwired L.P. and NASDAQ CORPORATE SOLUTIONS CANADA ULC shall be referred to indistinctively as the Applicant).

[2] For the reasons that follow, I reject the opposition.

THE RECORD

[3] On March 28, 2013 the Applicant filed the application bearing serial No. 1,620,446.

[4] The application is based on proposed use of the Mark in Canada in association with the services listed in Annex A to my decision (the Services).

[5] The application was published on December 3, 2014 in the *Trade-marks Journal* for the purposes of opposition.

[6] On May 4, 2015 the Opponent filed a statement of opposition. The grounds of opposition pleaded are based on sections 12(1)(d) (registrability), 16(3) (entitlement), 30(i) (compliance) and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[7] The Applicant filed a counter statement on July 29, 2015 denying each ground of opposition pleaded.

[8] The Opponent filed the affidavit of Elenita Anastacio sworn on November 30, 2015.

[9] The Applicant elected not to file any evidence.

[10] Only the Opponent filed written arguments and a hearing was held during which both parties made representations.

PRELIMINARY COMMENTS

[11] In reaching my decision I have considered all the evidence in the file. However, I shall refer only to those portions of the evidence which are directly relevant to the issues discussed in the body of my decision.

[12] At the hearing I asked the Opponent if the opposition concerned all the Services. The Opponent acknowledged that for some of the Services, for example “filing of securities documents”, there was no relationship between the Opponent’s services, to be described later, and those services. I will discuss this issue more in depth when assessing the nature of the parties’ goods and services and their channels of trade.

EVIDENTIARY BURDEN

[13] The legal onus is on the applicant to show that the application complies with the provisions 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 to support each ground of opposition exist. Once this initial burden is met, the applicant has to prove, on a balance of probabilities, that the particular ground of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB), *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD), and *Wrangler Apparel Corp v The Timberland Company* [2005] FCJ No 899, (FC)].

GROUND OF OPPOSITION SUMMARILY DISMISSED

[14] Ms. Anastacio is employed by the Opponent's agent firm. She states that on November 2, 2015 she conducted a search in the CD NameSearch Canadian Trade-marks Database to obtain full particulars of the following trade-mark registrations:

GET WIRED	TMA530862
HOTWIRED	TMA452764
WIRED	TMA447332
WIRED	TMA576325

The details of the goods and services covered by each of those registrations appear in Annex B to this decision. The Opponent is the current owner of each one of them.

[15] The mere filing of a certificate of registration of a trade-mark is not sufficient to meet the initial onus on an opponent to prove prior use of its trade-mark under a section 16 ground of opposition [see *Rooxs Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

[16] Since there is no evidence of prior use of the Opponent's trade-marks in the record, I dismiss the grounds of opposition based on section 16(3) of the Act for failure by the Opponent to meet its initial burden.

[17] As for the ground of opposition of lack of distinctiveness of the Mark (section 2 of the Act), the Opponent had to establish that, as of May 4, 2015, the filing date of the statement of opposition, any of its trade-marks listed above had become sufficiently known to negate the distinctiveness of the Applicant's Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FCTD)].

[18] Given that the Opponent has not filed any evidence of use of its trade-marks in the record, the Opponent has failed to meet its initial burden under this ground of opposition.

[19] Consequently, I also dismiss the ground of opposition based on lack of distinctiveness of the Mark.

REGISTRABILITY OF THE MARK UNDER SECTION 12(1)(D) OF THE ACT

[20] As mentioned previously, the Opponent filed, through the affidavit of Ms. Anastacio, the details of its registrations listed above. I checked the register and all those registrations are still extant.

[21] Therefore, the Opponent has met its initial burden with respect to this ground of opposition.

[22] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[23] The test under section 6(2) of the Act 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 section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-marks, who sees the Applicant's Services in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

Degree of resemblance

[24] As indicated by the Supreme Court of Canada in *Masterpiece*, in most instances, the degree of resemblance between the marks in issue is the most important relevant factor. One must consider the degree of resemblance between the marks in issue from the perspective of appearance, sound and in the ideas suggested by them. Moreover, it stated that the preferable approach, when comparing trade-marks, is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique. It is not the proper approach to set the marks side by side and to critically analyze them to find similarities and differences.

[25] Although the Mark is a coined word, as argued by the Applicant, it is formed by the juxtaposition of two common words namely, MARKET and WIRED. They are equally dominant portions of the Mark.

[26] The word “market” is defined in the *Canadian Oxford Dictionary* as:

noun

1. the gathering of people for the purchase and sale of provisions, livestock, etc., esp. with a number of different vendors.
2. an open space or covered building used for this.
3. [often foll. by for] a demand for a commodity or service: goods find a ready market.
 - a place or group providing such a demand: Canada is a small market.
4. conditions as regards, or opportunity for, buying or selling.
5. the rate of purchase and sale, market value: the market fell.
6. [prec. by the] the trade in a specified commodity: the market in soft drinks.
7. stock market.

