



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 181

Date of Decision: 2021-08-16

IN THE MATTER OF AN OPPOSITION

2042923 Ontario Inc. O/A Travel Leaders	Opponent
and	
Travel Leaders Group, LLC	Applicant
1,772,732 for TL NETWORK	Application

INTRODUCTION

[1] 2042923 Ontario Inc. O/A Travel Leaders (the Opponent) opposes registration of the trademark TL NETWORK (the Mark), which is the subject of application No. 1,772,732 by Travel Leaders Group, LLC (the Applicant).

[2] The Mark is applied for on the basis of proposed use in Canada in association with the following services:

- (1) Travel agency services, namely, travel booking agencies; travel information services; making reservations and bookings of seats for travel; arranging and conducting travel tours and vacation packages; arranging air, land, namely, bus and passenger train, and sea transportation for individuals and groups; coordinating travel arrangements for individuals and for groups; organizing packaged vacation and travel tours; car rental reservation services
- (2) Travel agency services, namely, making reservations and booking for temporary lodging; making reservations and bookings for restaurants and meals.

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's TRAVEL LEADERS trademark and tradename, previously used and/or registered in association with the same or related services.

THE RECORD

[4] The application for the Mark was filed on March 16, 2016 and was advertised for opposition purposes on April 5, 2017. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[5] On May 29, 2017, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. Following an amended statement of opposition filed on August 10, 2017 and interlocutory rulings dated August 16, 2017 and October 16, 2017, the grounds of opposition are based on non-registrability under section 12(1)(d), non-entitlement under section 16(3), and non-distinctiveness under section 2 of the Act. In this respect, I confirm that the pleaded ground of opposition based on section 30(i) of the Act was struck pursuant to the Registrar's August 16, 2017 ruling.

[6] The Applicant filed a counter statement denying the grounds of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of Amin Saleh, sworn November 29, 2017 in Toronto (the Saleh Affidavit). Mr. Saleh was cross-examined and the transcript was made of record.

[8] In support of its application, the Applicant filed the following:

- Affidavit of Stephen McGillivray, sworn September 20, 2018 in Alexandria, Virginia (the McGillivray Affidavit). Mr. McGillivray was cross-examined and the transcript was made of record.

- Two affidavits of Jon L. Purther, sworn November 30, 2018 and January 31, 2019, respectively, in Toronto (the Purther Affidavits).

[9] Both parties submitted written representations; an oral hearing was not requested.

[10] Before assessing the grounds of opposition, I will first provide an overview of the parties' evidence, the evidential burden on the Opponent, and the legal onus on the Applicant.

OVERVIEW OF THE OPPONENT'S EVIDENCE

[11] The Opponent is the owner of registration No. TMA790523 for the trademark TRAVEL LEADERS, registered since February 2011 on the basis of use in Canada since at least March 22, 2005 in association with the following services:

Travel agency services, namely: travel booking and travel information services; making reservations and booking for travel and transportation; arranging for travel insurance; arranging travel tours and packages; arranging air, land and sea transportation for individuals and groups; coordinating travel arrangements for individuals and groups; organizing packaged vacations, travel tours; car rental reservation services, special events, and making reservations and booking for temporary lodgings and for restaurants and meals.

The Saleh Affidavit

[12] Mr. Saleh is the General Manager of the Opponent. The Saleh Affidavit evidences the following:

- The background and history of the Opponent's TRAVEL LEADERS travel agency business [paras 7 to 9, Exhibits F to O];
- The background and file histories of the Applicant's trademark applications for TRAVEL LEADERS, TL NETWORK, and TL NETWORK & Design in Canada and the United States [paras 3 to 5, 10 to 12, 14, Exhibits C to E, P to R, FF/6, GG/7];
- Various publications the Opponent "has received", purporting to identify "(i) the letters TL as an acronym of the words Travel Leaders and (ii) the trade-mark TL Network as synonymous with Travel Leaders Network" [para 13, Exhibits S to Z, AA/1 to EE/5],

including printouts from third-party websites and publications referencing the Applicant's travel agency network.

- Email communications between the parties regarding the Applicant "acquiring or otherwise obtaining rights to [the Opponent's trademark] TRAVEL LEADERS [para 15, Exhibits HH/8 to JJ/10];
- Printouts from third-party websites referencing the Applicant's TL Network [paras 16 to 18, Exhibits KK/11 to MM/13];
- August 2017 email correspondence from an individual to the Opponent, requesting cancellation of what appears to be a membership with the Applicant [para 19, Exhibit NN/14];
- A mailing label and packing slip for a package of publications addressed to "Travel Leaders Network" but sent to the Opponent's address [para 20, Exhibit OO/15].

