

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 51

Date of Decision: 2020-03-31

IN THE MATTER OF AN OPPOSITION

WIGUP CORP.

Opponent

and

Wigu City Edutainment Centers Ltd.

Applicant

1,701,415 for WIGU CITY

Application

[1] WIGUP CORP. (the Opponent) opposes application no. 1,701,415 (the Application) for registration of the trademark WIGU CITY (the Mark) filed by Wigu City Edutainment Centers Ltd. (the Applicant).

[2] For the reasons that follow, the opposition is successful.

THE RECORD

[3] The Application was filed on November 5, 2014. It is based on proposed use of the Mark in Canada in association with the following goods:

Puzzles, uniforms, namely role-playing uniforms for various professions, namely policeman, fireman and nurse, t-shirts, hats, pens, cups, plates, glasses, buttons, dresses, plush toys, bags, namely carrying bags, tote bags, shopping bags and accessory cases, photographs, pins, fridge magnets, pencils, picture frames, hair clips, make-up, clips, note pads, paper clips, erasers (the Goods);

and the following services:

(1) Provision of leisure, entertainment and education facilities arranged at theme parks, indoor theme parks and amusement parks; providing an interactive website featuring an electronic replica of a real theme park or amusement park plus various interactive games for children and providing information for parents and children with respect to parenting issues, mental health issues, personal development, academic development and other personal interest content, namely, content pertaining to children's development and future career opportunities and prospects; providing online interactive games (the Services).

[4] The Application was advertised in the *Trademarks Journal* on December 30, 2015 for the purposes of opposition.

[5] On February 26, 2016, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. All references to the Act in these reasons are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition, which refer to the Act as it read immediately before it was amended (see the transitional provisions in section 70 of the Act, which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before that date).

[6] The grounds of opposition originally pleaded were based on sections 30(a), (e), (g) and (i) (compliance), 12(1)(d) (registrability), 16(3)(a) and (c) (entitlement), and 2 (distinctiveness) of the Act as it read immediately before June 17, 2019. In its written argument, the Opponent withdrew the grounds based on sections 30(a), (e) and (g), which was confirmed at the hearing.

[7] The opposition is based primarily on the Opponent's allegation that the Mark is confusing with its registered trademarks WIGUP and WIGUP THE CREATIVE SOCIAL NETWORK FOR SCHOOLS & Design (the WIGUP Registered Trademarks), its trademark and domain name WIGUP.TV (the WIGUP.TV Trademark), and its trade name WIGUP CORP. (the WIGUP Trade Name), all used in Canada in association with an educational online platform for students aged 9 to 14 and the related goods and services set out in Schedule A hereto.

[8] The Applicant filed a counter statement on June 16, 2016, denying each of the grounds of opposition.

[9] Only the Opponent filed evidence, which consists of the statutory declaration of Mark Chatel, dated January 12, 2017. Mr. Chatel was not cross-examined on his declaration. The Opponent's cover letter submitting the Chatel declaration also invites the Registrar to visit certain webpage addresses provided in the declaration; however, as I noted at the hearing, the Registrar has no authority to do so.

[10] Only the Opponent filed written arguments, but both parties were represented at an oral hearing.

PRELIMINARY MATTER: LEAVE TO FILE ADDITIONAL EVIDENCE REFUSED

[11] On January 17, 2020, the Applicant requested leave to file, as additional evidence, an affidavit of its trademark agent's articling student, Gurbinder Dhaliwal, affirmed January 15, 2020. The affidavit seeks to introduce a printout made that day of a webpage from the Opponent's website at *www.wigup.tv*. The Opponent objected to the leave request by way of a letter dated January 27, 2020. On January 31, 2020, I refused leave in accordance with section 55 of the *Trademarks Regulations*, SOR/2018-227 (the Regulations). At the hearing, I indicated that my reasons for refusing leave would follow with the final decision on the merits of the opposition, and these reasons are now set out below.

[12] As is explained in the practice notice *Practice in Trademark Opposition Proceedings*, leave to file additional evidence will only be granted if the Registrar is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances, including (1) the stage the opposition proceeding has reached; (2) why the evidence was not submitted earlier; (3) the importance of the evidence; and (4) the prejudice which will be suffered by either party [*McDowell v Automatic Princess Holdings, LLC*, 2015 FC 980; and *Dairy Processors Association of Canada v Dairy Farmers of Canada*, 2014 FC 1054].

The stage the proceeding has reached

[13] In the present case, the request for leave was made at a very advanced stage of the proceeding: two weeks before the oral hearing. The Applicant's deadline to file evidence had

expired almost three years earlier (on May 16, 2017) and, at that time, the Applicant had filed a statement that it does not wish to submit evidence (on May 10, 2017).

Why the evidence was not submitted earlier

[14] The Applicant states that the evidence was not submitted earlier because, although its agent remains the same, there was a “recent” change in the professional overseeing the matter. The Applicant adds that it is “unclear” whether the evidence was available during the evidentiary stage of the proceeding, but does not specify the reason for its uncertainty. In the circumstances, it would appear that the decision to seek leave to submit this evidence represents a change in the Applicant’s strategic direction two weeks before the hearing.

The importance of the evidence

[15] According to the Applicant, the proposed evidence “relates to the Opponent’s own admission as to what WIGUP stands for” and will “assist the Applicant in defending its position in this opposition proceeding”. However, I note that the webpage sought to be introduced is not attested to by a representative of the Opponent or someone who would otherwise have first-hand knowledge regarding its content. Furthermore, the proposed evidence does not indicate whether this content was available before January 15, 2020. As such, the proposed evidence could only be considered with respect to the section 12(1)(d) ground of opposition, as it postdates the material date for the other grounds. More importantly, to the extent that the webpage is intended to show how an average consumer would respond to the Opponent’s trademark, only limited weight could be given to this evidence, for reasons that will be discussed below.

The prejudice which will be suffered by either party

[16] The Applicant submits that it will be prejudiced if leave is denied because “public admissions by the Opponent will not be available to the Board when it hears oral submissions and renders its decision”. The Applicant submits that there will be no prejudice to the Opponent if leave is granted because the Opponent was aware of the existence of the evidence, given that it is drawn from the Opponent’s own, publicly accessible website. The Applicant also confirms that the affiant would be made available for cross-examination.

