

**IN THE MATTER OF TWO OPPOSITIONS
by Daniel Reeve to application nos. 1106425 and
1106427 for the trade-marks MILLIONAIRE
and MILLIONAIRE.COM, respectively, filed by
Millionaire Holdco, L.L.C.(successor in title to
Douglas Lambert and to Millionaire Properties, Ltd.)**

APPLICATION NO. 1106425 - MILLIONAIRE

On June 13, 2001, Douglas Lambert filed an application to register the trade-mark MILLIONAIRE based on proposed use in Canada in association with the wares

printed publications, namely, magazines.

Shortly thereafter the application was assigned to Millionaire Properties, Ltd., and subsequently assigned to Millionaire Holdco, L.L.C., the current applicant of record.

The Examination Section of the Trade-marks Office objected to the subject application on the basis that the applied for mark MILLIONAIRE was confusing with the trade-mark THE MILLIONAIRE IN YOU, registration no. 562994, covering, among other things, newsletters and printed booklets. The applicant responded by arguing that the applied for mark and the cited mark do not resemble one another in their entireties, and that the marks are associated with different wares. The Examination Section accepted the applicant's submissions and the applied for mark was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 19, 2003.

The subject application was opposed by Daniel Reeve, the owner of the above mentioned mark, THE MILLIONAIRE IN YOU, on July 18, 2003. A copy of the statement of opposition was forwarded by the Registrar of Trade-marks to the applicant on October 21, 2003, as required by Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement.

The opponent's evidence consists of the affidavit of Daniel Reeve. The applicant's evidence consists of the affidavit of Douglas Lambert, President of the applicant company. Both parties filed written arguments. The applicant was represented by counsel for most stages of the proceeding, however, at the oral hearing the applicant appeared on its own behalf. The opponent was represented by counsel throughout the proceeding.

STATEMENT OF OPPOSITION

Grounds

The first ground of opposition alleges that the applied for mark is not registrable, pursuant to Section 12(1)(d) of the *Trade-marks Act*, because the applied for mark MILLIONAIRE is confusing with the opponent's trade-mark THE MILLIONAIRE IN YOU, registration no. 562994 (registered on June 4, 2002), covering the following wares and services:

wares

newsletters, newspaper articles, periodic newspaper columns, printed booklets, books; television programs on videotape; shirts.

services

seminars and workshops relating to personal finance, financial advice and

financial planning; providing radio programming; providing television programming.

The second ground alleges that the applicant is not entitled to register the applied for mark, pursuant to Section 16(3)(a), because at the date of filing the application, it was confusing with opponent's mark THE MILLIONAIRE IN YOU which had been previously used and made known in Canada in association with the opponent's above mentioned wares and services.

The third ground alleges that the applicant is not entitled to register the applied for mark, pursuant to Section 16(3)(b), because at the date of filing the application, it was confusing with opponent's trade-mark application no. 1016569 for the mark THE MILLIONAIRE IN YOU (filed on May 25, 1999) which ultimately resulted in the opponent's registration.

The fourth ground alleges that the applicant is not entitled to register the applied for mark, pursuant to Section 16(3)(c), because at the date of filing the application, it was confusing with opponent's trade name THE MILLIONAIRE IN YOU which had been previously used in Canada in association with the opponent's business.

The last ground alleges that the applied for mark is not distinctive of the applicant's wares, pursuant to Section 2, because the mark MILLIONAIRE is not adapted to distinguish the applicant's wares from the wares and services of the opponent.

At the oral hearing (the two oppositions were heard consecutively, on the same day) counsel for the opponent requested leave to amend the statement of opposition to indicate that

the seminars and workshops conducted by the opponent relating to personal finance included financial advice and financial planning. As the applicant consented, the request was granted and the opposition has been considered on the basis of the amendment to the statement of opposition.

