

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

Citation: 2015 TMOB 16
Date of Decision: 2015-01-28

**IN THE MATTER OF AN OPPOSITION
by Children's Miracle Network to
application No. 1426499 for the trade-
mark MILLION POUND MIRACLE in
the name of the Foundation for Prader-
Willi Research Canada**

Overview

[1] The Foundation for Prader-Willi Research Canada (the Applicant) has applied to register the trade-mark MILLION POUND MIRACLE (the Mark) based upon proposed use in Canada in association with, among others, promoting public awareness and education about Prader-Willi Syndrome and charitable fundraising services. Prader-Willi Syndrome is a childhood disorder present at birth that results in a number of physical, mental and behavioural problems. The syndrome creates a constant sense of hunger that usually begins after the first year of life and makes it difficult to control weight. Complications of the syndrome are due to the resulting obesity.

[2] Children's Miracle Network (the Opponent) has opposed the application and I have identified two primary issues. The first issue turns on a determination of the issue of confusion between the Mark and any one or a combination of the following registered marks of the Opponent: CHILDREN'S MIRACLE NETWORK and Design, CMN CHAMPIONS CHILDREN'S MIRACLE NETWORK and Design, CHILDREN'S MIRACLE NETWORK, CHILDREN'S MIRACLE NETWORK TELETHON and CHILDREN'S MIRACLE NETWORK CHAMPIONS, previously used and made known in association with charitable

fundraising services, radio and television programming and broadcasting, and providing health care information and other services. The second issue relates to whether the Applicant could have been satisfied that it was entitled to use the Mark in Canada given the prior use by the Opponent of the above noted marks.

[3] For the reasons that follow, I reject the opposition.

The Record

[4] On January 23, 2009, the Applicant filed application No. 1426499 for the registration of the applied-for mark MILLION POUND MIRACLE based on proposed use in association with the following services:

(1) Promoting public awareness and education about Prader-Willi Syndrome; charitable fundraising services; arranging and conducting an awareness and fundraising campaign involving the raising of funds through pledges related to weight loss; operation of an internet website that encourages internet giving.

[5] The application was advertised on February 3, 2010, and the Opponent filed a statement of opposition on July 2, 2010, based on the following grounds of opposition set out in under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act): non-compliance with section 30(i), non-registrability under section 12(1)(d), non-entitlement under section 16(3) of the Act, and non-distinctiveness under section 38(2)(d) and section 2. The trade-mark registrations relied upon by the Opponent in support of these grounds are listed in Schedule A to this decision.

[6] As its evidence in chief, the Opponent filed the affidavit of John M. Hartman, Chief International Officer of the Children`s Miracle Network, as well as certified copies of each of the Opponent`s trade-mark registrations. Mr. Hartman was cross-examined and the transcript forms part of the record, as well as exhibits and replies to undertakings.

[7] As its evidence, the Applicant filed the affidavits of Keegan Johnson, President and Chairman of the Applicant and Tamsin Thomas, employee with the Applicant`s agent. Both affiants were cross-examined and their transcripts form part of the record, as well as Mr. Johnson`s answers to undertakings given during the cross-examination of Mr. Johnson.

[8] Both parties filed a written argument and both were represented at a hearing.

[9] At the hearing, the Opponent's agent stated that the Opponent was no longer relying on registration No. TMA478,745 for the trade-mark CMN CHAMPIONS CHILDREN'S MIRACLE NETWORK and Design.

Onus and Material Dates

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 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 CPR (3d) 413 (FCA)];
- Section 38(2)(c)/Section 16(3)(a) – the filing date of the application;
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Analysis of Grounds of Opposition

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

[12] The Opponent pleads that the Mark is not registrable because it is confusing with any one or a combination of its registered trade-marks. I have exercised my discretion and checked

the register to confirm that each of the Opponent's registrations are extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[13] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks.