[27] The word “wired” is defined in the *Canadian Oxford Dictionary* as:

adjective

1. slang hyper, strung out, or antsy, esp. due to the effects of a drug or stimulant, such as caffeine.
2. fitted with electrical connections or electric or fibre optic cables.
 - informal having access to the Internet.
3. supported, strengthened, or stiffened with wire.

[28] Consequently, the Mark could suggest “stock market information transmitted via the Internet”.

[29] As for the Opponent’s trade-marks they all have the component WIRED. As for HOTWIRED, the same reasoning described in the previous paragraphs is applicable. HOT and WIRED are equally dominant features of that trade-mark. I consulted the *Canadian Oxford Dictionary* for the definition of the word “hot” and I conclude that HOTWIRED could suggest “fresh news” when used in association with periodicals which are covered by the Opponent’s registration, as well as “news transmitted at high speed” when used in association periodicals embodied in electronic media.

[30] Taking into consideration the plain meaning of the word “get” combined to the word “wired”, the Opponent’s trade-mark GET WIRED could suggest the idea of “obtaining information electronically” when used in association with periodicals.

[31] The Opponent argues that there is a strong degree of resemblance between the marks in issue as the Mark contains the totality of its trade-mark WIRED. The presence of the component WIRED in the Mark does create some resemblance between the Mark and the Opponent trade-mark WIRED.

[32] However, the Opponent’s trade-mark WIRED is a common English word. In those instances the addition of a dominant element as a first component may serve to distinguish the marks in issue. In the present instance the addition of the word MARKET to WIRED creates a trade-mark that is distinguishable from the Opponent’s trade-mark WIRED. MARKET is the first component of the Mark and is one of its dominant features. The ideas suggested by the parties’ marks are different as detailed above.

[33] As for the Opponent’s trade-marks GET WIRED and HOTWIRED, they suggest different ideas than the Mark as outlined above; they have different first component than the Mark. Therefore, the Mark does not resemble those Opponent’s marks.

[34] The opponent refers to Exhibit D to Ms. Anastacio’s affidavit. Ms. Anastacio states that she conducted a Wayback Machine Internet Archive search. She used that website to view the history of the website <http://www.marketwire.com>. She asserts that it is the Applicant’s website.

Exhibit D represents a copy of the history of that website for the period of November 10, 1996 to October 27, 2015. I note that the Mark does not appear on any of the pages filed. The trade-mark appearing is MARKET WIRE and/or MARKET WIRE & Design, where the word WIRE is written in bold letters.

[35] The Opponent argues that it is most likely that the Applicant will use the Mark in a similar format namely, two separate words with WIRED written in bold letters. In the absence of the full text of the articles, I cannot make such inference. This application is for the registration of a word mark.

[36] The Opponent also relies on Exhibit B1 to Ms. Anastacio's affidavit. It is an extract of a Google Search. The full text of the articles located is not attached as part of her affidavit. I cannot consider these citations to be use of the Mark as a trade-mark as opposed to a trade name.

[37] In all, this most important factor favors the Applicant. This should be sufficient to dispose of the matter. However, I will assess the other relevant factors.

Inherent distinctiveness of the marks and the extent to which they have become known

[38] The Opponent takes the position that its trade-marks are not descriptive of the character or quality of the Opponent's goods and services. As such, they possess a high degree of inherent distinctiveness.

[39] These marks are not as strong marks as coined words. They possess a certain degree of inherent distinctiveness.

[40] The Mark is a coined word. However, as discussed previously, it is the combination of two common English words. The word MARKET is certainly highly suggestive of some of the Services, especially when used in association with "financial information". Similarly, WIRED is suggestive of the Internet when used in association with the Opponent's goods and services detailed in Annex B to this decision. Consequently, the Mark is as inherently distinctive as the Opponent's WIRED trade-marks.

[41] The degree of distinctiveness of a trade-mark can be enhanced through use and promotion in Canada. The Opponent has filed no evidence of use of its trade-marks in Canada. However, it refers to its registrations to assert that its marks have been used in Canada since at least as early as the various dates of first use mentioned in the registrations and detailed in Annex B to this decision.

[42] While the Opponent's registrations are partly based on use, this only entitles me to assume *de minimis* use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that the trade-mark has become known to any significant extent, nor that the trade-mark has been used continuously. Even if I were to consider such argument, I have no indication of the magnitude of such use. As such, I am unable to determine the extent to which the Opponent's trade-marks would have become known in Canada as of this date.

[43] Overall, this factor does not favour any of the parties.

