

OPIC



CIPO

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

Citation: 2018 TMOB 69

Date of Decision: 2018-07-04

IN THE MATTER OF OPPOSITIONS

Abirahim Ali-Rage

Opponent

and

Muqdisho Football Club

Applicant

**1,679,164 and 1,679,165 for
MUQDISHO FOOTBALL CLUB and
MUQDISHO FOOTBALL CLUB &
Design**

Applications

INTRODUCTION

[1] Abirahim Ali-Rage (the Opponent) opposes registration of the trade-marks MUQDISHO FOOTBALL CLUB and MUQDISHO FOOTBALL CLUB & Design (reproduced below) (sometimes hereinafter collectively referred to as the Marks) that are respectively the subject of application Nos. 1,679,164 and 1,679,165 by Muqdisho Football Club (the Applicant):



[2] The applications indicate that: “MUQDISHO is the Somali name for the capital city of Somalia (Mogadishu) and does not translate into English or French”, and were originally filed by Mohamed Abdi on May 30, 2014 on the basis of use in Canada since at least as early as March 2009 in association with the following goods and services:

Clothing, namely, athletic clothing, t-shirts, jackets, and hats; sports equipment, namely, soccer balls, shin guards, mouth guards, goalkeeper gloves, and soccer cleats; sports equipment bags; printed and electronic publications, namely, newsletters, posters, signs. (sometimes hereinafter collectively referred to as the Goods)

Soccer club services; arranging and conducting soccer competitions, soccer tournaments, and soccer skill demonstrations; conducting educational workshops in the field of soccer skills; providing facilities for soccer tournaments; sports camps; operating a website providing information in the fields of soccer, soccer clubs, soccer camps, and soccer games. (sometimes hereinafter collectively referred to as the Services)

[3] As explained below, Mr. Abdi assigned his rights in the subject applications to the Applicant on February 1, 2016.

[4] The oppositions were brought under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and set out a single ground of opposition, which is reproduced below:

With respect to application No. 1,679,164:

The applicant is not the person entitled to registration of the trade-mark.

I am the rightful owner of the trademark name and I have used it since 2009. This individual has fraudulently attempted to register it as his “own” trademark in the referenced application. I have attached all evidence of my use in the last 6 years. I have

also attached press coverage from reputable organizations such as Toronto Star Newspapers and ethnic media. I have attached invoices bearing the name and showing me as the purchaser and the individual who paid for the purchases under this name.

With respect to application No. 1,679,165:

The applicant is not the person entitled to registration of the trade-mark.

I am the rightful owner of the trademark name and I have used the logo with the same name since 2009. This individual has fraudulently attempted to register it as his “own” trademark in the referenced application. I have attached all evidence of my use in the last 6 years. I have also attached press coverage from reputable organizations such as Toronto Star Newspapers and ethnic media showing myself wearing jersey with the name and the logo as is this [*sic*] listed in this application. I have attached invoices bearing the name and showing me as the purchaser and the individual who paid for the purchases under this name.

[5] For the reasons that follow below, I find the oppositions ought to be rejected.

THE RECORDS

[6] The applications for the Marks were both advertised for opposition purposes in the *Trade-marks Journal* on November 4, 2015.

[7] The applications were opposed by the Opponent by way of statements of opposition filed with the Registrar on November 19, 2015.

[8] On February 5, 2016, the Applicant requested that the register be amended to identify the Applicant as owner of the Marks. In support, the Applicant enclosed a copy of a “Confirmatory Assignment of Trademark Applications” executed on February 1, 2016. On the same day, the Applicant also requested an interlocutory ruling to strike all, or in the alternative, portions of, the Opponent’s pleadings.

[9] On February 19, 2016, the Registrar recorded the assignment in favour of the Applicant. On April 6, 2016, the Registrar declined to strike all or portions of each of the statements of opposition, and decided as follows:

The attachments to the pleadings are not evidence but are documents which, when read together with the pleadings, suffice for the statement of opposition to satisfy s. 38(3)(a) of the [Act]. [...] The applicant’s request is therefore refused.

[10] The Applicant filed and served a counter statement in each case denying the ground of opposition set out in the statement of opposition.

[11] I note that there has been numerous correspondence received from both the Applicant and the Opponent throughout the present opposition proceedings, apparently due, in part, to the fact that the Opponent has been self-represented. For the ease of discussion, I will only refer to the pieces of correspondence that are necessary for my analysis.

[12] As confirmed by the Registrar in the Office Letters dated December 2, 2016 and January 12, 2017 in application file No. 1,679,165, the evidence that has been made of record consists of the following:

With respect to application No. 1,679,164:

- The statutory declaration of Abirahim Ali-Rage, dated June 2, 2016, filed as the Opponent's evidence in chief under section 41 of the *Trade-marks Regulations*, SOR 96/195 (the Regulations) (the First Ali-Rage 164 Declaration).

I note that in his covering letter dated June 10, 2016 to the Registrar enclosing the First Ali-Rage 164 Declaration, the Opponent indicated that:

I, Abirahim Ali-Rage, heretofor [*sic*] the Rightful Owner) [*sic*] am relying on the following as evidence of both my ownership and use and a basis for my challenge to the registration of both applications:

1. A signed affidavit – see exhibit A.
2. An e-mail address (*muqdishofc@hotmail.com*) and communication with Jersey vendors dated in [*sic*] March 25th 2009 – see exhibit B.
3. Supporting documentation provided as part of my opposition statement – See Exhibit C.

I will return to this point below.

