IN THE MATTER OF AN OPPOSITION by Cable News Network, Inc. to application No. 1,172,581 for the trade-mark ICNN filed by Claus Jensen

On March 28, 2003 Claus Jensen (the "Applicant") filed an application to register the trade-mark ICNN (the "Mark") based upon proposed use in Canada. The Mark has been applied for registration in association with the following wares and services:

Wares: (1) Pre-recorded audio-visual data carriers for use as teaching materials in the educational and entertainment fields, namely, pre-recorded audio-visual compact disks, digital video disks, music records, magnetic tapes, video cassettes, floppy diskettes, photographic film, photo cameras, video cameras; eyewear, namely, prescription glasses, sunglasses, sport goggles; computer hardware, namely, monitors, print cartridges, networking hardware, namely, computer hubs; televisions; image projectors, namely, cinematographic projectors, slide projectors, overhead projectors, epidiascopic projectors, video projectors and audio-visual slide projectors; imitation jewelry and jewelry of precious metal and stones, rings, necklaces, cuff links, tie pins, earrings, bracelets, brooches, chains, pendants; objects of art fashioned in bronze; clocks and watches, magnifying glass, medallions, money clips, diadems, trophies, chains for watches, neck chains, souvenir spoons; badges, books, notebooks, agendas, calendars, signs, photo albums, sticker pennants, bumper stickers, decals, macaroons, flags, lapel pins, maps, matches, licences plates, magnets, engravings, banners, paper plates, cups and saucers, paper napkins, wrapping paper, writing paper; board games, jigsaw puzzles, painting and colouring sets, colouring books, magazines, greeting cards, signets, book covers, postcards, photographs, newspapers, brochures, playing cards, printing blocks; Canadian art and Canadian momentos, namely, Canadian agenda books for school age children, high school students, university and continuing adult education students; leather and imitations of leather, namely, traveling bags, leather key chains, leather shopping bags; umbrellas, parasols and walking sticks; wearing apparel, namely womens, mens, childrens, infants jeans, pants, skirts, dresses, shirts, t-shirts, sweaters, jackets, coats, parkas, raincoats, wind resistant jackets, winter coats, socks and belts; footwear for men, women and children, namely, boots, shoes, sandals, slippers, running shoes, moccasins, rubber boots, overshoes, loafers and clogs; headgear for men, women and children, namely, hats, bonnets, berets, bands, bandannas, capes, hoods, headbands and visors; gymnastic and athletic sporting goods, namely, athletic wrist and joint supports; sports equipment, namely, hockey face masks, helmets and jerseys, protective padding for knees and joints, soccer balls, footballs, basketballs, baseballs, tennis balls and fishing tackle; toys, namely, mechanical and electronic action toys, toy arrows, baby multiple activity toys, bathtub toys, bendable toys, pet toys, children's multiple activity toys, crib toys, disc toss toys, drawing toys,

action figure toys, flying saucers, infant toys, inflatable toys, music box toys, party favors in the nature of small toys, plastic character toys, play mats containing infant toys, plush toys, pop up toys, pull toys, punching toys, push toys, ride-on toys, rubber character toys; sand and beach toys, namely, sandbox toys, toy pail and shovel sets, toy rakes, toy sand sieves, toy sand molds, water squirting toys, toy wheelbarrows; sketching toys, soft sculpture toys, squeeze toys, stuffed toys, talking toys, transforming robotic toys, water squirting toys, wind-up toys, wind-up walking toys.

Services: (1) Services of credit institutions other than banks, namely, cooperative credit associations, financial companies and lenders; services of "investment trusts" and holding companies; services rendered in the issuance of credit cards, services dealing with insurance, namely, services rendered by agents or brokers engaged in insurance, services rendered to insured and insurance underwriting services; providing consultation services, through the media of radio and/or television programs and/or a global computer network, namely, gateway services, reseller services, and air time brokerage services; receipt and delivery of online messages and other data by electronic transmission via computer terminals and wireless phones; operating online forums and chat rooms for the transmission of messages among multiple wireless phones.

The application was advertised in the *Trade-marks Journal* of September 1, 2004.