OVERVIEW OF THE APPLICANT'S EVIDENCE

The McGillivray Affidavit

[13] Mr. McGillivray is the Chief Marketing Officer of the Applicant [para 1]. The Applicant is a consortium offering travel agency services to leisure and corporate clients through more than 7000 company-owned, franchised or affiliated travel agencies throughout the United States, United Kingdom, Australia and Canada [para 3]. The McGillivray Affidavit evidences the following:

- Background and scope of operations of the Applicant [paras 3 to 8, 10];
- The Applicant's adoption and use of the tradenames and trademarks TRAVELLEADERS and TRAVEL LEADERS in the United States [paras 9 to 12, 28 to 31];
- The Applicant's knowledge of the Opponent's business and its interaction with the Opponent since 2009 [paras 14 to 19, 36 to 40, 42, 43];

- The adoption of the Mark by the Applicant and its affiliates in Canada following the filing of the subject application [paras 19 to 21, 34];

[14] Mr. McGillivray also opines on the likelihood of confusion between the parties' trademarks, including commenting on the differences in the parties' trademarks, the parties' differing business models and channels of trade, and alleged instances of confusion due to the parties' similar website addresses and trade names [paras 21 to 45].

The Purther Affidavits

[15] Mr. Purther is the President of CorbinPartners Inc. The Purther Affidavits relate to a survey conducted by CorbinPartners Inc. at the request of the Applicant regarding knowledge of the Opponent in the Halton region of Ontario, where the Opponent is located. This survey evidence was originally filed in a Federal Court action involving the parties. However, I do not consider this evidence substantially relevant or necessary to consider in this proceeding.

EVIDENTIAL BURDEN AND LEGAL ONUS

[16] In accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053, 30 CPR (3d) 293 (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.

[17] For those allegations for which the opponent has met its evidential burden, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against the applicant.

SECTION 12(1)(D) GROUND OF OPPOSITION – CONFUSING WITH A REGISTERED TRADEMARK

[18] The Opponent pleads, pursuant to section 38(2)(b) of the Act, that the Mark is not registrable in view of section 12(1)(d) of the Act as it is confusing with the Opponent's registered trademark TRAVEL LEADERS, which has been used since March 22, 2005 by the Opponent in association with the registered services, and which has not been abandoned by the Opponent.

[19] The material date with respect to confusion with a registered trademark is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd et al*, 1991 CarswellNat 1119, 37 CPR (3d) 413 (FCA)].

[20] I have exercised my discretion and checked the register to confirm that the Opponent's TRAVEL LEADERS trademark registration remains extant [per *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Accordingly, the Opponent meets its initial burden with respect to this ground.

[21] As such, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's TRAVEL LEADERS trademark.

Test to determine confusion

[22] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[23] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the applied-for services at a time when they have no more than an imperfect recollection of the Opponent's trademark and does

not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[24] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[25] The criteria or factors in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, the Supreme Court of Canada stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 66].

Inherent Distinctiveness and the Extent Known / Length of Time in Use

[26] I do not consider these factors to be significant in this case. Suffice to say, although the Opponent’s registration includes a claim of use since March 2005, there is very little indication that the Opponent’s TRAVEL LEADERS trademark has been used or become known to any extent in Canada. As a combination of the descriptive word TRAVEL and the somewhat laudatory term LEADERS, the Opponent’s trademark does not have a high degree of inherent distinctiveness.

[27] Similarly, while there is some indication in the McGillivray Affidavit that use of the Mark has commenced in Canada, the extent to which it has become known in Canada is unclear. Furthermore, as a combination of the acronym TL and the descriptive word NETWORK, while I consider the Mark to have a greater degree of inherent distinctiveness than the Opponent’s trademark, it is only nominally so for purposes of this analysis.

Nature of the Services or Business / Nature of the Trade

[28] When considering the nature of the services of the parties in respect of the issue of confusion, it is the statements in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749 (FCA); *Miss Universe Inc v Bohna*, 1994 CarswellNat 1443 (FCA)].

[29] As such, clearly there is overlap in the nature of the parties' services. Furthermore, notwithstanding the Applicant's position that the parties are not competitors and that their businesses and trades differ, there is nonetheless overlap in this respect. Indeed, in describing the nature of the Applicant's network, the McGillivray Affidavit speculates that "In effect, the Opponent would be a prospective client of the TL Network affiliate program of [the Applicant] in Canada" [at para 26]. In my view, this actually indicates significant overlap in the nature of the parties' channels of trade, notwithstanding their different business models or the scope of their respective businesses.

[30] Again, though, while favoring the Opponent, I do not consider these factors to be significant in the overall confusion analysis in this case with respect to the Mark.

Degree of Resemblance

[31] In my view, this case turns significantly on this factor. In this respect, I do not consider the Mark to resemble the Opponent's TRAVEL LEADERS trademark in appearance or when sounded, notwithstanding that both trademarks start with the letter T and share the letter L. With respect to the ideas suggested, the Opponent's argument largely turns on its assertion that TL is an acronym for TRAVEL LEADERS.

