



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

**Citation: 2015 TMOB 15
Date of Decision: 2015-01-28**

**IN THE MATTER OF AN OPPOSITION
by Vancouver Community College to
application No. 1,536,869 for the trade-
mark VCCOLLEGE.CA in the name of
Vancouver Career College (Burnaby) Inc.**

[1] On July 22, 2011, Vancouver Career College (Burnaby) Inc. (the Applicant) applied for the trade-mark VCCOLLEGE.CA (the Mark) for use in association with the operation of an educational institution at the college level (the Services). The application is based on proposed use.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 11, 2012.

[3] On June 11, 2012, Vancouver Community College (the Opponent) opposed the application on the following grounds:

- (a) The application does not conform to section 30(e) of the *Trade-marks Act* RSC 1985, c T-13 because the Applicant could not have intended to use the Mark in Canada because it was already in use prior to the filing of the application.
- (b) The application does not conform to section 30(i) of the Act because the Applicant could not have been satisfied it was entitled to use the Mark.

- (c) The application is not registrable pursuant to section 12(1)(e) of the Act because it is confusing with the official marks: No. 910,482 for VCC and No. 916,687 for VANCOUVER COMMUNITY COLLEGE.
- (d) The Applicant is not the person entitled to registration of the Mark pursuant to sections 16(3)(a) and 16(3)(c) of the Act since it is confusing with the Opponent's trade-marks and trade-names VCC and VANCOUVER COMMUNITY COLLEGE for use in association with the operation of an educational institution at the college level.
- (e) The Mark is not distinctive in that it is not adapted to distinguish and does not actually distinguish the Services of the Applicant.

[4] The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[5] The Opponent filed as its evidence the affidavits of Kathleen Chandler, Roberto Alfaro, Wendy LaFrance, Angela Abbinante, Doreen Chui-Chai, Tess Lawrence and Joan E. Brehl Steele. In Ms. Chandler's affidavit sworn on March 27, 2013, she attaches as Exhibit A an affidavit she swore on October 1, 2012 in relation to another proceeding involving the Applicant. She confirms the truth of the earlier affidavit, provides information to update the earlier affidavit and adopts the statements therein. References to paragraph numbers and Exhibits refer to the October 1, 2012 affidavit.

[6] The Applicant did not file any evidence.

[7] Both parties filed a written argument and were represented at a hearing held on September 10, 2014.

Preliminary Issue: Evidence of the Applicant's Use

[8] In support of its opposition, the Opponent relies on various printouts from the Internet attached to Ms. Chandler's affidavit including from the Applicant's purported website *www.vccollege.ca* (Exhibit JJ), Facebook page (Exhibit DD), Twitter account

(Exhibit CC) and GOOGLE searches showing the sponsored link www.vccollege.ca (Exhibit FF). These printouts are admissible even though they are hearsay since it is necessary for the Opponent to file them in support of the grounds of opposition and they are reliable since the Applicant, being a party, has the opportunity to refute the evidence [*Reliant Web Hostings Inc v Tensing Holding BV* (2012), 106 CPR (4th) 294 (TMOB) at para 35].

Material Dates and Onus

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

- sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/ 12(1)(e) - the date of my decision [*Canadian Olympic Assn v Allied Corp* (1989), 28 CPR (3d) 161 (FCA) and *Canadian Olympic Assn/Assoc Olympique Canadienne v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)];
- sections 38(2)(c)/16(3) - the filing date of the application [see section 16(3)]; 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 at 324 (FC)].

[10] Before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. 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. With respect to (ii) 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 (for those allegations for which an opponent has met its evidential burden). 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.

Analysis of the Grounds of Opposition

[12] I will now consider the grounds of opposition beginning with the distinctiveness ground.

Distinctiveness Ground of Opposition

[13] The Opponent alleges that the Mark is not distinctive because it does not actually distinguish nor is it adapted to distinguish the Services from the Opponent's goods and services.

[14] There is an initial burden on the Opponent to establish that, as of June 11, 2012, its trade-marks and trade-names VCC and VANCOUVER COMMUNITY COLLEGE were known to such an extent that they could negate the distinctiveness of the Mark. The Opponent will have met its burden if its trade-marks and trade-names are known in Canada to some extent or if they are well known in a specific area of Canada [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at para 33]. My analysis below will focus on the Opponent's trade-mark VCC as I consider that this mark represents the Opponent's best chance of success.