Cable News Network LP, LLLP filed a statement of opposition on October 25, 2004. The grounds of opposition are that: the application does not comply with the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"); the Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the registered trade-marks CNN (TMA302,803), CNN Design (TMA448,238) and CNN HEADLINE NEWS (TMA302,805); the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act because, at the filing date of the application, the Mark was confusing with the aforementioned and previously used trade-marks; and the Mark is not distinctive and is not adapted to distinguish the Applicant's wares and services.

During the course of this proceeding the record has been amended to reflect the opponent as Cable News Network, Inc. (the "Opponent"), which corresponds to the name of the owner of the registrations alleged in the statement of opposition, as further discussed in my analysis of the ground of opposition based upon s. 12(1)(d) of the Act.

The Applicant filed and served a counter statement on December 20, 2004.

The Opponent's evidence consists of an affidavit of Louise S. Sams (the "Sams Affidavit") dated January 18, 2006. Ms. Sams has been Senior Vice President and Secretary of Cable News Network, LP, LLLP since May 1, 2000. The Applicant did not cross-examine the Opponent's affiant. I note that Exhibits 1 through 7 appended to the Sams Affidavit are unnotarized. Unnotarized exhibits have been found admissible by the Registrar where no objection was raised by the other party or where an objection was raised at such a late stage of the opposition that the party which submitted the evidence had little or no opportunity to correct the deficiency [see *Maximilian Fur Co., Inc. v. Maximillian For Men's Apparel Ltd*. (1983), 82 C.P.R. (2d) 146 (T.M.O.B.); *Time Inc. v. Moisescu* (1990), 31 C.P.R. (3d) 255 (T.M.O.B.)]. Since the Applicant did not object to the admissibility of the unnotarized exhibits to the Sams Affidavit, I will accept them as admissible.

The evidence filed by the Applicant consists of an affidavit dated October 26, 2006 of Mr. Jensen himself. The Opponent did not cross-examine Mr. Jensen.

Both parties filed written arguments. Only the Opponent was represented at an oral hearing.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that the application complies with the requirements of the Act. There is, however, 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Material dates

The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b)/s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(3)(a) - the filing date of the application [see s. 16(3)];
- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Analysis of the grounds of opposition

Non-compliance with s. 30 of the Act

The Opponent has essentially alleged that the Applicant could not be satisfied of his entitlement to use the Mark in Canada since the Applicant was aware of the Opponent's alleged trade-marks and continued use thereof. The Opponent has not met its initial burden to show that the Applicant was aware of the Opponent's trade-marks at the material time. I would add that even if the Opponent had evidenced that the Applicant was aware of the Opponent's trade-marks at the relevant date, such a fact would not have been inconsistent with the statement that the Applicant was satisfied that he was entitled to use the Mark. In my opinion, where an applicant has provided the statement required by s. 30(i) of the Act, the ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. There is no such evidence in the present case.

In view of the above, I dismiss the ground of opposition based upon non-compliance with s. 30(i) of the Act.

Section 12(1)(d)

The details of the Opponent's alleged registrations have been provided through a Trademark Report filed as Exhibit 4 to the Sams Affidavit. The Opponent has not filed certified copies

of its alleged registrations. However, where an opponent raises s. 12(1)(d) of the Act as a ground of opposition and has not filed the certificate(s) of registration relied upon, the Registrar can use his discretion and check the register [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised the Registrar's discretion and determined that the three registrations, the details of which are as follows, are extant:

Trade-mark	Reg. No.	Reg. Date	Wares/Services
CNN	TMA302,803	May 17, 1985	Services: Research, production, transmission and broadcasting of television programs
	TMA448,238	Sept. 29, 1995	Wares: (1) Video tapes, video cassettes, motion pictures, videodiscs; tapes and cassettes for reproducing sound; books, program guides, program transcripts, photographs; instructional and teaching materials (except apparatus), namely educational video tapes, books and pamphlets. Services: (1) Cable and television broadcasting services. (2) Education and entertainment services, namely the production and distribution of cable television programs for entertainment and education purposes.
CNN HEADLINE NEWS	TMA302,805	May 17, 1985	Services: Research, production, transmission and broadcasting of television programs.

