



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 264

Date of Decision: 2021-11-29

IN THE MATTER OF AN OPPOSITION

Andrea Wilson, c.o.b. as Achieve

Opponent

And

AchieveForum, Inc.

Applicant

1,812,204 for ACHIEVEFORUM

Application

INTRODUCTION

[1] Andrea Wilson, c.o.b. as Achieve (the Opponent) opposes registration of the trademark ACHIEVEFORUM (the Mark), application No. 1,812,204 filed by AchieveForum Inc. (the Applicant). The Mark has been applied for in association with the Goods and Services set out in the attached Schedule A, which are for use in a variety of fields, including business management and leadership development.

[2] The Opponent bases its opposition on numerous grounds. However, as the Opponent did not file any evidence, it has failed to meet its evidential burden under most of these grounds. The determinative issue, therefore, is the likelihood of confusion with the Opponent's trademark ACHIEVE, registered in association with, *inter alia*, business consultancy and leadership related services.

[3] For the reasons that follow, the opposition is rejected.

THE RECORD

[4] The application for the Mark was filed on December 1, 2016, and was advertised for opposition purposes in the *Trademarks Journal* of June 20, 2018. The application is based on (i) proposed use for the Goods and Services, and (ii) prior registration in the United States on June 6, 2016, under application No. 87/060,911.

[5] On November 20, 2018, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). In accordance with section 70 of the Act, all references to sections of the Act pertaining to the grounds of opposition are to the Act as it read before June 17, 2019.

[6] On December 24, 2018, the Applicant filed a request for an interlocutory ruling. The Opponent requested leave to file an amended statement of opposition on January 23, 2019.

[7] The Registrar issued an interlocutory ruling on March 11, 2019, in which the Registrar granted leave to the Opponent to amend its statement of opposition and also struck the sections 30(a), 30(e) and the first section 30(i) ground of opposition which was based on awareness of the Opponent's mark. The remaining grounds of opposition are based on section 12(1)(d), 16(3)(a), 16(3)(c), 2 and a second section 30(i) ground which is based on the allegation that the use of the Mark would likely have the effect of depreciating the value of the goodwill attached to the Opponent's ACHIEVE mark.

[8] The Applicant denied each of the grounds of opposition in a counter statement filed on April 11, 2019.

[9] The Opponent elected not to file any evidence in support of its opposition. The Applicant's evidence consists of the affidavits of Gay Owens, trademark searcher with the Applicant's agent, Thomas James, a trademark research analyst employed by CompuMark, part

of Clarivate Analytics Canada Corp., and Josee Aubin, Research Analyst also employed by CompuMark. Neither of the affiants were cross-examined on their affidavits.

[10] Neither party filed a written argument and no hearing was held.

ONUS AND MATERIAL DATES

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements 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 [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD) at 298].

[12] The material dates that apply to the grounds of opposition pleaded are:

- Sections 38(2)(a)/30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b)/12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trademarks*, 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(3) – the filing date of the application [section 16(3) of the Act];
and
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Section 30(i) ground of opposition

[13] The Opponent's section 30(i) ground alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada on the basis that the use of the Mark by

the Applicant is likely to have the effect of depreciating the value of the goodwill attaching to the Opponent's trademark ACHIEVE.

[14] Since the Opponent has not filed any evidence in support of this opposition, it has not met its initial evidential burden to show that the use of the Mark with the Goods and Services would likely have the effect of depreciating the goodwill attaching to the Opponent's registered trademark ACHIEVE, contrary to section 22. Accordingly this ground of opposition is dismissed.

Section 16(3)(a) & (c) grounds of opposition

[15] The Opponent alleges in its statement of opposition that the Applicant is not the person entitled to register the Mark because at the filing date of the application, the Mark was confusing with the Opponent's previously used ACHIEVE trademark and trade name.

[16] In order to meet its initial burden under sections 16(3)(a) and (c) of the Act, the Opponent must provide evidence that it was using its trademark and trade name in Canada prior to the priority filing date of the application. As the Opponent has not filed any evidence in support of these grounds, it has failed to meet its initial burden. Accordingly, these grounds are also dismissed.

Section 2 ground of opposition

[17] The Opponent alleges in its statement of opposition that the Mark is not distinctive of the Applicant because it does not distinguish and is not adapted to distinguish the Goods and Services from the Opponent's goods and services sold in association with its ACHIEVE trademark.

[18] In order to meet its initial burden in support of the non-distinctiveness ground of opposition, the Opponent was required to show that as of the date of filing its statement of opposition, November 20, 2018, its ACHIEVE trademark was known in Canada to at least some extent and that the reputation of its trademark in Canada was substantial, significant or sufficient so as to negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd*, 1981 CanLII 2834 (FC), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* 2006 FC

657]. As the Opponent has not adduced any evidence whatsoever of the extent to which its registered trademark ACHIEVE has become known in Canada, the Opponent has not met its evidential burden. This ground of opposition is therefore also dismissed.

