



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

Citation: 2015 TMOB 120
Date of Decision: 2015-06-30

IN THE MATTER OF AN OPPOSITION

1772887 Ontario Limited	Opponent
and	
Vancouver Free Press Publishing Corp.	Applicant
1,597,423 for the trade-mark Best of Vancouver	Application

Background

[1] On October 9, 2012, the Applicant filed application no. 1,597,423 for the trade-mark Best of Vancouver (the Mark).

[2] The application is based upon use in Canada since September 1998 for “t-shirts”, “award certificates” and “door stickers” and based upon use in Canada since September 2007 for “tote bags” and “posters”. It is also based upon use in Canada since September 1996 for a variety of services, some of which include advertising, the operation of an awards program and conducting surveys and contests. A list of the specific goods and services which are covered by the application is attached hereto as Schedule “A”.

[3] The Opponent is the owner of the trade-marks KIDS GUIDE TO VANCOUVER & DESIGN (registration No. TMA495,094), THE ESSENTIAL VANCOUVER (registration No. TMA351,245) and KEY TO VANCOUVER (registration No. TMA302,899).

[4] The Opponent's registrations are based upon use in association with various "printed publications" and information and advisory services relating to children's activities. A list of the specific goods and services which are covered by the Opponent's registrations, as well as details pertaining to the claimed dates of first use for each of the trade-marks is attached hereto as Schedule "B".

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 19, 2013 and on November 19, 2013, 1772887 Ontario Limited (the Opponent) opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based upon sections 30(b), 30(i), 12(1)(d), 16(1)(a) and 2 (distinctiveness) of the Act.

[6] The Applicant filed a counterstatement on December 23, 2013, denying each of the allegations set out in the statement of opposition.

[7] As evidence in support of its opposition, the Opponent filed the affidavit of Elenita Anastacio, sworn April 15, 2014 (the Anastacio affidavit). Ms. Anastacio was not cross-examined.

[8] As evidence in support of its application, the Applicant filed the affidavit of Navdeep Chhina, sworn July 31, 2014. Ms. Chhina was not cross-examined.

[9] Both parties filed written arguments. No hearing was held.

Onus

[10] 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

Non-compliance - Section 30(i)

[11] The Opponent has pleaded that the application for the Mark does not comply with section 30(i) of the Act because its use damages the goodwill of the Opponent in its trade-marks KIDS GUIDE TO VANCOUVER & DESIGN (registration No. TMA495,094), THE ESSENTIAL VANCOUVER (registration No. TMA351,245) and KEY TO VANCOUVER (registration No. TMA302,899).

[12] In the decision *Euromed Restaurant Ltd v Trilogy Properties Corp* 99 CPR (4th) 445 (TMOB) at paras 12-13, Member dePaulsen pointed out that neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on a violation of section 22 is a valid ground of opposition [*Parmalat Canada Inc v Sysco Corp* (2008), 2008 FC 1104 (CanLII), 69 CPR (4th) 349 (FC) at paras 38-42]. In that case, Member dePaulsen went on to find that even if she had considered it to be a valid ground of opposition, the opponent had failed to adduce any evidence supporting a likelihood of depreciation of goodwill which would support a violation of section 22 [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 (SCC) at paras. 46, 63-68].

[13] In the present case, the Opponent also has not filed any evidence which can support this ground. Mere knowledge of the existence of the Opponent's trade-marks does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [*Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197 (CanLII)].

[14] Accordingly, this ground of opposition is dismissed.

Non-entitlement – Section 16(1)(a)

[15] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of its prior use of its trade-marks KIDS GUIDE TO VANCOUVER & DESIGN, THE ESSENTIAL VANCOUVER and KEY TO VANCOUVER With respect to this ground of opposition, there is an initial burden on the Opponent to evidence use of its trade-mark(s) prior to the Applicant's claimed date(s) of first use and to establish that it had not

abandoned its trade-marks as of the date of advertisement of the Applicant's application [section 16(5)]. The Opponent has not provided any evidence of use of its trade-marks.