According to the last entry on the registration pages, the Canadian Intellectual Property Office recorded Cable News Network, Inc. as owner of each registration on February 8, 2007 following a merger of December 31, 2006.

Since the registrations are extant, the Opponent has discharged its initial burden of establishing the facts relied upon in support of the ground of opposition. Therefore, the

burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion.

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time the trade-marks or trade-names have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al*. (2006), 49 C.P.R. (4th) 401 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

Prior to assessing all of the surrounding circumstances of this case, I note that Ms. Sams explains that Cable News Network LP, LLLP, which is referred to in her affidavit as CNN, is a limited liability limited partnership organized under the laws of the State of Delaware. She further explains that CNN is a division of Turner Broadcasting System, Inc., which is owned by Time Warner Inc. [paragraph 4].

Insofar as the Applicant's evidence is concerned, I note that Mr. Jensen explains that in order to "understand the ownership of the trade-mark CNN", he obtained copies of "chartered documents of various entities associated with CNN", which he files as Exhibit "C" [paragraph 5]. Mr. Jensen also explains that he "ordered the corporate history of Cable News Network LP, LLLP and files copies of various certificates issued by the State of Delaware [paragraph 6, Exhibit "D"]. The Applicant did not make any submissions as to what he is

trying to establish by Exhibits "C" and "D" to his affidavit. Without speculating on the Applicant's intent, I should say that the ownership, validity and enforceability of the Opponent's registrations are not at issue in this proceeding.

As I am of the opinion that the Opponent's position respecting this ground of opposition is stronger in relation to its registered trade-marks CNN and CNN Design, the determination of the issue of confusion between these trade-marks and the Mark will effectively decide the ground of opposition. As I will focus my discussion of the surrounding circumstances on the registered trade-marks CNN and CNN Design, I note considering that any evidence of use of the trade-mark CNN Design in the manner prescribed by s. 4 of the Act may serve as evidence of use of the trade-mark CNN. I also note that I am disregarding the portions of the Sams Affidavit wherein the affiant expresses her views regarding the likelihood of confusion between the parties' trade-marks as it is up to the Registrar to make such determination after review of all relevant circumstances. Finally, since the Opponent in its written argument refers to various decisions in which this Board or the Court concluded to confusion between trade-marks, I would remark that the issue of confusion between the Mark and the Opponent's trade-marks is a question of probabilities based on the particular facts of this case. In other words, each case has to be decided on its own merit.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which they have become known

It is a well-known principle that a trade-mark or design mark consisting only of letters is characterized as a 'weak mark' [see *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.)]. Thus the Mark is inherently weak as are the Opponent's trade-marks.

There is no evidence that the Mark has become known to any extent in Canada.

Ms. Sams states that CNN is a prestigious and well-known global brand of news services that was started in the United States on June 1, 1980 as the world's first 24-hour cable news network. She states that CNN is one of the foremost news brands in the world with networks and other services available to more than one billion people in more than 212 countries

throughout the world [paragraph 5]. CNN operates 16 cable and satellite television networks, 2 private placed networks, such as the CNN Airport Network, 2 radio networks, wireless devices that provide news and information to mobile devices around the world, 9 websites and CNN Newsource, the world's most extensively syndicated news service [paragraph 6]. Information from Turner Broadcasting's website describing some of CNN's networks and services is appended as Exhibit 2 to the Sams Affidavit [paragraph 7]. I note that these website pages appear to have been printed in 2004. Ms. Sams goes on to state that CNN, which is part of the Network Group of Time Warner, was a major contributor to the annual revenues of Time Warner's Network Group ranging from 6.082 billion to 9.054 billion US$ for the years 2000 to 2004 [paragraph 8].

I consider that the allegations contained from paragraphs 5 through 8 of the Sams Affidavit are of little assistance to the Opponent's case in considering the extent to which its trade-marks have become known in Canada. I wish to add that if I were to afford any significance to this evidence, I would find that Exhibit 2 tends to show that the Opponent's trade-marks may have become known as the trade-marks of Turner Broadcasting Systems, Inc.

