

IN THE MATTER OF AN OPPOSITION by Bose Corporation to application No. 1,088,449 for the trade-mark WAVERADIO.COM filed by Tim Siekawitch

On January 10, 2001, Tim Siekawitch [the “Applicant”] filed an application to register the trade-mark WAVERADIO.COM [the “Mark”] based upon use of the Mark in Canada since January 20, 2000 in association with the following services:

audio mastering, post audio production for film, radio and T.V., record labels, solo artists, groups, CD brokerage services.

The Applicant has disclaimed the right to the exclusive use of .COM apart from the Mark.

The application was advertised for opposition purposes in the Trade-marks Journal of February 5, 2003. On March 26, 2003, Bose Corporation [the “Opponent”] filed a statement of opposition. The Opponent has pleaded grounds of opposition under s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the “Act”].

The Applicant filed and served a counter statement.

In support of its opposition, the Opponent filed the affidavit of Natasha Rambaran, Human Resources Coordinator/Financial Analyst for the Opponent’s wholly-owned Canadian subsidiary, Bose Limited.

In support of its application, the Applicant filed the affidavit of Tim Siekawitch. The Opponent obtained an order for the cross-examination of Mr. Siekawitch but did not proceed with a cross-examination.

As reply evidence, the Opponent filed a further affidavit of Natasha Rambaran.

I note that on various occasions the Applicant forwarded materials to the Registrar but confirm

that the only material in evidence in these proceedings from the Applicant is his affidavit (which has six attachments). The other materials provided by the Applicant did not accord with the requirements of the *Trade-marks Regulations*.

To the extent that either party's evidence contains argument, hearsay, opinion, or information/material that is not relevant to the issues at hand, I have disregarded it. I also note that requests in the Applicant's affidavit that I access the Internet or contact certain individuals cannot be complied with. In opposition proceedings, the Registrar will have regard to only certain limited subject matter in the absence of it being properly proven in evidence (such as a dictionary definition or the status of a trade-mark registration that forms the basis of a pleading).

Only the Opponent filed a written argument. Neither party requested an oral hearing.

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, 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 each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 38(2)(b) grounds of opposition

The Opponent has pleaded that the Mark is not registrable within the meaning of s. 12(1)(d) of the Act as it is confusing with the Opponent's previously registered trade-marks ACOUSTIC WAVE (TMA311,599) registered February 21, 1986 for use in association with loudspeaker systems and WAVE (TMA561,135) registered May 1, 2002 for use in association with radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players.

The Opponent has met its initial burden with respect to its s. 12(1)(d) grounds of opposition because its registrations are extant.

The material date for assessing the likelihood of confusion under s. 12(1)(d) is today's date [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].

test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

I shall first address the likelihood of confusion between WAVERADIO.COM and WAVE.

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known

Each of the marks is inherently distinctive.

The Applicant states that it has used its Mark. However I do not see the Mark in any of the provided attachments.

The Applicant has not shown how its Mark has been promoted. Instead, Mr. Siekawitch has

explained that the Applicant does not “go all out with billboards and ads ‘on the dish’ or in magazines... [o]ur best advertising comes via word of mouth, or from people listening to our client’s CD’s/DVD’s that we Audio Mastered for them.”

The Applicant has also not provided any means by which I can assess the extent of any use or advertising that may have occurred in association with its Mark (e.g. sales figures, number of CDs produced, etc.)

Let me be clear in stating that I am not doubting the Applicant’s sworn statement that he has used or promoted the Mark; however, in the absence of evidence showing such use or promotion, I cannot find that the Mark has acquired any reputation. In this regard, I would also point out that the mark applied for is WEVERADIO.COM, not WAVE RADIO or www.waveradio.com. If the Applicant had filed proper significant evidence showing use/promotion of WAVE RADIO or www.waveradio.com, then the issue would have become whether such amounted to use/promotion of the applied for mark.

On the other hand, the Opponent has shown how its WAVE mark has been associated with radios: Exhibit NR-15 to the Rambaran (#1) affidavit shows the WAVE mark displayed on packaging that the affiant attests represents packaging for products sold in Canada since 1993 (“Wave® radio” appears on the outside of the box). Exhibit NR-16 lists a number of Canadian retailers that Ms. Rambaran attests sold the Opponent’s products as of 2005. In paragraphs 45 and 46 of the Rambaran (#1) affidavit, details of money spent promoting the Opponent’s WAVE brands have been provided, including a statement that in 1998/99 at least \$49,000 worth of print advertising was placed in the *Toronto Sun*. However, as no copies of such ads have been provided, I cannot determine that such ads would have resulted in the Opponent’s WAVE mark acquiring greater distinctiveness.

Ms. Rambaran has provided Canadian sales figures for the Opponent’s WAVE radio or radio/cds sold annually from 1994 through 2006; they have exceeded \$16 million. [paragraph 49, Rambaran (#1) affidavit]

Based on the foregoing, I conclude that the Opponent's WAVE mark has acquired more distinctiveness in Canada than has the Applicant's Mark.

s. 6(5)(b) - the length of time each mark has been in use

Based on the date of first use claimed in its registration, the Opponent began using its WAVE mark in Canada at least as early as June 21, 1993 and Ms. Rambaran has provided sales figures starting in 1994.

Based on the date of first use claimed in its application, the Applicant began using its Mark in Canada on January 20, 2000.

Thus the length of time that each mark has been in use in Canada favours the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

I believe that it is these factors that the Applicant feels are among the most significant.

