

Federal Court



Cour fédérale

Date: 20091124

Docket: T-1159-08

Citation: 2009 FC 1208

Montréal, Quebec, November 24, 2009

PRESENT: The Honourable Mr. Justice Mainville

BETWEEN:

ADVANCE MAGAZINE PUBLISHERS, INC.

Applicant

and

WISE GOURMET INC.

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] This case concerns an appeal pursuant to section 56 of the *Trade-marks Act* (the “Act”) from a decision dated May 20, 2008 (the “Decision”) of Jill W. Bradbury acting for the Registrar of Trade-marks pursuant to delegated authority as a member of the Trade-marks Opposition Board. I will refer to the decision maker in this case as the “Registrar”. Pursuant to this Decision, the Registrar dismissed the opposition of Advance Magazine Publishers (the “Applicant”) to the registration as a trade-mark of WISE GOURMET by Wise Gourmet Inc. (the “Respondent”).

[2] The Applicant has submitted to the Federal Court new evidence in the form of two lengthy affidavits which were not before the Registrar, as it is entitled to do pursuant to paragraph 56(5) of

the Act. Consequently, this case requires this Court to examine the standard under which it must review the Decision of the Registrar in light of the new evidence submitted.

Background

[3] On December 31, 2003, an application to register the mark WISE GOURMET was submitted pursuant to the Act and was based on the use of that mark since as early as January 2002. The proposed uses of the mark in Canada were stated to be in association with various food products and food supplements as well as in printed publications, namely cookbooks, newsletters, nutrition guides, food recipes and periodicals relating to nutrition and food. Uses relating to television and radio programming services as well as websites featuring health and gourmet foods were also proposed, as were retail store services specializing in health and gourmet foods and arranging and conducting travel tours.

[4] Following advertisement of the application for opposition purposes, the Applicant filed a statement of opposition on August 22, 2004 based on numerous grounds which are for the most part premised on the Applicant's view that the mark WISE GOURMET is confusing with its trade-mark GOURMET and related trade-mark registered pursuant to the Act under numbers 392,189 and 277,151. The Applicant also argued that the application to register the mark WISE GOURMET was not in compliance with the Act.

[5] Various affidavit evidence and arguments were submitted to the Registrar by both the Applicant and the Respondent and an oral hearing was held before the Registrar leading to the Decision.

The Decision under appeal

[6] The Registrar dismissed the argument on non-use of the mark WISE GOURMET pursuant to paragraph 30(b) of the Act on the basis that the opponent (in this appeal, the Applicant) had not met its evidentiary burden. The Registrar further dismissed the ground of opposition based on non-compliance with paragraph 30(i) of the Act on the same basis.

[7] The remainder of the Decision dealt with various grounds of opposition premised on confusion between the WISE GOURMET mark and the Applicant's trade-mark GOURMET.

[8] First, the Registrar dismissed the grounds of opposition raised in relation to section 16 of the Act which provides that in order to secure the registration of a trade-mark, it must not be confusing on the date of its first use, or as the case may be, on the date of filing of the application, with a trade-mark that had been previously used in Canada or made known in Canada by any other person. The Registrar held that there was no evidence that the Applicant was using its trade-mark GOURMET prior to the relevant dates (Decision, p. 5).

[9] Second, the Registrar applied the test for confusion to the remaining grounds of opposition to the registration of the mark WISE GOURMET. For these purposes, the Registrar applied the test of first impression and imperfect recollection to ascertain if confusion existed.

[10] The Registrar found that the mark WISE GOURMET and the GOURMET trade-mark were both not inherently distinctive, since both indicate that the subject matter of the marks would be of interest to lovers of food.

[11] The Registrar further found that there was insufficient evidence of the use or promotion of the WISE GOURMET mark to conclude that it had become known to any extent. In regard to the use of the trade-mark GOURMET, the Registrar made the following conclusions of fact:

As the Opponent has not provided any evidence concerning its use or promotion of GOURMET, I am unable to conclude that the mark has become known to any meaningful extent. It is true that the Applicant did provide some evidence of the use/promotion of the Opponent's mark [...], but there is no evidence of the extent to which Canadians may have been exposed to the Opponent's mark (Decision, p. 6).

[12] On the length of time each mark had been in use, the Registrar found that the trade-mark GOURMET has been used in Canada since at least 1957, although the Registrar assumed that use to be *de minimus*.

[13] The Registrar found that the parties' wares or services were related and overlapped. Though little information had been provided concerning the parties' channels of trade, the Registrar deemed it reasonable to assume that these could overlap, particularly with respect to publications.