[17] The Opponent submits that the Applicant will *not* be prejudiced if leave is denied, because (i) the purpose of the proceeding is not to question the validity of the Opponent's trademark and (ii) during the evidence stage the Applicant had the opportunity to cross-examine the Opponent on the meaning of its trademark. With respect to being prejudiced itself, the Opponent contends that the purpose of the proposed evidence is simply to thwart ("*nuire à*") the course of the proceeding. In this respect, the Opponent submits that an applicant who has not filed any evidence or written arguments in the normal course of the proceeding should not be permitted to introduce evidence for the first time at the hearing stage.

[18] Although I accept that the Opponent would be aware of its own webpages' existence and would be able to access them, I am not satisfied that the Opponent would have been aware of the need to address this particular webpage during the proceeding, particularly given the Applicant's explicit statement at the evidence stage that it does not wish to file evidence. The resulting prejudice to the Opponent could be mitigated by granting leave to cross-examine the affiant, to produce reply evidence, and to submit additional written arguments, while also postponing the hearing of this matter so that the entire evidentiary record and additional written submissions may be addressed. However, such steps would significantly delay the proceeding, which had already taken five years to reach the stage of the scheduled hearing. Furthermore, this delay would prolong the uncertainty over the fate of the Application and the registrability of the Mark, both for the Opponent and for any interested third parties.

[19] The prejudice to the Applicant is tied to the importance of the evidence. However, as I mentioned at the hearing, refusal of the proposed evidence does not preclude the Applicant from making oral submissions on the meaning of the Opponent's trademarks to the average consumer.

The interests of justice

[20] Considering that the proceeding is at a very late stage, that the Applicant has failed to adequately explain why the proposed evidence was not filed earlier, and that mitigating the potential prejudice to the Opponent would significantly delay the proceeding, I have concluded that it is not in the interests of justice to grant leave to file the affidavit of Gurpinder Dhaliwal in the present case. I find that the importance of the proposed evidence—which appears to be limited—does not outweigh the prejudice that would be occasioned to the Opponent by delaying

a final outcome in this case. In addition, I do not consider a change in a party's case strategy in the days leading up to the hearing to be a sufficient justification for returning to the evidence stage in the present circumstances. In view of the foregoing, the Applicant's request for leave to file the affidavit of Gurbinder Dhaliwal has been denied.

[21] I would note that, even if I had accepted the proposed evidence, it would not have affected the outcome of my decision, for reasons that will be discussed below.

EVIDENTIARY BURDEN

[22] The legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, there is an initial evidential burden on the opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist. For a ground of opposition to be considered at all, the opponent must meet its evidential burden. If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition pleaded should not prevent the registration of the trademark at issue [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155]. 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.

30I GROUND OF OPPOSITION BASED ON COMPLIANCE WITH SECTION 30(I)

[23] The Opponent pleads that the Application does not conform to the requirements of section 30(i) of the Act because, at the Application's filing date and at all other times, the Applicant could not be satisfied of its entitlement to use the Mark in Canada in association with the Goods and Services, since the Mark is confusing with the WIGUP Registered Trademarks, the WIGUP.TV Trademark, and the WIGUP Trade Name.

[24] Section 30(i) of the Act only requires an applicant to declare itself satisfied that it is entitled to use its trademark in Canada in association with the goods and services described in the application. The existence of an allegedly confusing trademark or trade name does not preclude

an applicant from making the required statement, since the applicant may nevertheless be satisfied of its own entitlement to use the trademark it is applying to register. Accordingly, where, as here, the required statement is included in the application, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud on the part of the applicant is alleged, or where federal legislation arguably prevents the registration of the mark [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)].

[25] In the present case, there are no allegations of that nature in the statement of opposition and there is no evidence in the record to that effect. Consequently, the ground of opposition based on section 30(i) of the Act is dismissed, as the Opponent has failed to meet its initial burden.

S12 GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)

[26] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act because, at the Application's filing date and at all other times, the Mark was confusing and is likely to cause confusion with the Opponent's trademarks WIGUP, registered under no. TMA778,651, and WIGUP THE CREATIVE SOCIAL NETWORK FOR SCHOOLS & Design (WIGUP Logo), registered under no. TMA883,802.

[27] The relevant date for the analysis of a section 12(1)(d) ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[28] The Opponent's initial burden for this ground is met if at least one of the registrations relied upon is in good standing at the relevant date. The Registrar has discretion to check the register in this respect [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I confirm that both of the registrations are extant and stand in the name of the Opponent.

[29] The Opponent having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's registered trademarks.

The test for confusion

[30] The test for confusion is outlined in section 6(2) of the Act, which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[31] This test does not concern confusion of the trademarks themselves, but rather confusion as to whether the goods and services associated with each of the trademarks come from the same source. It is described in the following terms by Justice Binnie in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, at paragraph 20:

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

[32] Some of the surrounding circumstances to be taken into consideration when determining whether trademarks are confusing are set out in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services, or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot, supra*; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Degree of resemblance between the trademarks

[33] As indicated by the Supreme Court of Canada in *Masterpiece, supra*, in most instances, the degree of resemblance between the trademarks is the most important factor in assessing the likelihood of confusion. One must consider resemblance from the perspectives of appearance, sound, and ideas suggested. The preferable approach is to begin by determining whether there is

an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra*, at para 64]. In this respect, the first portion of a trademark is generally considered to be the most important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Éditions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, it is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [see *Veuve Clicquot, supra*].

[34] As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at paragraph 34,

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole [citations omitted].

[35] In the present case, the Opponent submits that there is a striking resemblance between the trademarks at issue because the only distinctive element of the Mark—WIGU—is virtually identical to WIGUP and to the dominant element of the WIGUP Logo. The Opponent submits that the addition of the word CITY is not sufficient to distinguish the Mark, since CITY refers to the physical and virtual theme parks that the Applicant intends to operate and suggests a natural extension of the Opponent’s services. In the Opponent’s submission, since Internet and virtual games have propagated the idea of virtual cities, it would be natural to assume that “WIGU CITY” is simply another, city-themed offering in the Opponent’s “WIGUP” line.

[36] The Applicant submits that WIGU is not virtually identical to WIGUP, because the latter would be perceived as a combination of the dictionary words “wig” and “up” and would be sounded as such, while WIGU suggests no particular idea and would be sounded differently, *i.e.* as “why-goo”. The Applicant submits that trademarks differing by a single letter have, in the past, been held not to be confusing, and cites as an example the decision in *9013-0501 Quebec Inc v Gen-X Sports Inc* (2008), CPR (4th) 434 (TMOB), where the trademark RAGE was held not to resemble the trademark ORAGE. The Applicant also emphasizes that there is more than a single letter difference in the present case: the Opponent’s trademark is one word—WIGUP—whereas the Mark comprises two words—WIGU and CITY.