[14] At the hearing, the Opponent's agent conceded that the only marks for which the Opponent's evidence shows use of are registration No. 664,126 (CHILDREN'S MIRACLE NETWORK and Design) (sometimes referred to as the Opponent's Design Mark) and registration No. 469,845 (CHILDREN'S MIRACLE NETWORK) (sometimes referred to as the Opponent's Word Mark). I will assess the section 12(1)(d) ground of opposition based on confusion between the Mark and these marks as I am of the view that the Opponent's case is strongest with respect to these trade-marks. These marks are registered for use in association with almost identical services which include:

- (1) Charitable fund raising and donations.
- (2) Radio and television broadcasting in the field of children and children's issues.
- (3) Radio and television programming and production of radio and television programs in the field of children and children's issues.
- (4) Providing health care information, namely, generating healthcare awareness programs and educational programs concerning the healthcare needs of children and youth and the institutions and people who provide healthcare to them, educating the public thereof, and promoting good healthcare practices for children and youth.

[15] If there is no likelihood of confusion between the Mark and these registrations then there would be no likelihood of confusion with respect to the Opponent's other registrations. As a result, my determination of a likelihood of confusion as between the Mark and these registrations will be determinative of the section 12(1)(d) ground of opposition.

test for confusion

[16] Pursuant to section 6(2) of the Act, 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 . . . or performed by the same person, whether or not the wares or services . . . are of the same general class. Thus, section 6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the present case, the question posed by section 6(2) is whether there would be confusion of the services provided by the Applicant under its mark MILLION POUND MIRACLE as being provided, licensed or endorsed by the Opponent who is the owner of the registered marks CHILDREN'S MIRACLE NETWORK and CHILDREN'S MIRACLE NETWORK and Design.

[17] The test for confusion is one of first impression and imperfect recollection. 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 wares, 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. This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC) , 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 marks.

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[18] Neither of the Opponent's marks are inherently strong. In this regard, they are each comprised of three common English words which are suggestive of some of the Opponent's services. I do find the Opponent's Design Mark to be inherently stronger than the Opponent's Word Mark because of its design component.

[19] While the Mark is also comprised of three common English words, I find it to be inherently stronger than both of the Opponent`s marks as it is not as suggestive of its associated services.

[20] With respect to the extent to which the marks have become known, the Opponent has submitted the affidavit of Mr. Hartman. Mr. Hartman identifies himself as the Chief International Officer of Children`s Miracle Network. His evidence of use of the Opponent`s marks in Canada may be summarized as follows:

- The Opponent is a charitable organization that raises money for its member children`s hospitals throughout the U.S. and Canada, creates awareness concerning children`s healthcare issues and educates the public about the need for children`s healthcare, the shortage of available resources and good healthcare practices to prevent accidents and disease;
- There are over 170 hospitals and related institutions who are members of the Opponent, including twelve Canadian foundations which benefit various children`s hospitals throughout Canada;
- For almost three decades the Opponent has engaged in widespread television and radio broadcasts, sponsor campaigns, awareness campaigns and fund raising events establishing the Opponent as the preeminent charity in the fields of fundraising, awareness and education for children`s healthcare [Hartman, paragraph 7];
- Major Canadian sponsors of the Opponent include Walmart Canada, TD Bank Financial Group, Dairy Queen Canada, Costco Canada, PizzaPizza, Foresters, Blockbuster Canada, Re/Max Canada, Marriott Canada, Air Canada, and Microsoft and Xbox Canada. These sponsors conduct fundraising and awareness campaigns with their employees and customers;
- For the 2010 campaign year, the dollar value of the media coverage the Opponent received through these campaigns, promotions, activities and related publicity was estimated at \$20 million [Hartman, para. 10];
- The Opponent has placed prominent advertisements in national Canadian newspapers including *The National Post* and *The Globe and Mail*. Attached as Exhibit A is a copy of an advertisement which ran in the *Globe and Mail* on May 4, 2010, thanking the corporate sponsors of the Opponent;
- The amount of funds raised in Canada by CHILDREN`S MIRACLE NETWORK between 2003 and 2010 has ranged between \$16.3 million and \$42.7 million [Hartman, para. 12]; and

- The Opponent operates two internet websites furthering its charitable mission, located at www.childrensmiracletnetwork.org and a Canadian site located at www.childrensmiracletnetwork.ca.

