



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

**Citation: 2015 TMOB 24
Date of Decision: 2015-01-30**

**IN THE MATTER OF OPPOSITIONS by
Star Island Entertainment, LLC to
application Nos. 1,269,994 and 1,292,450 for
the trade-marks MANSIONS & Design and
M Design and MANSION.COM in the name
of Provent Holdings Ltd.**

Overview

[1] Provent Holdings Ltd. (the Applicant) applied to register the trade-marks MANSIONS & Design and M Design and MANSION.COM for use with a wide range of goods and services including games, sporting equipment, and gambling, hospitality and entertainment services. The trade-marks are set out below:

The logo for 'MANSIONS & Design' features a stylized 'M' inside a square frame, followed by the word 'MANSIONS' in a bold, serif font, and '& Design' in a smaller, sans-serif font.

MANSIONS & Design

The logo for 'M Design and MANSION.COM' features a stylized 'M' inside a square frame, followed by 'MANSION.COM' in a bold, serif font, and 'M Design and' in a smaller, sans-serif font.

M Design and MANSION.COM

[2] Star Island Entertainment, LLC (the Opponent) has opposed these applications primarily on the basis that (i) the applied-for trade-marks are confusing with its use of the trade-mark and trade-name MANSION in association with a night club in Miami, Florida

and related reservation services and (ii) the Applicant cannot be satisfied that it is entitled to use the applied-for trade-marks since it cannot legally provide gambling related services in Canada.

[3] For the reasons that follow, I find that the applications should be refused for online gambling services on the basis that the Applicant has not proven that it is satisfied it is entitled to use the applied-for trade-marks with these services in view of section 207 of the *Criminal Code* RSC 1985, c C-46 which prohibits the provinces from licensing another party to conduct a lottery scheme on or through a computer. I also find that the applications should be refused with respect to night club services and other closely related services in view of the Opponent's prior use of MANSION in association with reservation services in Canada.

Application No. 1,269,994

[4] On August 25, 2005, Provent Holdings Ltd. filed an application to register MANSIONS & Design (the Mark) based upon its proposed use with the Goods and Services (as amended) set out at Schedule A.

[5] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 22, 2009 and was opposed by the Opponent on September 22, 2010. The Applicant filed and served a counter statement denying the allegations in the statement of opposition.

[6] The Opponent's evidence consists of the affidavits of Vanessa Menkes, Peter Woods, and Elliot Choi. The Applicant's evidence consists of the affidavit of James Holtom. Ms. Menkes, Mr. Woods and Mr. Choi were cross-examined and the transcripts and exhibits were filed.

[7] Each party filed a written argument and attended a hearing held on September 16, 2014.

Grounds of Opposition

[8] The Opponent pleads the following grounds of opposition:

- (a) the application does not comply with section 30(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because it does not contain a statement in ordinary commercial terms of the specific Goods or Services with which the Mark is proposed to be used and/or some of the descriptions described goods as services or vice versa;
- (b) the application does not comply with section 30(b) of the Act since the Applicant had used the Mark in Canada in advance of the filing date;
- (c) the application does not comply with section 30(e) of the Act because the Applicant:
 - 1. did not intend to control the character or quality of the Goods and/or Services;
 - 2. did not intend to use the Mark to distinguish the Goods and/or Services;
 - 3. did not intend to associate the Mark with the Goods and/or Services in a manner that would constitute “use” under section 4 of the Act; or
 - 4. did not intend to use the Mark with each of the Goods or Services;
- (d) the application does not comply with section 30(g) of the Act because the address in the application is not the Applicant’s principal office or place of business abroad;

- (e) the application does not comply with section 30(i) of the Act since the Applicant could not have been satisfied that it is or was entitled to use the Mark since
1. it cannot legally provide the gambling-related services described in the application in Canada; or
 2. the Opponent had previously acquired substantial goodwill in Canada attached to its trade-mark and trade-name MANSION and the Applicant knew that its use of the Mark in Canada would violate the Opponent's rights under section 7(b) of the Act;
- (f) the Applicant is not the person entitled to register the Mark with the Goods or Services because the Mark was confusing with the Opponent's MANSION trade-name and trade-marks set out in Schedule B and used in Canada with reservation services for a nightclub and bar;
- (g) The Mark is not distinctive of the Goods or Services because:
1. of the prior use of the Opponent's MANSION trade-name and trade-marks; and
 2. the Applicant does not control the character or quality of the Goods and Services.

Evidential Burden and Legal Onus

[9] Before considering the allegations in the statement of opposition, I will first outline some of the technical requirements with regard to (i) the legal onus on an applicant to prove its case, and (ii) the evidential burden on an opponent to support the allegations in the statement of opposition.

[10] With respect to (i) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent 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 is in, then the issue must be decided against it. With respect to (ii) above, there is also, in accordance with the usual rules of evidence, an evidential burden on an opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on an 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.

Material Dates

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

- sections 38(2)(a)/30 - the date of filing the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(c)/16(3) - the date of filing the application; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC) at 324].