Length of time the trade-marks have been in use

[44] There is no evidence of use of the Mark. As discussed above, I have evidence of *de minimis* use of the Opponent's trade-marks. Nevertheless, in the absence of evidence of actual use of the Opponent's marks, the length of time the marks have been in use is not a determining factor in this case.

The nature of the parties' goods and services and their businesses

[45] Under a section 12(1)(d) ground of opposition, I must compare the services as described in the application with the goods and services covered by the Opponent's registrations [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd*

(1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)]. However, there is no such evidence in the record.

[46] The Opponent argues that the Applicant's Services and the Opponent's goods and services overlap as both include:

- An online interactive website that provides a variety of information to their consumers;
- Services related to advertising and marketing;
- Electronic transmission of a variety of information and data; and
- Consulting/informational services relating to technology.

[47] The Opponent has provided in paragraph 32 of its written argument a chart to illustrate its argument about the overlap of the parties' respective goods and services.

[48] As mentioned above, the Opponent, at the hearing, admitted that there was no overlap between some of the Services, such as for example "Filing of securities documents" and the Opponent's goods and services described in Annex B.

[49] There is no overlap in so far as the following Applicant's Services are concerned:

- Photograph archiving services;
 - Translation services for news and press releases; photography services, namely, photography assignment services;
 - Providing technology consulting services in the field of social media; and
 - Filing of securities documents
- (hereinafter referred to as the Non-overlapping services).

[50] Given that the Opponent's relevant goods and services are:

- online magazines and publications distributed in electronic format via the internet;
- on-line computer interactive communications, subscription, bulletin board, distribution and publication services;
- operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet;
- Electronic transmission of messages, documents and data via networks, television, radio and other broadcasting means; and
- magazine publishing services;

and taking into consideration the description of some of the Applicant's Services that appears to relate to media and information, I conclude that there is a potential overlap between the Opponent's relevant goods and services and the following Applicant's Services:

- Providing an interactive website containing a portal which provides users with access to information about business marketing, corporate commercial information and news and press release distributions; market research and analysis services, namely the provision of on-line and social media monitoring and analysis services;
- Providing an interactive website containing a portal which provides users with access to various services, namely, financial information;
- News wire services, namely, electronic transmission of news items to news reporting organizations;
- News wire services, namely, electronic transmission of news items to news reporting organizations; providing access to databases which contain contact information of journalists, and providing news alert systems for communications professionals and media/journalists; and
- multimedia distribution services, namely transmission and distribution of audio visual images, namely, video clips, animation clips, audio clips, web screen shots, in association with news and press releases

(hereinafter referred to as the Overlapping services).

[51] As for the parties' respective businesses, there is no evidence of the nature of the Applicant's business. However, the Applicant is referring to the Opponent's evidence and in particular, Exhibit D to Ms. Anastacio's affidavit, more fully described above.

[52] Extracts of websites do not make proof of their contents. They simply prove that they were published on the Internet at various dates indicated therein. If the Applicant wanted to prove a distinction between the Applicant's business and that of the Opponent, it should have filed an affidavit from one of its duly authorised representative explaining the nature of its business.

[53] Given the nature of the Opponent's goods and services as described above, and the absence of evidence regarding the nature of the Applicant's business, I conclude that there is a potential overlap in the parties' businesses in so far as the Overlapping services are concerned. As for the Non-overlapping services, there is no overlap in the parties' respective businesses. Finally, as for the remainder of the Applicant's Services, in the absence of evidence on the nature of the parties' respective businesses, and given that the legal burden is on the Applicant, I will infer that there is an overlap in the parties' respective businesses.

[54] Consequently these factors favour the Applicant only in so far as the Non-overlapping services are concerned.

Conclusion

[55] Subsequent to the analysis of all the relevant criteria listed under section 6(5) of the Act, I conclude that the Applicant has discharged its burden to prove, on a balance of probability, that there is no likelihood of confusion between the Mark and the Opponent's trade-marks when used in association with the Services.

[56] I reach this conclusion on the basis that, despite the fact that the marks have the common component WIRED which is a common English word, they differ phonetically, visually and in the ideas suggested when considered in their entirety with the addition of the word MARKET as the first component of the Mark; their goods and services and their channels of trade also differ, in so far as the Non-overlapping services are concerned. However, despite the fact that the remaining Services may overlap with the Opponent's relevant goods and services, and so are most likely their channels of trade, the differences in the marks, phonetically, visually and in the ideas suggested by them, are sufficient to avoid any likelihood of confusion as to the source of those services.