[21] Mr. Hartman does not provide a breakdown of use by mark. As noted above, the Opponent's agent conceded at the hearing that the only marks for which the Opponent's evidence shows use of are registration No. 664,126 (CHILDREN'S MIRACLE NETWORK and Design) and registration No. 469,845 (CHILDREN'S MIRACLE NETWORK).

[22] With respect to the Applicant's Mark, Mr. Johnson, President and Chairman of the Applicant, states that while the MILLION POUND MIRACLE fundraising campaign has not yet been launched, it is being promoted through advertising and a website [Johnson, para.12].

[23] In view of the above, I am able to conclude that the Opponent's CHILDREN'S MIRACLE NETWORK and CHILDREN'S MIRACLE NETWORK and Design marks have acquired distinctiveness in Canada in association with the Opponent's services. As the Applicant has not shown any use of its Mark, this factor favours the Opponent.

section 6(5)(b) - the length of time each trade-mark has been in use

[24] For the reasons stated above, the length of time that each mark has been in use favours the Opponent.

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

[25] It is the Applicant's statement of services as defined in its application compared to the Opponent's registered services that govern my determination of this factor [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd.* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[26] The Applicant's charitable fundraising services and operation of an internet website that encourages internet giving overlap with the Opponent's charitable fundraising services. The nature of these services and the other applied for services, however, are different. In this regard, the Applicant's services comprise promoting public awareness and education about a rare genetic

syndrome. The Applicant submits that it raises money to fund specific research projects and the organization is not tied in this respect to any particular hospital. According to the Applicant's evidence, the "Million Pound Miracle" campaign will be a specific campaign focused on having participants raise funds through sponsors, with the campaign involving an effort to lose one million pounds of weight. The nature of the Opponent's services, on the other hand, is to raise awareness about children's healthcare issues in general, and to raise money for its member children's hospitals.

[27] With respect to the parties' channels of trade, the Opponent's evidence shows that there are over 170 hospitals and related institutions who are members of the Children's Miracle Network. These include: The Stollery Children's Hospital Foundation in Edmonton, Alberta which benefits the Stollery Children's Hospital; Alberta Children's Hospital Foundation in Calgary Alberta which benefits the Alberta Children's Hospital, the McMaster Children's Hospital Foundation in Hamilton, Ontario which benefits the McMaster Children's Hospital and The Hospital for Sick Children Foundation in Toronto, Ontario which benefits the Hospital for Sick Children. Further, as noted above, the Opponent's Canadian sponsors conduct fundraising and awareness campaigns with their employees and customers, reaching millions of people.

[28] As noted above, the Applicant explains that MILLION POUND MIRACLE will be a fundraising event which will allow participants to raise funds through sponsors by losing weight [Johnson, para. 11]. While the Applicant's organization may not be tied to any particular hospital, I find that the Applicant's channels of trade could overlap with those of the Opponent. In this regard, the Applicant's evidence also shows that some of the Opponent's hospital foundations benefit a number of children's hospitals which also conduct research for, treat, and fund either the Applicant or patients with the Prader-Willi syndrome [Johnson transcript, p.4-5, 13, 14 and Hartman, para 3].

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

[29] It is worth repeating here that the degree of resemblance between the marks is often likely to have the greatest effect on the confusion analysis [see *Masterpiece, supra* and *Beverley*

Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd. (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70].

[30] More recently, in *London Drugs Ltd v International Clothiers Inc* (2014), 120 CPR (4th) 1, the Court made the following observation at para. 57:

There is no single method or recipe to assess the degree of resemblance between two marks. It has been held that the first word is important for purposes of distinctiveness: see *Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183, at p 188 (FC). In *Masterpiece* at para 64, the Supreme Court added that while this may be true in some cases, the preferable approach is to first consider “whether there is an aspect of the trade-mark that is particularly striking or unique”. While the average customer’s attention will no doubt be drawn by the dominant component of a mark, that consumer will also look at the mark as a whole.