Preliminary Evidence Issues

Affidavit of Ms. Menkes

[12] Ms. Menkes, Senior Vice President, Communications, of the Opponent sets out the Opponent's use, advertising and revenue associated with the MANSION trade-marks and trade-name. Ms. Menkes' evidence also details the extent that such business arises from Canadians. Despite Ms. Menkes' inability to answer certain questions on cross-examination, I am satisfied that she has personal knowledge of the relevant parts of the Opponent's business. I am therefore not prepared to disregard her evidence in its entirety although I am of the view that some of her evidence should be accorded reduced weight.

Affidavit of James Holtom

[13] Mr. Holtom, a summer student employed by the Applicant's agent, sets out a description of the website *www.mansioncasino.com* (including his play of games) and attaches printouts of this website and reviews of the Mansion Casino. First, this evidence postdates all of the material dates for the grounds of opposition. Second, this evidence is hearsay and there is no evidence as to why it was necessary for Mr. Holtom to provide it, nor any evidence concerning its reliability as it relates to the Applicant. In these circumstances, I am not prepared to find this evidence admissible [*Gowling Lafleur Henderson LLP v Guayapi Tropical* (2012), 104 CPR (4th) 65 (TMOB) at paras 7-9]. Mr. Holtom also attaches an article "MANSION.com Announces Sponsorships of the 3rd Annual B.C. Poker Championships" which was planned for November 18-25, 2007. While I accept that such an article exists, there is no basis on which to accept this evidence for the truth of its contents.

Affidavit of Peter Woods

[14] Mr. Woods, an articling student employed by the Opponent's agent, attaches evidence from the Statistics Canada website purporting to quantify the number of Canadian travellers to Florida. Despite the hearsay deficiencies in this evidence, I accept that many Canadians travel to Florida.

Section 30(a) Ground of Opposition

[15] The Opponent alleges that the application does not comply with section 30(a) of the Act with respect to a number of different descriptions found within the application. As no evidence or argument was filed in support of this ground of opposition, the Opponent has not met its evidential burden and it is rejected [*McDonald's Corporation v MA Comacho-Saldana International Trading Ltd c/o/b/a Macs International* (1984), 1 CPR (3d) 101 (TMOB) at 104].

Section 30(b), 30(e) and 30(g) Grounds of Opposition

[16] As no evidence or arguments were submitted in support of these grounds of opposition, the Opponent has failed to meet its evidential burden and the section 30(b), 30(e) and 30(g) grounds of opposition are rejected.

Section 30(i) Ground of Opposition

[17] The Opponent alleges that the application does not comply with section 30(i) of the Act as the Applicant could not have been satisfied it was entitled to use the Mark because the Applicant was aware that (i) it cannot legally provide the gambling services described in the application or (ii) the Opponent had previously acquired substantial goodwill in the trade-name and trade-mark MANSION and use of the Mark would violate the Opponent's rights under section 7(b) of the Act.

Section 7(b) of the Act

[18] I will first deal with the allegation that the Applicant knew that the use of the Mark in Canada would violate the Opponent's rights under section 7(b) of the Act. Section 7(b) of the Act is a statutory codification of the common law action for passing off. The Registrar has previously considered such a ground of opposition to be valid [*Bojangles' International LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553 (TMOB), at 561-562].

[19] The three necessary components of a passing off action (pursuant to section 7(b) of the Act) are: (i) the existence of goodwill; (ii) deception of the public due to a misrepresentation; and (iii) actual or potential damage [see *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120 at para 33].

[20] In order to meet its evidential burden, the Opponent must provide sufficient evidence that it has established the existence of goodwill in its MANSION trade-name or trade-mark in Canada as of the filing date of the application. The evidence submitted and described in this decision with respect to the section 2 and 16 grounds of opposition is not sufficient to establish the existence of goodwill. Likewise, there is no evidence of

potential deception or damage to the Opponent. As such, the Opponent has not met its burden and this ground of opposition is rejected.

Not Legally Entitled to Offer Gambling Services

[21] The first part of the section 30(i) ground of opposition is set out below:

[The application] does not conform to the requirements of s. 30(i) of the Act because, contrary to the Applicant's statement in the application, the Applicant could not have been satisfied when it filed the application that it was entitled to use the [Mark in Canada] ... because it was aware at that time that ... it cannot legally provide the gambling-related services described in the application in Canada.

[22] Although the Applicant submits that this ground of opposition is contrary to section 38(3)(a) of the Act, no such assertion is set forth in the counter statement, nor raised in an Interlocutory Ruling. Further, it was clear in the written argument and/or at the hearing that the Applicant understood the case that it had to meet. As such, I decline to find that the ground of opposition is contrary to section 38(3)(a) of the Act [see, for example, *Governor and Company of Adventurers of England trading into Hudson's Bay v Sears Canada Inc* (2002), 26 CPR (4th) 457 (TMOB) at 466-469; *Ralston Purina Canada Inc v Quaker Oats Co of Canada Ltd/Compagnie Quaker Oats du Canada Ltee* (1995), 61 CPR (3d) 540 (TMOB) which discuss the issue of pleading a ground of opposition is insufficient in the counter statement].

