



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

Citation: 2010 TMOB 192
Date of Decision: 2010-11-15

**IN THE MATTER OF AN OPPOSITION
by Playboy Enterprises International Inc.
to application No. 1,219,213 for the trade-
mark PLAY BODY in the name of Rick
Worobec**

[1] On June 4, 2004, Rick Worobec (the Applicant) filed an application to register the trade-mark PLAY BODY (the Mark). The application is based upon proposed use of the Mark in Canada in association with the following wares: clothing, namely undergarments, swimwear; footwear, namely shoes.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 15, 2004. On February 14, 2005, Playboy Enterprises International Inc. (the Opponent) filed a statement of opposition. The grounds of opposition are based on s.38(2)(a)/s.30(e), s.38(2)(b)/s. 12(1)(d), s.38(2)(c)/s. 16(3) and s.38(2)(d)/s. 2 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the Act].

[3] The Applicant filed and served a counter statement on March 8, 2005.

[4] In support of the opposition, the Opponent filed the affidavit of Judy Kawal. The Applicant filed three affidavits of Rick Worobec, dated May 15, 2006, June 16, 2006 and June 19, 2006. Neither affiant was cross-examined.

[5] Only the Opponent's written argument is of record, and both parties participated in an oral hearing.

Onus

[6] 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 to support each ground of opposition exist [see *John Labatt Ltd. v. Molson Cos.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Relevant Dates

[7] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30(e) - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(b)/s. 12(1)(d) - the date of my decision [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.)];
- s. 38(2)(c)/s. 16(3) – the filing date of the application [see s. 16(3)];
- s. 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30(e) Ground of Opposition

[8] The Opponent withdrew this ground of opposition in its written argument. It will therefore not be considered.

Section 12(1)(d) Ground of Opposition

[9] The s. 12(1)(d) ground of opposition turns on the issue of the likelihood of confusion between the Mark and the following registered trade-marks of the Opponent:

Trade-mark	Regn. No.	Wares/Services
PLAYBOY	TMA307,887	Undershorts, undershirts, swimwear,...
PLAYBOY	TMA267,515	Footwear, namely men's ladies and children's shoes,...
PLAYBOY	TMA140,596	Articles of clothing...
PLAYBOY	TMA290,136	Men's and women's rain slickers and rain jackets...
PLAYBOY	TMA297,190	Men's and women's jeans, men's woven tops, knit tops and sweatshirts
PLAYBOY	TMA546,605	Vests and bow ties, cummerbunds and pocket squares
PLAYBOY & Design	TMA260,719	Footwear, namely men's, ladies' and children's shoes, boots and slippers.

[10] As I consider the first three registered PLAYBOY marks (i.e. TMA307,887; TMA267,515; and TMA140,596) to be the most relevant to the issue of confusion in the present case, I will focus my discussion on these trade-marks and where appropriate refer to them collectively as the PLAYBOY mark.

the test for confusion

[11] 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.

[12] The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in its decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 [*Veuve Cliquot*]. It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

s. 6(5)(a) – inherent distinctiveness and the extent to which the trade-marks have become known

[13] In *Playboy Enterprises Inc. v. Tattilo Editrice s.p.a.* (1987), 14 C.P.R. (3d) 250 (T.M.O.B.) [*Tattilo*], former Chairman Partington commented on the distinctiveness of the Opponent's PLAYBOY mark as follows: "With respect to the inherent distinctiveness of the marks at issue, the Opponent's trade-mark PLAYBOY as applied to magazines is somewhat suggestive of the fact that the Opponent's contents are directed towards young male readers who are or would wish to be "playboys." While the Opponent in the present case has not relied on its registered PLAYBOY mark for magazines, I consider these comments equally applicable to the registered wares the Opponent has relied upon in the present case. For example, I would consider PLAYBOY for underwear suggestive that the underwear is directed to young men who wish to be playboys.

[14] The Mark, on the other hand, does not appear to be suggestive of the wares. As such, it appears to possess more inherent distinctiveness than the Opponent's mark.

[15] The strength of a trade-mark, however, may be increased by means of it becoming known through promotion or use. The evidence adduced by the Opponent clearly establishes that its PLAYBOY trade-mark has become very well known in Canada. In this regard, the evidence of the Opponent's affiant Judy Kawal, Director, Business and Contract Administration with Playboy Enterprises International, Inc., may be summarized as follows:

- While its primary business is the distribution of a monthly men's magazine, over time the Opponent has expanded into three separate divisions: publishing, entertainment (i.e.

television, dvds and on-line) and licensing. Between the years 1998-2004, the Opponent's average net annual revenues generated through its above noted business groups has been in excess of \$277 million.

