

**IN THE MATTER OF TWO OPPOSITIONS
by Hope International Development Agency
to application nos. 801413 and 801410 for the
trade-marks H.O.P.E and H.O.P.E HELPING
OTHER PEOPLE EVERYWHERE & Design,
respectively, filed by H.O.P.E. Helping Other
People Everywhere, Ottawa-Carleton Inc.**

APPLICATION NO. 801413 H.O.P.E

On January 10, 1996, H.O.P.E. Helping Other People Everywhere, Ottawa-Carleton Inc., filed an application to register the trade-mark H.O.P.E. based on use in Canada since at least as early as 1986 in association with the wares

clothing, namely, hats, golf shirts, t-shirts, shorts, jackets; promotional materials, namely, brochures, posters, flyers, signage, press kits; novelty pins and buttons; volleyballs; mugs and glassware; stickers,

and based on use in Canada since at least as early as 1982 in association with the services of

organizing, promoting and conducting fund-raising activities and events for the benefit of charitable organizations.

The Examination Section of the Trade-marks Office objected to the application on the basis that the mark H.O.P.E. was a prohibited mark in view of Section 9(1)(n)(iii) of the *Trade-marks Act*, which reads of follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, . . .

(n) any badge, crest, emblem or mark . . .

(iii) adopted and used by any public authority, in Canada as **an official mark** for wares or services,

in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use.

(emphasis added)

The Examination Section relied on the official marks, shown below, that were recorded by the Registrar as adopted and used by Hope International Development Agency.



The applicant responded by arguing, among other things, that (i) the applied for mark “is obviously and plainly different from each of the cited marks, both with respect to the text and the design features which are present,” (ii) the term HOPE is a component of various registered trade-marks used in association with charitable activities. The applicant’s submissions were accepted and the subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated September 26, 2001. The subject application was opposed by Hope International Development Agency, the owner of the above mentioned official marks, on November 5, 2001. A copy of the statement of opposition was forwarded by the Registrar of Trade-marks to the applicant on December 11, 2001, 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 affidavits of I. Jeannine Summers and Brian C. Cannon. The applicant's evidence consists of the affidavits of Cheryl Bowden, Shelley Jones and Karen Thompson. The opponent filed a second affidavit of I. Jeannine Summers as reply evidence. Both parties filed a written argument and both parties were ably represented by counsel at an oral hearing.

STATEMENT OF OPPOSITION

The first ground of opposition, pursuant to Section 30(a) of the *Trade-marks Act*, alleges that the application does not specify the wares and services in ordinary commercial terms.

The second ground, pursuant to Section 30(b) of the *Act*, alleges that the applicant "had not used the trade-mark as alleged, or at all, or had subsequently abandoned the trade-mark."

The third ground, pursuant to Section 30(i), alleges that the applicant could not have been satisfied that it was entitled to use the applied for mark H.O.P.E. having regard to the opponent's official marks.

The fourth ground, pursuant to Sections 12(1)(e) and 9(1)(n)(iii), alleges that the applied for mark H.O.P.E. is not registrable because it is a prohibited mark in view of the opponent's "family of official marks" which include the official marks referred to earlier, as well as the official marks HOPE INTERNATIONAL DEVELOPMENT AGENCY and the official mark shown below:



The lines above and below the component CONCERN read “Hope International Development Agency’s” and “ A Paper for People who care about People,” respectively.

The fifth and sixth grounds of opposition, pursuant to Section 16, allege that the applicant is not entitled to register the applied for mark because, at the date of first use of the mark H.O.P.E., it was confusing with the opponent’s trade-marks HOPE; HOPE INTERNATIONAL; HOPE INTERNATIONAL DEVELOPMENT AGENCY; HOPE FOR TODAY; HOPE-INTERNATIONAL.COM and with the opponent’s trade-name HOPE INTERNATIONAL DEVELOPMENT AGENCY, all previously used in Canada in association with charitable fund-raising and related activities.

The seventh, eighth, and ninth grounds of opposition allege that the applied for mark H.O.P.E. is not distinctive, within the meaning of Section 2, because (i) the mark is not capable of distinguishing the applicant’s wares and services from the charitable fund raising activities of the opponent, (ii) the applied for mark is “used outside the scope of permitted use provided for by Section 50 . . .” (iii) the applied for mark has not been used for the purpose of distinguishing the applicant’s wares from the wares and services of others, respectively.