REMAINING GROUND OF OPPOSITION – SECTION 12(1)(D)

[19] The Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's registration No. TMA960,397 for the trademark ACHIEVE.

[20] Having exercised the Registrar's discretion to check the Register [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)], I confirm that registration No. TMA960,397, for the trademark ACHIEVE is in good standing. The current owner, however, is listed as Achieve Potential Inc.

Test to determine confusion

[21] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[22] Accordingly, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether purchasers of the Applicant's Goods and Services, provided under the trademark ACHIEVEFORUM, would believe that those Goods and Services were being provided by the Opponent, or that the Applicant was authorized or licensed by the Opponent who offers goods and services under the trademark ACHIEVE.

[23] 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 trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in

appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Masterpiece v Alavida Lifestyles Inc*, 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) (*Masterpiece*)]. However, as noted by the Supreme Court of Canada in *Masterpiece*, although the degree of resemblance is the last factor cited in section 6(5) of the Act, it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion (*Masterpiece*, para 49).

Inherent distinctiveness and the extent to which the trademarks have become known

[24] The Opponent's mark is not inherently strong as it is composed of the ordinary dictionary word ACHIEVE. The Canadian Common Law Dilution Search provided in the Aubin affidavit identified the following definition of the word ACHIEVE on *dictionary.com*: "to bring to a successful end; carry through; accomplish". As noted by the Applicant's agent, the Mark therefore suggests that the Opponent's business consultancy and leadership related services will teach the consumer how to bring about/accomplish certain desired objectives or results. Accordingly the Opponent's mark is entitled to a narrower ambit of protection than that would be afforded to an inventive, coined term that is not at all suggestive.

[25] I find the Mark to possess a higher degree of inherent distinctiveness than the Opponent's mark because, although I find again that the component "achieve" is suggestive of the desired objectives or results of the Applicant's Goods and Services, the Mark as a whole is a coined word. In this regard, the Mark ACHIEVEFORUM has no dictionary meaning in any language and is comprised of two terms (*i.e.* "achieve" and "forum") which are not typically featured directly next to one another in written or spoken English.

[26] Neither party has filed any evidence of use or making known of their marks.

[27] This factor therefore favours the Applicant.

Length of time in use

[28] Neither party has filed any evidence of use of their marks. Accordingly, this factor does not favour either party.

Nature of the goods, services and trade

[29] The parties' services are of the same nature and there is some direct overlap as both are either applied for or registered in association with business consultancy and leadership related services.

[30] Accordingly, and in the absence of evidence to the contrary, it is reasonable to assume that there would be overlap in the parties' channels of trade.

Degree of resemblance

[31] When considering the degree of resemblance between trademarks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23 (CanLII) at para 20].

[32] The parties' marks share some resemblance in appearance and sound because they both include the word ACHIEVE either alone or as the first component of their mark.

[33] The ideas suggested by the marks, however, are different. In this regard, as noted above, when the Opponent's mark is viewed in the context of its associated business consultancy and leadership related goods and services, it conveys the idea that the Opponent's services will teach the consumer how to bring about or accomplish certain desired objectives or results. The Mark, on the other hand, suggests a service that allows consumers to discuss achievements.

[34] This factor therefore does not favour either party.

Surrounding circumstance – state of the register evidence

[35] The Applicant relies on the state of the register evidence submitted through the Owens, Aubin and James affidavits.

[36] The Owens affidavit shows that there are least 13 marks on the register standing in the name of 10 different entities which prominently feature the word "achieve", "achievers" or

“achievement” and are registered in association with business consultancy and/or leadership related services.

[37] The Aubin and James affidavits provide the results of common law searches to support the conclusion that trade names and trademarks consisting of or containing the word “achieve” have been used in Canada in association with business consulting and leadership related goods and or services. Ms. Aubin located at least 18 trade names/company names which prominently feature the word ACHIEVE (or variants thereof) and either (1) list business or management related goods/services or (2) contain other terms in their company name/trade name which suggest that they offer business or management related services. Mr. James identified at least 9 instances of trademarks, trade names or company names that prominently feature the term ACHIEVE for use in association with business consultancy or leadership related services.

[38] The Applicant acknowledged that the Aubin and James affidavits are not determinative that the trademarks and trade names identified in them have been used in Canada. As noted by the Applicant’s agent, neither Ms. Aubin nor Mr. James attempted to purchase any of the goods or services advertised or offered for sale on the webpages or directories shown in their affidavits. That being said, the Applicant submitted the following in its written argument:

...the Aubin and James affidavits are relevant because they provide a large number of results which suggest that there are many entities using trademarks or trade names featuring the word “achieve” in association with business consultancy and leadership related goods and services in Canada. It would be highly irregular for all of those webpages or companies to exist without at least some of them reflecting marketplace use.