[23] A section 30(i) ground of opposition will succeed where there is a *prima facie* case of non-compliance with a federal statute such as the *Copyright Act* RSC 1985, c C-42, *Food and Drugs Act*, RSC 1985, c F-27 or *Canada Post Corporation Act*, RSC 1985, c C-10 [*Interactiv Design Pty Ltd v Grafton-Fraser Inc* (1998), 87 CPR (3d) 537 (TMOB) at 542-543].

[24] The Opponent's position is that its *prima facie* burden has been met since the application covers many services that clearly fall within the scope of the activities

prohibited by section 206 of the *Criminal Code* including (the Opponent's Written Argument, para 26):

Providing casino facilities for gambling and gambling services, namely bingo hall services, betting on horses, lotteries, credit card betting, bookmaking services; gaming, namely, operation of casinos; and online gambling related to gaming machine entertainment services, namely gaming services related to blackjack, keno, craps, roulette, poker, slot machines, pontoon, boule, baccarat, punto banco, chemin de fer, mini-dice, fan tan, sic bo, pai gow, pai gow poker, lucky wheel, casino war, red dog, and video poker machines; gaming services for entertainment purposes, namely provision of gaming machine entertainment equipment, namely, coin and counter-fed gaming machine, counters, video games cartridges, electronic table-tops, data processors and television monitors, compact discs featuring music, electric timer, countdown timer; bingo hall services; promoting third party poker tournaments through the distribution of printed material and/or promotional contests; operating of lotteries; non-downloadable Internet games and provision of games by means of a computer based system, namely provision of electronic gaming, gambling and betting services transmitted via a global computer network namely the Internet

[25] The relevant sections of the *Criminal Code* are set out at Schedule C and I am prepared to take judicial notice of them. Board Member Martin explains in *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB) that sections 206 and 207 of the *Criminal Code* govern the legality and conduct of lottery schemes in Canada which may only be conducted and managed by the government of a province through legislatively designated entities or, in specific circumstances, by a licensee.

[26] However, subsection 207(4) of the *Criminal Code* defines lottery scheme and specifically excludes games, operations and the like "operated on or through a computer." This means that that lottery schemes that are operated "on or through a computer" in Canada may only be conducted by the provinces who, furthermore, are not entitled to license another party to conduct such a scheme [*Reference re: Earth Future Lottery* (2002), 215 DLR (4th) 656 (PEICA); *Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB) at 449].

[27] I find that the Opponent has met its initial evidential burden with respect to online gambling services since the provinces are not entitled to license another party to conduct a lottery scheme "on or through a computer". The arguments of the Opponent lead to the

inference that there is a *prima facie* case that the offering of online gambling services would be in contravention of the *Criminal Code*.

[28] While I agree with the Applicant that the Registrar's expertise does not extend to "the interpretation and application of ss. 206 and 207 of the *Criminal Code*, particularly when complicated by issues of jurisdiction and territoriality on the Internet" (Applicant's Written Argument, para 47), the Registrar must consider whether there is a *prima facie* case pursuant to the general principle that he cannot condone registration of a mark if the applicant's use would violate Federal legislation [*Bojangles' International LLC v Bojangles Café Ltd* (TMOB), *supra*]. The Applicant's arguments that the presence of its website in Canada (which there is no admissible evidence of) constitutes use in Canada (Applicant's Written Argument, para 48) is not sufficient for me to find that it has met its legal onus to show that there is not a *prima facie* case that the offering of online gambling is in contravention of the *Criminal Code*.

[29] With respect to the remaining gambling related services, the Opponent has not met its evidential burden of proving a *prima facie* case the Applicant does not intend to offer these services in compliance with the *Criminal Code* as there are several exceptions through which gambling services and lotteries can be offered legally. Second, there is no evidence that the Applicant has not, or will not, obtain the appropriate license(s) in compliance with the *Criminal Code* [see *Interprovincial Lottery Corp v Monetary Capital Corp*, *supra*; *Interprovincial Lottery Corp v Western Gaming System*, *supra* where the evidence was found to show that the applicant was not licensed]. In the absence of evidence to the contrary, I consider it reasonable to assume that the Applicant will comply with sections 206-207 of the *Criminal Code* in performing the remaining Services [*Ontario Lottery Corp v Arkay Marketing Associates Inc* (1993), 47 CPR (3d) 398 at 402-403].

[30] As the Opponent has only met its evidential burden with respect to the services listed below, the section 30(i) ground of opposition is successful with respect to only these services.

online gambling related to gaming machine entertainment services, namely gaming services related to blackjack, keno, craps, roulette, poker, slot machines, pontoon, boule, baccarat, punto banco, chemin de fer, mini-dice, fan tan, sic bo, pai gow, pai gow poker, lucky wheel, casino war, red dog, and video poker machines; provision of games by means of a computer based system, namely provision of gambling and betting services transmitted via a global computer network namely the Internet

Section 16 Grounds of Opposition

[31] The Opponent alleges that the Applicant is not the person entitled to register the Mark in association with the Goods or Services as it is confusing with the Opponent's MANSION trade-marks (set out in Schedule B) and trade-name, which the Opponent had previously used in Canada in association with reservation services for a nightclub and bar.