At paragraph 12 of her affidavit, Ms. Sams states: "Today, CNN's news television programming is broadcast on approximately 145 broadcast, cable or satellite television carriers in Canada." She files the list of television carriers (broadcast, cable and satellite) carrying CNN's television programming in Canada [Exhibit 5]. At paragraph 13, she states having been advised that there are about 10.1 million households with access to cable television in Canada and that there are about 7.8 million subscribers to CNN's television programming in Canada. In the absence of cross-examination, I have no reason to question the reliability of Ms. Sams' statement at paragraph 12. However, I am not affording any weight to Ms. Sams' statements at paragraph 13 since they are based on data collected by a third party (Mediastats) and thus constitute inadmissible hearsay evidence. Further, no reasons were given as to why a person having direct knowledge could not have provided the evidence [see *R. v. Khan* [1990] 2 S.C.R. 531]. I would add that since Ms. Sams does not provide any evidence directed to the use or advertising of the trade-marks during the broadcast of television programs, statements with respect to the broadcasting of CNN's news

television programming in Canada do not by themselves constitute evidence of use of the Opponent's trade-marks within the meaning of s. 4(2) of the Act.

Ms. Sams states that CNN has invested "an enormous amount of time, resources and expenditures in promoting, advertising and maintaining a high profile under the CNN mark in Canada" in a number of ways, including advertising on television, in trade and consumer magazines, newspapers, television guides and other promotional activity [paragraph 14]. She further states that the wares and services associated with the trade-mark CNN are advertised and promoted by means of the press and by the distribution of promotional material such as brochures, leaflets, news letters and programming guides. Although Ms. Sams files samples of some advertising and promotional material distributed in Canada [Exhibit 6], she does not indicate the nature of these samples, nor does she provide any evidence relating to the period and the extent of their distribution. For all intents and purposes, I note that Exhibit 6 includes three samples, but only the first two samples display the Opponent's trade-marks. The first sample seems to be a handbook for the Annual General Meeting of the Canadian Cable Systems Alliance Inc. held in Toronto from September 22 to September 24, 2004. The second sample shows the following marking: "© and ® Turner Broadcasting Systems, Inc. A Time Warner Company All rights Reserved."

Ms. Sams goes on to state that in addition to CNN's advertising and promotion, "the fame of the CNN mark has been enhanced by unsolicited editorial coverage in magazines, newspaper and other periodicals in Canada". She attaches copies of "about two hundred (200) articles" on CNN in publications from Canada [Exhibit 7]. These articles were obtained through a search of computer databases for articles published from 2000 to 2005 "in which CNN appeared in the headline or lead paragraph and was mentioned anywhere in the article at least five (5) times" [paragraph 16]. Suffice it to say that these articles do not constitute advertisement of the Opponent's trade-marks and cannot be considered as proper evidence of use of a trade-mark in association with services [see *Williams Companies Inc. et al. v. William Tel Ltd.* (2000), 4 C.P.R. (4th) 253 (T.M.O.B.)].

Ms. Sams states that the "fame of CNN in Canada is also enhanced by the proximity of

Canada to the United States" where CNN was started on June 1, 1980 and Canadians "visit the United States on a regular basis and are exposed and have access to CNN in the United States." [paragraph 17] I am in doubt as to whether the Opponent relies on these allegations as evidence directed to the extent to which its trade-marks have become known in Canada. In any event, these statements do not evidence that the trade-marks have been made known in Canada within the meaning of s. 5 of the Act [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 (F.C.T.D.)].

I am far from being satisfied that the evidence introduced through the Sams Affidavit supports the Opponent's contention with respect to the notoriety of its trade-marks in Canada. The Sams Affidavit does not introduce any direct evidence of use and promotion of the Opponent's trade-marks in Canada in association with wares. Furthermore, as discussed above, there are significant deficiencies in the Sams Affidavit with respect to the use and promotion of the Opponent's trade-marks in Canada in association with its services. Even if I can presume from the mere existence of the registrations that there has been *de minimis* use of the trade-marks CNN and CNN Design in Canada [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)], I am not satisfied that *de minimis* use can be considered as increasing the distinctiveness of these trade-marks when considering the extent to which they have become known.

s. 6(5)(b) - the length of time the trade-marks have been in use

There is no evidence that the Applicant has ever used his proposed Mark in association with the wares and services identified in the application.