[31] With respect to the Applicant’s Mark, I consider the combination of all three words to be striking. In this regard, all three words MILLION, POUND and MIRACLE together give the Mark its uniqueness. One is left to ponder what the idea suggested by the Mark is.

[32] In contrast, while the most striking or dominant element in the Opponent’s Word Mark may be the word MIRACLE, the remaining words in the Opponent’s Word Mark are suggestive of at least some of the Opponent’s services. As for the Opponent’s Design Mark, I find the balloon design to be the more dominant feature of this mark with the other words also being suggestive of the Opponent’s services.

[33] In addition, the first words of both parties’ marks are different.

[34] In view of the above, I do not find there to be a high degree of resemblance between any of the marks.

Further surrounding circumstances

State of the Register and State of the Marketplace Evidence

[35] Ms. Thomas, employee with the Applicant’s agent, conducted searches of CIPO’s online database for active marks that contained MIRACLE in association with various wares and services related to charities, fundraising and children. The marks of note include the following:

Mark	Regn./Appln. No.	Services
TD MIRACLE SAVE	TMA554,101	Banking services and the operation of a charitable fund raising program.
MIRACLE-EAR Children's Foundation & Design	1,361,328(advertised)	Non-profit foundation services involving the donation, fitting and servicing of hearing aids for children of low income families.
INVEST IN A MIRACLE	TMA567,562	Charitable fundraising services
MIRACLE ON BAY STREET	TMA680,520	Charitable fundraising services
MIRACLE DAY	TMA675,623	Charitable fundraising services
MIRACLE MAKERS LOGO	908354 (official mark)	
MIRACLE MAKERS & Design	TMA421,534	Operation of a hospital research
Boy golfer & Design with words MIKE WEIR MIRACLE GOLF DRIVE FOR KIDS	TMA703,798	...charitable fundraising services promoting the physical, emotional and educational welfare of children
MIRACLE 2000	TMA538,552	...charitable fundraising, campaigns and events; philanthropic services and fund raising...

[36] Ms. Thomas also accessed various websites and attached printouts from these websites. She found that the following examples of use of the word MIRACLE in association with charitable fundraising and awareness campaigns related to children's health issues:

- the B.C. Children's Hospital Foundation's "Be a SuperHero Miracle Weekend";

- the Hamilton Health Sciences Foundation's "Mac Kids Miracle Weekend" Campaign;
- Re/Max's "Miracle Makers" campaign;
- Alberta Children's Hospital Foundation's "Miracle Maker" Campaign;
- Give a Miracle a Chance's "Give a Miracle a Chance Charity Baseball Tournament"
- the BC Mining Industry's "Mining for Miracles" Campaign in support of BC Children's Hospital;
- Walmart's "Walk for Miracles" Campaign;
- Children's Rehabilitation Foundation's "A Night of Miracles" Campaign;
- Alberta Adolescent Recovery Centre's "Miracle Gala" and "Tournament of Miracles";
- SickKids Foundation's "The Miracle Club" Campaign;
- Dairy Queen's "Miracle Treat Day";
- CN's "Miracle Match" Campaign; and
- The Miracle League of Amherstburg's "Miracle League" Campaign.

[37] The Opponent raised numerous objections about the weight that should be given to Ms. Thomas' evidence given its evidentiary limitations. While I agree with the Opponent that her evidence is hearsay, I agree with the Applicant that the fact that Mr. Hartman admitted knowledge of the use of the word MIRACLE by most of the above entities, as will be discussed further below, supports the reliability of such evidence. Further, I am prepared to infer from the content of these articles that they are Canadian. I am also prepared to assume that evidence of this form was necessary because it would have been a very onerous a task to have expected the Applicant to have provided affidants from each of these entities to attest to the facts set out in the websites. For all of these reasons, I am prepared to give some weight to this evidence.