[14] Concerning the degree of resemblance between both marks, the Registrar was of the view that the first portion of a trade-mark was the most relevant for purposes of distinction, and consequently concluded that "...although there is a fair degree of resemblance between the marks, the word WISE does serve to distinguish the Applicant's Mark somewhat from the Opponent's mark in appearance, sound and idea suggested" (Decision, p.7).

[15] The Registrar was unable to make any meaningful inference about the state of the marketplace in light of the lack of evidence provided. However the Registrar noted that the Applicant had provided evidence of 740 books being offered for sale from the Canadian online bookseller www.indigo-chapters.ca which contained the word Gourmet in their title, including by way of illustration "The Country Gourmet", "Natural Gourmet", "Microwave Gourmet", "Gourmet Traveller" and many other similar titles. Though the Registrar accorded reduced weight to this evidence of third party publications, it nevertheless played a supporting role in respect to the conclusion independently reached by the Registrar, "...namely that, without evidence of acquired reputation, the mark GOURMET should only be entitled to a very narrow scope of protection due to its descriptive nature" (Decision, p.8).

[16] The Registrar thus concluded that on a balance of probabilities, confusion between the marks was not likely. In particular, the Registrar concluded that the average Canadian would not as a matter of first impression conclude that GOURMET magazine and WISE GOURMET cookbooks, newsletters, nutrition guides, food recipes, or periodicals relating to nutrition and food would share a common source. In reaching this overall conclusion, the Registrar stressed the

following: “I have reached this overall conclusion because the common word GOURMET is just that, a very common word, with a well-known descriptive meaning. The Opponent has not evidenced that it has acquired a significant reputation in its mark, and it is trite law that where a party adopts an inherently weak mark, relatively small differences will suffice to distinguish another’s mark” (Decision, pp. 8-9). This conclusion was also extended to the registered trade-mark GOURMET Design.

[17] Finally, the Registrar rejected on technical grounds the opposition based on another registration No. 576,562 for the GOURMET mark related to use on online magazines and publications and for Internet website purposes.

[18] In regard to the non-distinctiveness ground of opposition, the Registrar rejected it for lack of supporting evidence: “[i]n order to meet its initial burden with respect to these grounds, the Opponent need only show that its marks were “known to some extent at least” as of August 22, 2005. [...] I find that the Opponent has not met its initial burden and I therefore dismiss these grounds” (Decision, pp. 9-10).

The additional evidence

[19] In this appeal, the Applicant has submitted two lengthy affidavits for the purpose of correcting the evidentiary deficiencies of its opposition noted by the Registrar in the Decision.

[20] One of the affidavits is from a trade-mark associate of the trade-marks agent for the Applicant, Marlye Monfiston, which explains an Internet search carried out on December 3, 2008 from the Canadian online bookseller www.indigo-chapters.ca for books offered for sale online and which contain the words “best of gourmet” in their title. The results show that a variety of editions of the “Best of Gourmet” book line of the Applicant were indeed being offered for sale over the online book sales services of Indigo-Chapters on the search date.

[21] The other affidavit dated December 17, 2008 is from the New York City based Associate Publisher/Marketing of Gourmet magazine, Susan Bornstein (the “Bornstein Affidavit”) and it contains relevant information which was not before the Registrar. It runs for hundreds of pages with its schedules. Though Ms. Bornstein appears to be occupying her current position only since 2008, she has held a similar position in a related Condé Nast magazine from 2000 to 2008. As a senior officer of Gourmet magazine having access to its corporate records, I am of the view that she can validly provide information concerning the records of that magazine and other relevant information on past distribution and sales.

[22] In this Bornstein Affidavit, we learn that Gourmet magazine is published on a monthly basis by the Applicant through its unincorporated division Condé Nast Publications, and that this magazine is devoted to entertaining, food, beverages, lifestyle, travel, restaurants and epicurean product reviews. The Bornstein Affidavit states that Gourmet magazine has been distributed continuously in Canada and the United States since as early as 1957.

[23] The Bornstein Affidavit contains important information concerning the circulation of Gourmet magazine. The Bornstein Affidavit claims an average circulation well in excess of 700,000 copies per month in the United States of America, and in excess of 20,000 copies per month in Canada. To support this claim, the Bornstein Affidavit includes as Exhibit D the publisher's unaudited statements of circulation for the magazine disclosed to the Audit Bureau of Circulations from June 2002 to June 2008. These unaudited statements tend to confirm these circulation claims for the concerned period, including well over 20,000 copies circulated per month in Canada, with sales in every province.

[24] The Bornstein Affidavit also notes that the Applicant has published or has licensed to publish the "Best of Gourmet" cookbook series from 1985 to 2007, as well as other cookbooks bearing the mark "GOURMET" in their titles, such as the "Gourmet Cookbook" published since the 1950's.