- The affidavit of Abdifatah Ahmed, dated October 7, 2016, filed as the Applicant's evidence under section 42 of the Regulations (the Ahmed affidavit).
- The statutory declaration of Abirahim Ali-Rage, dated November 28, 2016, purportedly filed as the Opponent's reply evidence under section 43 of the Regulations (the Second Ali-Rage 164 Declaration).

With respect to application No. 1,679,165:

- The statutory declaration of Abirahim Ali-Rage, dated December 16, 2016, filed as the Opponent's evidence in chief under section 41 of the Regulations (the Ali-Rage 165 Declaration); and
- The affidavit of Abdifatah Ahmed, dated October 7, 2016, filed as the Applicant's evidence under section 42 of the Regulations. As this affidavit is identical to the one filed in application No 1,679,164, I will use the singular to refer to these two affidavits.

[13] None of the deponents were cross-examined on their affidavits/statutory declarations.

[14] On October 7, 2016, the Applicant filed a revised application in each case to clarify the chain of title as indicated below; they were accepted by the Registrar by way of Office Letters dated October 18, 2016:

The applicant or applicant's predecessor(s) in title (MOHAMED ABDI DAYNIILE RECREATIONAL CULTURAL AND SPORTS ASSOCIATION) has/have used the trade-mark in association with the [Goods and Services].

[15] Both parties filed written arguments identical in each case, except for their title/heading. In this regard, I note that while the Opponent's evidence that has been made of record in application No. 1,679,165 differs from that in application No. 1,679,164, the parties' written arguments focus on the Opponent's evidence that has been made of record in application No. 1,679,164.

[16] No hearing was held.

PRELIMINARY REMARK

[17] In each of his written arguments the Opponent submits that:

[The] Applicant's sole claim for Registration is that the trademark name was "used in CANADA since at least as early as March 2009 on goods and services". Yet, throughout the three years this application has been in process both the original Applicant (Mr. Mohamed Abdi) and the "new" Applicant Mr. Abdifatah Ahmed representing an Ontario April 24th 2014 registered organization called Muqdisho Football Club (heretofore known as MFC) has failed to:

- a) Provide a single shred of evidence of either in the form of the goods or in the services listed in the application, **as is required by s. 30(a)(b)** of the [Act], that shows such use at the date claimed in the application;
- b) Provide invoices for goods and services bearing [...]

In every case from 1.a to 1.e above, the Applicant has failed to show documented evidence of use of the trademark name hence my opposition should be sustained and the trademark application rejected. [My emphasis]

[18] However, in the absence of any specific pleading alleging non-compliance with sections 30(a) or (b) of the Act, I find I am precluded from considering this issue [*Le Massif Inc v Station touristique Massif du sud (1993) Inc*, 2011 FC 118].

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[19] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that each of the Marks is registrable remains on the Applicant, on a balance of probabilities [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

ANALYSIS

[20] As indicated above, the Opponent has pleaded that the Applicant is not the person entitled to registration of each of the Marks because the Opponent is the rightful owner of these trade-mark names and have used them since 2009.

[21] To meet his evidentiary burden in respect of a ground of opposition based upon section 16(1) of the Act, the Opponent must show that as of the alleged date of first use of the Marks in Canada, the Opponent's MUQDISHO FOOTBALL CLUB trade-mark and/or logo and/or trade-name had been previously used or made known in Canada and had not been abandoned as of the date as of advertisement of the Applicant's applications, namely November 4, 2015 [section 16(5) of the Act].

[22] This brings me to review the evidence that has been made of record in these proceedings.

Overview of the evidence

The Opponent's evidence in chief

With respect to application No. 1,679,164: the First Ali-Rage 164 Declaration

[23] This declaration is very brief, comprising only four paragraphs.

[24] Mr. Ali-Rage states that he is “both the sole founder and rightful owner of the name Muqdisho Football Club, its logo, and the acronym MFC” and that he has used these name/logo/acronym “since [his] founding in 2009” [para 2].

[25] Mr. Ali-Rage then states in paragraphs 3 and 4 of his declaration that:

3. The individual, Mr. Mohamed Abdi, who attempted to register this name and has since transferred it, has never owned the name or its MFC acronym. Nor has this individual ever had any role in the creation of the MFC logo.

4. The individual or individuals now claiming to own the name have also had no role in the founding of the MFC name. Neither have they had any role in the creation of the MFC logo.

[26] As mentioned above, the First Ali-Rage 164 Declaration was filed together with two other exhibits. However, as noted by the Applicant in its written argument, Exhibits B and C were not stamped by a Commissioner for taking Oaths or a Notary, as a result of which the Applicant submits that these documents should not be considered as evidence.

[27] Indeed, section 41 of the Regulations provides that the Opponent's evidence must be submitted by way of affidavit or statutory declaration, or in accordance with section 54 of the Act. In the present case, not only are Exhibits B and C not notarized, but they are not properly identified as exhibits or otherwise referenced in the First Ali-Rage 164 Declaration. As reproduced above, Exhibits B and C were simply attached to the Opponent's letter to the Registrar dated June 10, 2016, making this more than a mere technical deficiency. As such, I agree with the Applicant that Exhibits B and C should not be considered as evidence.

[28] In any event, even if I were to consider these documents as evidence, Exhibit B merely consists of a quote for uniforms and practice balls sent on March 25, 2009 by a representative of Inaria International Inc. (Inaria) to the following two email addresses:

abdirahim14@hotmail.com and *muqdishofc@hotmail.com*. Except for the name “muqdishofc” in one of the email addresses, there is no reference whatsoever to either of the Marks. As such, this document does not assist the Opponent in establishing that he is the “rightful owner” of the MUQDISHO FOOTBALL CLUB trade-mark and/or logo and/or trade-name and has used same since March 2009.