Resemblance between the Mark and WIGUP

[37] I find that the most striking and unique aspect of the Mark is indeed the first portion, the coined word WIGU. The word CITY is an ordinary dictionary word and as such does not stand out to the same extent. As noted by the Opponent, the only difference between this dominant WIGU element and WIGUP is in the presence or absence of the final letter P, resulting in a high degree of resemblance in appearance. Furthermore, neither WIGU nor WIGUP suggests any particular idea that might serve to differentiate WIGU CITY from WIGUP.

[38] With respect to resemblance when sounded, I am not convinced that the average consumer would necessarily break the word WIGUP down into the individual words “wig” and “up”, particularly when the Opponent’s goods and services have no connection to wigs. The fact that the trademark is indexed for search purposes in the Canadian Trademarks Database as both “WIGUP” and “WIG UP”—as noted by the Applicant—is not determinative of how the trademark will be perceived by the average consumer in the marketplace. In my view, it is at least as likely that an anglophone consumer would perceive WIGUP as a coined word and pronounce it “why-gupp” or “why-goop”, while pronouncing WIGU as “why-goo” or “why-gyoo”. Moreover, I must consider not only the perspective of the unilingual anglophone or bilingual consumer but also that of the unilingual francophone consumer. In this respect, there is no indication that a unilingual francophone consumer would likely perceive WIGUP as a combination of the English words “wig” and “up” or to pronounce it “wigg-up”. Rather, I agree with the Opponent’s submission at the hearing that a unilingual francophone consumer would more likely pronounce WIGUP as “wee-gupe” (« *oui-gupe* ») and WIGU as “wee-gu” (« *oui-gu* »), resulting in a high degree of resemblance when sounded.

[39] With respect to the Applicant’s citation of *GEX-X Sports*, I do not find the situation in that case to be analogous. In *GEX-X Sports*, the trademarks RAGE and ORAGE were differentiated on the basis of a difference in ideas suggested: RAGE referred to a state of extreme anger whereas ORAGE referred to a storm (in French) or appeared to be an invented word (in English). In any event, the application was ultimately refused for certain goods based in part on the visual resemblance between the two trademarks and their phonetic resemblance in French. In

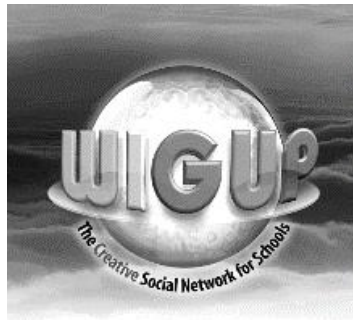
the present case, the words WIGU and WIGUP do not appear to differ conceptually and there is no basis on which to find that they would not be pronounced similarly, at least in French.

[40] As I noted above, the Applicant requested leave to file a printout from the Opponent's website as evidence that WIGUP is an acronym, and that request was denied. However, even if this evidence were of record, it would not change the outcome of my analysis, since there is no basis for a conclusion that consumers of the parties' goods and services would be aware of the proposed meaning. In particular, there is no evidence that consumers are likely to consult the webpage in question—which suggests that WIGUP is short for “While I Grow UP”— and no evidence that WIGUP is otherwise a known acronym or abbreviation, in the field of children's education and development or otherwise. In addition, although the Applicant submits that the word WIGU is coined, there is no evidence to suggest that those consumers who might read and remember WIGUP as an acronym, if any, would not read WIGU in a similar way, particularly given that the initial letters in “While I Grow Up” are only W, I, G and U.

[41] The addition of the word CITY lengthens the Mark in appearance and when sounded; however, the idea suggested by the combination WIGU CITY is merely that of a city named “WIGU”. The nature of the Goods and Services reinforces this notion. The Services are centred on theme parks, amusement parks and interactive games, which could be set in a pretend city. The Goods include items that could act as souvenirs of a city visit (photographs, pins, fridge magnets etc.), as well as role-playing uniforms for careers relating to the life and function of a city (policeman, fireman, nurse) and informational services that could pertain to such careers. In my view, this context creates the impression that WIGU is a city (perhaps a fictional one) or that WIGU CITY is a city-themed version of WIGU parks, games and educational products and services. Similarly, to the extent that aspects of the Opponent's social network service and media content may have as their theme a community, a city or the like, the word WIGUP could give the impression of being a place name. As a result, I find that the addition of the word CITY does not significantly diminish the resemblance between the trademarks WIGU CITY and WIGUP in the present case.

Resemblance between the Mark and the WIGUP Logo

[42] With respect to the WIGUP Logo, it consists of the word WIGUP—in large capital letters with beveled edges—standing on what looks like a planetary ring, curving around the front of a textured globe. The phrase THE CREATIVE SOCIAL NETWORK FOR SCHOOLS in small lettering appears along the globe’s bottom edge and the entire design is set against a cloudscape. This logo is reproduced below:



[43] In my view, the most striking feature of the WIGUP Logo is the combination of the word WIGUP and the fanciful, planet-like globe. I do not consider the phrase THE CREATIVE SOCIAL NETWORK FOR SCHOOLS to contribute significantly in terms of appearance or ideas suggested, given that it is in small print and describes the nature of the services offered under the mark. I also consider it likely that at least some consumers will identify the logo by sounding only the dominant WIGUP element.

[44] Despite the added word and design elements in the WIGUP Logo, it and the Mark suggest similar ideas, in that both the planet design and the word CITY represent a geographic area. To the extent that consumers may perceive the WIGUP Logo as denoting a WIGUP-brand service that involves a pretend world or activities on a global scale, they may perceive WIGU CITY as denoting a WIGU-brand good or service that involves a pretend city within a larger world or activities on a municipal scale. Bearing in mind the visual and phonetic similarities between the striking and unique WIGUP and WIGU elements, as well as the notional relationship between a globe and a city, I find there to be a significant degree of resemblance between the Mark and the WIGUP Logo.

[45] Given the significant degree of resemblance between the parties' trademarks in appearance, in sound and in the ideas suggested by them, this factor favours the Opponent in respect of both its word mark and the WIGUP Logo.

Inherent distinctiveness of the trademarks and the extent to which they have become known

[46] Distinctiveness has to be assessed in the context of the goods and services in question [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327]. Considered in this light, the Mark possesses a high degree of inherent distinctiveness owing to the coined element WIGU, although the addition of the word CITY makes the Mark as a whole at least somewhat suggestive of the nature of the Applicant's goods and services, to the extent that they can be set in a pretend city.