[32] The Opponent has an initial evidential burden to prove that it had used its MANSION trade-marks or trade-name, within the meaning of section 4 of the Act, prior to August 25, 2005, the filing date of the application. The Opponent must also demonstrate that it had not abandoned its trade-marks or trade-name as of the date of advertisement of the Mark (April 22, 2009). As I consider that the Opponent's trade-mark MANSION provides the Opponent with its best chance of success, I will concentrate my analysis on this trade-mark.

Section 4(2) and Use of the Trade-marks on the Internet

[33] The Opponent submits that it has been using its MANSION trade-mark and trade-name in Canada since at least as early as 2004 in association with reservation services for a nightclub and bar through the websites *www.mansionmiami.com*; *www.theopiumgroup.com*; and *www.clubzone.com*.

[34] Section 4(2) of the Act sets out what constitutes use of a trade-mark in association with services:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

Although there is no specific definition of use in the Act pertaining to trade-names, the principles in sections 2 and 4 apply [*Mr. Goodwrench Inc v General Motors Corp* (1994), 55 CPR (3d) 508 (FCTD) at 511-512].

[35] Where a trade-mark owner is offering and is prepared to perform the services in Canada, use of the trade-mark on advertising of those services in Canada meets the requirements of section 4(2) of the Act [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (RTM)].

[36] Further, the Federal Court and the Registrar have both considered when the use of a trade-mark on a website constitutes use in Canada. The following principles apply:

- Displaying a trade-mark can suffice as a means of use of a trade-mark only in cases where services are actually targeted at and offered to Canadians or performed in Canada [*HomeAway.com, Inc v Hrdlicka*, 2012 FC 1467; *Unicast SA v South Asian Broadcasting Corp* (2014), 122 CPR (4th) 409 (FC) at paras 46-47 (*Unicast*)].
- Evidence that Canadians access the website, that there are Canadian currency options or that the website includes information specific to Canadians all support an inference that the services are being actively offered to Canadians [*Star Island Entertainment LLC v Provent Holdings Ltd* (2013), 112 CPR (4th) 321 (TMOB) at para 30; *McCarthy Tétrault v Lawyers Without Borders Inc* (2010), 87 CPR (4th) 437 (TMOB) at para 21; *Unicast, supra* at para 64].
- If a party is relying on services being advertised to Canadians, evidence that the party solicits or actually advertises in Canada will be relevant (*Unicast, supra* para 63).

Has the Opponent Met Its Evidential Burden?

[37] While the evidence could have been more clearly set out, ultimately I find that the Opponent meets its initial evidential burden as the evidence of Mr. Choi and Ms. Menkes

set out below shows use of the Opponent's MANSION trade-mark and trade-name commenced in Canada prior to August 25, 2005:

- Mr. Choi, Vice President of Sales of myZone Media Inc., a promoter of night clubs, states that myZone Media Inc. has acted as an agent for the Opponent through its website *www.clubzone.com* which is also accessible through *www.clubzone.ca* (Choi affidavit, para 4, Choi cross-examination, page 7, lines 33-41).
- *www.clubzone.com* is a website in which night clubs themselves can post and promote events, venues and tickets about “nightlife information” (Choi affidavit, Exhibit B).
- The Opponent advertises the MANSION trade-name and trade-mark on the *www.clubzone.com* website through which Canadians can make a reservation request (Menkes affidavit, para 20, Exhibit L; Choi affidavit, para 5, Exhibit B). To the extent that part of the reservation services are performed by myZone Media Inc., this constitutes performance of the reservation services by the Opponent [see, for example the analogous case, *Société Nationale des Chemins de Fer Français SNCF v Venice Simplon-Orient-Express* (2000), 9 CPR (4th) 443 (TMOB) at 448-449].
- Mr. Choi indicates that 4500 inquiries about the MANSION night club have been received through the Clubzone websites and approximately 15% of such inquiries originate from Canada (Choi affidavit, para 6). On cross-examination Mr. Choi confirms that the majority of inquiries are requests for reservations and “this number has been since 2004” (Choi cross-examination, pages 26-27).

Confusion Analysis

[38] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 likely lead to the inference

that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[39] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

inherent distinctiveness and extent known

[40] I can take judicial notice of dictionary definitions [*Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29]. The on-line dictionary *www.dictionary.com* defines mansion in part as “a very large, impressive, or stately residence”. The parties’ trade-marks appear to be suggestive of impressive, luxury and “large” experiences, perhaps offered in stately surroundings, and as such have similar degrees of inherent distinctiveness.

