



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 72

Date of Decision: 2024-04-04

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

Opponent: Leclerc Communication inc.

Applicant: Dimitrios Zamani-Mahforjaki

Application: 1926816 for WKND

INTRODUCTION

[1] Leclerc Communication inc. (the Opponent) opposes registration of the trademark WKND (the Mark), which is the subject of application No. 1926816 (the Application), on behalf of Dimitrios Zamani-Mahforjaki (the Applicant), for use in association with the following goods and services, as last revised by the Applicant on December 22, 2022 (collectively, the Goods and Services):

Goods (Nice class & Statement)

9 (1) Downloadable computer software for musical event venue management, namely, software that enables event producers, promoters, and venue managers to manage event information and attendees, promote, and that facilitate sales of tickets and other access types by integration with other programs.

Services (Nice class & Statement)

42 (1) Hosting a website featuring non-downloadable software for musical event venue management, namely, software that enables event producers, promoters, and venue managers to manage event information and attendees, promote, and that facilitate sales of tickets and other access types by integration with other programs.

Claims:

Used in Canada since at least as early as March 1, 2018, on services

Used in the United States of America on goods

Registered in the United States of America on September 18, 2018, under No. 5564287 on goods.

[2] The main issue in this case is whether the Mark is confusing with either of the trademarks WKND (registered under No. TMA851685) and WKnd & Design (registered under No. TMA851686), reproduced below (collectively, the Opponent's WKND Marks), that have been previously used in Canada by the Opponent in association with the following services described in these registrations (collectively, the Opponent's Registered Services) and with [TRANSLATION] "a mobile application, as well as a website, that enables users to listen to music, listen to music-related radio programs, musical performances, and other musical events, and obtain information on music, musical performances, and other musical events" (collectively, the Opponent's Non-Registered Goods and Services):



[TRANSLATION]

TMA851685

(1) Development, manufacture, radio broadcasting and webcasting of radio programs; operation of radio stations; promotion and sale of the goods and services of others through promotional contests and commercials.

TMA851686

(1) Development, manufacture, radio broadcasting and webcasting of radio programs.

(2) Operation of radio stations.

(3) Promotion and sale of the goods and services of others through promotional contests and commercials.

[3] For the reasons that follow, the opposition succeeds.

THE RECORD

[4] The Application was filed on October 24, 2018, and advertised for opposition in the *Trademarks Journal* on March 9, 2022.

[5] The Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, R.S.C. 1985, c T-13 (the Act) on April 7, 2022. I note that the Act was amended on June 17, 2019. Since the Application was advertised after that date, it is the Act, as amended, that applies [section 69(1) of the Act].

[6] The Opponent raises grounds of opposition based on the non-registrability of the Mark under section 12(1)(d) of the Act, non-entitlement under section 16(1)(a) of the Act, non-distinctiveness of the Mark under section 2 of the Act, and non-compliance of the Application under sections 38(2)(a.1), 38(2)(e), and 38(2)(f) of the Act.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] Only the Opponent filed evidence and written representations. No hearing was held.

EVIDENTIAL BURDEN

[9] The burden is on the Opponent to ensure that each of its grounds of opposition is properly pleaded and to meet the initial evidentiary burden by establishing the facts on which it bases its grounds of opposition. Once this initial evidential burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that none of grounds of opposition preclude the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29].

ANALYSIS

Non-registrability of the Mark pursuant to section 12(1)(d) of the Act

[10] The Opponent submits that the Mark is not registrable because it is confusing with the Opponent's WKND Marks.

[11] I have exercised my discretion to review the register and confirm that the trademark registrations pleaded by the Opponent are extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[12] As the Opponent has met its initial evidentiary burden, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and either of the trademark registrations pleaded by the Opponent.

[13] Except where otherwise indicated, I will focus my analysis on the Opponent's WKND word mark.

The test for confusion

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely 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.