At the oral hearing counsel for the opponent advised that the opponent would not be relying on the first, fifth, sixth, and eight grounds of opposition.

OPPONENT'S EVIDENCE

Brian Cannon

Mr. Cannon has been a staff member of the opponent company since 1982. The opponent was incorporated as a non-profit corporation in 1977 under the name Food for the Hungry/Canada and changed its name to Hope International Development Agency in 1985. Mr. Cannon describes the opponent as “ an autonomous Christian agency working in cooperation with other agencies in the field of Third World development to assist the neediest of the needy to become self-reliant.” The opponent provides food to the needy and destitute, provides research and development projects to help the needy become self-reliant, and educates the general public to understand the need for development of underdeveloped countries. The opponent is funded by private and institutional donations, the provincial governments of Manitoba, Saskatchewan and Alberta, and by the Federal government. Mr. Cannon confirms the opponent's ownership of the official marks, trade-marks, trade-names and domain names relied on in the statement of opposition. The opponent refers collectively to its Marks and I will do likewise. The opponent's programs are designed to assist the poor in Africa, Asia, India, Central America and the Caribbean by improving health care, education, rural income and the environment.

Annual reports which bear one or more of the opponent's Marks describe the opponent's activities in detail. The opponent also published a magazine entitled *Concern* (from 1986 to April

1999), then changed the name of the magazine to *Hope for Today*. The magazine is mailed to over 5,000 donors across Canada two to three times each year. The publications all bear one or more of the opponent's Marks. Other newsletters are published at least monthly and mailed to about 5,000 donors monthly. The newsletters all bear one or more of the opponent's Marks. The opponent regularly publishes brochures related to international development. About 83,000 brochures entitled *Resources; From Despair to Hope in Ethiopia; Building Blocks of Hope; Global Opportunities* and others have been distributed across Canada. The brochures all bear one or more of the opponent's Marks.

The opponent on occasion arranges for the inclusion of newsletter inserts in the publications of other organizations including *The United Church Observer* and others which have a combined circulation of over 700,000 copies. Various other publications including posters, "postal drops," and a Christmas Catalogue are also distributed regularly. The opponent advertises and solicits donations in various magazines with substantial distribution in Canada. The opponent organizes various social events to raise awareness of international development issues and in this way reaches about 50,000 people annually. The opponent's website began operating in November 1999 and by November 2002 more than 10,000 Internet users were viewing the website each year. The cost for magazine and newspaper advertising and direct mailings amounted to \$165,000 in 1985, gradually declining to \$74,000 in 2001, for a total cost of about \$2.1 million. Costs to raise public awareness about third world development, including the cost for the publication of the magazine *Hope for Today*, public service announcements, curriculum materials for schools and maintaining a Resource Centre amounted to about \$179,000 annually for the period 1985 to 2001.

The opponent has 10 paid employees and 250 volunteers across Canada.

Most donations to the opponent are from a base of 25,000 general public donors across Canada comprised of individuals, businesses, and churches. Provincial, federal and institutional grants comprise another source of donations. General public donations amounted to about \$33 million for the period 1985 to 2001 while governmental and institutional donations amounted to \$131 million for the same period. The opponent has issued over 100,000 charitable receipts to donors for income tax purposes since 1985. Exhibit materials attached to Mr. Cannon's affidavit provide examples of the magazines, newsletters, brochures and stationery employed by the opponent. From my perusal of the exhibit material, it appears that the marks most often used by the opponent are the word marks HOPE; HOPE INTERNATIONAL; HOPE INTERNATIONAL DEVELOPMENT AGENCY and the combination word and design mark shown below:



It should be noted that Mr. Cannon's testimony regarding financial, business and advertising statistics; newsletter national distribution statistics; and website details have been sourced from third parties and are therefore inadmissible hearsay.

Jeannine Summers

Ms. Summers conducted various on-line Internet searches to obtain information regarding

the incorporation date for the applicant. Included in her affidavit as Exhibit D is a corporate profile for an entity which appears to be the applicant showing that it was incorporated in Ontario on August 3, 1989.