[38] It is the Applicant's position that the evidence furnished, as well as Mr. Hartman's cross-examination and answers to undertakings, show that the word MIRACLE is not distinctive of the Opponent. In this regard, the Applicant submits that the evidence does not show that the Opponent has controlled the third party use of marks that contain the word MIRACLE.

[39] Considering first the registered trade-marks MIRACLE ON BAY STREET, MIRACLE DAY and INVEST IN A MIRACLE, Mr. Hartman stated in his answers to undertakings that the Opponent did not follow through with oppositions against CIBC for these marks because a settlement agreement was reached between the parties, a copy of which was attached. A review of the settlement agreement, however, shows that the only substantive limitation to the use by CIBC and related parties of the above three marks was to limit charitable fundraising in the United States to fundraising from institutional investors who were clients of CIBC [Hartman answers to undertakings for q. 64 and q.67].

[40] Mr. Hartman also provided a copy of a license agreement between the Opponent and Re/max International, Inc. as an answer to undertaking regarding the use of various MIRACLE trade-marks. While the agreement did refer to the marks MIRACLE HOME and CHILDREN'S MIRACLE NETWORK, the marks listed in the agreement did not include those marks which were located by Ms. Thomas including RE/MAX MIRACLE MAKERS GOLF TOURNAMENT and MIRACLE MAKERS [Hartman answers to undertakings for q. 86].

[41] Mr. Hartman was also asked whether the Opponent had objected to use of CN MIRACLE MATCH or Walmart's WALK FOR MIRACLES. Mr. Hartman was not sure if the Opponent had objected to use of CN MIRACLE MATCH. As for Walmart's WALK FOR MIRACLES, there is no evidence with respect to any permission being granted to use the word MIRACLE despite an alleged agreement between Wal-Mart and the Opponent [Hartman transcript, q. 95-97 and 121-123].

[42] Finally, with respect to the use of MIRACLE marks by four out of the twelve hospital foundations that the Opponent works with, Mr. Hartman was asked on cross-examination if the Opponent gave permission to use the marks that he acknowledged he was aware of. Mr. Hartman repeatedly answered the following: "the terms and conditions that are within our membership agreements with the Foundation and the programs that they run, I am aware of the word being used in that agreement or in that relationship" [Hartman transcript, q. 121-123; 127-128; 131-133; and 138-139]. The membership agreements referred to by Mr. Hartman are not part of the evidence.

[43] In my view, the Opponent had the opportunity to respond to the Applicant's evidence by demonstrating that such uses were in fact licensed by it. The only mark that Mr. Hartman states the Opponent gives permission to or licenses other entities to use is the Design Mark covered by registration No. 664,126 [Hartman transcript, q. 49-50]. The Applicant has provided examples of numerous other MIRACLE marks on the trade-mark register and in the marketplace that have not been shown to be licensed by the Opponent. I therefore find that the Applicant has substantiated its position that the word MIRACLE has been adopted by various third parties in association with charitable fundraising and related services.

conclusion

[44] As noted above, section 6(2) of the Act does not concern confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the present case, the question posed by section 6(2) is whether there would be confusion of the services sold under the Mark such that they are thought to be provided by the Opponent. I conclude that, on a balance of probabilities, given all the surrounding circumstances there is not a reasonable likelihood of confusion. The differences between the marks and the use by third parties of other marks that include the word MIRACLE in association with similar services is sufficient to make confusion unlikely. I reach this conclusion notwithstanding the acquired distinctiveness of the Opponent's marks. This ground of opposition is therefore dismissed.

Non-compliance – Section 30(i)

[45] Under this ground the Opponent pleads that at the filing date of the application, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada since such use was and is likely to have the effect of depreciating the value of the goodwill attaching to the Opponent's registered trade-marks contrary to section 22(1).