[25] The Bornstein Affidavit states that by September 2007, 378,000 copies of the "Gourmet Cookbook" were sold in North America whereas over 10,000 units and 30,000 units of the "Best of Gourmet" cookbooks were sold in 2006 and 2007 respectively. Sales figures relating to Canada alone are not set out in the affidavit.

[26] The Bornstein Affidavit also provides information concerning various Internet websites of the Applicant bearing the names www.gourmet.com and www.gourmetscoop.com in which various

articles and information pertaining to food and related matters are posted. These websites are a vehicle for the Applicant to sell advertisement placements to third parties.

[27] The Bornstein Affidavit also states that the Applicant promotes its magazine through various means, including promotional and merchandizing events in association with the GOURMET trade-mark, such as interactive seminars, fine wine and cocktails tastings, chef demonstrations, etc. and it spends annually on average in excess of two million dollars for such purposes. However, the breakdown of this promotional spending between Canada and the USA is not set out in the affidavit, leading to the inference that the promotional spending in Canada is at best proportional to the Canadian circulation numbers for its magazine.

[28] In this case, substantial new evidence has been submitted to this Court by the Applicant, evidence which negates many of the findings of the Registrar. Indeed, the Applicant has presented convincing evidence that it has been using its trade-mark GOURMET for many decades in Canada, and that this use has been extensive throughout Canada. The new evidence shows conclusively that its trade-mark GOURMET has been exposed in a significant way to Canadian consumers for a long time, thus acquiring a certain reputation in Canada.

[29] The Respondent in this appeal did not challenge the new evidence nor did it make submissions in this appeal. However, in a letter dated October 20, 2009 the Respondent informed the Court that Gourmet magazine was ceasing publication after its November 2009 issue. Since the Respondent did not copy the Applicant on this letter, a copy of this was forwarded by the Court to

the Applicant. At the hearing of this appeal held in Toronto on October 28, 2009, the Applicant stated that it was leaving it to the Court to decide on the admissibility of the letter; furthermore counsel for the Applicant informed the Court that his client did not deny the information contained in this letter.

[30] Since this letter from the Respondent was not submitted in affidavit form, there are serious issues as to its admissibility as evidence in these proceedings. These issues are compounded by the fact that the Respondent has not participated in this appeal save by sending the aforementioned letter a few days prior to the hearing without even forwarding it to the Applicant.

Position of the Parties

[31] The Applicant's basic argument is that in light of the new evidence presented to this Court, a reasonable likelihood of confusion exists between the mark WISE GOURMET and its own registered trade-mark for GOURMET. It is the Respondent which has the legal burden to establish that there is no reasonable likelihood of confusion, but it has nevertheless decided not to challenge the new evidence submitted by the Applicant. In light of the burden of proof which is on the Respondent and the reasonable likelihood of confusion, the Applicant concludes that the Respondent is not entitled to the registration of WISE GOURMET as a trade-mark.

[32] As noted above, the Respondent did not participate in this appeal. The Respondent is nevertheless entitled to have its position considered in appeal: Gill & Jolliffe, *Fox on Canadian Law of Trade-Marks and Unfair Competition*, Fourth Edition, at para. 6.8 (d.) at page 6-34.1 of the

loose-leaf edition; *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1 at pp. 4-5. I have therefore reviewed the material submitted by the Respondent before the Registrar in the opposition proceedings, including the affidavits and written arguments submitted on its behalf.

[33] The Respondent basically argued before the Registrar that there is no inherent distinctiveness in the Applicant's trade-mark GOURMET, which is a common word in widespread use. It is further argued that the use of the word WISE in association with GOURMET minimizes any resemblance between the two marks such that there can be no likelihood of confusion between them.

Standard of review

[34] In its recent decision of *Dunsmuir v. New Brunswick*, [2008] 1 S.C.R. 190 at para. 62, the Supreme Court of Canada established a two-step process for determining the standard of review: “[f]irst, courts ascertain whether the jurisprudence has already determined in a satisfactory manner the degree of deference to be accorded with regard to a particular category of question. Second, where the first inquiry proves unfruitful, courts must proceed to an analysis of the factors making it possible to identify the proper standard of review”. It is therefore appropriate to first ascertain what the case law has determined as the appropriate standard of review for appeals under section 56 of the Act.