[16] Accordingly, this ground of opposition is also dismissed.

Non-distinctiveness – Section 2

[17] The Opponent has pleaded that the Mark does not distinguish and is not adapted to distinguish the Applicant's goods and services from those of the Opponent, in association with which it has used its trade-marks KIDS GUIDE TO VANCOUVER & DESIGN (registration No. TMA495,094), THE ESSENTIAL VANCOUVER (registration No. TMA351,245) and KEY TO VANCOUVER (registration No. TMA302,899).

[18] In order to satisfy its initial burden with respect to a distinctiveness ground of opposition, an opponent's evidence must show that its trade-marks had become known sufficiently as of the commencement of the opposition to negate the distinctiveness of the applied-for trade-mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC) and *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[19] In this case, the Opponent has not filed any evidence of use which would enable me to conclude that its trade-marks have become known to any extent. It has therefore failed to meet its initial burden in respect of this ground.

[20] Accordingly, this ground of opposition is also dismissed.

Analysis of Remaining Grounds of Opposition

Non-compliance - Section 30(b)

[21] The Opponent has pleaded that the application for the Mark does not comply with section 30(b) of the Act as the Applicant has not used the Mark in association with the goods and services set out in the application since the claimed dates of first use or at all. In addition, the Opponent has pleaded that if there has been use in Canada, it has not been in compliance with section 50 of the Act.

[22] The material date for considering the circumstances with respect to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[23] While the *legal* burden is upon the applicant to show that its application complies with section 30 of the Act, there is an initial *evidential* burden on the opponent to establish the facts relied upon by it in support of its Section 30 ground [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 at 329 (TMOB); and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the initial evidentiary burden on the Opponent with respect to this ground is relatively light [see *Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, the Opponent may rely upon both its own evidence and that of the Applicant in order to meet its initial evidential burden [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230].

[24] In cases where an opponent has relied upon the applicant's evidence in order to meet its evidential burden for a section 30(b) ground of opposition, it has been held that in order to do so, the opponent must show that the applicant's evidence is "clearly inconsistent" with the claims set forth in its application [see, *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), affirmed 2001 FCT 252 (CanLII), 11 CPR (4th) 489 (FCTD)]. However, I note that in a more recent decision in the Federal Court, Justice Rennie pointed out that this "clearly inconsistent" approach leads to a somewhat opaque evidential burden, as the burden is described simultaneously as being a "light" burden while also demanding, in the case of an opponent who relies on the applicant's evidence, that the evidence be "clearly inconsistent" with the applicant's claims, shifting the burden higher [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paragraphs 30-38 (CanLII)].

[25] In this case, the Opponent is relying on both its own evidence (the Anastacio affidavit) and on the evidence which has been filed by the Applicant (the Chhina affidavit) in order to meet its initial evidential burden. However, for reasons which I will discuss below in more detail, I am not prepared to give much weight to the Opponent's evidence and I do not find the Applicant's

evidence, either alone or in combination with the Opponent's evidence, sufficient for the Opponent to meet even a light initial evidential burden.

Chhina Affidavit

[26] In paragraph 1, Ms. Chhina identifies herself as the Brand Manager/Promotions of the Applicant. She states that the Applicant does business under the trade names and business names "The Georgia Straight" and "Straight.com". As a result of her position, she has access to the Applicant's business records and she is involved on a day to day basis with its trade-marks [para 4].

[27] In paragraphs 5 to 8, Ms. Chhina provides details pertaining to some of the Applicant's services. She states that the Applicant has, as some of its services, conducted surveys and polls, contests and awards programs under or in association with the Mark, in order to promote awareness of local businesses, communities, organizations, and their activities and events and for customers to provide advertising and to hold "winner recognition" events. According to Ms. Chhina, the surveys, polls, contests and awards programs have been provided by the Applicant under the Mark continuously from 1996 to the current date, in or through the Applicant's printed publications, flyers, news box cards and webpages throughout greater Vancouver and in other areas of Canada [para 5].