APPLICANT'S EVIDENCE

Karen Thompson

Ms. Thompson conducted a search of the Canadian Trade-marks Database “with the objective of locating trade-marks including the word HOPE as applied to charitable or fund-raising activities that are the subject of registrations or pending, allowed trade-mark applications.” Her search results are filed *en liasse* as Exhibit A and consist of 123 “hits.” Included in the search findings are, for example, the marks ANGEL OF HOPE; BREATH OF HOPE; BUILDING HOMES BUILDING HOPE; CHILDHOPE; CYCLE OF HOPE; FOUNTAIN OF HOPE; GREEN RIBBON OF HOPE; HELP FOR TODAY, HOPE FOR TOMORROW; HOPE & COPE; HOPE BEAR; MARATHON OF HOPE and GARDEN OF HOPE.

Shelley Jones

Ms. Jones conducted on-line Internet searches “with the objective of locating representative examples of use of the word ‘hope’ as a component of trade-marks or trade names in conjunction with third party charitable endeavours or fund raising activities . . .” The results of her search are collected as Exhibit A to her affidavit and consist of about 24 third party “hits.” It appears that several of the third parties are the owners of marks located by Ms. Thompson in her search.

Cheryl Bowden

Ms. Bowden testifies that a H.O.P.E. beach volleyball event is a longstanding and well known charitable event in Ottawa that has been organized annually since at least 1991. She conducted a computer database search to locate archived copies of the *Ottawa Citizen* newspaper for articles referencing the history of the H.O.P.E. beach volleyball tournament. The articles substantiate Ms. Bowden's testimony, however, as noted by the opponent in its written argument, the contents of the articles must be regarded as inadmissible hearsay.

OPPONENT'S REPLY EVIDENCE

Jeannine Summers

Ms. Summers' reply evidence documents that several of the marks located by Ms. Thompson have been opposed, voluntarily abandoned, or refused.

SECOND GROUND OF OPPOSITION

Section 30(b) of the *Trade-marks Act* requires a trade-mark application to contain the date from which the applicant has used its mark in association with the wares and services specified in the application. As always, the legal onus is on the applicant to show that its application complies with Section 30(b). That is, the applicant must show that the date of first use alleged is factually correct. The applicant may allege a date of first use later than the actual date of first use but may not allege a date earlier than the actual date of first use.

There is also, in accordance with the usual rules of evidence, an evidential burden on the

opponent to establish the facts inherent in its allegation that the applicant's date of first use is incorrect. The presence of an evidential burden on a party 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. The evidential burden on the opponent with respect to Section 30(b) is lighter than in the ordinary case: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at pp. 298-300 (F.C.T.D.). The presence of a legal 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. The material time for considering the circumstances respecting the issue of non-compliance with Section 30(b) is the filing date of the application: see *Thomas J. Lipton Inc. v. Primo Foods Ltd.* (1992), 44 C.P.R.(3d) 556 at p. 560 (TMOB); *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 468 at p. 475 (TMOB).

In the instant case the opponent relies on Exhibit D of Ms. Summers first affidavit to meet its evidential burden. Exhibit D is a printout of pages from a database which provides particulars of Ontario's official records of publicly available business information. The corporate profile indicates that the applicant was incorporated on August 3, 1989, that is, well after the dates of first use claimed in the subject application. As noted by the opponent, there is no claim in the application to a predecessor-in-title nor is there any evidence of a transfer of rights from a predecessor-in-title.

At the oral hearing, counsel for the applicant argued that the evidence shows that a group of

friends and associates initially used the applied for mark H.O.P.E., then the mark was used by the applicant corporate body controlled by the same above mentioned individuals. Counsel argued that in such circumstances it would inequitable and unfair to permit Section 30(b) to deprive the applicant of a registration. I would note, however, that the applicant's evidence is too incomplete for me to arrive at any definite conclusions regarding the history of use of the applied for mark. Even if I were to accept counsel's history of use of the mark, it is far from apparent that the mark had been used or owned by a legal entity prior to August 3, 1989.

In view of the foregoing, I agree with the opponent that it has met its evidential burden to put the dates of first use of the mark in issue and that the applicant has not met the legal onus on it to show compliance with Section 30(b). The second ground of opposition is therefore successful.

FOURTH GROUND OF OPPOSITION

In its written argument, and at the oral hearing, counsel for the applicant noted that a public authority must be (i) subject to a significant degree of government control and (ii) must exist for the public benefit. Counsel then pointed to Mr. Cannon's affidavit wherein Mr. Cannon states that the opponent is "an autonomous agency" working in cooperation with other agencies. Counsel argues that part (i) above has not been met as the opponent has admitted that it is not under a significant degree of government control. Counsel concludes that the opponent cannot rely on its official marks as it cannot claim that it is a public authority. I disagree.