[29] Likewise, Exhibit C merely supports the Opponent’s assertion that he is the “founder” of an organization named the “MUQDISHO FOOTBALL CLUB”, whose goal and objective is to build and encourage sportsmanship among the youth of the Somalia community in Toronto by fostering and teaching the game of soccer. However, as explained below in my review of the Ali-Rage 165 Declaration, the documentation contained in Exhibit C by no means establishes that the Opponent is the “rightful owner” of the MUQDISHO FOOTBALL CLUB trade-mark and/or logo and/or trade-name and had used same for his own benefit as of the alleged date of first use of the Marks in Canada.

With respect to application No. 1,679,165: the Ali-Rage 165 Declaration

[30] Mr. Ali-Rage states that he is the “sole founder” and “rightful owner of the name Muqdisho Football Club (heretofore referred to as MFC), its logo, and the acronym MFC” and that he has used these name/logo/acronym since “[his] founding in 2009” and “[does] continue to use the name and the logo to this day” [para 1].

[31] Mr. Ali-Rage then turns to the Applicant’s history of incorporation and states in paragraphs 2-4 and 10-11 of his declaration that:

2. The individual, Mr. Mohamed Abdi, who attempted to register the name MFC and the associated logo and who has since illegally transferred the application to himself by hiding behind the name of an Ontario registered organization calling itself as Muqdisho Football Club [See Exhibit F] where he is one of three officials/directors, has never owned or used my MFC name and its logo. Neither has Mr. Abdi ever had any role in the creation of the MFC logo. His first involvement as a volunteer coach is documented in Exhibit E.

3. The individual Mr. Haji Isse who is one of three individuals who are identified as the registrants of the Ontario MFC Corporation (See Exhibit F) also had no role in the founding of the MFC name and its logo. In fact he was not even a Canadian resident when MFC was founded.

4. Mr. Abdifatah Ahmed who is one of three individuals who are identified as the registrants of the Ontario MFC Corporation (See Exhibit F) also had no role in the founding of the MFC name or the creation of the logo. I have recruited him to join the volunteer administrators I was putting together in and around February/March 2009 time frame. He held the role of Vice President as can be seen in Exhibit C and for a short period as President as seen in Exhibit A. In the Exhibit A, he self identifies and identifies my role and tile [*sic*] in the presentation while in Exhibit C, he is identified by picture and by title whereas I was identified as the Founder of MFC. Mr. Ahmed held the role of a volunteer coach for Boys Under 10 and Boys Under 12 until his voluntary departure from my organization on May 23rd 2014.

[...]

10. [...] The three individuals (Abdi, Isse and Ahmed) attempted to take over MFC while I was out of the country from March 24th/2014 to April 15th/2014 – See Exhibit F for my electronic ticket and entry and exit dates. Upon my return, parents and elders intervened and listened to the accusations that these three individuals leveled against me. Having failed in their bid to take over MFC, the three of them immediately started and registered the Ontario Corporation bearing my MFC name and using my MFC logo. Mr. Abdi was the first to leave MFC on May 21st 2014. He was followed by Mr. Ahmed on the 23rd of May 2014 and finally by Mr. Isse on May 24th 2014. In fact by the time they left my organization, they not only have already registered my MFC as an Ontario Corporation but they also had started the Trade Mark application under the false pretense.

11. My MFC was never adopted by an organization in its seven year existence. I have in late April/early May 2009 adopted the name Dayniile Football Club (heretofore referred to as Dayniile FC). At the time, my MFC had assembled a very strong youth/adult team. I wanted my MFC to participate in the yearly Somali Week soccer competition organized by SOSCA and TODAY in June/July time frame every year. At the time the problem was given the popularity of this competition, team entries were restricted to those who participated in the tournament in the prior years. Given that Dayniile FC has participated in this tournament before and yet had no team and Mr. Ahmed had control of the Dayniile FC through the Dayniile Recreational Cultural And Sports Association – heretofore referred to as DRCASA, we agreed that Hassan Harbi who at the time was a Manager for this organization and the acting President of my MFC would write a name adoption letter which to be sent to both SOSCA and TODAY to enable my MFC to participate in the tournament. This was specific to the tournament in question. It was a permission granted for MFC to adopt the Dayniile FC name. Any individual who claims otherwise or presents evidence to the contrary is not only lying but is engaging in blatant fraud with the aim of misleading the Opposition Board.

[32] Mr. Ali-Rage attaches to his declaration various exhibits, which he describes as follows:

- Exhibit A: “an e-mail communication in Somali, the English translation of the e-mail content and the original attachment saved in a folder with the name Exhibit A found in the key FC found in Exhibit G”. Mr. Ali-Rage explains that Exhibit A includes a PowerPoint

presentation prepared by Mr. Ahmed on March 24, 2011, which presentation accurately sets out “MFC history, its work, its facilities it used at the time, [Mr. Ahmed’s] role and [the Opponent’s] role where [Mr. Ahmed] clearly identifies [the Opponent] as the Founder of the club MFC.”

- Exhibit B: “numerous MFC club invoices dating back to 25/03/2009 to the present”.
- Exhibit C: “National and ethnic and [*sic*] newspapers showing [the Opponent’s] name, role as the MFC founder and bearing the MFC logo while describing the work the club undertook since its inception.”
- Exhibit D: “Partnerships and Recommendations letters from other clubs.”
- Exhibit E: documents relating to Mr. Abdi’s “first involvement as a volunteer coach [with MFC]”.
- Exhibit F: “Electronic ticket and entry and exit dates” attesting that the Opponent was out of the country from March 24, 2014 to April 15, 2014; and Letters Patent relating to Ontario Corporation Number 1913174 named “MUQDISHO FOOTBALL CLUB.”
- Exhibit G: “the electronic key – [...] electronic copy of [support] letter provided to [the Opponent on behalf of MFC] from [Honorable Kristy Duncan, MP for Etobicoke North]’s office.”