[32] However, the Opponent's submissions in this respect [Opponent's written representations at 12 to 14], appear to conflate the idea suggested by the letters "TL" with the Applicant's use of its tradename and trademark TRAVEL LEADERS outside of Canada and the resulting spillover advertising in Canada. In the context of the subject services, I agree with the Applicant that the letters TL do not necessarily represent the words TRAVEL and/or LEADERS and are capable of many meanings [McGillivray Affidavit at para 41]. While a consumer may infer that the "T" in

TL represents the descriptive word “travel”, a similar inference is neither obvious nor intuitive with respect to the letter “L” and the word “leaders”.

[33] In this respect, in part, as the Registrar may take judicial notice of dictionary definitions [*Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65], I note that the *Merriam-Webster Dictionary* only defines “TL” as the symbol for thallium.

[34] Nothing in the evidence indicates that TL is a common term in the trade, and there is no indication that, for example, the Opponent itself uses or displays TL in the course of its business, whether as an acronym for TRAVEL LEADERS or otherwise.

[35] Even if I were to consider the Applicant’s use of TRAVEL LEADERS outside of Canada and any spillover advertising of such as a relevant surrounding circumstance, it is simply outweighed by the absence of resemblance between the parties’ trademarks.

[36] In view of the foregoing, this factor strongly favours the Applicant.

Additional Surrounding Circumstance – Instances of Actual Confusion

[37] In its written representations, the Opponent submits the email exchange and errant mailing label/packing slip at Exhibits NN/14 and OO/15 of the Saleh Affidavit, respectively, as examples of actual confusion [page 16]. However, at most, these exhibits demonstrate confusion between the parties’ respective email addresses and/or trade names, which are not at issue in this proceeding.

[38] Accordingly, I do not consider this to be a surrounding circumstance that favours either party.

Conclusion – Confusion with the Opponent’s Trademark

[39] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal burden with respect to the likelihood of confusion between the parties’ trademarks. I reach this conclusion due to the low degree of resemblance between the trademarks, and notwithstanding the overlap in the nature of the parties’ services and trades.

[40] In view of the foregoing, the section 12(1)(d) ground of opposition based on confusion with the Opponent's TRAVEL LEADERS trademark is rejected.

SECTION 16(3) GROUND OF OPPOSITION – NON-ENTITLEMENT

[41] The Opponent pleads, pursuant to section 38(2)(c) of the Act, that the Applicant is not the person entitled to registration of the proposed Mark in Canada in view of the following:

- 16(3)(a): At the date of filing of the application, the Mark was confusing with a trademark [TRAVEL LEADERS] that has been previously used in Canada or made known in Canada since March 22, 2005 by the Opponent.
- 16(3)(b): At the date of filing of the application, the Mark was confusing with a trademark [TRAVEL LEADERS] in respect of which an application for registration had been previously filed in Canada by the Opponent.
- 16(3)(c): At the date of filing of the application, the Mark was confusing with a tradename [TRAVEL LEADERS] that had been previously used in Canada by the Opponent.

[42] With respect to the ground based on section 16(3)(b) of the Act, I note that the Opponent's application for the trademark TRAVEL LEADERS was not pending as of the advertisement date of the application for the Mark. Otherwise, in its written representations, the Applicant submits that the Opponent has failed to meet its initial burden under these grounds [at page 13].

[43] While I agree that the Opponent's evidenced use of its trademark and tradename are at best limited, this issue is moot. To the extent that these grounds ultimately turn on the issue of confusion, as above, I find that the Applicant has met its legal burden.

[44] In this regard, the degree of resemblance factor weighs heavily in the Applicant's favour, such that there is no likelihood of confusion with respect to any of the applied-for services.

[45] In view of the foregoing, the grounds of opposition based on non-entitlement are rejected.

SECTION 2 GROUND OF OPPOSITION – NON-DISTINCTIVENESS

[46] The Opponent pleads, pursuant to section 38(2)(d) of the Act, that the Applicant's proposed Mark is not distinctive within the meaning of section 2 of the Act because it would not distinguish the services intended to be offered by the Applicant from the services actually offered by the Opponent, nor is it adapted to so distinguish in that the letters TL are known to be an acronym for the words TRAVEL LEADERS.

[47] As the evidence does not support this pleading, the Opponent fails to meet its initial burden under this ground. In any event, to the extent this ground would ultimately turn on the issue of confusion, I reach essentially the same conclusion as above with respect to the other grounds.

[48] Accordingly, the ground based on non-distinctiveness is rejected.

DISPOSITION

[49] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the opposition.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No hearing held

AGENTS OF RECORD

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