[47] I consider the Opponent's WIGUP trademark to also possess a high degree of inherent distinctiveness, given that it is a single coined word having no readily apparent meaning in relation to the Opponent's goods and services, being a social network for schools and related goods and services.

[48] Had I granted the Applicant leave to file evidence that WIGUP is an acronym, it would not have changed my opinion. I appreciate that acronyms consisting mainly of one or more letters of the alphabet are generally considered to possess a low degree of inherent distinctiveness, as noted in *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD). However, given the length and pronounceability of "WIGUP", I consider it more likely to be perceived as an invented word than as a mere combination of letters of the alphabet. Moreover, this would not be a case where the letters stood for a descriptive corporate name or professional designation, as was the case in *GSW* and the other cases cited by the Applicant on this point.

[49] I consider the WIGUP Logo to possess a higher degree of inherent distinctiveness, owing to its fanciful arrangement of design elements. Although the design as a whole suggests a global setting, I find that this allusion is made in an inventive manner, in contrast to the mere addition of an ordinary dictionary word like "world" or "city".

[50] The degree of distinctiveness of a trademark can be enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW, supra*]. Only the Opponent filed evidence in this respect. It consists of the statutory declaration of Mark Chatel, founder and president of the Opponent and of the Opponent's predecessor in title, Balestra Productions Inc. (Balestra).

[51] In his affidavit, Mr. Chatel states that the WIGUP trademark was assigned from Balestra to the Opponent after the registration date of September 30, 2010 [at para 5]. Indeed, an assignment of the WIGUP registration from Balestra to the Opponent was recorded on November 25, 2010; however, the register shows the date of the actual change in title as September 13, 2010. In addition, Mr. Chatel has not explained why a BALESTRA logo appears on the WIGUP user guides attached to his affidavit, which appear to have been published after 2010 (see below). However, nothing turns on these apparent discrepancies.

[52] The most relevant portions of Mr. Chatel's evidence on use and promotion of the WIGUP Registered Trademarks in Canada can be summarized as follows:

- 1) Twelve schools participated in a pilot project for the WIGUP platform in 2010 [para 12; Exhibit P-3.a)]. However, Mr. Chatel does not indicate whether or how either registered trademark was used during the pilot project.
- 2) Two user guides for the WIGUP platform were produced in partnership with the Association Canadienne en Éducation de Langue Française (ACELF) and published on the association's website [para 11; Exhibits P-3.a), P-3.b)]. The first of these guides invites school representatives to register for, and create a school profile on, the *www.wigup.tv* website that would soon be launched as the WIGUP platform; the second provides guidance for teachers on doing student projects with the platform's e-portfolio tool, used to create multimedia presentations combining text, images, photographs, animations, sound, music and videos. Both guides are undated; however, Mr. Chatel states that they were funded in 2012. The WIGUP trademark is prominently displayed on each guide's cover page (across a hot air balloon design) and in its page headers.

- 3) The WIGUP trademark is prominently displayed in the page headers of both the English and French versions of the *www.wigup.tv* website; in addition, the WIGUP Logo is prominently displayed at the top of the English homepage and on various other pages of the site, including the pages ABOUT WIGUP.TV, INFO, APPROACH, F.A.Q., CLIPS and CONTACT US [para 7; Exhibit P-1]. The screenshots of these pages at Exhibit P-1 are dated January 11, 2017; however, in addition, a screenshot of the French homepage appears at Exhibit P-6, in a June 2014 report on the WIGUP project by the Canada Research Chair on Technologies in Education at the University of Montreal (Canada Research Chair). The latter screenshot shows that the WIGUP trademark was displayed on the website—or at least on its homepage—in substantially the same way in 2014 as it was in 2017.
- 4) Although the Canada Research Chair’s June 2014 report on the WIGUP project was produced by a third party, Mr. Chatel explains that the Opponent played a role in the report’s development, in that he accompanied the report’s author on school visits and answered his questions; Mr. Chatel also states that the Opponent provides a link to the report on its website [para 20; Exhibit P-6]. This report is based on a winter 2014 case study of two Ontario classrooms using the WIGUP platform for entrepreneurial projects to provide aid in their communities and elsewhere in the world. An image of the WIGUP trademark—in the same lettering as the WIGUP Logo—is displayed on the cover and first page of the report, as well as in the screenshot of the French homepage on page 3.
- 5) In addition, at Mr. Chatel’s request, made to promote WIGUP, an article on the WIGUP project (authored by the holder of the Canada Research Chair) was published in the Association Canadienne d’Éducation’s journal *Pour favoriser le développement de compétences entrepreneuriales des élèves* in winter 2016 [para 9; Exhibit P-2]. The article’s footnotes appear to contain a link to the author’s website for accessing the full report.
- 6) On October 23, 2015, the Opponent, in partnership with the University of Ottawa and the Conseil des Écoles Publiques de l’Est de l’Ontario, launched a WIGUP research chair on the integration of educational technologies, whose objective is a five-year study of the

WIGUP teaching approach; the event was advertised on the university's online calendar [paras 18–19; Exhibit P-5.a)]. I note that the advertisement does not directly reference the platform or any of the goods or services in association with which the WIGUP trademark is registered. Mr. Chatel's states that a video of the event recorded by the Opponent may be viewed on the *www.wigup.tv* website; however, as I noted at the hearing, although Mr. Chatel's declaration includes a link to the relevant webpage, neither that webpage nor the video itself is furnished as evidence in this proceeding.

- 7) In 2015 and 2016, the Opponent participated at conventions on education in several provinces, including Québec, Alberta and Ontario, where it presented workshops for teachers, school principals, and educational advisors [paras 16–17]. Mr. Chatel states that, following each convention, teachers asked their managers to subscribe to the platform—although this statement appears to be hearsay, I find it reasonable to infer that the Opponent's presentations were made to promote WIGUP subscriptions and that teachers would have been shown the website to which they could subscribe.
- 8) Ontario's Education Minister has been financially supporting the purchase of licences to access the WIGUP platform for all of the province's school boards and has obtained a licence allowing all francophone students in Ontario to access the platform [para 25]. In addition, at the time of Mr. Chatel's declaration, negotiations for the purchase of student licences were underway with the provincial school boards of Manitoba, Newfoundland and Labrador, Québec and Alberta [para 15]. Again, I find it reasonable to infer that representatives of these school boards would have been shown the website in respect of which they were negotiating.
- 9) At the time of Mr. Chatel's declaration, the WIGUP platform reached 100,000 francophone youth in Ontario and 50,000 youth in other provinces, including Manitoba, Newfoundland and Labrador, Québec and Alberta [para 25].