[33] I note that Exhibits B, C, D, and E essentially correspond to the “supporting documentation” attached as Exhibit C to the Opponent’s aforementioned letter dated June 10, 2016 in respect of application No. 1,679,164.

[34] Upon review of these exhibits, I note that the PowerPoint presentation attached as Exhibit A displays throughout the MUQDISHO FOOTBALL CLUB & Design trade-mark as a watermark and indicates, among other things, that the “Muqdisho Football Club” was created in February 2009 and that its coaches and staff include, among others, the following individuals:

- Abdirahin Ali-Rage – Coach & Founder
- Abdifatah Ahmed (Sette) – Coach & President
[As acknowledged by both parties, Mr. Abdifatah Ahmed (the Applicant’s affiant) sometimes goes by the name Mr. Sette]
- Ahmed Ali – Manager

- Isse Adde – Head of Staff

[35] The invoices attached as Exhibit B are, for the most part, billed and shipped to:

- the “Muqdisho Futbol Club” at 340 Dixon Rd #706, Toronto, ON
- the “Muqdisho Futbol Club” at 320 Dixon Rd #1510, Toronto, ON

[36] The earliest invoice is dated May 25, 2009 (which is after the material date of March 2009) and was issued by Inaria. It refers to “P.O. Number: Ali’s Muqdisho FC” and was billed and shipped to “Inaria Soccer-Promotion”. The latest invoice is dated July 7, 2016 and was issued by Avanti Sports Group Inc.

[37] The “National and ethnic newspapers” attached as Exhibit C consist of two articles published in June 2010 in the *Toronto Star* and *The Immigrant Post* newspapers respectively. The articles refer to, among other things, the “Muqdisho Football Club”, which is described as a non-profit and “volunteer organization, managed by volunteers, supported by volunteers, and coached by volunteers”, “established in 2009”. The articles include photographs of the Opponent wearing the team jersey depicting the MUQDISHO FOOTBALL CLUB & Design mark as well as the Inaria logo. The *Immigrant Post* article also includes photographs of team players as well as other volunteers of the “Muqdisho Football Club” wearing the team long-sleeve jerseys. In addition to identifying the Opponent as the “Founder” of the “Muqdisho Football Club”, the articles and photographs refer to, among others, the following individuals:

- Hasaan Mohamud Harbi – President
- Adan Salad Awale – General Manager
- Abdifatah Ahmed Sette – Vice President

[38] The *Immigrant Post* article further includes photographs of Charles Wyatt of the Toronto Soccer Association and the Honorable Kirsty Duncan attending the “Muqdisho Football Club (MFC) [...] first anniversary and closing ceremony season ending tournament on May 29th, 2010”.

[39] With respect to the “recommendation” letters attached as Exhibit D, I note that the addressee in the letter dated February 27, 2012 provided by Ms. Duncan is simply identified as “To whom it may concern” without any address. Ms. Duncan writes that:

I am writing this letter on behalf of the Muqdisho Football Club. The Muqdisho Football Club has been providing an organized soccer program in Etobicoke North for children and youth since 2009. The club provides a valuable opportunity for the youth in our riding to be active [*sic*] involved in the positive benefits of team sport.

I have personally observed how enthusiastic and committed the Muqdisho Football Club is to providing a community based recreational soccer program that helps the players improve their soccer skills while building their personal skills such as [...] I’ve had the privilege of attending the clubs’ year end banquet for the past two years and have seen how this club positively impacts the lives of our children.

The Muqdisho Football Club is a definite asset to our community. If you require more information please call my office at [...].

[40] Likewise, the addressee in the letter dated June 13, 2011 provided by Mr. Wyatt of the Toronto Soccer Association is simply identified as “To whom it may concern” without any address. The letter merely confirms that:

The Muqdisho Football Club has been providing an organized soccer program for children and youth since 2009 [...].

In [Mr. Wyatt’s] discussions with the club’s founder, Ali Raghe, and the club’s other volunteers, [he has] found them to be enthusiastic and committed to providing a community based recreational soccer program [...].

[41] Exhibit D also includes a letter dated March 9, 2011 printed on “Muqdisho Youth Cultural Sport Organization of Toronto” letterhead, signed by the Opponent and addressed to the Toronto Soccer Association. The letter is “to confirm that the MFC has entered into an affiliation agreement with the Toronto Sporting FC for the 2011-2012 soccer season [...] and that [...] [t]his agreement will be reviewed after the 2011-2012 outdoor – indoor season.” There is no information on the organization named “Muqdisho Youth Cultural Sport Organization of Toronto” and the relationship, if any, existing between this organization and the “Muqdisho Football Club”.

[42] Finally, with respect to Exhibit F, I note that the Letters Patent relating to Ontario Corporation Number 1913174 “MUQDISHO FOOTBALL CLUB” are dated April 24, 2014 and

identify Abdifatah Hassan Ahmed, Mohamed Omar Abdi, and Haji Isse Rage as the first directors of the corporation.