[28] Ms. Chhina states that revenues from the Applicant's surveys and polls, contests and awards programs during the period 1996 to the date she swore her affidavit, have been generated every year since 1996 and total revenues from 1996 to September 2012 exceeded \$5000. Some of these services were also provided free of charge [para 5]. Attached as Exhibit A, are copies of: a) a flyer distributed by the Applicant in Vancouver in September 2012; b) a news box card distributed in Vancouver by the Applicant in 2003; c) a ballot distributed in Vancouver by the Applicant in August 2004; d) a contest entry form distributed and used in Vancouver by the Applicant in June 2011; and e) a webpage from the Applicant's website that was accessible to the Canadian public in June 2011 [para 5].

[29] In paragraph 7, Ms. Chhina states that a further service provided by the Applicant is advertising and promoting the goods and services of others in association with the Mark.

According to Ms. Chhina, the Applicant has provided these services continuously since 1996 via its printed publications, flyers, news box cards, and webpages throughout greater Vancouver and in other areas of British Columbia. Ms. Chhina states that revenues from these services from 1996 up until she swore her affidavit were generated in every year and the total amount of revenue generated from these services from 1996 to September 2012 exceeded \$15,000 [para 7].

[30] Attached as Exhibit B are copies of: a) a page extract from one of the Applicant's publications which was published and distributed in Vancouver on September 19, 1996; b) a flyer distributed by the Applicant in Vancouver in September 2012; and c) a webpage from the Applicant's website that was accessible to the Canadian public in September 2004 and which Ms. Chhina states referred to, described or was used as part of the advertising and promotional services of the Applicant in association with the Mark [para 8].

[31] In paragraph 9, Ms. Chhina states that the Applicant has been selling t-shirts bearing the Mark continuously since 1998 in Vancouver. Revenues for such sales have exceeded \$150 from 1998 to September 2012. Attached as Exhibit C, are two photographs of a t-shirt bearing the Mark, together with a representative invoice from the Applicant showing a sale of such t-shirts to a Canadian customer on October 27, 2010.

[32] In paragraph 12, Ms. Chhina states that based upon her review of the Applicant's records, no member of the public has mistakenly contacted the Applicant while attempting to contact the Opponent and no member of the public advised the Applicant that he or she mistook the Applicant for the Opponent or believed that the parties were somehow associated with one another. In addition, according to Ms. Chhina, no member of the public has advised or notified the applicant that she or he bought goods or services from the Applicant that were branded with or used in association with the Mark based on a belief that such goods or services originated from or were associated with the Opponent.

Anastacio Affidavit

[33] Ms. Anastacio is a trade-mark searcher employed by the former agent for the Opponent [para 1]. On March 17, 2014, she conducted an internet search to "retrieve and cite the exact terms BEST OF VANCOUVER in association with Vancouver Free Press Publishing (the

applicant)...”. Ms. Anastacio states that her search located BEST OF VANCOUVER in association with Vancouver Free Press Publishing only in association with the publication of news articles and publications [para 4]. She states that the results of her search are attached as Exhibit B. However, Exhibit B appears to show only the first few of many search results. It is unclear whether Ms. Anastacio actually visited any of the websites which were associated with her search results, whether she reviewed all of her search results, rather than just those which were listed in Exhibit B or how she ascertained from her search that BEST OF VANCOUVER only appeared in association with the publication of news articles and publications. I also note that the search conducted by Ms. Anastacio was arguably somewhat narrow, given that the Applicant also appears to carry on business under the business or trade-names “The Georgia Straight” and “Straight.com”.