GROUND OF OPPOSITION BASED ON SECTION 30(I) OF THE ACT

[57] The ground of opposition based on the provisions of section 30(i) of the Act reads as follow:

At the date of application by the Applicant, the Applicant was well aware or ought to have been aware of the existence of the Opponent and its predecessors, and the use and notoriety of the Opponent's Marks in Canada. This is confirmed by the fact that the Applicant has amended its trade-marks and trade-name from Marketwire to Marketwired and Marketwire L.P. to Marketwired L.P. The Applicant could not have been satisfied under Section 30(i) of its entitlement to use the Offending Mark.

[58] It has often been ruled that section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use the mark applied for in Canada in association with the goods and services described in the application. Such a statement is included in the present application. An opponent may rely on section 30(i) in specific cases such as where bad faith on

the part of the applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[59] The mere knowledge of the Opponent's trade-mark registrations, even if proven, would not be sufficient to sustain this ground of opposition.

[60] Consequently, this ground of opposition is also dismissed as the Opponent failed to meet its initial evidential burden.

DISPOSITION

[61] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual property Office

Annex A

The Applicant's trade-mark

Trade-mark	Application number	Services
MARKETWIRED	1620446	<p>Providing an interactive website containing a portal which provides users with access to information about business marketing, corporate commercial information and news and press release distributions; market research and analysis services, namely the provision of on-line and social media monitoring and analysis services; providing a monitoring platform for on-line and social media which allows for collaboration and workflow management; reputation management services in the field of on-line and social media; consulting services, namely, marketing consulting in the field of on-line and social media monitoring and analysis; providing marketing strategies for others in the field of on-line and social media monitoring and analysis; providing marketing consulting in the field of social media.</p> <p>(2) Providing an interactive website containing a portal which provides users with access to various services, namely, financial information.</p> <p>(3) News wire services, namely, electronic transmission of news items to news reporting organizations; providing access to databases which contain contact information of journalists, and providing news alert systems for communications professionals and media/journalists; providing teleconferencing services, Internet broadcasting services and web-casting services, all via external and internal computer networks for the dissemination of corporate commercial communications pertaining to investor relations; multimedia distribution services, namely transmission and distribution of data or audio visual images, namely, photographs, maps, logos, video clips, animation clips, audio clips, charts, graphs, web screen shots, B-rolls and vignettes in association with news and press releases; distribution of photographs via news wires.</p> <p>(4) Photograph archiving services.</p>

		<p>(5) Translation services for news and press releases; photography services, namely, photography assignment services.</p> <p>(6) Computer services, namely, providing search engine services on a global computer network for obtaining business, financial, investment and corporate news and information; website hosting services in the field of corporate communications and investor relations; providing a website featuring temporary use of non-downloadable software for use in monitoring and analysis of on-line and social media; providing technology consulting in the field of social media.</p> <p>(7) Filing of securities documents.</p>
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Annex B

The Opponent's trade-marks registrations

Trade-mark	Registration Number	Goods/Services
WIRED	TMA447332	<p>Goods:(1) Magazines published in either printed, analog or digital format and directed towards the digital, computer and multimedia interest sectors.</p> <p>(2) Stationery, namely writing paper, cards and pens.</p> <p>Services:(1) On-line computer interactive communications, subscription, bulletin board, distribution and publication services; television, audio, video and cable programming services and magazine publishing services.</p> <p>Goods(1): Used in Canada since at least as early as January 27, 1993;</p> <p>Goods(2) and services: Declaration of use filed July 18, 1995.</p>
WIRED	TMA530862	<p>Services: Online magazines and publications distributed in electronic format via the internet; operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet.</p> <p>Used in Canada since at least as early as July 1997</p>
GET WIRED	TMA530862	<p>Goods: Periodicals, namely magazines about cultural and lifestyle, as embodied in electronic, optical, video, audio, film or printed media; clothing, namely t-shirts, jackets, sweatshirts, sweaters, shirts, pants, shorts, hats, scarves, shoes.</p> <p>Services: Electronic transmission of messages, documents and data via networks, television, radio and other broadcasting means.</p> <p>Used in Canada since at least as early as January 01, 1993 on goods.</p> <p>Declaration of Use filed June 21, 2000 on services.</p>
HOTWIRED	TMA452764	<p>Goods: (1) Pre-recorded magnetic data media, namely recording discs, floppy discs, compact discs, CD-ROMs, videotape, audiotape and film; publications, namely magazines in printed and electronic form; clothing, namely t-shirts, jackets, sweatshirts, sweaters, shirts, pants, shorts, hats, scarves, shoes.</p> <p>Services: (1) Electronic transmission of messages, documents and data via networks, television, radio and other broadcasting means.</p> <p>Used in Canada since at least as early as April 1994 on services.</p> <p>Declaration of use filed November 21, 1995 on goods.</p>

The abovementioned goods and services being globally referred to as the Opponent's goods and services.

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2017-12-07

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