[53] Mr. Chatel does not specify how well the above-mentioned promotional events were attended or to what extent the exhibited materials were distributed or accessed online.

Nevertheless, given the evidence of schools subscribing to and using the platform, I am prepared to infer that the promotional materials reached at least some Canadian education professionals

and that the platform has been accessed by a fair number of students over the years, along with their parents and teachers.

[54] I would also note that Mr. Chatel speaks to there being various prestigious supporters of the WIGUP platform, for example, a vice-rector and dean from the University of Ottawa participating in the launch of the WIGUP research chair [para 19; Exhibit P-5.a)]; national and international celebrities providing web interviews posted on the WIGUP platform [para 21]; and recognition of the platform by the Clinton Global Initiative in New York [para 24]. However, as discussed above, confusion is to be assessed from the point of view of the average consumer, and there is no indication of the extent to which such interest and support has increased awareness of the WIGUP trademarks among Canadian consumers of the Opponent's goods and services.

[55] Similarly, although Mr. Chatel also states that the Association Canadienne des Professeurs en Immersion (ACPI) and Canadian Parents for French (CPF) promote the WIGUP platform among teachers and parents respectively [paras 14–15], there is no evidence of how such activity may have increased awareness of the WIGUP Registered Trademarks. In particular, there is no evidence of how either WIGUP Registered Trademark has been displayed in promotions involving these organizations and no indication as to which of the Opponent's goods and services relating to the WIGUP platform were advertised.

[56] In view of the foregoing, I find that the Opponent's Registered Trademarks have each become known to some extent in Canada in connection with the Opponent's services relating to the provision of an online education platform and social network for students aged 9 to 14. Conversely, there is no evidence of the Mark having become known in Canada to any extent.

[57] Overall, this factor favours the Opponent with respect to both the WIGUP trademark and the WIGUP Logo.

Length of time the trademarks have been in use

[58] Although Mr. Chatel's evidence could have been more precise regarding dates of first use, I am satisfied that each of the Opponent's Registered Trademarks has been used in Canada for several years, starting with the word mark. Conversely, there is no evidence that the

Applicant has commenced use of the Mark in Canada. Accordingly, this factor favours the Opponent with respect to both the WIGUP trademark and the WIGUP Logo.

Nature of the parties' goods, services, and trades

[59] When considering the nature of the goods and services and the nature of the parties' trades under section 12(1)(d) of the Act, it is the statement of goods and services as defined in the applicant's application and the statement of goods and services in the opponent's registration that must be assessed, having regard to the channels of trade that would normally be associated with such goods and services [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The statements must 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; evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd*, 1999 CarswellNat 3465 (TMOB)].

[60] Furthermore, it is settled law that where it is likely to be assumed that the applicant's goods or services are approved, licensed, or sponsored by the opponent, so that a state of doubt and uncertainty exists in the minds of the purchasing public, it follows that the trademarks are confusing [*Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD); see also *Conde Nast Publications Inc v Gozlan Brothers Ltd* (1980), 49 CPR (2d) 250 (FCTD); and *Courvoisier International SA v Paragon Clothing Ltd* (1984), 77 CPR (2d) 168 (TMOB)].

[61] The Opponent's WIGUP trademark is registered for use in association with interactive teaching and training games and the operation of an Internet site involving online discussion forums; interactive video games; broadcasting and sale of interviews, films, reports, and televised documentaries and shows; dissemination of multimedia content; and online sale of MP3s, music, pre-recorded compact discs and books.

[62] The services with which the WIGUP Logo is registered can be generally described as the provision of educational software and social networking services in the nature of online virtual communities for registered users—including web facilities; online forums and databases; chat

rooms and electronic bulletin boards; streaming video; and peer-to-browser sharing services for pictures, videos and e-portfolios—to be used for school projects, school activities, personal profiles, interactive discussions and virtual communication, all in the field of primary and secondary school life (including athletics, entertainment, arts, fundraising, and academics), as well as online forums on best practices for teachers.

[63] As described by Mr. Chatel, these services are provided through an educational online platform for helping youth ages 9–14 discover who they are in life so that they may make enlightened career choices and thus fully contribute to society [para 4]. Youth are given the tools to publish photos, blogs, videos and e-portfolios; produce career interviews with celebrities in their community; and do entrepreneurial projects to help causes of their choice [para 27]. The platform features web interviews recorded by dozens of national and international celebrities from all areas of society to inspire youth in their career choices [paras 21–22]. The platform also features over 2000 short documentaries in the fields of arts, sciences, entrepreneurship, traditions, adventures in exploration etc. [para 23].

[64] Indeed, on the *www.wigup.tv* homepage, the cloudscape surrounding the WIGUP Logo includes additional globes topped with banners for NEWS, SCIENCE, ADVENTURES, SPORTS, ENTREPRENEURS, ARTS and TRADITIONS, flanked by links for students on one side and for teachers on the other, including VIDEO, BLOG, E-PORTFOLIO, IWB (presumably for Interactive White Board), and WEB INTERVIEWS, among others [Exhibit P-1]. I note that the website's page header features the slogan "Discover who you are" and the banner for pages in the WHO WE ARE section specifies that the site was conceived to inspire youth to "become who they really are" [Exhibit P-1].

[65] I would also note that features of the platform are advertised in the user guides for the site and in the report published by the Canada Research Chair. Both mention how the platform inspires youth to be engaged in the community, including through fundraising [Exhibits P-3.a), P-3.b), P-6]. The user guides specifically advertise games and activities, videos, reports, webisodes, webzines, blogs, news bulletins, and bulletin boards; the ability to create news reports and multimedia e-portfolios; and the provision of teachers' guides and bulletin boards [Exhibits P-3.a), P-3.b)]. The Canada Research Chair's report explains how the platform inspires

youth to become who they really are through the presentation of videos, webisodes, reports and school projects, noting also the applications for interactive white boards, and the ability to view short videos and web-interviews with celebrities [Exhibit P-6]. The article based on this report notes the project's support of "students' personal development, self-discovery and entrepreneurial skills through a variety of online tools – including videos, web interviews, webisodes and interactive whiteboard applications" [Exhibit P-2].

[66] There is no evidence regarding the nature of the Applicant's business or its channels of trade. However, the Applicant submits that there is no overlap in the nature of the parties' goods and services or in their channels of trade because it is clear from the wording of the Application that the Goods and Services are tied to theme parks, in a physical setting, in contrast to the Opponent's services, which are provided online to a niche market—the school setting. The Applicant submits that there is no suggestion that the Goods and Services target the school setting and no evidence that the Opponent's services have been distributed or have become known *outside* of that particular setting. To the extent that some of the services in the Opponent's registrations, such as the broadcasting services, have a broader definition, the Applicant submits that they do not intersect with any of the Goods or Services.