[34] In paragraph 6, Ms. Anastacio states that she also conducted a Wayback Machine Internet Archive Search to view the history of the Applicant’s website from 1996-2014. Ms. Anastacio states that a copy of the history is attached as Exhibit C. According to Ms. Anastacio, she reviewed the website pages for the years 2005 to 2009 and found only a few references to BEST OF VANCOUVER in association with a department, article, column or section of The Georgia Straight publication and the Applicant’s website. It is unclear why Ms. Anastacio selected only those particular years to review and notably, only pages from those years were included in Exhibit C. It may be that there were no pages for the years prior and subsequent to those dates or that there were and Ms. Anastacio for some reason elected not to include them. I also note that websites are only one of many ways by which the Applicant provides its various services.

[35] The Federal Court of Appeal has made it clear that “it is not good practice for a law firm to cause its employees to act as investigators for the purpose of having them later give opinion evidence on the most crucial issues in the case” [see *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada* 206 FCA 133 (CanLII) at para 4, (2006), 53 CPR (4th) 286 (FCA)]. The Court is less clear on how solely non-opinion evidence furnished by a firm’s employee should be treated. However, it does state that “it is improper for a solicitor to compromise his independence by acting in a proceeding in which a member of his firm has given affidavit evidence on a point of substance” [*Cross-Canada, supra*, at para 7].

[36] Whether the Mark was in use at a particular time or not is certainly a point of substance in this case. In view of this, and in view of the lack of information which has been provided by Ms. Anastacio with respect to why she selected her search parameters, how and why she selected the pages which she chose to include as exhibits and how her search results are able to support the statements made in her affidavit, I question the quality and reliability of Ms. Anastacio's evidence. I am therefore prepared to give it very little weight. Overall, I do not find her evidence sufficient for the Opponent to meet the light initial evidential burden upon it to establish that the facts alleged to support its section 30(b) ground of opposition exist.

[37] As previously mentioned, the Opponent may also rely upon the Applicant's evidence to meet its initial evidential burden. However, I don't find that the Applicant's evidence offers the Opponent much assistance in meeting its burden either. The Opponent is essentially relying upon the absence of affirmative statements of use for some goods and services and/or the absence of complete evidence of use in support of the affirmative statements which have been made.

[38] While Ms. Chhina has not necessarily provided clear or abundant evidence of use of the Mark in association with all of the goods and services in the application, she has provided some evidence of use and she has also provided some sworn statements that the Mark has been continuously used since the claimed dates of first use in the application. In the absence of cross-examination and/or more reliable or additional evidence from the Opponent, I have no reason to doubt the veracity of her statements or draw negative inferences from any shortcomings in her evidence.

[39] Thus, although the burden on an opponent is relatively light in respect of a section 30(b) ground of opposition, I am of the view that it has not been met in this case.

[40] With respect to the Opponent's allegation that the Chhina affidavit does not provide any evidence of licensed use of the Mark, I note that the Opponent has not made any meaningful submissions in this regard. In addition, I note that there is no indication that the Mark is in use by a licensee. Rather, according to Ms. Chhina, it is used by the Applicant, which does business under trade names.

[41] Accordingly, this ground of opposition is unsuccessful.

Non-registrability - Section 12(1)(d)

[42] The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-marks KIDS GUIDE TO VANCOUVER & DESIGN (registration No. TMA495,094), THE ESSENTIAL VANCOUVER (registration No. TMA351,245) and KEY TO VANCOUVER (registration No. TMA302,899).

[43] The material date to assess a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[44] The Opponent has filed copies of its registrations as part of its evidence. I have exercised my discretion to check the register to confirm whether they are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I confirm that only KIDS GUIDE TO VANCOUVER & DESIGN (registration No. TMA495,094) and THE ESSENTIAL VANCOUVER (registration No. TMA351,245) are still extant. The trade-mark KEY TO VANCOUVER (registration No. TMA302,899) was expunged for non-use on October 9, 2014.

[45] The Opponent has therefore only met its initial burden with respect to this ground for the trade-marks KIDS GUIDE TO VANCOUVER & DESIGN (registration No. TMA495,094) and THE ESSENTIAL VANCOUVER (registration No. TMA351,245). My analysis under section 12(1)(d) of the Act will therefore be limited to those two trade-marks.