[41] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The Opponent’s evidence suggests that its trade-mark and trade-name was known to a limited extent in Canada amongst those that are travelling to Miami. There is no evidence that the Mark is known to any extent.

the degree of resemblance

[42] When considering the degree of resemblance between the marks, the law is clear that the marks must be considered in their totality; it is not correct to lay the trade-marks 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), 49 CPR (4th) 401 at para 20]. As a result of the shared component MANSION, the marks have a significant degree of resemblance in sound and appearance. Furthermore, as both trade-marks fancifully suggest an impressive or luxurious experience, perhaps offered in stately surroundings, the degree of resemblance with respect to idea suggested is also high.

length of time in use

[43] This factor favours the Opponent who has performed reservation services in Canada since 2004. In contrast, there is no evidence that the Mark has been in use.

nature of the wares, services, business or trade

[44] This factor favours the Opponent with respect to the following services:

Club cabaret service; provision of club recreation facilities, namely social club facilities, nigh club facilities; night clubs; night club entertainment, namely, theatrical and musical shows provided at discotheques and night clubs; entertainment, namely management of entertainment provided on night clubs, night club and variety entertainment, namely, theatrical and musical floor shows provided at discotheques, theatres and nightclubs; Club services for the provision of food and drink, and food and drink hospitality services, namely restaurant services incorporating licensed bar facilities, bar facilities, bar services, cocktail lounge services, social and night club services, namely, provision of food; cocktail lounge services; bar services; restaurant services incorporating licenced bar facilities.

[45] While some of the remaining services may also fall under the umbrella of hospitality services, I do not consider this sufficient to form the basis for overlap in the

nature of the services since hospitality services are very broad and encompass many different and distinct services.

Conclusion

[46] 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 when he or she has no more than an imperfect recollection of the Opponent's MANSION trade-mark and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin, supra*].

[47] For the reasons explained above, and in particular the similarity between the parties' marks and the overlap in the nature of the services listed below, I conclude that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the Opponent's trade-mark and trade-name. The section 16(3)(a) and 16(3)(c) ground of opposition is successful is therefore successful with respect to the following services:

Club cabaret service; provision of club recreation facilities, namely social club facilities, nigh club facilities; night clubs; night club entertainment, namely, theatrical and musical shows provided at discotheques and night clubs; entertainment, namely management of entertainment provided on night clubs, night club and variety entertainment, namely, theatrical and musical floor shows provided at discotheques, theatres and nightclubs; Club services for the provision of food and drink, and food and drink hospitality services, namely restaurant services incorporating licensed bar facilities, bar facilities, bar services, cocktail lounge services, social and night club services, namely, provision of food; cocktail lounge services; bar services; restaurant services incorporating licenced bar facilities.

Distinctiveness Ground of Opposition Based on Licensing

[48] The Opponent alleges that the Mark is not distinctive of the Goods and Services because the Applicant does not control the character or quality of the Goods and Services. As there is no evidence supporting this allegation, the Opponent fails to meet its evidential burden and this ground of opposition is rejected.

Distinctiveness Ground of Opposition Based on the Opponent's MANSION Trade-Name and Trade-Marks

[49] The Opponent alleges that the Mark does not distinguish the Goods and Services of the Applicant from the Opponent's night club, restaurant and bar services, live musical concert services and reservation services associated with the Opponent's MANSION trade-name and trade-marks set out in Schedule B. As the Opponent's trade-mark and trade-name MANSION provide the Opponent with its best chance of success, I will focus my analysis on this trade-mark and trade-name.

[50] There is an evidential burden on the Opponent to establish that, as of September 22, 2010, its MANSION trade-mark (or trade-name) was known to such an extent that it could negate the distinctiveness of the Mark. An attack based on non-distinctiveness is not restricted to the sale of goods or services in Canada. It may also be based on evidence of knowledge or reputation of the Opponent's MANSION trade-mark or trade-name including that spread by means of word of mouth or newspaper or magazine articles [*Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at paras 44-45].

[51] The following propositions summarize the relevant jurisprudence on distinctiveness [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at paras 33-34].

- The evidential burden lies on the party claiming that the reputation of its mark prevents the other party's mark from being distinctive;
- However, a burden remains on the applicant for the registration of the trade-mark to prove that its mark is distinctive;
- A mark should be known in Canada to some extent at least to negate another mark's distinctiveness and its reputation in Canada should be substantial, significant or sufficient;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada; and

- A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect.

Has the Opponent Met its Evidential Burden?

[52] While the Opponent's evidence described below supports an inference that a number of Canadians may have come into contact with the MANSION brand as of the material date, taken as a whole, it is not sufficient to show that the Opponent's reputation in Canada is substantial, significant or sufficient to negate the distinctiveness of the Mark.

Canadian Visitors at the MANSION Night Club

[53] The Opponent's MANSION night club opened in February 2004 in Miami, Florida and attracts over 10,000 customers a week (Menkes affidavit, para 4). Since 2004, the Opponent has taken reservations for more than 4000 customers with Canadian addresses (Menkes affidavit, para 15). Further, the Opponent's evidence shows that a substantial number of Canadians travel to Florida (Woods affidavit).

[54] While this evidence may suggest that some Canadians are familiar with the Opponent's MANSION trade-mark and may have visited the Opponent's night club, it does not imply that Canadian consumers would have any recollection of the brand such that it has a substantial, sufficient or significant reputation in Canada [*Bojangles* (FC), *supra* at para 52].