[46] In considering this issue, I had regard to the following comments from Member dePaulsen, in the decision *Euromed Restaurant Ltd v Trilogy Properties Corp* 99 CPR (4th) 445 (TMOB) at paras 12-13 which I find instructive:

Section 30(i) of the Act requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark. The jurisprudence suggests that non-compliance with s. 30(i)

can be found in one of two circumstances. The first circumstance is where there are exceptional circumstances such as bad faith which render the applicant's statement that it is satisfied that it is entitled to use the applied-for mark untrue [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155; *Cerverceria Modelo, S.A. de C.V. v. Marcon* (2008), 70 C.P.R. (4th) 355 (T.M.O.B.) at 369]. In this case, there is no evidence of bad faith on the part of the Applicant. The second circumstance is where there is a *prima facie* case of non-compliance with a federal statute such as the *Copyright Act*, R.S.C. 1985, c. C-42, *Food and Drugs Act*, R.S.C. 1985, c. F-27 or *Canada Post Corporation Act*, R.S.C. 1985, c. C-10 [see *Interactiv Design Pty Ltd. v. Grafton-Fraser Inc.* (1998), 87 C.P.R. (3d) 537 (T.M.O.B.) at 542-543].

Neither the Registrar, nor the Federal Court has ruled on whether a s. 30(i) ground of opposition based on the violation of s. 22 is a valid ground of opposition [*Parmalat Canada Inc. v. Sysco Corp.* (2008), 69 C.P.R. (4th) 349 (F.C.) at paras. 38-42]. Even if I found this to be a valid ground of opposition, as the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill which would support a violation of s. 22 [see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) at paras. 46, 63-68], it would have no chance of success. Accordingly, this ground of opposition is dismissed.

[47] In the present case, there is no evidence of bad faith on the part of the Applicant. 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].

[48] Considering next the issue of whether there is a *prima facie* case of non-compliance with a federal statute, as noted by Ms. de Paulsen, neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on the violation of section 22 is a valid ground of opposition [*Parmalat, supra*].

[49] In my view, a section 30(i) ground based on the violation of section 22 cannot be a valid ground of opposition where, as in the present case, the Mark is based on proposed use and there is no evidence of use of the Mark subsequent to the filing date of the application. In considering this issue, I have had regard to the following statements made by Justice O'Keefe in *Indigo Books & Music Inc v C & J Clark International Limited* 2010 FC 859 at paragraph 45:

Arguably the above mentioned actions provide a more appropriate method of defending alleged rights under section 22 than opposition proceedings. As discussed by the Supreme Court in *Veuve Cliquot* above, a section 22 plaintiff has to show that the defendant has already used the mark in a manner that is likely to depreciate the value of

the goodwill attaching to the plaintiff's trade-mark (paragraphs 46, 47, 56 to 61). Thus, section 22 is premised on an analysis of what a defendant has done, not what a defendant proposed to do, such as in the context of most opposition proceedings. Reiterating this point, the Supreme Court stated specifically that the linkage between the defendant's use and the plaintiff's goodwill, which is the third element of a section 22 claim, is a matter of "evidence not speculation. (emphasis mine)"

[50] As the present case is based on what the Applicant proposes to do as opposed to what the Applicant has done, there is no premise for section 22 to be based on. This ground is accordingly dismissed.

[51] Even if I had found this to be a valid ground of opposition, the Opponent has failed to adduce sufficient evidence supporting a likelihood of depreciation of goodwill which would support a violation of section 22 [*Veuve Cliquot, supra*, at paras. 46 and 63-68]. In this regard, the Opponent admits that the extent of any actual depreciation is unknown since the Applicant has not yet used the Mark. Instead, the Opponent relies primarily on a survey conducted in June 2010 by an independent marketing firm to measure the awareness of the Children's Miracle Network name and brand, the results of which were attached as Exhibit B to the affidavit of Mr. Hartman. The Opponent's agent submits that that when dealing with a proposed use mark, a survey is one manner to assess the potential for depreciation addressed by section 22. On page 13 of the survey, the following is written: "While some Canadians correctly identify helping sick and disabled children as the mission of Children's Miracle Network, they continue to more often confuse the organization with Make-A-Wish or other wish-granting charities." The Opponent submits that in view of the use of MIRACLE as a distinguishing element of the Mark and the identical nature of charitable fundraising services and related fundraising services listed in the application, a consumer who viewed the Mark in association with the Applicant's services would make a link or connection to the Opponent's registered trade-marks resulting in the likelihood of depreciation.