[35] Pre-*Dunsmuir*, the applicable standard of review for appeals of this type, where the principal issue at stake is a likelihood of confusion, had been extensively canvassed by the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772, (2006) 49 C.P.R. (4th) 321 [*Mattel*]. In that decision, where new evidence had been adduced before the Federal Court but not found relevant, the applicable standard of review was determined to be reasonableness *simpliciter* (at para. 40):

Given, in particular, the expertise of the Board, and the “weighing up” nature of the mandate imposed by s. 6 of the Act, I am of the view that despite the grant of a full right of appeal the appropriate standard of review is reasonableness. The Board’s discretion does not command the high deference due, for example, to the exercise by a Minister of a discretion, where the standard typically is patent unreasonableness (e.g. *C.U.P.E. v. Ontario (Minister of Labour)*, [2003] 1 S.C.R. 539, 2003 SCC 29, at para. 157), nor should the Board be held to a standard of correctness, as it would be on the determination of an extricable question of law of general importance (*Chieu v. Canada (Minister of Citizenship and Immigration)*, [2002] 1 S.C.R. 84, 2002 SCC 3, at para. 26). The intermediate standard (reasonableness) means, as Iacobucci J. pointed out in *Ryan*, at para. 46, that “[a] court will often be forced to accept that a decision is reasonable even if it is unlikely that the court would have reasoned or decided as the tribunal did.” The question is whether the Board’s decision is supported by reasons that can withstand “a somewhat probing” examination and is not “clearly wrong”: *Southam*, at paras. 56 and 60.

[36] Though the question was not directly at issue in the *Mattel* decision, Justice Binnie noted that a different standard of review would apply in the event fresh and relevant evidence was adduced in appeal before the Federal Court (at para. 35 in part):

Where fresh evidence is admitted, it may, depending on its nature, put quite a different light on the record that was before the Board, and thus require the applications judge to proceed more by way of a fresh hearing on an extended record than a simple appeal (*Philip*

Morris Inc. v. Imperial Tobacco Ltd. (No. 1) (1987), 17 C.P.R. (3d) 289 (F.C.A.)). Section 56 suggests a legislative intent that there be a full reconsideration not only of legal points but also of issues of fact and mixed fact and law, including the likelihood of confusion. See generally *Molson Breweries v. John Labatt Ltd.*, [2000] 3 F.C. 145 (C.A.), at paras. 46-51; *Novopharm Ltd. v. Bayer Inc.* (2000), 9 C.P.R. (4th) 304 (F.C.A.), at para. 4, and *Garbo Creations Inc. v. Harriet Brown & Co.* (1999), 3 C.P.R. (4th) 224 (F.C.T.D.).

[37] In the decision of the Federal Court of Appeal *Molson Breweries v. John Labatt Ltd.*, [2000] 3 F.C. 145 (C.A.), (2000) 5 C.P.R. (4th) 180, [2000] F.C.J. No. 159 (QL) cited approvingly by Justice Binnie in *Mattel*, Justice Rothstein (as he then was) stated the following (at para. 46 and 51):

Because of the opportunity to adduce additional evidence, section 56 is not a customary appeal provision in which an appellate court decides the appeal on the basis of the record before the court whose decision is being appealed. A customary appeal is not precluded if no additional evidence is adduced, but it is not restricted in that manner. Nor is the appeal a "trial de novo" in the strict sense of that term. The normal use of that term is in reference to a trial in which an entirely new record is created, as if there had been no trial in the first instance. Indeed, in a trial de novo, the case is to be decided only on the new record and without regard to the evidence adduced in prior proceedings.

[...]

I think the approach in *Benson & Hedges v. St. Regis* and in *McDonald v. Silcorp* are consistent with the modern approach to standard of review. Even though there is an express appeal provision in the Trade-marks Act to the Federal Court, expertise on the part of the Registrar has been recognized as requiring some deference. Having regard to the Registrar's expertise, in the absence of additional evidence adduced in the Trial Division, I am of the opinion that decisions of the Registrar, whether of fact, law or discretion, within his area of expertise, are to be reviewed on a standard of reasonableness *simpliciter*. However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division judge must come to his or her own

conclusion as to the correctness of the Registrar's decision. [emphasis added]

[38] In *Maison Cousin (1980) Inc. v. Cousins Submarines Inc.*, 2006 FCA 409, (2006) 60 C.P.R. (4th) 369, [2006] F.C.J. No. 1968 (QL) [*Maison Cousin*], which was decided after the *Mattel* decision, the Federal Court of Appeal called for a *de novo* review in appeal where substantial new relevant evidence is adduced before the Federal Court (at para. 4 and 7):

The appellant appealed this decision before the Federal Court. Alerted by the comments of the Registrar's delegate about the flimsy evidence it had in support of its opposition, the appellant invoked its right under subsection 56(5) to supplement the evidence on record. It submitted new evidence. The judge analyzed this new evidence on the basis of the standard of review. He concluded that it was sufficiently significant and probative and that he had to apply the standard of correctness. In doing so, the judge unduly restricted his discretion to intervene, in our view, because having noted the significance and probative value of the new evidence, he was no longer called on to review the decision of the registrar's delegate, but rather to decide the issue on the merits based on the evidence before him.