[15] Thus, section 6(2) of the Act does not concern confusion between the trademarks themselves, but of the goods or services from one source as being from another.

[16] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act. The weight to be given to each factor may vary depending on the circumstances [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 321; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion]. These factors are discussed below.

[17] In *Masterpiece, supra* at paragraph 49, the Supreme Court of Canada discussed the importance of the factor of section 6(5)(e) in the analysis of the likelihood of confusion between the parties' trademarks pursuant to section 6 of the Act:

... the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis. (K. Gill and R. S. Jolliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition* (4th ed. (loose-leaf), pp. 8–54; R. T. Hughes and T. P. Ashton, *Hughes on Trade Marks* (2nd ed. (loose-leaf), § 74, p. 939). As Professor Vaver points out, if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar (Vaver, at p. 532) As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start (ibid.).

[18] In this case, it is appropriate to first analyze the degree of similarity between the Mark and the Opponent's WKND mark.

The degree of resemblance between the trademarks in appearance or sound, or in

the ideas suggested by them

[19] Since the Mark and the Opponent's WKND mark are identical, this first factor undoubtedly favours the Opponent.

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

[20] The inherent distinctiveness of a trademark refers to its originality. Trademarks consisting wholly or in part of words descriptive of the articles to be sold or of the services to be rendered attract a more limited range of protection than does an invented, unique, or non-descriptive word or an original design [see *General Motors Corp v Bellows*, 1949 CanLII 47 (SCC), [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 CPR 39 at p 41 (HL); and *Fairmont Properties Ltd v Fairmont Hotel Management LP*, 2008 FC 876].

[21] In this case, some online dictionary definitions indicate that the term WKND can be understood as the abbreviation of the English word "weekend" [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 (CanLII) at para 29, which enables the Registrar to take judicial notice of dictionary definitions]. In any event, since the parties' trademarks are identical and not descriptive of the goods and/or services associated with them, I consider their inherent distinctiveness equivalent.

[22] The inherent distinctiveness of a trademark may be increased by means of it becoming known through promotion or use.

[23] Despite the claims of use contained in the Application, there is no evidence of any use or promotion of the Mark in Canada. On the other hand, the Opponent's evidence, introduced through the affidavit of Jean-François Leclerc, discussed below, establishes that the Opponent's WKND mark has become appreciably known in Canada, particularly in the Montréal and Québec metropolitan areas.

The affidavit of Jean-François Leclerc

[24] As summarized by the Opponent in its written representations, Mr. Leclerc essentially attests to the following in his affidavit, sworn on November 4, 2022 (the Leclerc Affidavit):

- Mr. Leclerc is the Vice-President of Programming of the Opponent, which is a family business founded by Mr. Leclerc, his father, and his brother in 2011 [paras 1 and 3; and Exhibit JFL-1];
- the Opponent works in the media, and its mission is [TRANSLATION] “to breathe fresh air into the radio industry by offering innovative products that celebrate good music in a fun way” [paras 3 and 4];
- the Opponent has been using the WKND mark in Canada since as early as June 2012, including through:
 - a) the operation of commercial radio stations present in a large part of Quebec [paras 11–20; and Exhibits JFL-5, JFL-6];
 - b) the broadcast of musical and informational content about the organization of concerts and the sale of concert tickets in Canada through a mobile application and websites [paras 21–30, 39–42; and Exhibits JFL-7 to JFL-9 and JFL-15];
 - c) advertisements in mainstream media [paras 43–45; and Exhibits JFL-16 to JFL-27];
 - d) a strong social media presence [paras 29 and 30; and Exhibit JFL-9]; and
 - e) the organization and holding of musical events and concerts [paras 31 to 38; and Exhibits JFL-10 to JFL-14].