The trade-mark CNN has proceeded to registration on the basis of use in Canada since at least as early as April 2,1984. The trade-mark CNN Design has proceeded to registration on the basis of use and registration in the United States as well as on the basis of use in Canada since at least as early as September 30, 1984 in association with the services identified at (1) and further to the filing of a declaration of use on August 9, 1995 for the wares and for the services identified at (2).

Paragraph 11 of the Sams Affidavit reads as follows:

> The CNN mark has been continuously used in Canada by CNN since February 1984 in association with "cable and television broadcasting services; research, production, transmission, and broadcasting television programs" and since at least as early as 1995 in association with "video tapes, video cassettes, motion pictures, video discs, tapes and cassettes for reproducing sound; books, program guides, program transcripts, photographs, instructional and teaching materials, (except apparatus), namely education videotapes, books, pamphlets; education and entertainment services, namely production and distribution of cable television programs for entertainment and education purposes".

As previously indicated, there is no evidence supporting the use of the trade-marks in association with wares. Furthermore, given the deficiencies of the Sams Affidavit, there is no evidence of significant or continuous use of the trade-marks since the dates of first use claimed in the registrations. As the registrations can establish no more than *de minimis* use, I consider the length of time the trade-marks have been in use to be of little significance.

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

In considering the nature of the wares and services and the nature of the trade, it is the statement of wares and services in the application and the statement of wares and/or services in the registrations that govern the assessment of the likelihood of confusion under s. 12(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

I am disregarding the portion of paragraph 4 of the Applicant's affidavit where he opines that the services associated with the Opponent's trade-marks are not similar to the wares and services associated with the Mark.

I agree with the Opponent's submissions that the wares "pre-recorded audio-visual data carriers for use as teaching materials in the educational and entertainment fields, namely, pre-recorded audio-visual compact disks, digital video disks, music records, magnetic tapes, video cassettes, floppy diskettes, photographic film, books, photographs, brochures" are either identical, overlapping or closely related to the wares of Registration No. TMA448,238.

As there could be some relationship between “magazines” and the wares “program guides” of Registration No. TMA448,238, I also agree with the Opponent’s submissions that these wares overlap. However, I do not agree with the Opponent’s submissions that there is an overlap between “newspapers” and its registered wares.

The Opponent submits that there is an overlap between its registered services and the following services associated with the Mark: providing consultation services, through the media of radio and/or television programs and/or a global computer network, namely, gateway services, reseller services, and air time brokerage services. A plain reading of the statement of services leads me to conclude that these services are “consultation services”, though without indication as to their specific field, and thus differ from the registered services. Notwitstanding this remark, since “television programs” is identified as a means of providing the consultation services, I find it not without merit for the Opponent to argue that these services overlap with its registered services.

There are important differences between the registered services and the other services associated with the Mark, namely: services of credit institutions other than banks, namely, cooperative credit associations, financial companies and lenders; services of "investment trusts" and holding companies; services rendered in the issuance of credit cards, services dealing with insurance, namely, services rendered by agents or brokers engaged in insurance, services rendered to insured and insurance underwriting services; receipt and delivery of online messages and other data by electronic transmission via computer terminals and wireless phones; operating online forums and chat rooms for the transmission of messages among multiple wireless phones.

For the purposes of considering confusion, I find it reasonable to conclude that the channels of trade associated with the parties’ trade-marks would either be identical or overlapping when considering identical, closely related to or overlapping wares and services, as discussed above.

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

The remaining criterion is the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested. In most instances, it is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)].

The Mark incorporates the Opponent's trade-mark CNN in its entirety. The Applicant has added the letter "I" in front of the common letters. The Opponent argues that when considering the Mark, the average consumer "will focus on the world recognized letters CNN featured in its trade-marks". At the oral hearing, the agent for the Opponent argued that the letter "I" would be perceived as the pronoun showing contrast of person thus untying the letter "I" from the letters "CNN" and increasing the probabilities of confusion. Apart from the fact that I am not necessarily convinced that the Opponent's contentions have any merit, they imply an inappropriate dissection of the Mark, which must be considered in its entirety.