[...]

The judge deciding the issue *de novo* may intervene without having to identify any error committed by the delegate and is not obliged to defer to the delegate's decision. The judge must decide the issue on the basis of the evidence before him or her and the applicable legal principles.

[39] The approach in *Maison Cousin* has subsequently been followed in many decisions: *Shell Canada Ltd. v. P.T. Sari Incofood Corp.*, 2008 FCA 279, (2008) 68 C.P.R. (4th) 390, [2008] F.C.J. No. 1320 at para. 22; *Canadian Tire Corp. v. Accessoires d'autos Nordiques Inc.*, 2007 FCA 367, (2007) 62 C.P.R. (4th) 436 at para. 30; *Curb v. Smart & Biggar*, 2009 FC 47, (2009) 72 C.P.R. (4th)

176, [2009] F.C.J. No. 85 (QL) at para. 7; *Vêtement Multi-Wear Inc. v. Riches, Mckenzie & Herbert LLP*, 2008 FC 1237, (2008) 73 C.P.R. (4th) 3, [2008] F.C.J. No. 1602 at paras. 12 to 16; *Guido Berlucchi & C. S.r.l. v. Brouillette Kosie Prince*, 2007 FC 245, (2007) 56 C.P.R. (4th) 401, [2007] F.C.J. No. 319 at para. 24.

[40] This review of the case law has proven fruitful to determine the standard of review, and consequently I need not proceed to a further standard of review analysis.

[41] In this case, the findings of the Registrar concerning the issue of confusion have been largely negated in light of the new relevant, and in this case significant, evidence submitted by the Applicant. Though there is nothing in the record suggesting that the findings of the Registrar were inappropriate on the issue of confusion insofar as only the evidence before the Registrar is taken into account, the depth and significance of the new evidence submitted by the Applicant is such that a new determination on a *de novo* or fresh basis is required.

[42] Indeed, the grounds of opposition based on section 16 of the Act were dismissed by the Registrar on the basis the Applicant had failed to establish use of its mark GOURMET in Canada prior to the filing date of the application by the Respondent for WISE GOURMET and prior to the Respondent's claimed date of first use of WISE GOURMET (page 5 of the Decision). This finding can no longer be supported in light of the new evidence submitted.

[43] As concerns the core test for confusion taking into account the factors specifically enumerated in the Act, the Registrar dismissed the grounds of opposition principally on the grounds that "...the Opponent has not provided any evidence concerning its use or promotion of GOURMET" (Decision, p. 6), "...there is no evidence of the extent to which Canadians may have been exposed to the Opponent's mark" (*Ibid*), "...such use [of the opponent's mark] is assumed to be only *de minimus*" (*Ibid*), "[v]ery little information has been provided concerning the parties channels of trade..." (*Ibid*), "[t]he Opponent has not evidenced that it has acquired a significant reputation in its mark..." (Decision, p. 8), "[t]he Opponent did not establish that it has acquired any substantial reputation in association with GOURMET with respect to these registered services [web services]" (Decision, p. 9), etc. These findings can no longer be supported in light of the new evidence submitted.

[44] Consequently, I will proceed with this appeal on a *de novo* or fresh basis on the issues raised by this appeal, particularly the issue of confusion, being understood that the evidence already submitted before the Registrar is also part of the record before me and is to be taken into account.

[45] Though I will be proceeding on a *de novo* or fresh basis, the Registrar's findings on those issues which remain unaffected by the new evidence presented on appeal still deserve some deference, and I will be referring to such findings where appropriate.

The test for confusion

[46] Paragraph 12(1)(d) and subsections 16(1) and (3) of the Act state that a trade-mark (or, in the case of subsection 16(3) of the Act, a proposed trade-mark) may be registered if it is not confusing with a registered trade-mark or with a trade-mark that has been previously used in Canada or made known in Canada by any other person. The statutory test for confusion is set out in subsections 6(2) and (5) of the Act:

(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(2) L'emploi d'une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les marchandises liées à ces marques de commerce sont fabriquées, vendues, données à bail ou louées, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces marchandises ou ces services soient ou non de la même catégorie générale.