I do not regard Mr. Cannon's statement that the opponent is "an autonomous agency" as an admission that the opponent is not subject to a significant degree of government control. Taken in the context of his affidavit as a whole, I understand Mr. Cannon to mean that the opponent decides autonomously how, where, and when to pursue its objectives in the same sense that a CEO operates autonomously but is ultimately subject to control by a board of directors.

As discussed in *B. C. Hydro and Power Authority v. Gallagher Group Ltd.* 31 C.P.R.(4th) 370 at 377-378 (TMOB), the test to be applied under Section 9(1)(n)(iii) is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, the issue is whether the applicant's mark is identical to, or almost the same as, any of the opponent's official marks. Further, the test is to be applied as a matter of first impression and imperfect recollection, that is, the issue must be determined in the context of whether a person who, on a first impression, knowing one mark only and having an imperfect recollection of it, would likely be deceived or confused.

In assessing the resemblance between the parties' marks, regard may be had to the three aspects of resemblance set out in s. 6(5)(e) of the *Trade-marks Act*, namely the degree of resemblance between the parties' marks in appearance, in sound and in the ideas suggested by them. However, a consideration of the nature of the wares, services or trades associated with the parties' marks is not relevant.

It should also be noted that the Court in *Techniquip Limited v. Canadian Olympic*

Association (1999), 3 C.P.R.(4th) 298 (F.C.A.); affg. (1998), 80 C.P.R.(3d) 225 at 233 (F.C.T.D.) held (at page 304) that it was open to a party to evidence the state of the trade-marks register and the marketplace in order to negate the effect of any claimed family of official marks. In this regard, the affidavits of Mss. Thompson and Jones filed by the applicant serve to significantly lessen the importance of the opponent's claim to a family of official marks as the word HOPE is not unique to the opponent as a component of trade-marks.

The issue in the present case is whether a person familiar with one or more of the opponent's official marks, but having an imperfect recollection of them, would be likely to mistake the applied for mark H.O.P.E. as belonging to the opponent's series of official marks. In this regard, I find that there is a high degree of resemblance visually, aurally, and in ideas suggested, between the applied for mark H.O.P.E. and the opponent's series of official marks since the word HOPE is a prominent component of the opponent's official marks.

Taking into account the mitigating effects of the Thompson and Jones affidavits, I nevertheless find that, on a balance of probabilities, the conclusion that the applied for mark so nearly resembles as to be likely to be mistaken for one of the opponent's series of official marks weighs equally with the conclusion that the applied for mark does not so nearly resemble as to be likely to be mistaken for one of the opponent's series of official marks. As the onus is on the applicant to show that, on a balance of probabilities, the applied for mark does not so nearly resemble as to be likely to be mistaken for one of the opponent's series of official marks, I must find against the applicant. The fourth ground of opposition is therefore successful.

As I have found for the opponent on two grounds of opposition, it is not necessary to consider the remaining grounds. However, given that (i) the opponent has established a fair reputation for its marks at the material date November 5, 2001 (after discounting Mr. Cannon's hearsay evidence), (ii) the applicant has not evidenced more than a minimal reputation for its mark, and (iii) the parties' operate in the same general area of charitable works, it is likely that the grounds of opposition alleging non-distinctiveness would also have succeeded.

APPLICATION NO. 801410



H.O.P.E.

HELPING OTHER PEOPLE EVERYWHERE

The above referenced application was also filed on January 10, 1996, and covers the same wares and services as application no. 801413. However, in the instant application the date December 31, 1986, is claimed as the date of first use for both the wares and services. The application disclaims the right to the exclusive use of the term **HELPING OTHER PEOPLE** apart from the mark as a whole.

The issues, evidence and considerations are essentially the same as in application no. 801413. However, in my view there is a greater resemblance between the applied for mark and the

opponent's word and design mark, shown below, visually (owing to the circular design feature of the applied for mark) and in ideas suggested (owing to the similar concepts of "international development" and "helping other people everywhere").



Accordingly the same results follow as in application no. 810413. That is, the opponent succeeds on the grounds of opposition alleging non-compliance with Section 30(b) and non-compliance with Section 9(1)(n)(iii).

DISPOSITION

In view of the foregoing, application nos. 801413 and 801410 are refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 24th DAY OF DECEMBER, 2008.

Myer Herzig,
Member,
Trade-marks Opposition Board