I would mention now that counsel for the opponent also requested leave for the same amendment in respect of its opposition to the mark MILLIONAIRE.COM. Further, counsel requested leave to add a new ground to its opposition to the mark MILLIONAIRE.COM alleging that the applicant had not used the mark since the date of first use claimed in application no.1106427. However, in this instance the applicant objected to the amendment. Considering the lateness of the request, and that no satisfactory reason was given for the delay in requesting leave to amend, the opponent's request was denied.

Statutory Requirements

With respect to the third ground, above, I note that application no. 1016569 was allowed on October 26, 2000, and was registered on June 4, 2002. Thus, application 1016569 was not pending (but was registered) on February 19, 2003, which is the date that the applied for mark MILLIONAIRE was advertised in the *Trade-marks Journal*. By operation of Section 16(4) of the *Trade-marks Act*, the opponent's application must be pending as of the date of advertisement of the applied for mark in order to sustain a ground of opposition under Section 16(3)(b). Accordingly, the opponent cannot rely on application no.1016569 to support its ground of opposition pursuant to Section 16(3)(b). The third ground of opposition is therefore rejected.

OPPONENT'S EVIDENCE

The opponent's evidence may be summarized as follows. Mr. Reeve is the founder and president of Daniel P. Reeve & Associates Inc. ("Company") founded in 1994. The Company is licensed, under the control and supervision of Mr. Reeve, to use the mark THE MILLIONAIRE IN YOU. The Company has continuously since about June 1999 provided financial advice and planning, and related wares and services, under the opponent's mark.

The opponent Mr. Reeve has authored a book entitled *The Millionaire in You*. About 3,000 copies were distributed in Canada prior to June 2001 and about 2,800 more were distributed prior to February 2003. The Company produces a quarterly newsletter entitled *The Millionaire in You* which provides guidance for financial investing. Four issues were produced in 2000 and about 3,000 copies of each issue were distributed in Canada. The Company has operated a website under the domain name THEMILLIONAIREINYOU.COM since about 1999. Most of the Company's services are provided in southern Ontario and therefore the goodwill and reputation of the mark THE MILLIONAIRE IN YOU is concentrated primarily in southern Ontario. Various promotional items have been distributed bearing the opponent's mark, and the opponent, as well as other members of the Company, have appeared in radio programs and on television programs in which the mark THE MILLIONAIRE IN YOU has been mentioned and displayed in association with financial planning and advice.

The Company has presented about 12 seminars annually on financial investing and financial planning beginning in 1999. The financial advice and planning services provided by the

Company under the mark THE MILLIONAIRE IN YOU have generated revenues in excess of \$1 million in 1999, rising to \$5 million in 2001 and thereafter averaging \$7.7 million annually for 2002 to June 2004. Expenses for promoting the Company's services amounted to about \$425,000 for the period 1999 to June 2004.

Essentially the same evidence was filed by the opponent in respect of the opposition to application no. 1106427 for the mark MILLIONAIRE.COM.

APPLICANT'S EVIDENCE

The applicant's evidence may be summarized as follows. Mr. Lambert describes himself as a "Presiding Member" of the applicant company, which is a limited liability company under the laws of the State of Nevada in the United States of America. Mr. Lambert owned the mark MILLIONAIRE before assigning it to the present applicant in May 2002. Millionaire Corporation ("the Licensee") was licensed by Mr. Lambert and is now licensed by the applicant to use the mark MILLIONAIRE. The Licensee publishes a magazine entitled MILLIONAIRE which contains information on luxury goods and services as well as advertisements for companies offering such goods and services. The wares and services include, for example, aircraft, antiques, art, automobiles, cigars, clothing, yachts, healthcare services, and home decorating services. The magazine has been sold in Canada since at least as early as September 2001. On average several hundred magazines are sold monthly through various retail outlets across Canada generating, on average, about \$31,000 annually in revenue. Additional revenues accrue to the applicant from advertisements in the magazine.

As noted by the opponent in its written argument, there are hearsay issues respecting the applicant's evidence concerning sales and distribution figures in Canada which are sourced from third parties.