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

(a) the inherent distinctiveness of the trademarks or trade-names and the extent to which they have become known;

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

(b) the length of time the trade-marks or trade-names have been in use;	b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;
(c) the nature of the wares, services or business;	c) le genre de marchandises, services ou entreprises;
(d) the nature of the trade; and	d) la nature du commerce;
(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.	e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

[47] In *Mattel, supra* at para. 54, the Supreme Court of Canada noted that all surrounding circumstances must be taken into account. The enumerated factors in subsection 6(5) are not exhaustive and different circumstances will be given different weight in a context specific assessment, see: *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.) as cited in *Mattel, ibid.* Moreover, the Supreme Court of Canada also noted that the onus is on the Applicant for the trade-mark registration (here the Respondent) to show on a balance of probabilities that there is no likelihood of confusion, *Mattel, supra* at para. 54.

[48] What must be considered is the “first impression in the mind of a casual consumer somewhat in a hurry” who has an “imperfect recollection” of another trade-mark, see: *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824, (2006) 49 C.P.R. (4th) 401 at para. 20. The perspective from which the likelihood of confusion is to be measured is that of a

mythical consumer dubbed by the Supreme Court of Canada as the “casual consumer somewhat in a hurry” and extensively described in *Mattel, supra* at paras. 56 to 58. The principal question is whether the “ordinary casual consumers somewhat in a hurry are likely to be deceived about the origin of the wares or services” (*Mattel, supra* at para. 58).

Application of the statutory test

(1) *The inherent distinctiveness of the trade-marks and the extent to which they have become known*

[49] I agree with the Registrar that neither the GOURMET trade-mark nor the Respondent’s mark WISE GOURMET is inherently distinctive. Both refer to the commonly used word “gourmet” that is defined as follows in the second edition of the Canadian Oxford Dictionary: “*noun* a connoisseur of good food, having a discerning palate. *attributive adjective* 1 (of food) of very high quality, suitable for refined tastes. 2 of, relating to, or suitable for a gourmet”. The use of the word “gourmet” is relatively common in relation to food products, and as such neither mark shows any particular originality or imagination which would provide it with some inherent distinctiveness.

[50] I also agree with the Registrar that there is insufficient evidence of the use and promotion of the Respondent’s mark WISE GOURMET to conclude that it has become known to any significant extent.

[51] Indeed the principal evidence of use submitted by the Respondent before the Registrar consisted of an affidavit dated April 6, 2006 from Tom Abols who carried out various Internet

searches on behalf of the Respondent's representatives (the "Abols Affidavit"). This affidavit refers to a search on the Internet website www.wanttoknownow.com indicating reference to "Wise Gourmet" in relation to cooking classes and educational tours. The Abols Affidavit also notes an Internet search on the Internet website of Western Web published by the students' council of the University of Western Ontario on which "Wise Gourmet" is referred to in relation to a speaking engagement relating to nutrition. Though this evidence does demonstrate some use of the mark WISE GOURMET, it is far from demonstrating that this mark has become known to any significant extent.

[52] Concerning the Applicant's trade-mark GOURMET, however, the new evidence submitted in this appeal and described above shows conclusively that it has been used throughout Canada for many decades. The new evidence also shows conclusively that the trade-mark GOURMET has been exposed in a significant way to Canadian consumers for a long time, thus acquiring a certain reputation in Canada. I do not however find that the Applicant's trade-mark GOURMET is "famous" since it does not meet the immediate trade-mark recognition required to make out such a claim.

[53] Though the Applicant is not entitled to fence in the use of the word "gourmet" or appropriate it over a wide area, see: *Mattel, supra* at para. 75, I accept that through use over time GOURMET has acquired a secondary meaning associated with the Applicant's magazine, and on that account has achieved some distinctiveness in the magazine publishing world as well as some

limited recognition in Canada associated with the “Best of Gourmet” cookbooks and web information services related to food.

(2) *The length of time the trade-marks have been in use*

[54] The new evidence submitted in appeal clearly shows that the Applicant’s trade-mark GOURMET has been widely used in Canada for many decades in relation to the magazine and, for a lesser period of time in relation to the “Best of Gourmet” cookbook series.

[55] On the other hand, the Respondent’s mark WISE GOURMET has only been in use for a few years. Indeed the Respondent’s “Revised application for the registration of a trade-mark” dated October 26, 2004 asserts use in Canada in association with arranging and conducting cooking classes only since January 2002. The written argument made before the Registrar on behalf of the Respondent dated February 7, 2006 asserts at para. 15 use “in association with at least certain of the Wares and Services since at least February 2006.”

(3) *The nature of the wares, services or business*

[56] Even with a limited evidentiary record, the Registrar found that the two parties’ wares and services were related and overlapped in some respects. The new evidence submitted in appeal greatly reinforces this conclusion.