[25] In particular, and as summarized by the Opponent in its written representations, Mr. Leclerc attests that:

- the commercial radio station WKND 91.9 has been operated by the Opponent since June 20, 2012, and largely covers the Québec metropolitan area and its surrounding area. The commercial radio station WKND 99.5 has been operated by the Opponent since June 17, 2020, and largely covers the Montréal

metropolitan area and its surrounding area [paras 8 and 10; and Exhibit JFL-5 illustrating the geographic coverage of the WKND 91.9 and WKND 99.5 radio stations operated by the Opponent];

- the audio content of the WKND 91.9 and WKND 99.5 stations [TRANSLATION] “puts music at the heart of its programming” and broadcasts varied musical content to its listeners. Information segments on upcoming concerts in Canada are also available to listeners [paras 12 and 13];
- the WKND 91.9 and WKND 99.5 stations have had significant listenership for over 10 years in Canada. Hundreds of thousands of Canadians listen to the content broadcast by these stations each week [paras 15 and 16, which include tables that reflect the exact statistics of the average weekly audience of each station per reference period since their launch];
- media coverage of WKND 91.9 and WKND 99.5 is significant as evidenced by the 13 articles from various major newspapers such as LaPresse, le Soleil, the Journal de Montréal, and the Journal de Québec provided by Mr. Leclerc in support of his affidavit [Exhibit JFL-6];
- the Opponent also operates two websites and a mobile application, on which the audio content of the WKND 91.9 and WKND 99.5 stations is available across Canada and on which the WKND mark is used to provide visitors with information on the world of music and concerts in general. The WKND 91.9 website (<http://quebec.wknd.fm>) has been available since June 20, 2012; the WKND 99.5 website (<http://montreal.wknd.fm>) has been available since June 17, 2020; and the mobile application (which can be downloaded free of charge as WKND on major download platforms such as *Google Play* or *App Store*) has been available since June 20, 2012 [paras 22 and 26];
- the websites operated under the Opponent’s WKND mark are visited by millions of people annually [para 25];
- the mobile application used by the Opponent in association with the WKND mark has been downloaded more than 47,000 times since its launch, and Mr. Leclerc provides the details of the downloads by application period [para 28];

- the websites, application, and social media operated by the Opponent under the WKND mark enable consumers to obtain (i) information on upcoming concerts and other musical events in the Québec and Montréal metropolitan areas and elsewhere in Canada; (ii) details on the hosting and organization of concerts and other musical events; (iii) links and information on the purchase of tickets for these events and (iv) tickets for such events through various contests and promotions [paras 39–42; and Exhibit JFL-15];
- since as early as 2012, the Opponent has organized and managed several musical events and concerts under the WKND mark in Canada [paras 32–37; and Exhibits JFL-10 to JFL-14]; and
- the Opponent conducts major marketing campaigns in Canada annually to promote the WKND mark through various mainstream media, such as television, billboards, and newspaper advertising. Mr. Leclerc gives different examples of these campaigns for each year since 2012 [paras 43–45; and Exhibits JFL-16 to JFL-27].

[26] In reviewing the various exhibits attached to the Leclerc Affidavit, I note that the Opponent's WKND mark is often used as illustrated in registration No. TMA851686 reproduced above, with the radio frequency band number 99.5 replacing 91.9 depending on the geographical area. In any event, I have no difficulty concluding that such use amounts to use of the WKND word mark, which, in my view, preserves its identity and overall remains recognizable in the context of its use [according to the *Registrar of Trade-marks v Compagnie Internationale pour l'informatique CII Honeywell Bull*, 1985 CanLII 5537 (FCA), 4 CPR (3d) 523; and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)]. Furthermore, the WKND word mark, without the addition of the radio frequency band number, appears in many of the attachments to the Leclerc Affidavit.

[27] In conclusion, my overall assessment of this second factor, which concerns both the inherent distinctiveness and acquired distinctiveness of the marks at issue, clearly favours the Opponent.

The period during which the trademarks or trade names were in use

[28] In view of my findings made above, this factor also favours the Opponent.