[67] Conversely, the Opponent submits that it can be readily inferred from the wording of the Application that both parties' goods and services (i) target the same markets, namely children and their teachers and parents, (ii) employ the same methods, namely a website and interactive games, and (iii) deal with the same subject matter and objectives, namely providing information on children's personal and academic development and career opportunities. The Opponent characterizes the Applicant's parks as mere vehicles for its awareness raising services and transmission of information to parents. In the Opponent's submission, the Applicant's costumes help children gain familiarity with certain professions through role play while its puzzles and other products are clearly only ancillary accessories and promotional items. The Opponent further submits that, since the Goods and Services are to help youth make career choices, they will be of interest to various education professionals.

[68] The Opponent also emphasizes that, although the WIGUP platform is geared mainly towards school networks, it is used by young students and, as noted by Mr. Chatel and the first

user guide, it is the students' parents who must create their child's personal account [para 12; Exhibit P-3.a)]. The Opponent submits that parents can therefore also be expected to accompany their child on the platform in schoolwork, personal development, and career exploration.

[69] I agree with the Opponent that there is overlap in the nature of the parties' goods and services. The Applicant's Services specifically include education facilities, an interactive website, and the provision of information for parents and children on topics including personal development, academic development, and future career opportunities and prospects. Moreover, the wording of the Application could be interpreted as specifying that the interactive website is what provides the information for parents and children, in addition to replicating a theme park or amusement park and providing interactive games. Indeed, the Application specifies that the physical "education facilities" are arranged at theme parks or amusement parks.

[70] The Applicant furnished no evidence to suggest that the themes of its parks would differ from those of the WIGUP platform and, in any event, the Application is broad enough to cover similar themes. In particular, in my view, the information topic "career opportunities and prospects" listed in the Application is closely related to the Opponent's themes of "Discover who you are" and inspiring schoolchildren to "become who they really are". Indeed, Mr. Chatel confirms that aspects of the WIGUP platform, including the web interviews and short documentaries, aim to inspire career choices [paras 21-23]. As for the Applicant's information on parenting issues, mental health issues, personal development, and academic development, I consider there to be a potential for overlap between such information and that provided through the Opponent's online forums for "school best practices in the field of education".

[71] With respect to the Applicant's leisure and entertainment services and online interactive games, nothing restricts them from also being educational and informative. Indeed, the statement of Services could be interpreted to mean that the Applicant's park facilities are simultaneously for leisure, entertainment and education; the Applicant did not provide any evidence to suggest a contrary interpretation. I would also note that the Opponent's services include leisure and entertainment themes as well. For example, the services listed in the WIGUP registration include "*jeux vidéo interactifs*" (interactive video games) and the services listed in the WIGUP Logo registration include databases on "college athletics, concerts, entertainment events, art,

performing arts, music, ... dance". Indeed, the globes on the *www.wigup.tv* homepage feature such topics and Mr. Chatel confirms that the platform offers documentaries in such fields [para 23; Exhibit P-1].

[72] I am also of the view that there is a potential for overlap in the parties' trades. In this regard, in the absence of evidence to the contrary, I am prepared to infer that the Applicant could provide the Services to schoolchildren and school groups. As for the Opponent's services, Mr. Chatel states that the WIGUP teaching approach links school to parents and the community, involving all three in the development of each child's potential to discover his or her career [para 23]. Although the evidence does not illustrate this link with parents in detail, I accept that parents will at least access the platform to create their child's account, and I note as well that the exhibited user guides specifically contemplate parents accessing the platform's digital scrapbooks [Exhibit P-3.a)] and students using the e-portfolio feature for personal projects such as creating souvenir albums for their parents [Exhibit P-3.b)]. The Canada Research Chair's report also specifically notes that parents can access the platform from home [Exhibit P-6].

[73] In the circumstances, I agree with the Opponent that the Services may be perceived as an extension of or complement to the Opponent's offerings.

[74] With respect to the Goods, I agree with the Opponent that there appears on its face to be a connection between role-playing uniforms for various professions and providing information for parents and children with respect to career opportunities and prospects. In addition, in the absence of evidence from the Applicant, I consider there to also be a relationship between role-playing uniforms and goods such as hats, dresses, hair clips, make-up, and accessory cases; a relationship between education facilities and goods such as puzzles, pens, pencils, clips, note pads, paper clips, and erasers; and a relationship between theme and amusement parks and goods that may serve as souvenirs, such as plush toys, t-shirts, cups, plates, glasses, buttons, photographs, pins, fridge magnets, picture frames, carrying bags, tote bags and shopping bags. Moreover, there is nothing in the Application that would restrict the Goods from being sold through the Applicant's educational facilities or parks, whether physical or virtual.

[75] In view of the foregoing, for the purpose of assessing confusion, I conclude that the section 6(5)(c) and (d) factors also favour the Opponent. For the reasons discussed above, I find

that there is either direct overlap, a relationship creating a potential for overlap, or an apparent nexus between each of the Goods and Services on the one hand and one or more goods and services from either the WIGUP registration or the WIGUP Logo registration on the other hand. In this respect, I note that, although the statement of services in the WIGUP Logo registration is, for the most part, more descriptive and precise, the definition of the Internet site service in the WIGUP registration—including with respect to discussion forums; dissemination of multimedia content; and pre-recorded broadcasting of interviews, films, reports and other content—is broad enough to cover most of the same services.

Conclusion with respect to confusion

[76] As noted above, the test for confusion does not concern confusion of trademarks themselves but rather confusion as to whether goods and services come from a common source. The issue is whether a consumer who has a general and not precise recollection of the opponent's trademark will be likely to think, as a matter of first impression upon seeing the applicant's mark, that the goods and services associated with both trademarks might share a common source. The onus is not on the opponent to show that such confusion is likely but rather on the applicant to satisfy the Registrar, on a balance of probabilities, that there is no likelihood of such confusion.

[77] In the present case, whether one takes the WIGUP registration or the WIGUP Logo registration, the analysis of each of the factors listed in section 6(5) of the Act favours the Opponent. Having considered all the surrounding circumstances, I find that a causal consumer of the Goods and Services having only an imperfect recollection of either the WIGUP trademark or the WIGUP Logo could, as a matter of first impression, upon seeing the Mark, assume that the Goods and Services are from the same source as the WIGUP platform, either as an extension of the Opponent's services or as complementary goods and services in some way approved of or licensed by the Opponent. The Applicant has failed to demonstrate, on a balance of probabilities, that there is no reasonable likelihood of such confusion.