[57] The Respondent declares in its “Revised application for the registration of a trade-mark” dated October 26, 2004 that it has used the mark WISE GOURMET in association with “arranging

and conducting cooking classes”, and that it intends to use it in association with a large list of food products and beverages as well as in association with “printed publications, namely cookbooks, newsletters, nutrition guides, food recipes, periodicals relating to nutrition and foods”. The Respondent also declares its intention to use this mark in respect to various services such as “television and radio programming services; providing access to a website featuring health and gourmet foods, recipes and nutritional information; retail store services specializing in health and gourmet foods; arranging and conducting travel tours”.

[58] In its trade-mark registrations 392,189 and 277,151, the Applicant’s declared use of its trade-mark GOURMET is stated to be “[m]agazines”.

[59] In its trade-mark registration 576,562, the Applicant declared use related to “[o]n line magazines and publications distributed in electronic format via the internet; operating an internet website which allows consumers to subscribe to the consumer magazines and allows advertisers to promote their goods and services via the internet”. The Registrar rejected on technical grounds the Applicant’s paragraph 12(1)(d) ground of opposition based on its trade-mark registration 576,562. I find no reason to disturb the Registrar’s finding in regard to this technical issue. Consequently, no consideration of trade-mark 576,562 has been taken into account in this appeal in regard to paragraph 12(1)(d) grounds of opposition.

[60] In any event, the Bornstein affidavit contains sufficient factual elements demonstrating that the Applicant has used as a trade-mark GOURMET in relation to online magazines and publications

via the Internet and has operated an Internet website which allows consumers to subscribe to the consumer magazines and allows advertisers to promote their goods and services via the Internet. The Bornstein affidavit also shows that this Internet and web use precedes that of the Respondent's use of its mark WISE GOURMET.

[61] In the Bornstein Affidavit, the use of the GOURMET trade-mark is also stated to extend to other wares and services such as cookbooks and recipe books (paras. 3, 10 and 11 of the affidavit), and merchandizing events such as interactive seminars, fine wine and cocktails tastings, cooking, chef demonstrations and book signings, exclusive dinners, private cooking classes, wine and culinary week-ends (para. 17 of the affidavit), as well as information and educational services in the field of nutrition, nutritional advice, healthy eating and lifestyle (para. 19 of the affidavit).

[62] There is therefore a broad overlap in the wares and services which both marks seek to identify. Both seek to market products and services related to food. Though the wares and services are not all identical, they are broadly comparable and basically seek to service the same markets and consumers.

(4) *The nature of the trade*

[63] The Respondent has provided little information on its channels of trade, but indicates that publications and periodicals, the Internet and radio and television are either used or contemplated to be used.

[64] The Applicant's channels of trade are clearly set out in the Bornstein Affidavit and include the magazine, publications, the Internet and television.

[65] In the present case, not only are the wares and services broadly overlapping, but the channels of trade are largely similar.

(5) *The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[66] The Registrar found that there was a fair degree of resemblance between both trade-marks since the Respondent had incorporated the Applicant's GOURMET trade-mark in its entirety into its WISE GOURMET mark. However, on the basis of the principle that the first portion of a trade-mark is the most relevant for the purposes of distinction, the Registrar found that the word WISE does serve to distinguish both trade-marks in appearance, sound and idea suggested.

[67] Though it is true that the word "wise" does serve to distinguish both marks to some degree in appearance and sound, the idea suggested by both marks is nevertheless similar. The determinative word in the mark WISE GOURMET is the noun "gourmet" rather than its adjective "wise". Both marks consequently do resemble each other, and could be difficult to distinguish in appearance to a casual observer, particularly if the get-up of WISE GOURMET is made such as to emphasise the latter word.

(6) Other surrounding circumstances

[68] The Respondent had presented evidence before the Registrar concerning the existence of one other “gourmet” mark on the trade-marks register, namely the trade-mark THE SURREAL GOURMET registered in relation to aprons and T-shirts as well as cookbooks, calendars and posters and for entertainment services in the nature of ongoing television programs in the field of cooking and culinary arts. The Registrar found this insufficient to enable to make any meaningful inference about the state of the marketplace (Decision, p. 7).

[69] In addition, through the Abols Affidavit, the Respondent provided evidence of hundreds of books offered for sale by the online bookseller www.indigo-chapters.ca which contain the word “gourmet” in their titles, including “Gourmet Barbecue”, “Vegetarian Gourmet Cookery” “Gourmet Ireland”, “Gourmet Sweets”, “The Natural Gourmet”, etc. This evidence certainly tends to demonstrate both that the word “gourmet” is commonly used in the cookbook publishing business, and that it is in common use.