Nature of the goods, services or business; and the nature of the trade

[29] When considering the nature of the goods and services and the nature of the trade, I must compare the statement of Goods and Services specified in the Application with the statement of services specified in the Opponent's registrations [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 1987 CanLII 8953 (FCA), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade nature of the parties' trades rather than all the possible trades that might be encompassed by the wording. Evidence of the parties' actual trade is useful in this regard [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (CFA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 1999 CanLII 36773 (CA TMOB), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 2000 CanLII 50940 (CA TMOB), 5 CPR (4th) 110 (TMOB)].

[30] In its written representations, the Opponent submits, *inter alia*, that:

[TRANSLATION]

49. The description of the goods and services in this case shows that both are in the same field of activity, namely the musical field.

50. The description of the Opponent's services includes "web radio broadcast" services. The Opponent's evidence shows that this service is provided through (1) websites and (2) a mobile application.

51. The Opponent's evidence also shows that the websites and application used for webcasting of programs enable users to:

- a) [TRANSLATION] "Obtain information on upcoming concerts and other musical events in the greater Québec and Montréal areas and elsewhere in Canada."

- b) Obtain “details on the holding and organization of concerts and other musical events and provides links and information on the purchase of tickets for such events.”
- c) To obtain “tickets for such events... through various contests and promotions.”

[Affidavit, paras 39–42 and Exhibit JFL-15];

52. The Opponent’s evidence therefore shows that the true nature of the services of the WKND Registrations covers in particular informational services relating to the organization and holding of concerts and other musical events, as well as the distribution of tickets for such events.

53. There is therefore a clear overlap between the goods and services in the Application and the services in the WKND Registrations.

54. The Applicant’s Nice class 9 goods are for “downloadable computer software,” namely, a mobile application, related to the organization and sale of tickets for musical events.

55. It appears from the evidence that the parties’ mobile applications with the same name could therefore be downloaded on the same platforms, for example, “Google Play” or the “App Store.”

56. Therefore, the distribution channels are similar.

57. Consumers could clearly be confused about the source of the WKND mobile application if the Applicant were to launch such an application in Canada, and consumers could falsely believe that there is a link to the Opponent’s well-known mobile application that has been available to consumers since 2012.

58. The Applicant’s Nice class 42 goods are for a website related to the organization and sale of tickets for musical events.

59. Therefore, consumers could clearly be confused about the source of a WKND site if the Applicant were to launch such a site in Canada, and consumers could falsely believe that it is one of the Opponent’s well-known sites that has existed since 2012.

60. In this case, the Applicant has not provided any evidence of the nature or channels of trade of its proposed goods and services. In view of this lack of evidence and the connectedness in the general field of music, the Board can only conclude that channels of trade of the services are likely to overlap...

[31] In the absence of any evidence or representations to the contrary from the Applicant, I am in general agreement with the Opponent's arguments.

[32] Therefore, these factors also favour the Opponent.

Conclusion on the likelihood of confusion

[33] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the parties' goods and services. Because of the burden on the Applicant, if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant [see *John Labatt, supra*].

[34] Having considered all the circumstances of the case, I am not satisfied that the Applicant has met his legal burden of proving, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's WKND mark.

[35] Consequently, the ground of opposition based on section 12(1)(d) of the Act succeeds.

Other grounds of opposition

[36] Since the ground of opposition based on section 12(1)(d) of the Act has already succeeded, I find that it is not necessary to address the other grounds of opposition, except to say that I would likely have decided in favour of the Opponent on the sections 16(1)(a) and 2 grounds of opposition revolving around the likelihood of confusion between the Mark and the Opponent's WKND word mark.

DISPOSITION

[37] 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.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Certified translation

Daniel Lépine, Lisa Hannaford-Wong, Beau Brock

Appearances and Agents of Record

DATE OF HEARING: No hearing held

AGENTS OF RECORD

For the Opponent: Langlois Lawyers, LLP

For the Applicant: Fasken Martineau Dumoulin LLP