[39] I am prepared to accord some weight to the Applicant’s evidence as it seems clear that third parties have been active under trademarks and trade names that incorporate the words ACHIEVE (or variants of these words) in the general field that the parties operate within. As such, this factor favours the Applicant to some extent.

Conclusion regarding the likelihood of confusion

[40] While the nature of the goods, services and trade favours the Opponent in this case, I consider the jurisprudence on weak marks to have a mitigating effect on the Opponent’s

advantage under this factor. As noted by the Federal Court in *Provigo Distribution Inc v Max Mara Fashion Group SRL*, 2005 FC 1550 (CanLII), 46 CPR (4th) 112 at para 31 (FC):

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first use of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used...

[41] While it is possible for the degree of distinctiveness attributable to a weak mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 240 (FCTD)], the Opponent has filed no evidence of use its trademark. Further, a party adopting a weak trademark has been held to accept some risk of confusion [*General Motors v Bellows*, 1949 CanLII 47 (SCC), 10 CPR 101 at 115-116 (SCC)].

[42] Considering all of the factors as discussed above, and in particular, taking into account that the Opponent's mark is a weak mark entitled to a narrow ambit of protection, and the differences in the ideas suggested by the marks, I find that the balance of probabilities between finding that there is no reasonable likelihood of confusion, and that there is a reasonable likelihood of confusion, falls slightly in favour of the Applicant. Accordingly, this ground of opposition is rejected.

DISPOSITION

[43] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1,812,204 – ACHIEVEFORUM

Goods (Nice class& Statement)

9 (1) Computer software for use in training and education in the fields of business strategy, organization and management, supervisory skills, interpersonal skills, customer service, leadership development, business management and sales training; pre-recorded CDs featuring courses and presentations in the fields of business strategy, organization and management, supervisory skills, interpersonal skills, customer service, leadership development, business management and sales training; downloadable electronic publications in the nature of newsletters delivered via electronic mail concerning business strategy, organization and management, supervisory skills, interpersonal skills, customer service, leadership development, business management and sales training.

16 (2) Instructional and training kits, namely, printed training and questionnaire booklets, workbooks and manuals in the fields of business strategy, organization and management, supervisory skills, interpersonal skills, customer service, leadership development, business management and sales training. (the Goods)

Services (Nice class& Statement)

35 (1) Business consulting services in the fields of talent analytics, organizational performance, leadership development, employee development, business management, customer service, and sales.

41 (2) Educational services, namely, providing web-based training and educational programs in the fields of business strategy, organization and management, supervisory skills, interpersonal skills, customer service, leadership development, business management and sales; educational and training services, namely, conducting seminars and workshops in the fields of business strategy, organization and management, supervisory skills, interpersonal skills, customer service, leadership development, business management and sales. (the Services)

SCHEDULE B

Registration No. TMA960,397 ACHIEVE

Goods

- (1) Printed material, namely information sheets, in the field of people and organizational management
- (2) Brochures and pamphlets in the field of people and organizational management
- (3) Training manuals, printed course materials, and workbooks in the field of people and organizational management

Services

- (1) Business management consulting
- (2) Management training, facilitation, and business consulting services provided to organizations for team and people development through individual coaching, team accountability sessions, seminars, classes, and workshops
- (3) Delivery of educational programs to enable leadership teams to accomplish their business and personal objectives
- (4) Management consulting to businesses, business teams, and individuals to define business visions, objectives, and action plans
- (5) Drawing out ideas from business leaders for strategic planning including ownership, accountability, execution and outcome monitoring
- (6) Utilizing assessment and strategic management tools and programs to improve the effectiveness of business leaders and their team members to meet business objectives
- (7) Utilizing assessment and strategic management tools and programs to identify and eliminate non-value added tasks and wasteful business practices
- (8) Utilizing assessment and strategic management tools and programs to equip employees with problem solving tools to identify and resolve issues
- (9) Design of customizable systematic organizational problem solving tools and organizational continuous improvement recognition tools
- (10) Utilizing assessment and strategic management tools to drive bottom line business results in the areas of sustainability of people, profits, and environment

- (11) Implementation of quality and environmental management systems
- (12) Utilizing assessment and strategic management tools and programs to improve employee engagement
- (13) Utilizing assessment and strategic management tools and programs to improve customer loyalty and retention
- (14) Conducting workshops and utilizing exercises to identify action plans
- (15) Conducting surveys to determine employee engagement and customer satisfaction
- (16) Providing business leaders and individuals an outside perspective
- (17) Delivery of training on situational leadership theories and its application to staff supervision and training
- (18) Public speaking seminars on services in the field of people and organizational success management
- (19) Mentorship of business professionals to accomplish their business and personal objectives
- (20) Public speaking seminars to inspire and motivate business leaders

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Smart & Biggar

For the Opponent

Ledgley Law

For the Applicant