Website Hits

[55] The MANSION trade-mark and trade-name are advertised on the Opponent's websites *www.mansionmiami.com* and *www.theopiumgroup.com*. Ms. Menkes states that the Opponent's website data shows that tens of thousands Internet users with Canadian ISP addresses have accessed the *www.mansionmiami.com* website and that from January

1, 2009 to March 3, 2011 there were 33,923 unique visits as stated in the GOOGLE Analytics report attached to her affidavit (Menkes affidavit, para 10, Exhibit F).

[56] This evidence was challenged on cross-examination and it became clear that Ms. Menkes was uncertain as to how GOOGLE Analytics obtains its information, how many visits are unique (Menkes cross-examination, Q133, Q136), whether some of the information is duplicated (Qs 134-135) and what the other information on the report might indicate including the bounce rate (Qs 138-141). Given that the evidence of hits has been challenged and I cannot approximate the number of hits to the website, I am unable to give any real weight to Ms. Menkes evidence that a significant number of Canadians have viewed the *www.mansionmiami.com* website.

[57] Ms. Menkes further provides that roughly 10% of all reservation requests made through the Opponent's website *www.mansionmiami.com* since January 2009 derive from Canada (Menkes affidavit, para 10). In the absence of the total number of requests, this information does not assist me in determining the reputation of the MANSION brand in Canada.

Promotion on myZone Media's Websites

[58] The MANSION trade-marks are also featured on the *www.clubzone.com* website of MyZone Media Inc. which has served as an agent for the Opponent's Canadian customers since 2004 (Menkes affidavit, para 20, Exhibits I and L). Mr. Choi indicates that 4500 inquiries about the MANSION night club have been received through the Clubzone websites and approximately 15% of such inquires originate from Canada (Choi affidavit, para 6). However, 4500 inquiries received over an approximately seven year period some of which falls after the material date does not have a notable impact on the Opponent's reputation in Canada.

References in Publications

[59] Ms. Menkes attaches various periodicals mentioning MANSION which she understands are available in Canada. First, I note that many of the publications referenced

appear to be primarily US based such as the New York Post, Daily News, Gotham, the Miami Herald and the Herald Broward County Edition and would not impact the MANSION brand's reputation in Canada. Second, while I can take judicial notice of the circulation of some of the other periodicals referenced in Ms. Menkes affidavit such as US Weekly, People and Life & Style Weekly (see, for example, *Milliken & Co v Keystone Industries (1970) Ltd*, (1986), 12 CPR (3d) 166 (TMOB) at 168-169), the references to MANSION are not prominent and do not lead to the inference that the reputation of the MANSION brand would be impacted to a significant extent by these articles.

Advertising

[60] The MANSION trade-marks and trade-name are also advertised in the the American Airlines and Delta in flight magazines, the Florida based *Ocean Drive* magazine, and on beach flyers (Menkes affidavit, para 18). However, no information is given as to the frequency or extent of advertising which would have been viewed by Canadians.

The Distinctiveness Ground of Opposition Based on the Opponent's Use and Reputation is Rejected

[61] As the Opponent has not met its evidential burden of demonstrating that the reputation of its MANSION trade-mark and trade-name is substantial, significant or sufficient, this ground of opposition is rejected. I note that if I had been able to ascribe weight to the Opponent's website analytics evidence, I may have found the Opponent's evidence sufficient to meet its evidential burden.

Application No. 1,292,450

[62] While the statement of goods and services and material dates slightly differ with respect to this application, the issues raised and evidence are substantially the same. As such, my reasons apply equally to the opposition to application No. 1,292,450.

Disposition

[63] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions with respect to all of the Goods and Services except for the following:

1,269,994	<p>And online gambling related to gaming machine entertainment services, namely gaming services related to blackjack, keno, craps, roulette, poker, slot machines, pontoon, boule, baccarat, punto banco, chemin de fer, mini-dice, fan tan, sic bo, pai gow, pai gow poker, lucky wheel, casino war, red dog, and video poker machines; provision of games by means of a computer based system, namely provision of gambling and betting services transmitted via a global computer network namely the Internet</p> <p>Club cabaret service; provision of club recreation facilities, namely social club facilities, nigh club facilities; night clubs; night club entertainment, namely, theatrical and musical shows provided at discotheques and night clubs; entertainment, namely management of entertainment provided on night clubs, night club and variety entertainment, namely, theatrical and musical floor shows provided at discotheques, theatres and nightclubs; Club services for the provision of food and drink, and food and drink hospitality services, namely restaurant services incorporating licensed bar facilities, bar facilities, bar services, cocktail lounge services, social and night club services, namely, provision of food; cocktail lounge services; bar services; restaurant services incorporating licenced bar facilities</p>
1,292,450	<p>Providing casino facilities for gambling, namely online gambling; Gambling services, namely online gambling; Cruise ship entertainment services, namely on-line gambling, provision of online gambling and betting services transmitted over a global computer network, namely the internet; Credit card betting services, namely, on-line gambling using a credit card to secure the funds;</p> <p>Cabaret club services service; night clubs; entertainment night club services; Management of entertainment services, namely management of nightclubs, live music venues for entertainment; night club services, namely, provision of food; cocktail lounge</p>

	services; bar services; restaurant services incorporating licenced bar facilities
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Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