I consider that there is no idea suggested by the Mark or by the Opponent's trade-marks. At page 17 of its written argument, the Opponent submits:

> In view of the world recognition of the CNN trade-mark as the acronym of CABLE NEWS NETWORK, the ICNN letter combination could be viewed as denoting the word combination INTERNATONAL CABLE NEWS NETWORK. In marks consisting of letter combination, it is not unusual for the letter "I" to stand as a shortened version of the word "International"; an illustration being found in the IBM letter combination."

Even if I accept the Opponent's submissions that its trade-marks are an abbreviation of "Cable News Network", I cannot agree with its submissions that the Mark could be viewed as denoting the combination "International Cable News Network". Suffice it to say that there is no evidence to support the Opponent's contention that it is not unusual for the letter "I" to stand as a shortened version of the word "International" in trade-marks consisting of letters combination.

In applying the test for confusion I have considered it as a matter of first impression and imperfect recollection. I am mindful of the following comments of Mr. Justice Cattanach in *GSW Ltd., supra*:

> "In short, where a trader has appropriated letters of the alphabet as a design mark without accompanying distinctive indicia, and seeks to prevent other traders from doing the same thing, the range of protection to be given that trader should be more limited than in the case of a unique trade mark and comparatively small differences are sufficient to avert confusion and a greater degree of discrimination may fairly be expected from the public in such instances. (See Lord Simond's remarks concerning trade names in *Office Cleaning Services v. Westminster Window and General Cleaners Ltd*. (1944), 61 R.P.C. 133 at p. 135.)"

In view of my conclusions above, and weighing all the factors and their relative importance together, I find that the Applicant has discharged its onus to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's registered trade-marks CNN and CNN Design. As previously mentioned, I consider that the determination of the issue of confusion between these trade-marks and the Mark effectively decides the ground of opposition.

Having regard to the foregoing, I dismiss the ground of opposition based upon confusion with the registered trade-marks CNN, CNN Design and CNN HEADLINE NEWS.

Non-entitlement

Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks, the Opponent has the initial onus of proving that its alleged trade-marks were being used at the filing date of the application and that use had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act].

The Sams Affidavit does not provide any evidence of use of the Opponent's alleged trade-marks in Canada in association with wares within the meaning of s. 4(1) of the Act. Furthermore, as previously discussed, there are serious deficiencies in the evidence introduced by the Sams Affidavit with respect to the use of the Opponent's trade-marks in

Canada in association with its services pursuant to s. 4(2) of the Act. Even if I accept that the first sample included in Exhibit 6 to the Sams Affidavit shows the Opponent's trade-marks being displayed in the advertisement of its services, I have to conclude that such advertisement took place in 2004.

In view of the above, I find that the Opponent has failed to meet its initial onus of evidencing use of its alleged trade-marks in Canada at the material date. Therefore, I dismiss the non-entitlement ground of opposition based upon s. 16(3)(a) of the Act.

I wish to add that if I had found that the Opponent had met its initial onus, I would have dismissed the non-entitlement ground of opposition. In view of the material date, the Opponent's case would be weaker under this ground than under the registrability ground of opposition and thus my previous finding that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks would apply.

Distinctiveness

There was an initial burden on the Opponent to show that one or more of its trade-marks had become known sufficiently as of the material date to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)].

However, because of the deficiencies of the Sams Affidavit, I am not satisfied that the Opponent has discharged its initial burden to show that its trade-marks have become known sufficiently as of the material date to negate the distinctiveness of the Mark. I would like to add that even if I were wrong in so finding, the overall outcome in the present case would have been the same since the difference in the relevant dates when analysing confusion under this ground of opposition and the registrability ground of opposition does not impact my previous finding that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks.

Conclusion

Having regard to the foregoing, and with the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED AT MONTREAL, QUEBEC, THIS 13th DAY OF MARCH 2009.

Céline Tremblay
Member
Trade-marks Opposition Board