EVIDENTIAL BURDEN & MAIN ISSUE

The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the 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.

In the instant case, the main issue for decision is whether the applied for mark MILLIONAIRE is confusing, within the meaning of Section 6(2) of the *Trade-marks Act*, with the opponent's mark THE MILLIONAIRE IN YOU. The material dates to assess the issue of confusion are (i) the date of my decision with respect to the ground of opposition pursuant to Section 12(1)(d) alleging non-registrability, (ii) the date of filing of the application, June 13, 2001, with respect to the grounds of opposition pursuant to Section 16(3) and (iii) the date of opposition, that is, July 18, 2003, with respect to the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings

see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

LEGAL ONUS

As alluded to earlier, the legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark MILLIONAIRE and the opponent's mark THE MILLIONAIRE IN YOU. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Trade-marks Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or the sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

SECTION 6(5) FACTORS

The applied for mark MILLIONAIRE possesses a relatively low degree of inherent

distinctiveness because it is suggestive of the type of consumer, that is, the wealthy, who would be interested in the subject matter of the applicant's magazine. The opponent's mark THE MILLIONAIRE IN YOU also possesses a relatively low degree of inherent distinctiveness because it suggests that the opponent's services can create wealth for the ordinary individual. The opponent's mark had acquired some distinctiveness at the earliest material date June 13, 2001, through sales of its financial advice and planning services, and through advertising and promotion, beginning in about June 1999. Further, the opponent's mark THE MILLIONAIRE IN YOU continued to acquire distinctiveness through to the later material dates. As noted earlier, the applicant cannot claim any acquired distinctiveness for its mark MILLIONAIRE at the earliest material date. Further, owing to the hearsay nature of portions of the applicant's evidence, I am unable to ascribe anything more than a minimal reputation for its mark at the later material dates. The length of time that the marks in issue have been in use favours the opponent but only to a slight extent as the applicant commenced use of its mark in September 2001.

It is the wares specified in the subject application and the wares and services specified in the opponent's registration cited in the statement of opposition which must be considered in assessing the issue of confusion, at least in regard to the first ground of opposition pursuant to Section 12(1)(d). However, those descriptions should be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.), at 10 -11; *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986),

12 C.P.R. (3d) 110 (Fed. C.A.), at 112; *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.), at 390-392 and *McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.), at 169).

With respect to the remaining grounds, it is the actual trades of the parties that are relevant to the issue of confusion. In this regard, the evidence shows that the parties are engaged in distinct areas of business. The opponent provides financial advice and financial planning directed to the average individual while the applicant publishes a magazine of interest to persons of high wealth.

The resemblance between the marks in issue owes to the component MILLIONAIRE common to each mark. However, in my view, when the parties' marks are considered in their entirety, the marks are more different than alike visually and in sounding. The ideas suggested by the parties' marks are also more different than alike. In this regard, the opponent's mark, THE MILLIONAIRE IN YOU, suggests that there is potential for the average individual to become wealthy, while the applied for mark, MILLIONAIRE, suggests realized wealth.

CONCLUSION

Having regard to the above, and keeping in mind that small differences may suffice to distinguish between marks of low inherent distinctiveness (see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R.(2d) 154 (F.C.T.D.)), I find that the applicant has shown, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark MILLIONAIRE and opponent's mark THE MILLIONAIRE IN YOU at the earliest

material date or at the later material dates. Accordingly, the opposition to application no.1106425 is rejected.

APPLICATION NO. 1106427 - MILLIONAIRE.COM

The above referenced application was also filed on June 13, 2001, but unlike application no. 1106425, is based on use in Canada since at least as early as March 5, 2001, for the following services:

operation of an internet web site featuring information about luxury goods and services; operating an internet web portal providing information about companies offering luxury goods and services; providing an electronic magazine; providing on-line shopping services in the field of luxury goods and services; electronic publishing services; providing on-line advertising services for others.