GOODS:

(1) Backgammon games; small balls for games and playing balls, namely, rubber action balls, sport balls, namely, billiard balls, rugby balls, cricket balls, soccer balls, baseballs, footballs, basketballs, golf balls, tennis balls, and table tennis balls; billiard cue tips; bingo cards; board games; chess games; counters in the form of discs for games, namely, roulette and poker games; darts; dice; cups for dice ; dominoes; draughtboards; games, namely, action skilled games, card games, arcade games, coin-operated video games, electronic dart games, equipment as a unit for play card and board games, parlor games, namely, table, dice, cards and tokens; bats for games, namely cricket bats, baseball bats, softball bats, hockey sticks, tennis racquets; marbles for games; apparatus for electronic games other than those adapted for use with television receivers only, namely, hand held unit for playing electronic and video games and games with liquid crystal displays, namely mobile phones, personal digital assistants; mah-jong; playing cards; ring games, namely live poker games, namely, caribbean stud poker, five card draw, seven card stud, texas holdem, using money instead of poker chips; roulette wheels; roulette chips; poker chips.

(2) Tobacco; cigarettes; cigars; smoker's articles not made of precious metal), namely raw and manufactured tobacco; tobacco products, namely, cigars, cheroots, cigarettes, smoking tobacco, pipe tobacco, snuff, and chewing tobacco; ashtrays, cigar holders, cigarette holders, lighters, pipe holders, cigar jars, cigarette cases, cigar cases, tobacco pouches, cigar cutters, and matches; electronic publications provided by electronic mail; magazines, newsletters, brochures and flyers in the field of sports and entertainment; gaming flyers; business news flyers; news flyers in the fields of sports and entertainment; electronic publications, namely, articles, news reports, advertisements on gambling and entertainment matters provided on-line from databases or the Internet sent electronically by e-mails, SMS, and websites.

SERVICES:

(1) Providing casino facilities for gambling and gambling services, namely bingo hall services, betting on horses, lotteries, credit card betting, bookmaking services; gaming, namely, operation of casinos; and online gambling related to gaming machine entertainment services, namely gaming services related to blackjack, keno, craps, roulette, poker, slot machines, pontoon, boule, baccarat, punto banco, chemin de fer, mini-dice, fan tan, sic bo, pai gow, pai gow poker, lucky wheel, casino war, red dog, and video poker machines; gaming services for entertainment purposes, namely provision of gaming machine entertainment equipment, namely, coin and counter-fed gaming machine, counters, video games cartridges, electronic table-tops, data processors and television monitors, compact discs featuring music, electric timer, countdown timer; bingo hall services; club services for entertainment or education, namely promotion and organization of live entertainment and poker tournaments for the benefit of others, namely, organization of poker tournaments and live entertainment namely, baseball games, basketball games, soccer games, boxing matches, football games, hockey games, horse shows, personal appearances by a movie star or sports celebrity; promoting third party poker tournaments through the distribution of printed material and/or promotional

contests; promotional services, namely print, radio, television, and internet promotions for third party poker tournaments; promotional services, namely arranging for sponsors to affiliate goods and services with third party poker tournaments; club cabaret services; provision of club recreation facilities, namely social club facilities, country club facilities, night club facilities; provision of club sporting facilities, namely, providing fitness and exercise facilities, swimming pools, gymnasiums, health clubs, exercise clubs; provision of facilities for sports and athletic competitions and awards programmes, namely, for aerobics, athletics, swimming fitness, football, racing and dancing; provision of dining club facilities for dining, food and drink; betting on horses; night clubs; night club entertainment, namely, theatrical and musical shows provided at discotheques and night clubs; entertainment services, namely, casino entertainment services, namely, entertainment services, namely, providing a place for gambling, meetings and dancing; entertainment, namely, visual and audio performances and musical and variety shows for cruise ships; entertainment, namely management of entertainment provided on cruise ships, night clubs and casino and planning, arranging and conducting sport competitions; provision of entertainment information; cable television and television shows in for sport news and poker tournament, namely, distribution, transmission, broadcasting and recording of sport news and poker tournament; cable television and television show production; entertainment services relating to arcade games, coin-operated video games, amusement game machines; entertainer services, namely conducting parties, theater shows, musicals, movies, and plays on board cruise ships for passengers of all ages; night club and variety entertainment, namely, theatrical and musical floor shows provided at discotheques, theatres and nightclubs; provision of entertainment facilities namely providing facilities, namely, providing of theatres or concert halls for movies, shows, plays, music, and educational training; providing non-downloadable on-line electronic publications, namely, magazines, journals, newsletters, newsflashes, publication of electronic books and journals on-line; electronic publications and gaming information provided on-line from databases or the Internet; providing on-line electronic non-downloadable publications, namely, providing access to on-line electronic non-downloadable publications, namely, magazines, journals, newsletters, newsflashes in relation to sports events results, news events, offers of bets, and betting odds; publication of electronic books and journals on-line; operating of lotteries; organization of sports competitions, namely organizing community sporting events and arranging and conducting sports competitions, namely, for aerobics, athletics, swimming, fitness, football, racing and dancing; electronic games services provided by means of the Internet, namely providing databases featuring sports, news and gaming information, provision of gaming news and information over a global computer network namely the Internet; electronic information relating to entertainment, on-line gaming and gambling, provided on-line from a computer database or via the Internet; compilation of sporting and other statistics including odds; non-downloadable Internet games and provision of games by means of a computer based system, namely provision of electronic gaming, gambling and betting services transmitted via a global computer network namely the Internet.