[43] In the end, I find the evidence introduced through the Ali-Rage 165 Declaration is of little assistance in establishing that the Opponent is the “rightful owner” of the MUQDISHO FOOTBALL CLUB trade-mark and/or logo and/or trade-name and had used same for his own benefit as of the alleged date of first use of the Marks in Canada and had not abandoned same as of November 4, 2015. At best, this evidence supports the Opponent’s assertion that he is the “founder” of a non-profit and volunteer organization named “Muqdisho Football Club”. However, it is unclear how the Opponent’s contributions to that organization gave him any rights in the MUQDISHO FOOTBALL CLUB trade-mark and/or logo and/or trade-name and how the Opponent’s alleged use of these mark/logo/name could be considered an independent exercise of prior rights; all such use being apparently for the benefit of the organization “Muqdisho Football Club” that would have been created in and around February-March 2009 and which was presided at the time by the Applicant’s affiant, Mr. Ahmed, and managed and operated by other volunteers.

[44] This brings me to consider the Applicant’s evidence.

The Applicant’s evidence

The Ahmed affidavit

[45] In his affidavit, Mr. Ahmed explains that he is the President of the Applicant, and that he has held this position since the Applicant was incorporated on April 24, 2014 [para 1].

[46] In paragraph 2 of his affidavit, Mr. Ahmed states that he has been involved with youth soccer in Canada since he emigrated from Somalia in 1999. In support, he attaches as Exhibit A, a copy of a reference letter from the Somali Sports and Cultural Association (SOSCA).

[47] Commenting on the Applicant’s predecessors, Mr. Ahmed states in paragraph 3 of his affidavit that the Marks were “first adopted and used in March 2009 by Dayniile Recreational Cultural and Sports Association, a corporation without share capital, incorporated in Ontario on June 30, 2006 (hereinafter ‘Dayniile’). He states that he is also the President of Dayniile and has

held this role since 2009, and, prior to that, he held the title of secretary since Dayniile was incorporated. In support, he attaches as Exhibit B, copies of the Corporation Profile Reports for Dayniile together with the Letters Patent for the Applicant, and as Exhibit C, a copy of a Notification of Name Change dated March 23, 2009.

[48] Mr. Ahmed states that the original applicant, Mohamed Abdi, joined Dayniile as a coach in or about 2009 and became secretary of the Applicant when it was incorporated in 2014, a role that he continues to this day [para 5].

[49] In paragraph 6 of his affidavit, Mr. Ahmed states that Mr. Adan Awale created the logo for the MFC design mark that is the subject of application No. 1, 679,165. In support, he attaches as Exhibit D, a copy of an email from Mr. Awale from 2009, forwarding a new design. Mr. Ahmed adds that he controls the email accounts shown as the recipients to that email, namely *sette007@hotmail.com* and *muqdishofc@hotmail.com*. He also states that for a time, the Opponent also had access to the *muqdishofc@hotmail.com* email account, but that the account has always been connected to his [Mr. Ahmed] telephone number.

[50] Mr. Ahmed states that “Mr. Abdi caused the subject applications to be made” and that by way of written assignment, the latter assigned his rights to the Marks on February 1, 2016 to the Applicant [paras 5 and 7].

[51] Commenting on the Applicant’s use, marketing and advertising activities, Mr. Ahmed states in paragraphs 8 and 9 of his affidavit that the Applicant has invested considerable sums in the advertising and promotion of the Marks in Canada, specifically in the Greater Toronto Area. As well, the Applicant has maintained a presence on the Internet at *www.muqdishofc.com* since May 19, 2009. In support, he attaches as Exhibit E, representative usages in periodicals and photographs, including team photos, coach documents, flyers, and sign up forms; and as Exhibit F, copy of a whois report for this domain name and representative pages from this website.

[52] Mr. Ahmed then turns to the Opponent’s activities. He states that the Opponent “joined Dayniile as a coach and, on behalf of Dayniile, co-signed [the] name change notification [...]

attached above at Exhibit C. At that time, [the Opponent] was the Treasurer of Dayniile as shown in the corporate profile report attached above at Exhibit B” [para 10].

[53] Mr. Ahmed further states at paragraphs 11-14 of his affidavit that:

11. As a coach and member of Dayniile – his appointment as coach was confirmed on January 11, 2009 as shown in the meeting minutes and the confirmation of training with TSA dated March 9, 2009, attached above at Exhibit C – [the Opponent] was entrusted with responsibilities for the benefit of Dayniile. His use of the [Marks] was for the benefit of Dayniile.

12. However, without the knowledge of the other members of Dayniile, and in violation of his fiduciary duties as Treasurer, [the Opponent] registered a competing organization with a new Board and registered a competing website at *www.muqdishofc.ca*. The website was registered on August 11, 2010. A copy of the whois report for this domain name, together with the homepage of this website, is attached as Exhibit G. A copy of the corporate profile report for his organization called Muqdisho Youth Cultural Sports Organization of Toronto is attached as Exhibit H.

13. [The Opponent] has admitted that he is not the founder of MFC on several occasions. In 2013, [the Opponent] arranged for Somalia media (SNTV) to cover a 2013 March Break program. [The Opponent] sent an email to the SNTV host Muxudin Jama advising the TV program not to identify him as “founder”. A copy of this email dated March 13, 2013 is attached as Exhibit I. Moreover, Somalia media interviewed [the Opponent] in respect of a 2015 March Break program. In the clip shown on Universal TV, [the Opponent] admitted that MFC “was founded in 2009 by parents living in Toronto”. A copy of the film clip, together with a screen capture, transcript and translation is attached as Exhibit J.

14. Upon learning of [the Opponent’s] activities in early 2014, and owing to the confusion, [the Applicant] caused a letter to be issued addressing the competing use of the Marks, a copy of which is attached under Exhibit K.