[46] As the Opponent's evidentiary burden has been satisfied, the Applicant must establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks KIDS GUIDE TO VANCOUVER & DESIGN and THE ESSENTIAL VANCOUVER.

[47] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[48] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[49] The Mark consists of the phrase BEST OF VANCOUVER, which is somewhat laudatory or suggestive in nature and the word VANCOUVER has been disclaimed. Overall, I find that the Mark possesses a low degree of inherent distinctiveness. The Opponent's trade-marks THE ESSENTIAL VANCOUVER and KIDS GUIDE TO VANCOUVER & DESIGN (shown below),



are also somewhat suggestive or descriptive in nature. Notably, in registration No. TMA495,094, the entire word portion of the mark, namely, KIDS' GUIDE TO VANCOUVER, has been disclaimed and I do not find that the design portion of the trade-mark adds much distinctiveness to the mark. Similarly, in registration No. TMA351,245 for ESSENTIAL VANCOUVER, the word VANCOUVER has been disclaimed. Accordingly, I find that both of the Opponent's trade-marks also possess a fairly low degree of inherent distinctiveness.

[50] The distinctiveness of a trade-mark may be increased through promotion or use.

[51] In this case, the Opponent has not filed any evidence of promotion or use of its trade-marks which would enable me to conclude that they have become known to any extent.

[52] The Applicant has filed evidence of use of the Mark in Canada for some of its goods and services and provided some sales figures. However, its evidence is not overwhelming. For example, revenues from the Applicant's surveys and polls, contests and awards programs during the period 1996 to September 2012 only exceeded \$5000 and revenues from its advertising and promotional services during that same period exceeded only \$15,000 [Chhina affidavit, paras 5 and 7]. Although Ms. Chhina states that some services were provided free of charge as well, no further detail has been provided in this regard. While Ms. Chhina has provided examples of flyers, ballots, contest entry forms, page extracts from publications, etc. as Exhibits "A" and "B" to her affidavit, she has not provided any details pertaining to how widely they were disseminated. There is also no information in her affidavit with respect to how many Canadians visit the Applicant's website each year. Insofar as the Applicant's goods are concerned, Ms. Chhia states only that sales of t-shirts from 1998 to September 2012 exceeded \$150 and she has provided only a single invoice from 2010 [Chhina affidavit, paras 6, 8-10 and Exhibit "C"].

[53] In view of the foregoing, I find that this factor, which is a combination of the inherent distinctiveness of the marks and the extent to which they have become known, slightly, but not significantly, favours the Applicant.

Section 6(5)(b) – the length of time each has been in use

[54] The Opponent has not filed any evidence of use of its trade-marks. By contrast, as mentioned previously, the Applicant has provided evidence of use for at least some of its goods and services.

Sections 6(5)(c) and (d) – the nature of wares, services or business and trade

[55] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods and services in the application for the Mark and the statement of goods and services in the Opponent’s registrations that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[56] Although there is no indication in the application for the Mark that the goods and services of the Applicant are directed to children or families, I consider at least some of the Applicant’s goods (for example, “posters”) and services to be similar in nature or related to those of the Opponent. The Applicant promotes awareness of local businesses, communities, organizations and their activities and events by conducting contests, operating an awards program and conducting surveys and polls. It also advertises and promotes the services of others through various media. Similarly, the Opponent provides information and advisory services to “promote and inform and advise” on available children’s activities and family entertainment services, and it uses promotions contests, cooperative promotional efforts with providers and various other means to do so.

[57] In view of the similarities in the nature of the parties’ goods and services, it is reasonable to conclude that there may also be some overlap in their channels of trade.

[58] The sections 6(5)(c) and (d) factors therefore favour the Opponent.

Section 6(5)(e) – degree of resemblance between the trade-marks

[59] In *Masterpiece Inc v Alavida Lifestyles Inc et al* [supra], 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 parties’ trade-marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. If the parties’ trade-marks do not resemble one

another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion.