[52] Evidentiary issues aside, I do not see how a survey which states that some Canadians often confuse the Opponent with other wish granting charities like Make-A-Wish is sufficient to show that depreciation of the Opponent's CHILDREN'S MIRACLE NETWORK or CHILDREN'S MIRACLE NETWORK and Design mark is likely to occur if the Applicant uses its MILLION POUND MIRACLE trade-mark. In this regard, the survey did not address the

issue of confusion of the marks in the present opposition. Further, the Applicant in the present case is not a wish granting charity as those referred to in the survey. In fact, the survey only considered wish granting charities and not those that use the word MIRACLE in their marks. Finally, the survey was conducted after the material date for this ground of opposition.

Remaining Grounds of Opposition

[53] The Opponent has essentially pleaded that the Applicant is not the person entitled to the Mark pursuant to section 16(3) of the Act and that the Mark is not distinctive of the Applicant pursuant to section 38(2)(d) and section 2 of the Act because the Mark is confusing with any one or a combination of the Opponent's registered marks which had been previously used in Canada as of the filing date of the application.



[54] As previously noted, the Opponent's agent conceded at the hearing that the only marks for which the Opponent's evidence shows use of are registration No. 664,126 (CHILDREN'S MIRACLE NETWORK and Design) and registration No. 469,845 (CHILDREN'S MIRACLE NETWORK). The Opponent has therefore only met its initial burden under both of these grounds with respect to these two marks.

[55] In the circumstances of this case, nothing turns on the date at which the issue of confusion is determined. Both the non-entitlement ground and the non-distinctiveness grounds of opposition accordingly are dismissed for reasons similar to those set out in the discussion of the section 12(1)(d) ground of opposition.

Disposition

[56] In view of the above, and 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.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

TRADE-MARK	REGISTRATION NO.	SERVICES
	TMA664126	<p>(1) Charitable fund raising and eleemosynary services in the field of monetary donations.</p> <p>(2) Radio and television broadcasting in the field of children and children's issues.</p> <p>(3) Radio and television programming and production of radio and television programs in the field of children and children's issues.</p> <p>(4) Providing health care information, namely, generating healthcare awareness programs and educational programs concerning the healthcare needs of children and youth and the institutions and people who provide healthcare to them, educating the public thereof, and promoting good healthcare practices for children and youth.</p>
CHILDREN'S MIRACLE NETWORK	TMA469,845	1) Charitable fund raising and donations; radio and television broadcasting; radio and television programming, production and education in the field of children and children's issues; providing health care education and information.
	TMA478,745	<p>(1) Charitable fund raising services and monetary donations; radio and television broadcasting in the field of children and children's issues; radio and television programming and broadcasting, and production of radio and television programs in the field of children and children's issues; providing health care information.</p>

<p>CHILDREN'S MIRACLE NETWORK TELETHON</p>	<p>TMA321,071</p>	<p>(1) Charitable fund raising services. (2) Charitable fundraising and donations; radio and television broadcasting; radio and television programming, production and education in the field of children and children's issues namely, fund raising for the benefit of sick and injured children for proceeds towards treatment, health care research and acquisition of health care equipment and supplies; providing health care education and information through television broadcasts, charitable fund raising events and seminars namely, generating awareness programs concerning the health care needs of children and the institutions and people who care for them, generating education programs to promote good health care practices for children, to educate parents and others in good health care practices for children and to educate the public in health care needs and practices for children and the institutions and people who provide health care to children.</p>
<p>CHILDREN'S MIRACLE NETWORK CHAMPIONS</p>	<p>TMA483,069</p>	<p>(1) Charitable fund raising services and monetary donations; radio and television broadcasting in the field of children and children's issues; radio and television programming and broadcasting, and production of radio and television programs in the field of children and children's issues; providing health care information.</p>