[70] As noted above, in a letter submitted a few days before the hearing, the Respondent represented that the Applicant was ceasing to publish its Gourmet magazine after its November 2009 edition, thus consequently ceasing to use its trade-mark GOURMET in association with the wares or services for which it is registered in Canada, namely for magazines. I have decided not to accept into evidence this letter and the fact that it attempts to place before the Court. However, in the event I am found to have erred in this regard, I will proceed to explain why this fact would not affect the outcome of this case even if it was deemed part of the evidence.

[71] In its recently released decision of *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2009 FCA 290, [2009] F.C.J. No. 1263 (QL), the Federal Court of Appeal has provided new guidance concerning the temporal parameters within which the confusion analysis is to be assessed. In that decision, the temporal parameters were stated to be as follows: a) the material date for determining confusion with an existing mark under paragraph 12(1)(d) of the Act is the date of the disposition of the matter (*Ibid.* at para. 12); b) the material date for assessing confusion in actions for infringement under section 20 of the Act, though normally the time of the hearing, may vary depending on the specific facts and pleadings of each case (*Ibid.* at para. 13); c) the relevant date on which to assess the likelihood of confusion under paragraph 16(1)(a) of the Act is the Respondent's first use of the trade-mark (*Ibid.* at para. 14); and, d) the relevant date on which to assess the likelihood of confusion under subsection 16(3) of the Act is the date of the filing of the application for registration (*Ibid.* at paras. 15 to 18).

[72] Consequently, the end of publication of GOURMET magazine would not be a relevant fact to take into account for the purposes of these proceedings. Indeed, for the purposes of paragraph 12(1)(d) of the Act, the relevant date would be either the date of the disposition of the matter by the Registrar or by this Court, though some controversy still exists as to this latter date of disposition by this Court, see: *Park Avenue Furniture Corp. v. Wickes-Simmons Bedding Ltd.*, (FCA) (1991) 37 C.P.R. (3d) 413, [1991] F.C.J. No. 546 (QL) and Gill & Jolliffe, *Fox on Canadian Law of Trade-Marks and Unfair Competition*, Fourth Edition, at para. 6.7 (d.1) found at pages 6-20.7 and 6-20.8 of the loose-leaf edition. In any event, at either date Gourmet magazine was in circulation in Canada.

[73] For the purposes of paragraph 16(1)(a) or of subsection 16(3) of the Act, the material dates of the confusion analysis are the date of first use by the Applicant for registration, or as the case may be, the date of filing of the registration application. At both these dates, the new evidence submitted by the Applicant conclusively shows that GOURMET magazine was widely circulated in Canada.

Conclusion

[74] It is incumbent on the Respondent to show on a balance of probabilities that there is no likelihood of confusion. The Respondent was successful in this regard before the Registrar.

[75] However, the new relevant and substantial evidence submitted by the Applicant has resulted in a reconsideration of the question of confusion between GOURMET and WISE GOURMET on a *de novo* or fresh basis. The Respondent has chosen not to challenge this new evidence or to participate in this appeal. Since the Respondent bears the onus to show that there is no likelihood of confusion in this case, it has failed to do so in light of the new evidence submitted.

[76] Though the GOURMET trade-mark is not inherently distinctive, its use over time by the Applicant has allowed it to gain a certain reputation in Canada related to its magazine and associated wares and services. Though the word “gourmet” is in common usage in regard to food and related products and services, the Applicant has demonstrated that its trade-mark GOURMET has become well known in Canada through its magazine. Furthermore, the GOURMET trade-mark has been in use for a long time in Canada while the Respondent’s mark is a new entrant in the

market. Taking into account that the nature of the wares and services and that the trade related to both marks overlap to a considerable degree, the fact that there is a fair degree of resemblance between both marks, and the absence of any evidence or submissions by the Respondent to challenge the new evidence submitted in this appeal by the Applicant, I find on a balance of probabilities that there is a likelihood of confusion between the Respondent's mark WISE GOURMET and the registered trade-mark GOURMET.

[77] As a consequence thereof, the appeal shall be granted.

[78] In light of the particular circumstances, this is not a case for costs.

JUDGMENT

THIS COURT ORDERS AND ADJUDGES that:

1. The appeal is granted;
2. Application no. 1,202,570 under the *Trade-marks Act* for the trade-mark WISE GOURMET is refused.

“Robert Mainville”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1159-08

STYLE OF CAUSE: ADVANCE MAGAZINE PUBLISHERS, INC. v.
WISE GOURMET INC.

PLACE OF HEARING: Toronto, Ontario

DATE OF HEARING: October 28, 2009

**REASONS FOR JUDGMENT
AND JUDGMENT:** Mainville J.

DATED: November 24, 2009

APPEARANCES:

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No appearance FOR THE RESPONDENT

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Nil FOR THE RESPONDENT