The Opponent Has Met Its Evidential Burden

[15] The Opponent's evidence included in the affidavits of Ms. Chandler and Ms. Steel summarized below is sufficient to meet its evidential burden. I am satisfied that the exposure of consumers in Vancouver to various advertisements, information, promotional material and articles including the Opponent's trade-mark VCC resulted in this trade-mark being well known in this area as of June 11, 2012 (the material date).

[16] Ms. Chandler, Senior Public Affairs Advisor with the Opponent, provides the following evidence as of the material date.

- (a) The Opponent was established in 1965 and has been operating under the name Vancouver Community College since 1974 (paras 5-6). Ms. Chandler states that the Opponent or its predecessor-in-title has used the trade-mark VCC since at least 1965 (para 15) and her evidence shows use of the mark VCC since at least as early as 1977 (Exhibit C).
- (b) Between 2008-2012, the average number of students per year has exceeded 23,000 (paras 12, 74).
- (c) The Opponent offers 78 certificates, 28 diplomas and 3 bachelor's degrees in a variety of career disciplines including health, hospitality, applied business, transportation and other skilled trades (paras 8, 11).
- (d) The trade-mark VCC has appeared on printed materials distributed by the Opponent including program brochures, calendars, flyers, and program content guides since 1977 (paras 22-47; Exhibits F-K). The trade-mark VCC has also appeared on community newsletters including the VCC Community Report for which over 148,000 copies were distributed annually between 2004-2009 (paras 22-27; Exhibits A, B, C, D and E).
- (e) The Opponent's website *www.vcc.ca* which features the VCC trade-mark prominently received over 1.5 million visits per year from 2007-2012 (paras 63-67, Exhibits T,U,V).
- (f) The Opponent displays advertisements in SkyTrains and SkyTrain stations promoting its education services in association with the VCC trade-mark (paragraphs 75-76; Exhibit Z).
- (g) From 2002-2012, the Opponent has hosted Information Nights twice a year to prospective students (approximate attendance of 1000 students) at which marketing materials featuring the trade-mark VCC is distributed (paras 59-62, Exhibit S).

(h) Between 1988-2012, the Opponent has been featured in over 30 stories in the Vancouver Sun, Vancouver Province or Victoria Times Colonist with VCC or VANCOUVER COMMUNITY COLLEGE in the headline or body of the article (para 48; Exhibit P).

[17] Ms. Steele is the Vice President / General Manager, Brand Leadership & Innovation of the Alliance for Audited Media. Ms. Steele provides circulation figures for various periodicals referenced in paragraph 48 of Ms. Chandler's affidavit including The Province, and the Vancouver Sun. The evidence shows that there is extensive circulation of these periodicals in the Vancouver area.

Applicant's Onus

[18] As the Opponent has met its burden, the Applicant has the onus of proving on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark VCC such that the Mark is distinctive of or adapted to distinguish the Services.

Test to Determine Confusion

[19] 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 goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the goods 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 goods 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. The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [Mattel, Inc v 3894207 Canada Inc, 2006 SCC 22 (CanLII), [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.

[20] In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

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] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Further, the assessment of a likelihood of confusion asks what occurs when consumers encounter a trade-mark not any subsequent steps which may be taken [*Masterpiece, supra* at paras 70-73].

Inherent Distinctiveness

[21] Neither party's marks have a high degree of inherent distinctiveness. Marks consisting of initials are considered weak marks with low inherent distinctiveness [*GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD) at 163-164]. The Opponent's trade-mark VCC is an acronym for Vancouver Community College. The Applicant's trade-mark consists of the acronym VC (for Vancouver Career) and the descriptive components COLLEGE and .CA (see, for example, Chandler affidavit, Exhibits CC, FF (see, for example, pages 3530, 3545 and 3565), and JJ).

Extent Known and Length of Time in Use

[22] This factor significantly favours the Opponent. The Opponent has shown extensive use of the trade-mark VCC in the Vancouver area for a long period of time. Such extensive use has resulted in the Opponent's trade-mark VCC becoming distinctive [*Gemological Institute of America Inc v Gemology Headquarters International LLC*, 2014 FC 1153 at paras 104; 111; *Sarah Coventry, Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 6 (FCTD)]. In contrast, there is no evidence that the Mark has become known to any real extent.