[78] Consequently, this ground of opposition is successful.

S16 GROUNDS OF OPPOSITION BASED ON ENTITLEMENT UNDER SECTIONS 16(3)(A) AND 16(3)(C)

[79] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark under sections 16(3)(a) and 16(3)(c) of the Act because, at the Application's filing date and at all other times, the Mark was confusing with the following trademarks and trade names of the Opponent, which it has not abandoned:

- (a) the trademark WIGUP, used by the Opponent and its predecessor in title Balestra since at least as early as April 2010 in association with the goods and services set out in Schedule A to this decision;
- (b) the WIGUP Logo, used by the Opponent in Canada since at least as early as August 12, 2014 in association with the services set out in Schedule A to this decision;
- (c) the WIGUP.TV Trademark, used by the Opponent and Balestra in Canada since at least as early as April 2010 in association with the goods and services set out for WIGUP in Schedule A and used by the Opponent since at least as early as August 12, 2014 in association with the services set out for the WIGUP Logo in Schedule A; and
- (d) the WIGUP Trade Name, used by the Opponent in Canada since at least as early as April 2010 in association with the goods and services set out for WIGUP in Schedule A and since at least as early as August 12, 2014 in association with the services set out for the WIGUP Logo in Schedule A.

[80] To meet its initial burden under these grounds, the Opponent must evidence not only the prior use of its trademark or trade name in accordance with section 16(3)(a) or 16(3)(c) of the Act, but also that its trademark or trade name had not been abandoned at the date of advertisement of the Application, as stipulated in sections 16(5) of the Act.

[81] The material date for the section 16(3) grounds of opposition is the filing date of the Application, namely November 5, 2014.

Section 16(3)(c)

[82] I would first note that the Opponent's evidence in respect of the WIGUP Trade Name is dated after the material date. The advertisement for Wigup Corp. and the University of Ottawa

launching the WIGUP Research Chair is dated October 23, 2015 [Exhibit P-5.a)] and the screenshots showing the notation “WIGUP CORP [CA]” in a browser address bar are dated January 11, 2017 [Exhibit P-1].

[83] The Opponent also invites the Registrar to exercise its discretion to confirm the existence of the WIGUP Trade Name on the federal corporate register. I am not prepared to do so. The Registrar will exercise its discretion to consult the trademarks register in very limited situations involving public interest, such as to verify whether a registration or pending application alleged in the statement of opposition is extant, but will not consult other registers to assist a party to do what ought to have been done through the filing of evidence. In any event, an opponent relying on prior use of a trade name must demonstrate its use in the normal course of a functioning business and in relation to the class or classes of persons with whom such business is to be conducted [*Mr Goodwrench Inc v General Motors Corp* (1994), 55 CPR (3d) 508 (FCTD)]. Merely registering a company under a trade name does not, by itself, constitute “use” of that name [see *Opus Building Corp v Opus Corp* (1995), 60 CPR (3d) 100 (FCTD); and *Pharmx Rexall Drug Stores Inc v Vitabrin Investments Inc* (1995), 62 CPR (3d) 108 (TMOB)].

[84] Thus, the Opponent has failed to satisfy its initial burden with respect to its section 16(3)(c) ground of opposition.

Section 16(3)(a)

[85] With respect to the section 16(3)(a) ground, I consider the Opponent’s position under this ground to be strongest with respect to its reliance on the word mark WIGUP. I will therefore focus my discussion on use of this trademark.

[86] As discussed above under the section 12(1)(d) ground of opposition, Mr. Chatel’s declaration provides evidence of use of the Opponent’s WIGUP trademark prior to the Application’s filing date of November 5, 2014. In particular, the Canada Research Chair’s report on use of the WIGUP platform in two Ontario classrooms is dated June 2014; I am prepared to infer that the screenshot of the WIGUP homepage in that report is representative of how the platform appeared to the two classes using it for the study, which was conducted earlier that year. I am also prepared to accept that the two user guides funded in 2012, one of which refers to the

platform's upcoming launch, were also published prior to November 5, 2014. Furthermore, in view of the screenshots from the Opponent's website, dated in 2017, I accept that the Opponent had not abandoned its WIGUP trademark when the Application was advertised on December 30, 2015.

[87] Accordingly, I find that the Opponent has met its initial burden under the section 16(3)(a) entitlement ground of opposition. The onus is therefore again on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's WIGUP trademark.

[88] With respect to the test for confusion according to the factors set out in section 6(5) of the Act, the earlier material date associated with the section 16 ground of opposition does not significantly alter the results of the analysis performed under the previous ground.

[89] Although the majority of the promotional activities referenced in Mr. Chatel's declaration took place after the material date, and his figures with respect to the platform's reach appear to be from the date of his declaration in 2017, there remains at least some evidence of the WIGUP trademark's use and promotion prior to November 5, 2014, whereas there is no evidence whatsoever that the Mark has been used or promoted in Canada.

[90] I would also note that, under the section 16 ground of opposition, it is the statement of goods and services as defined in the Application versus the goods and services for which the Opponent has shown actual use that governs the analysis of the sections 6(5)(c) and (d) factors. However, I am satisfied from my review of the aforementioned user guides and research report promoting the WIGUP platform that the services offered in association with the WIGUP trademark through this platform at the time were substantially the same as the services discussed under the sections 6(5)(c) and (d) factors under the previous ground.

[91] Accordingly, all of the surrounding circumstances continue to favour the Opponent. Consequently, the section 16(3)(a) ground of opposition succeeds as well.

S2 GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[92] The Opponent also pleads that the Mark is not distinctive within the meaning of section 2 of the Act, because the Mark does not actually distinguish and is not capable of distinguishing the Goods and Services from the goods and services of the Opponent, given that the Mark causes confusion with the WIGUP Registered Trademarks, the WIGUP.TV Trademark, and the WIGUP Trade Name.

[93] The relevant date for this ground of opposition is February 26, 2016, the date of filing the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[94] To succeed under this ground, an opponent relying on its own trademark or trade name must establish that, as of the relevant date, its mark or name had become sufficiently known in Canada to negate the distinctiveness of the applicant's mark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. In this respect, the opponent has the initial burden to show that its trademark or trade name (i) was known in Canada to some extent at least, *i.e.* that it had a reputation in association with the relevant goods or services that was “substantial, significant or sufficient”, or (ii) was well known in a specific area of Canada [*Bojangles, supra*]. Once the opponent's initial burden is met, the applicant has a legal onus to show, on a balance of probabilities, that its own trademark was adapted to distinguish or actually distinguished its goods and services from those of the opponent [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[95] The Opponent's evidence with respect to the WIGUP Registered Trademarks becoming known in Canada is summarized above under the section 12(1)(d) ground of opposition. However, the information regarding the extent to which licences for the platform have been granted or are being negotiated postdates the material date of February 26, 2016. In addition, of the conventions on education in which the Opponent participated, only one—the Google Education Summit held in Ontario in September 2015— predates the material date.