(2) Club services for the provision of food and drink, and food and drink hospitality services, namely restaurant facilities, restaurant services, restaurant services incorporating licensed bar facilities, bar facilities, bar services, cocktail lounge services, catering services; country club services, namely, provision of food, drink and temporary

accommodation, namely, hotels, boarding houses; social and night club services, namely, provision of food; social clubs, namely, provision of accommodation; hospitality services (accommodation), namely, hotels, resorts, serviced apartments, boarding houses; cocktail lounge services; bar services; restaurant services incorporating licenced bar facilities.

(3) Social escort agency services; social escorting; escorting in society, namely, chaperoning.

Schedule B

Opponent's Trade-marks

MANSION



Schedule C

206(1) Everyone one is guilty of an indictable offence and liable to imprisonment for a term not exceeding two years who

- (a) makes, prints, advertises or publishes, or causes or procures to be made, printed, advertised or published, any proposal, scheme or plan for advancing, lending, giving, selling or in any way disposing of any property by lots, cards, tickets or any mode of chance whatever;
- (b) sells, barter, exchanges or otherwise disposes of, or causes or procures, or aids or assists in, the sale, barter, exchange or other disposal of, or offers for sale, barter or exchange, any lot, card, ticket or other means or device for advancing, lending, giving, selling or otherwise disposing of any property by lots, tickets or any mode of chance whatever;
- (c) knowingly sends, transmits, mails, ships, delivers or allows to be sent, transmitted, mailed, shipped or delivered, or knowingly accepts for carriage or transport or conveys any article that is used or intended for use in carrying out any device, proposal, scheme or plan for advancing, lending, giving, selling or otherwise disposing of any property by any mode of chance whatever;
- (d) conducts or manages any scheme, contrivance or operation of any kind for the purpose of determining who, or the holders of what lots, tickets, numbers or chances, are the winners of any property so proposed to be advanced, lent, given, sold or disposed of;
- (e) conducts, manages or is a party to any scheme, contrivance or operation of any kind by which any person, on payment of any sum of money, or the giving of any valuable security, or by obligating himself to pay any sum of money or give any valuable security, shall become entitled under the scheme, contrivance or operation to

receive from the person conducting or managing the scheme, contrivance or operation, or any other person, a larger sum of money or amount of valuable security than the sum or amount paid or given, or to be paid or given, by reason of the fact that other persons have paid or given, or obligated themselves to pay or give any sum of money or valuable security under the scheme, contrivance or operation;

- (f) disposes of any goods, goods or merchandise by any game of chance or any game of mixed chance and skill in which the contestant or competitor pays money or other valuable consideration;
- (g) induces any persons to stake or hazard any money or other valuable property or thing on the result of any dice game, three-card monte, punch board, coin table or on the operation of a wheel of fortune;

.....

207(1) Notwithstanding any of the provisions of this Part relating to gaming and betting, it is lawful

- (a) for the government of a province, either alone or in conjunction with the government of another province, to conduct and manage a lottery scheme in that province, or in that and the other province, in accordance with any law enacted by the legislature of that province;

...

- (f) for any person, pursuant to a licence issued by the Lieutenant Governor in Council of a province or such other person or authority in the province as may be designated by the Lieutenant Governor in Council thereof, to conduct and manage in the province a lottery scheme that is authorized to be conducted and managed in one or more other provinces where the authority by which the

lottery scheme was first authorized to be conducted and managed consents thereto;

.

207(3) Every one who, for the purposes of a lottery scheme, does anything that is not authorized by or pursuant to a provision of this section

- (a) in the case of the conduct, management or operation of that lottery scheme,
 - (i) is guilty of an indictable offence and liable to imprisonment for a term not exceeding two years, or
 - (ii) is guilty of an offence punishable on summary conviction; or
- (b) in the case of participating in that lottery scheme, is guilty of an offence punishable on summary conviction.

207(4) In this section, 'lottery scheme' means a game or any proposal, scheme, plan, means, device, contrivance or operation described in any of paragraphs 206(1)(a) to (g), whether or not it involves betting, pool selling or a pool system of betting other than ...

- (c) for the purposes of paragraphs (1)(b) to (f), a game or proposal, scheme, plan, means, device, contrivance or operation described in any of paragraphs 206(1)(a) to (g) that is operated on or through a computer, video device or slot machine, within the meaning of subsection 198(3), or a dice game.