[54] Commenting on the Opponent’s documentation served in respect of these opposition proceedings dated June 10, 2016, Mr. Ahmed states that he has been advised by his counsel that Exhibits B and C should be excluded from the evidence because they have not been commissioned properly. He adds that “[e]ven if they are considered proper evidence, and show use by [the Opponent], that use was for the benefit of the [A]pplicant or a predecessor” [para 15].

[55] Mr. Ahmed states that the Opponent is not the sole founder and rightful owner of the Marks. Instead, he was a coach and treasurer of the Applicant’s predecessor in title. Mr. Ahmed further states that the Opponent was not authorized to use the Marks independently from the Applicant or its predecessors [para 16].

[56] Mr. Ahmed concludes his affidavit stating, among other things, that the use of the Marks by the Opponent has harmed the Applicant's ability to provide its services in Canada, disrupting and threatening a substantial portion of the Applicant's activities [para 19].

[57] From my review of the Ahmed affidavit and accompanying exhibits, I agree with the Applicant that the evidence shows that when the Marks were adopted, the Opponent was an officer of the Applicant's predecessor in title, Dayniile, whose objectives included, among others:

To create a creational activities [*sic*] for the Somali youth in Ontario.

To establish soccer tournament between the Somali youth and other youth in Ontario.

To provide a tutorial and after school activities for Somali youth in order to prevent them joining criminal gangs, violence and drug dealers.

Select a committee that organizes the yearly soccer tournament in Ontario and Canada.
[As per Exhibits B and C]

[58] More particularly, Exhibit B shows that the Opponent was both a director and the treasurer of Dayniile and that he was domiciled at the time at 320 Dixon Rd #1510, Toronto, ON. I note that this address matches one of the addresses indicated in the invoices referred to above in Exhibit B attached to the Ali-Rage 165 Declaration. I further note that Exhibit B shows that Messrs. Ahmed and Harbi were also respectively director and president, and director and secretary of Dayniile at the time.

[59] Exhibit C shows that the Opponent was also a member of the committee of the Dayniile organization in charge of the yearly soccer tournament and the Head Coach of Dayniile's soccer club. Exhibit C further shows that the committee changed Dayniile team's name to "Muqdisho Football Club" on March 23, 2009. As stressed by Mr. Ahmed in his affidavit, the Opponent co-signed the name change notification.

[60] Likewise, some of the material attached as Exhibit E to the Ahmed affidavit supports the Applicant's position that, at least during his affiliation with Dayniile, the Opponent's use of the Marks did not constitute an exercise of independent rights in the Marks. For example, one of the flyers attached as Exhibit E describes the goal and objective of the "Muqdisho Football Club" and invites feedback, comments and suggestions to be provided by calling or emailing the club's

“management, coaches and volunteers” at either one of the email addresses *muqdishofc@hotmail.com* or *info@muqdishofc.com* or telephone numbers of “Ahmed Ali”, “Abdirahim”, and “Harbi”.

[61] The circumstances that led to the departure of the Opponent from Dayniile organization are unknown, as is the exact time when this occurred. According to Mr. Ahmed’s testimony, without the knowledge of the other members of Dayniile, and in alleged violation of his fiduciary duties as Treasurer, the Opponent registered the competing organization “Muqdisho Youth Cultural Sports Organization of Toronto” and a competing website at *www.muqdisho.ca*. In any event, I note that the Corporation Profile Report for this organization attached as Exhibit H shows the incorporation date of “2010/04/08”, and the whois report for this domain name attached as Exhibit G shows the creation date of “2010-08-11”, which dates are well after the Applicant’s claimed date of first use of the Marks, namely March 2009.

[62] This brings me to consider the Opponent’s evidence in reply filed with respect to application No. 1,679,164.

The Opponent’s evidence in reply

[63] As indicated above, the Second Ali-Rage 164 Declaration was purportedly filed as reply evidence with respect to application No. 1,679, 164.

[64] In its written argument, the Applicant submits that:

18. The Second Ali-Rage 164 Declaration is not confined at all to matters in reply to the Applicant’s evidence and as such should be rejected in its entirety. Rather, the evidence is meant to overcome the obvious deficiencies and gaps in the First Ali-Rage [164] Declaration submitted as the Opponent’s Rule 41 [e]vidence. The Opponent gives no explanation as to why this evidence was not and could not have been included in the First-Ali Rage [164] Declaration.

[65] In order to put the Applicant’s objection in context, I will briefly go over the Second Ali-Rage 164 Declaration.

The Second Ali-Rage 164 Declaration

[66] In this declaration, the Opponent reiterates that he is “the sole founder, the rightful owner of the name Muqdisho Football Club - heretofore referred to as MFC, its logo, and the acronym MFC”. He further opines that the Ahmed affidavit “in fact supports [the Opponent’s] claim and opposition” and comments on Exhibits D and I attached to the Ahmed affidavit as follows:

a) In the Applicant Evidence in Exhibit D: it shows that I am the one being consulted and asked to sign off on the logo creation because I was the one who had come with the logo design idea. It is also me who asked the individual who was facilitating the creation of the logo as shown in the e-mail communication.

b) In the Applicant Evidence in Exhibit I: it shows that I am being consulted on how MFC and its personnel will be presented in the television program. As the founder, I am the one who is deciding whether my title as the Founder should be used or not.

c) Neither in Exhibit D or I of the Applicant’s Evidence is there any mention of the old applicant. This individual is not also mentioned in any of the e-mail communications shown in the exhibits. At best, Mr. Abdifatah Ahmed – the individual who swore the affidavit – is being copied in the communication solely for awareness.