It is true that the Applicant has applied to register its Mark for services, whereas the Opponent has registered its mark for wares. However, as stated in s. 6(5)(2), confusion may occur, "whether or not the wares or services are of the same general class".

In the present case, the parties' services and wares are not completely unrelated – both relate to music and both parties' businesses aim to provide the best sound quality. The Applicant does that by providing superlative recording services; the Opponent does that by providing superlative equipment for use in listening to recordings.

The type of individual who purchases the Applicant's services is typically a musician or movie/video producer whereas the type of person who purchases the Opponent's wares is someone who listens to music, possibly an audiophile. However, differences in the parties' customers do not mean that confusion is not likely. The Applicant has emphasized that he does

not manufacture any “playback” devices or any consumer devices and that the Opponent does not audio master sound recordings. However, that is not decisive. The test for confusion is whether someone who has an imperfect recollection of the Opponent’s mark might conclude upon seeing the Applicant’s Mark as a matter of first impression that the source of the Opponent’s wares and the source of the Applicant’s services are either the same or somehow related. Such a conclusion appears to be reasonably likely given that both parties’ businesses concern music.

The connection between the parties’ services, wares, businesses and trades is further supported by the following:

- i) Recordings created using the Applicant’s services indicate on the CD packaging that they are WAVE RADIO certified (see Attachment 4, Siekawitch affidavit) and such CDs may very well be played on the Opponent’s WAVE compact disc players.
- ii) The Applicant has indicated that he is “developing ‘The Wave Radio’ series of Laboratory Quality Reference Speakers” [Exhibit NR-2, Rambaran (#2) affidavit]; whether or not these are of a quality or purpose similar to the speakers sold by the Opponent under its ACOUSTIC WAVE mark or as part of its WAVE compact stereo systems, the Applicant’s expansion plans further reinforce the connection between the two parties’ businesses.
- iii) There is evidence in the Rambaran (#1) affidavit that the Opponent also has a line of professional audio products, for use by musicians, albeit not in association with its WAVE or ACOUSTIC WAVE trade-marks (see Exhibit NR-4).

s. 6(5)(e) - the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70].

There is a high degree of resemblance between the parties’ marks. The first portion of a trade-mark is the most relevant for the purposes of distinction [*Conde Nast Publications Inc. v. Union*

des Editions Modernes (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188] and the Applicant's Mark includes the Opponent's WAVE mark in its entirety as the first portion of the Applicant's Mark. Moreover, the remainder of the Applicant's Mark consists merely of ordinary/descriptive words/terms. It does not help the Applicant that the second word in his Mark, "radio", is one of the key wares sold in association with the Opponent's WAVE mark and that "radio" appears immediately after WAVE on the Opponent's packaging.

other surrounding circumstances

i) Mr. Siekawitch states that there has been no confusion between the Opponent's wares and the Applicant's services. However, evidence of confusion is not a prerequisite for an opponent to succeed under s. 12(1)(d). Moreover, although the parties appear to have co-existed in Canada since 2000, I have difficulty in determining where the Applicant has offered its services and whether there has been a significant geographical overlap with where the Opponent has sold its wares; if the parties have not been active in the same part of Canada, then this alone could explain a lack of evidence of confusion.

It is true that an adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and there is no evidence of confusion, but here such an inference cannot be drawn because the prerequisite evidence of extensive co-existence is lacking. [See *Christian Dior S.A. v. Dion Neckwear Ltd.* 2002, 20 C.P.R. (4th) 155 (F.C.A.).]

ii) The fact that the Applicant's application was approved for advertisement by the Examination Section of the Canadian Intellectual Property Office does not preclude the Opponent from successfully arguing that the Mark is not registrable. A decision by the Examination Section is not binding on this Board and does not have precedential value for this Board. The onus on an applicant is much higher in an opposition than it is during examination and the Examination Section does not have before it evidence that is filed by parties in an opposition proceeding. [See *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 at 277 and *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 at 386.]

iii) What has taken place in other jurisdictions is not decisive of the outcome of the present proceedings.

iv) The fact that trade-mark notices have or have not been used is not significant.

conclusion regarding likelihood of confusion

Having considered all of the surrounding circumstances, I find that the Applicant has not met its burden to show that, on a balance of probabilities, confusion between its WAVERADIO.COM trade-mark and the registered trade-mark WAVE is not likely. The distinctive portion of the Applicant's Mark is the Opponent's mark. There is little if any evidence that shows how the Applicant has used or promoted WAVERADIO.COM to date, whereas there have been significant sales of the Opponent's WAVE wares. Although the Applicant's services are clearly not the same as the Opponent's wares, there is a nexus between them.

The s. 12(1)(d) ground accordingly succeeds based on the registration for WAVE.

Section 38(2)(c) ground of opposition

The Opponent has pleaded that the Applicant is not the person entitled to registration having regard to s. 16(1)(a) on the ground that the Mark, at the date of first use alleged in the application, was confusing with the trade-marks ACOUSTIC WAVE and WAVE previously used in Canada by the Opponent in association with the wares for which those marks have been registered.

The Opponent has evidenced more than \$3 million worth of Canadian sales of its WAVE radio or radio/CDs prior to the Applicant's claimed date of first use. Overall, a consideration of the likelihood of confusion between WAVERADIO.COM and WAVE as of that date does not differ significantly from a consideration as of today's date. Accordingly, for reasons similar to those set out above in my discussion of the s. 38(2)(b) ground, the s. 38(2)(c) ground of opposition also succeeds.

Remaining grounds of opposition

As I have already refused the application under two grounds, I will not address the remaining grounds.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 24th DAY OF NOVEMBER 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board