[60] In *Masterpiece*, the Supreme Court observed that even though the first word of a trade-mark may be the most important, for the purpose of distinctiveness [see *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[61] In the present case, I don't find that there is anything particularly striking or unique about the parties' trade-marks. As previously discussed, the marks in question are all somewhat laudatory, suggestive or descriptive in nature.

[62] The only commonality between the marks is the inclusion of the word VANCOUVER, which is clearly a geographic location in Canada. Otherwise, I find the marks to be quite visually and phonetically different. They also differ somewhat in terms of their suggested idea. The Opponent's trade-mark KIDS GUIDE TO VANCOUVER & DESIGN conveys the idea that the printed publications and information and advisory services of the Opponent are intended to be a guide to activities and services for kids in Vancouver. By contrast, the words "essential" and "best" which appear in THE ESSENTIAL VANCOUVER and BEST OF VANCOUVER contain no references to kids and have meanings which are entirely different from one another.

[63] In view of this, I do not find there to be a high degree of resemblance between the parties' trade-marks.

Conclusion on the Likelihood of Confusion

[64] I am of the view that the differences between the trade-marks in the present case are sufficient to avert confusion. There is no evidence that the Opponent has established any reputation in its trade-marks so as to enable them to acquire distinctiveness and it has been held that comparatively small differences will suffice to distinguish between weak marks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66]. Thus, although there is some overlap in the nature of the parties' goods and services and

channels of trade, I find that the differences between the trade-marks in appearance, sound and suggested idea are sufficient to avoid any reasonable likelihood of confusion. Having considered all of the surrounding circumstances, I have therefore concluded that, on a balance of probabilities, there is no likelihood of confusion between the trade-marks at issue.

[65] Accordingly, the section 12(1)(d) ground of opposition is also unsuccessful.

Disposition

[66] In view of the foregoing, 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.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule “A”

Goods:

- (1) T-shirts, award certificates, door stickers
- (2) Tote bags, posters

Services:

- (1) Advertising and promoting the wares and services of others through various media including newspapers, printed materials, electronic publications and websites, and through customer discount cards and booklet
- (2) Operation of an awards program and venue in printed publications, electronic publications, on websites, to promote awareness of local businesses, communities, organizations, and their activities and events, and for customers to provide advertising, and holding winner recognition parties and events
- (3) Conducting surveys and polls by the means of ballots and other printed publications, electronic publications and on websites, to promote awareness of local businesses, communities, organizations, and their activities and events, and for customers to provide advertising, and holding winner recognition parties and events
- (4) Conducting contests by the means of ballots and other printed publications, electronic publications and on websites, to promote awareness of local businesses, communities, organizations, and their activities and events, and for customers to provide advertising, and holding winner recognition parties and events


Claims:

Used in CANADA since September 1998 on goods (1).

Used in CANADA since September 2007 on goods (2).

Used in CANADA since September 1996 on services.

Schedule "B"

Trade-mark	Reg'n No.	Goods/Services	Claimed Dates of First Use
	TMA495,094	<p>Printed publications namely books and booklets of all kinds, newspapers, brochures, pamphlets, manuals, guides, maps, posters, pictures and photographs relating to children's activities in specified locations in Canada.</p> <p>Provision of information and advisory services relating to children's activities by providing information and advice regarding specific entertainment and educational services directed to parents and children to promote and inform and advise on specified available children's activities and family entertainment services through printed publications, print advertising, tourist information booths, point of purchase signage, promotions contests and cooperative promotional efforts with content providers, in specified locations in Canada.</p>	Used in CANADA since September 21, 1995.
THE ESSENTIAL VANCOUVER	TMA351,245	Printed publications, namely magazines.	Used in CANADA since at least as early as June 1987.
KEY TO VANCOUVER	TMA302,899	Printed publications, namely magazines, magazine columns or special inserts and periodicals.	Declaration of Use filed February 21, 1985.

No Hearing Held

Agents of Record

Miller Thomson LLP

Alec Szibbo

For the Opponent(s)

For the Applicant