[67] The following paragraphs of the Second Ali-Rage 164 Declaration purport to evidence ownership of the name Muqdisho Football Club (MFC) and its logo, the role played by Messrs. Abdi, Isse and Ahmed and their alleged failed attempt to take over MFC. These paragraphs are basically identical to the ones found in the Ali-Rage 165 Declaration.

[68] The last part of the Second Ali-Rage 164 Declaration is entitled “Fraudulent Documentation” and begins as follows:

Having carefully examined the evidence provided by Mr. Ahmed acting for the Applicant under oath, I would like to bring to the Opposition Board’s attention to the fact that this individual has engaged in fraud and perjured himself while under oath by uttering forged documentation as a way to mislead the Opposition Board. [...]

[69] More particularly, the Opponent asserts that:

[Exhibit C attached to the Ahmed affidavit] is a doctored document whose original was not finalized until late April/early May/2009 – the original does not support his Trade Mark application hence the doctored letter with an earlier date. See Exhibit G for e-mail communication with a draft attachment of the original letter. [...]

[Exhibit K attached to the Ahmed affidavit] is also a doctored document. The original letter (publicly available on *Muqdishofc.net* and via Google) had a different address (see side by side comparison of original and doctored letter as seen in Exhibit H) [...]

[With respect to Exhibit B attached to the Ahmed affidavit:] Contrary to the very evidence in the form of incorporation documents that shows clearly that the two organizations [that is the Applicant MFC and DRCASA] are independent of each other, Mr. Ahmed has knowingly lied under oath by claiming that DRCASA was the parent company of the applicant MFC. MFC and DRCASA are two independent, Ontario registered corporations. Neither one has a parent company nor has one ever acted as the parent of the other. See Exhibit I for certified copies of reports from the Ontario Ministry of Government Services attesting to this legal fact.

[With respect to paragraph 6 of the Ahmed affidavit:] Mr. Ahmed has again perjured himself by claiming that he ‘control[s] the email accounts...namely *sette007@hotmail.com* and *muqdishofc@hotmail.com*.’ There is absolutely no argument that the Sette007 email is his own email, but Mr. Ahmed never was the creator of the *muqdishofc@hotmail.com* email nor did he have any control of it at any time. I have created the email address and gave access to all the volunteer administrators including Mr. Ahmed. [...]

[With respect to Exhibit F attached to the Ahmed affidavit:] Mr. Ahmed had lied under oath when he claimed [...] that his organization registered in Ontario in 2014 had maintained ‘presence on the Internet at *muqdishofc.com* since May 19, 2009.’” Mr. Ahmed claimed “a domain name *Muqdishofc.com* (a dormant website) that he is neither shown as the registrar of record nor had anything linking him to the site simply highlights the twisted logic used by this individual to claim ownership of my MFC through his attempt to register it as his own trademark. [...] See Exhibit K [...] for screen capture from the Internet Archives [...].”

[With respect to Exhibit E attached to the Ahmed affidavit:] This flier presented as evidence of the ‘investments’ Mr. Ahmed claimed to have made is my own flier that I have had it designed for me and I paid for it. See side by side comparison of the doctoring that was made by Mr. Ahmed as is shown in Exhibit L. [...]

[70] Commenting on the Opponent’s allegations of bad faith, the Applicant submits in its written argument that :

120. In the Second Ali Rage [164] Declaration, [the Opponent], a party who is acting *pro se*, makes accusations of bad faith in an attempt to discredit the Applicant’s witness and to damage his reputation. The Applicant notes that [the Opponent] had an opportunity to cross-examine the Applicant’s witness and chose not to take this opportunity.

121. The Applicant asks the Board to reject, utterly and completely, the allegations of fraud or bad faith on the part of the Applicant. With that said, the Applicant makes these submissions with respect to the specific assertions of bad faith raised for the first time in the reply evidence:

(a) Consultation on logo development – [the Opponent] was consulted because he was the Treasurer of Dayniile. [The Opponent’s] claim that the Applicant’s witness “is being copied in the communication solely for awareness” rings hollow.[...]

(b) Invoices – again, [the Opponent] is listed on the invoices because he was the Treasurer of Dayniile and responsible for financial matters. At all times, [the Opponent] was acting on behalf of, and for the benefit of, Dayniile.

(c) Newspaper clippings and endorsements – [the Opponent] sought out recommendation letters from local officials, including MP Kirsty Duncan [...], and post facto asked to be credited as founder of the Club, Significantly, MP Kristy Duncan refused to mention [the Opponent] in her reference letter (Exhibit D, page 3, Second Ali-Rage [164] Declaration) despite being specifically asked to do so by the Opponent (Exhibit D, page 4, Second Ali-Rage [164] Declaration).

(d) The alleged “take over attempt” described on page 2 of the Second Ali-Rage [164] Declaration is a red herring and, in any case, consists of entirely improper reply.

(e) The alleged “doctored” name change letter described on page 3 of the Second Ali-Rage [164] Declaration is also a red herring, and also consists of improper reply. The date when the decision was taken is important; not when the minutes were finalized. Even the draft offered by the Opponent (at Exhibit G of the Second Ali-Rage [164] Declaration) confirms the name change by Dayniile. Moreover, this document proves that the Opponent was active with Dayniile.

(f) [The Opponent’s] characterization that the Applicant’s witness “lied” in reference to Exhibit I on the bottom of page 3 of the Second Ali-Rage [164] Declaration is at best puzzling and at worst outrageous – Dayniile was never said to be a subsidiary of the Applicant; rather, it is a predecessor relationship. [The Opponent’s] noting of discrepancies between draft and final documents, or internal drafts such as the PowerPoint slide deck, reveal trivial differences and are not evidence of any wrong doing.