[96] Mr. Chatel's evidence also includes the following with respect to the WIGUP.TV Trademark and the WIGUP Trade Name:

1. The WIGUP.TV Trademark is displayed across a hot-air balloon design on the last page of the first user guide for the WIGUP platform [Exhibit P-3.a)];
2. References to “*le site WIGUP.tv*” (the WIGUP.tv site) appear in the Canada Research Chair’s 2014 report on the WIGUP project [Exhibit P-6]; and
3. The WIGUP Trade Name is used to identify the Opponent as one of the partners inviting students and education professionals to the October 23, 2015 launch of the WIGUP Research Chair [Exhibit P-5.a)].

[97] I note that, in addition, the screenshots of the Opponent’s website at Exhibit P-1 show the WIGUP.TV Trademark displayed in webpage titles (on the browser tabs) and elsewhere on the site and also show the notation “WIGUP CORP [CA]” in the address bar (although it is replaced by “*Identifiée par VeriSign*” (Identified by VeriSign) in one of the screenshots). However, this evidence postdates the material date. I note that neither the WIGUP.TV Trademark nor the WIGUP Trade Name is shown in the screenshot in the report from 2014 [Exhibit P-6]. In any event, even if I had accepted that the WIGUP.TV Trademark and WIGUP Trade Name were displayed on the site in 2014, it would not have changed my decision, for the reasons discussed below.

[98] Having considered the Opponent’s evidence, I find that it is insufficient to meet the burden of demonstrating that the WIGUP Registered Trademarks, WIGUP.TV Trademark and/or WIGUP Trade Name, were sufficiently known in Canada at the material date to negate the distinctiveness of the Mark. As explained in *Bojangles*, a trademark owner cannot simply assert that its trademark or trade name is known in Canada; there must be clear evidence of the extent to which it is known. In the present case, the Opponent’s evidence falls short of demonstrating that its trademarks and/or trade name were known to some extent at least in Canada or well known in a specific area of Canada on February 26, 2016.

[99] In particular, there is no evidence of the extent to which the promotional materials for the WIGUP platform had been distributed or accessed at that date and no evidence of the extent to which any of the Opponent’s trademarks or trade name were advertised at the Google Education Summit.

[100] In addition, there is no evidence of the extent to which education professionals, students or parents would have seen any of the Opponent's trademarks or trade name on its website as of February 26, 2016. Although there is evidence that twelve schools participated in a pilot project for the WIGUP platform in 2010, there is no indication of whether or how the trademarks and trade name in question were used during the pilot project. At best, there is evidence that two classrooms in Ontario used the website in 2014. In my view, this is insufficient for a conclusion that the trademarks and/or trade name on which the Opponent relies had become sufficiently known to negate the distinctiveness of the Mark on February 26, 2016.


[101] Accordingly, the ground of opposition based on non-distinctiveness is dismissed, as the Opponent has failed to meet its initial burden.

DISPOSITION:

[102] In view of all the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Registration No. Trademark	Goods and Services
<p>TMA778,651</p> <p>WIGUP</p>	<p>Goods:</p> <p><i>Matériel d'enseignement et de formation, nommément: jeux interactifs.</i></p> <p>(TRADEMARKS JOURNAL TRANSLATION : Teaching and training material, namely : interactive games.)</p> <p>Services :</p> <p><i>Exploitation d'un site internet, nommément : forums de discussion en ligne, jeux vidéo interactifs, diffusion de reportages télévisés, en direct ou préenregistrés; diffusion d'entrevues en direct ou préenregistrées; diffusion de documentaires télévisés, d'émissions ou d'extraits d'émissions de télévision, de films et de reportages en direct ou préenregistrés; diffusion de documents multimédia, vente en ligne du contenu du site internet ci-haut décrit, de mp3 et de musique par téléchargement, vente en ligne de disques compacts préenregistrés et de livres.</i></p> <p>(TRADEMARKS JOURNAL TRANSLATION : Operation of an Internet site, namely :online discussion forums, interactive video games, live or prerecorded broadcasting of televised reports; pre-recorded broadcasting of interviews; broadcasting of televised documentaries, shows or excerpts from live or pre-recorded television shows, films and reports; dissemination of multimedia documents, online sale via downloads of MP3s, music and the Internet content described above, online sale of pre-recorded compact discs and books.)</p>
<p>TMA883,802</p> <p>WIGUP THE CREATIVE SOCIAL NETWORK FOR SCHOOLS & Design</p> 	<p>Services :</p> <p>Streaming of video via the Internet featuring pre-recorded documentaries and providing online live or pre-recorded conferences of personalities on their life experience, all of which being addressed to 9-14 years old students; providing online school interactive boards educational software; providing access to messages, photos, videos, graphic images and students' e-portfolios in the field of students' school projects and students' school activities, via chat rooms and electronic bulletin boards; providing chat rooms for student virtual communication and social networking; providing online forums for school teachers, to allow the transmission of, and social networking on, photographic images, school projects and school best practices in the field of education; providing on-line computer databases and on-line searchable databases in the field of primary school and secondary school life concerning college athletics, concerts, entertainment events, art, performing arts, music, fundraising activities, dance and academics; providing on-line computer databases and on-line searchable databases, featuring class or individual students' creative projects; computer services, namely: hosting online web facilities for schools for sharing projects and holding interactive discussions; computer services in the nature of customized web pages featuring user defined information, personal profiles and information about creative projects; computer services, namely: creating an on-line community for registered users to participate in discussion, get feedback from their peers, from virtual communities, and engage in social networking; peer-to-browser photo sharing service, namely: providing a website featuring technology enabling users to upload and view pictures, videos and e-portfolios; internet based introduction and social networking services for schools; providing on-line computer databases and on-line searchable databases in the field of social networking for schools.</p>

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2020-02-03

APPEARANCES

Isabelle Deshaies

FOR THE OPPONENT

Pablo Tseng

FOR THE APPLICANT

AGENTS OF RECORD

Isabelle Deshaies

FOR THE OPPONENT

McMillan LLP

FOR THE APPLICANT