Nature of Services and Trade

[23] This factor significantly favours the Opponent. The services of the parties, operating an educational institution at the college level, are identical as is the nature of trade. While the Applicant submits that there is a high degree of care on the part of the customer when choosing a college (Applicant's Written Argument, paras 48-49), this does not necessarily diminish the potential for a likelihood of confusion. The Supreme Court of Canada has affirmed that as the test is one of "first impression" what is relevant is the attitude of the consumer when he or she first encounters the mark in the marketplace, without consideration of the research, inquiries or care that may subsequently be taken [see *Masterpiece, supra*, paras. 67-74].

Degree of Resemblance

[24] As stated earlier, the degree of resemblance between the trade-marks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trade-mark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée, supra* at para 20].

[25] This factor favours the Opponent as the two trade-marks under consideration closely resemble each other in appearance and as sounded. The Opponent's trade-mark is incorporated entirely within the Mark. Further, in the context of the Services, the ideas suggested by the marks would be very similar to consumers located in the Vancouver area. By virtue of its long standing use, the Opponent's trade-mark VCC suggests college level education services offered in Vancouver. In comparison, the Mark suggests a domain name for an entity offering college level educational services in Vancouver or potentially another city beginning with a V. Further, while the Mark includes the components COLLEGE and .CA, these components do not impact the degree of resemblance to any real extent since they are descriptive [*Reno-Dépôt Inc v. Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) at para 58; *Masterpiece, supra* at para 64].

Evidence of Actual Confusion

[26] As part of its evidence, the Opponent filed the affidavits of Angela Abbinante, Wendy LaFrance, Robert Alfaro, and Doreen Chui-Chai, each of whom are employees and provide details of conversations with potential students who have mistakenly contacted or attended the Opponent's location(s) when they had made an appointment with the Applicant. I have not had regard to this evidence since it is not clear to me that the confusion described by the affiants arose because of confusion between VCCOLLEGE.CA and the Opponent's mark VCC.

BCCA Decision

[27] At the hearing, the Applicant submitted that the *Insurance Corporation of British Columbia v Stainton Ventures Ltd* 2014 BCCA 296 (*ICBC v Stainton*) case supports its position that the Mark which is a domain name would not cause confusion with the Opponent's trade-mark. In *ICBC v Stainton*, the ICBC argued that the domain name *ICBCadvice.com* was prohibited by its official marks as consumers would be led to believe the website was operated by it. The BCCA found rather that a consumer would not mistake the domain name for the official mark at para 37:

Even though there is some resemblance between *ICBCadvice.com* and ICBC's family of marks, the average Internet user with an imperfect recollection of ICBC's marks would not likely be mistaken by the domain name. ... They understand, for example, that a domain name which, in part, contains the name of a business or its acronym will not necessarily be affiliated with or endorsed by that business and may, instead, be the subject matter of the website or entirely unrelated to that business. As well, they understand that it is necessary to view a website to determine whose site it is.

[28] The BCCA's decision in this case does not assist the determination of confusion between the Mark and the Opponent's trade-mark. This opposition does not involve assessing the likelihood of confusion between a particular domain name *per se* and an official mark. Rather, in this context, the Applicant has applied for VCCOLLEGE.CA as a trade-mark, the function of which is to indicate source and to distinguish the Services of the Applicant from those of others.

Conclusion

[29] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Because the otherwise weak VCC trade-mark has gained distinctiveness due to use and reputation, the small differences between the Mark and the VCC trade-mark are not sufficient to avert confusion. Having examined all of the circumstances of the case, I conclude that the Applicant has failed to meet its legal onus of showing, on a balance of probabilities, that on June 11, 2012, the Mark was distinctive of the Services. This ground of opposition is successful.

Section 16(3)(a) Ground of Opposition

[30] Although the material date for the section 16(3)(a) ground of opposition falls earlier than the material date for the distinctiveness ground of opposition, the different date does not result in a different outcome. Therefore, the section 16(3)(a) ground of opposition also succeeds.

Remaining Grounds of Opposition

[31] As I have already found in favour of the Opponent under two grounds, I do not consider it necessary to address the remaining grounds of opposition.

Disposition

[32] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office