(g) [The Opponent’s] further characterization that the Applicant’s witness “perjured himself” in reference to the *mudishofc@hotmail.com* account, and his allegations with respect to the *muqdishofc.com* domain name and other marketing materials are also troubling and without support and even if true, not at all probative. At the time he made his affidavit, Mr. Ahmed controlled the hotmail account. As well, the *archive.org* page shows that the Applicant’s website, which has been updated over time, was first captured in June 2009 and corroborates the Applicant’s claimed first use date in 2009 (at Exhibit K of the Second Ali-Rage [164] Declaration).

122. The Applicant has attempted to address, at least in part, the assertions raised by the Opponent for the first time in the reply evidence. However, the Applicant submits that all the above information should have been led in the first instance and it would be improper to accept it as reply evidence. The Applicant submits that the only admissible material led by the Opponent is a one page document containing bald assertions of competing ownership and entitlement [the First Ali-Rage [164] Declaration].

[71] I agree with the Applicant that the Opponent's purported reply evidence is not admissible.

[72] As stressed by the Applicant, the purpose of reply evidence under section 43 of the Regulations is not to correct or complete the Opponent's evidence in chief under section 41 of the Regulations. Rather, reply evidence must be "strictly confined to matters in reply". I further note that if an opponent is uncertain about whether its evidence constitutes proper reply, it is able to request leave to file additional evidence under section 44 of the Regulations. However, no such request was made by the Opponent in this case.

[73] Justice Pelletier in *Halford v Seed Hawk Inc* (2003), 2003 FCT 141 (CanLII), 24 CPR (4th) 220 (FCTD) provides the following guidelines as to what constitutes proper reply evidence:

15. [...], I believe that the following principles govern the admissibility of reply evidence:

1- Evidence which is simply confirmatory of evidence already before the court is not be [sic] allowed.

2- Evidence which is directed to a matter raised for the first time in cross-examination and which ought to have been part of the plaintiff's case in chief is not be [sic] allowed. Any other new matter relevant to a matter in issue, and not simply for the purpose of contradicting a defence witness, may be allowed.

3- Evidence which is simply a rebuttal of evidence led as part of the defence case and which could have been led in chief is not be be [sic] admitted.

16. To these principles, I add one further. Evidence which is excluded because it should have been led as part of the plaintiffs' case in chief will be examined to determine if it should be admitted in the exercise of my discretion.

[74] It is true that the mere fact that the evidence was available at the time of filing the evidence in chief does not preclude the admissibility as reply evidence. Still, a party is not entitled to split its case [see *Halford, supra*].

[75] In the present case, the first and last parts of the Second Ali-Rage 164 Declaration essentially consist of arguments and criticisms for the purpose of contradicting Mr. Ahmed's testimony and the middle part of the Second Ali-Rage 164 Declaration is basically identical to the Ali-Rage 165 Declaration that was filed as the Opponent's evidence in chief with respect to application No. 1,679,165. As such, the Second Ali-Rage 164 Declaration does not relate to anything new or unanticipated and could have been filed as the Opponent's evidence in chief under section 41 of the Regulations.

[76] In any event, whether it is proper reply or not, I do not consider it to be of much assistance to the Opponent for the same reasons as those given above with respect to the Ali-Rage 165 Declaration. As evidenced by the Ahmed affidavit and supporting exhibits, the Opponent was a coach and Treasurer of Dayniile when the Marks were adopted by Dayniile back in March 2009 [as per Exhibits B and C attached to the Ahmed affidavit]. Far from contradicting this, the Opponent's evidence confirms the name change by Dayniile [see Exhibit G attached to the Second Ali-Rage 164 Declaration according to which "Starting today [March 23, 2009], we (committee of Dayniile Team) changed the team name to MUQDISHO FC"]. More importantly, the Opponent's evidence fails to establish that, at the time Dayniile's team name was changed to "Muqdisho Football Club", the Opponent was the "rightful owner" of the MUQDISHO FOOTBALL CLUB trade-mark and/or logo and/or trade-name and was using them for his own benefit. Rather, there was only one non-profit organization named "Muqdisho Football Club", apparently belonging to Dayniile, and to which the Opponent was actively contributing together with the other representatives/volunteers of the Applicant's predecessor in title.

[77] I say "apparently" because the Opponent's assertions (in both the Ali-Rage 165 Declaration and the Second Ali-Rage 164 Declaration) that Dayniile's team name change to "Muqdisho Football Club" was "specific to the tournament [organized by SOSCA and TODAY in June/July 2009]" and consisted of "a permission granted for MFC to adopt the Dayniile FC name" are unsupported by corroborating exhibits. Likewise, the Opponent's assertions that he had, at the time, put together a so-called "volunteer administrators" or "organization" separate and distinct from that of Dayniile are unsupported by persuasive exhibits. By contrast, I find that, at least at the time Dayniile's team name was changed to "Muqdisho Football Club", the Applicant's position that the Opponent's use of the Marks did not constitute an exercise of

independent rights in the Marks to be supported by more compelling evidence, and not directly contradicted by any of the exhibits led by the Opponent.

Conclusion – *Re* Has the Opponent met his evidentiary burden?

[78] In view of all the foregoing, I am not satisfied that the Opponent has met his evidentiary burden with respect to the pleaded ground of opposition in each case.

[79] Accordingly, the section 16(1) ground of opposition is rejected in each case.

DISPOSITION

[80] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject both oppositions pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

No agent

FOR THE OPPONENT

Chumak & Company LLP

FOR THE APPLICANT