The subject application for MILLIONAIRE.COM was advertised for opposition purposes in the *Trade-marks Journal* issue dated July, 2003, and was opposed on August 21, 2003. The grounds of opposition are entirely analogous to those in application no.1106425. Thus, the main issue for decision is whether the applied for mark MILLIONAIRE.COM is confusing with the opponent's mark THE MILLIONAIRE IN YOU. The material dates to consider the issue of confusion are (i) the date of my decision with respect to the ground of opposition alleging non-registrability, (ii) the date of first use of the mark, that is, March 5, 2001, with respect to the grounds of opposition pursuant to Section 16(1), (iii) the date of opposition, that is, July 18, 2003, with respect to the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons*, above.

The evidence of record consists of the affidavits of Daniel Reeve and Douglas Lambert. Both parties filed written arguments. As mentioned earlier, the applicant appeared on its own behalf at an oral hearing while the opponent was represented by counsel.

Mr. Lambert's evidence in respect of the mark MILLIONAIRE.COM parallels in many respects his evidence filed in support of the application for the mark MJLLIONAIRE. That is, the ownership history of the marks MILLIONAIRE and MILLIONAIRE.COM is the same as is the nature of Licensee's (Millionaire Corporation) permitted use of the mark. In this regard, the Licensee operates an Internet website, which features the mark MILLIONAIRE.COM, under the domain name WWW.MILLIONAIRE.COM. It is on this website that the Licensee provides information on luxury goods and services as well as an electronic magazine, on-line shopping and on-line advertising services paralleling the content of the applicant's printed magazine discussed previously. The website has been in operation since at least as early as March 5, 2001. Exhibit D of Mr. Lambert's affidavit contains printouts of the website for April 4, 2001, while Exhibit C contains printouts showing use of the mark MILLIONAIRE.COM. On average, the website receives about 400,000 to 500,000 hits per month, however, the evidence does not specify the number of hits from Canadian sources. Annual advertising revenues are in the hundreds of thousands of U.S. dollars. Again, the evidence does not specify how much advertising is sourced from Canadian businesses.

In assessing the issue of confusion, the consideration of the factors in Section 6(5) of the *Act* differ only slightly from the previous discussion in respect of the opposition to the mark

MILLIONAIRE. The applied for mark MILLIONAIRE.COM possesses a relatively low degree of inherent distinctiveness because it is suggestive of the type of consumer the applicant caters to, that is, the wealthy, and also suggests how the applicant provides its services, that is, via the internet. Further, the applicant's evidence is insufficient to establish more than a minimal reputation for its mark at any material date.

As noted earlier, the opponent's mark THE MILLIONAIRE IN YOU had acquired some distinctiveness at the earliest material date March 5, 2001, and continued to acquire distinctiveness through to the later material dates. The length of time that the marks in issue have been in use favours the opponent but only to a slight extent as the applicant commenced use of its mark in March 2001. It appears from the evidence of record that the parties' trades are distinct.

The resemblance between the marks MILLIONAIRE.COM and THE MILLIIONAIRE IN YOU owes to the component MILLIONAIRE common to each mark. However, as in the prior opposition, I find that the marks in issue are more different than alike visually and in sounding. Further, the ideas suggested by the parties' marks are also more different than alike. In this regard, the opponent's mark suggests that there is potential for the average individual to become wealthy, while the applied for mark, MILLIONAIRE.COM, suggests a website of interest to wealthy persons.

Having regard to the above, and again keeping in mind that small differences may suffice to distinguish between marks of low inherent distinctiveness (see *GSW Ltd.*, above), I find that the

applicant has shown, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark MILLIONAIRE.COM and opponent's mark THE MILLIONAIRE IN YOU at the earliest material date or at the later material dates. Accordingly, the opposition to application no. 1106427 is rejected.

DISPOSITION

In view of the foregoing, the oppositions to application nos. 1106425 and 1106427 are rejected.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 26th DAY OF NOVEMBER, 2008.

Myer Herzig,
Member,
Trade-marks Opposition Board