- The Opponent's licensed products business as a whole generates in excess of \$600 million in global retail sales in more than 130 countries and territories, including Canada.
- The Opponent has granted approximately 20 licenses for the trade-mark PLAYBOY for use in association with a wide variety of products and services sold in Canada, under which the Opponent has control of the character or quality of the wares and services in association with which the trade-mark PLAYBOY is used. Copies of catalogs showing the Opponent's trade-mark in association with, *inter alia*, clothing, underwear and footwear are attached as Exhibit F to the Kawal affidavit.
- Over the two year period prior to the date of the Kawal affidavit, retail sales for PLAYBOY clothing and related goods in Canada were at least \$2,000,000 Canadian.
- At the date of Ms. Kawal's affidavit, there were at least 200 stores in Canada that were selling licensed merchandise bearing the trade-mark PLAYBOY.
- The Opponent's Canadian licensees also extensively advertise licensed merchandise in association with the trade-mark PLAYBOY in a variety of manners, including in catalogues, advertisements in widely circulated magazines, sales sheets, brochures and promotional contests, all of which are distributed or made available to the consuming public in Canada.
- The Opponent is the owner of 34 Canadian registrations for the PLAYBOY mark, either alone or in combination with other words, for use in association with a wide variety of wares and services.

[16] With respect to the extent to which the marks have become known, I am satisfied from the evidence furnished that the trade-mark PLAYBOY has become known in Canada in association with the Opponent's clothing and related products. As the Applicant has not shown any use of its proposed mark, this factor favours the Opponent.

s. 6(5)(b) Length of time the marks have been in use

[17] Based on the dates of first use claimed in its registration Nos. TMA140, 597; 267,515; and 307,887, the Opponent began using its PLAYBOY mark in association with clothing on June 4, 1965, with footwear on March 19, 1982, and with underwear and swimwear on November 1st, 1985. I do note, however, that the affidavit evidence only shows use of the Opponent's PLAYBOY mark in association with some of these wares in Canada in 2004 and later. In any

case, in view that the Applicant has not shown any use of its mark, this factor favours the Opponent.

s. 6(5)(c) & (d) Nature of wares and trade

[18] When considering the wares, services and trades of the parties, it is the statement of wares or services in the Applicant's trade-mark application, as amended, and the Opponent's registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[19] The goods identified in the Applicant's application are: clothing, namely undergarments, swimwear; footwear, namely shoes. The Opponent's registration Nos. TMA307,887; 267,515 and 140,596 cover a variety of clothing wares including underwear, bathing suits and footwear. Thus, the goods at issue are at least in part identical.

[20] As for the parties' channels of trade, the Applicant submits that the Opponent's mark is associated with adult entertainment whereas the Mark is intended for all customers, including men, women and children. However, there are no trade channel restrictions in either party's description of wares. Ms. Kawal states that PLAYBOY clothing and related goods are sold in retail stores such as Bootleggers, Sears and Spencers, as well as dozens of Canadian fashion boutiques such as "Te Koop" and "Over the Rainbow". Given the identical nature of the parties' wares, and the absence of any trade channel restrictions in either party's description of wares, the parties' channels of trade would presumably overlap.

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

[21] It is axiomatic that the first portion of a trade-mark is the most important for assessing the likelihood of confusion [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.)].

[22] In the present case, there is a high degree of resemblance between the marks in appearance because both begin with the same six letters, i.e. PLAYBO, and end with the letter “Y”. The marks do not possess the same degree of resemblance in sound, however, because the last components of both marks (i.e. BOY and BODY) are pronounced differently.

[23] With respect to ideas suggested, the Opponent’s mark is an ordinary dictionary word that suggests a sexually promiscuous man. The Applicant’s mark, on the other hand, conveys the idea of a person or body who likes to play or have fun.

Surrounding Circumstances

[24] As a surrounding circumstance, the Applicant has relied on the state of the register, and in this regard submitted the affidavit of Rick Worobec, sworn May 15, 2006. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R.(3d) 432 and the decision in *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

[25] Attached to the affidavit of Mr. Worobec sworn May 16, 2006, are copies of the following trade-mark registrations/applications: LITTLE PLAYMATE, registration No. TMA243,495 for portable container for ice, food and beverages; PLAYBOY, registration No. TMA159,285 for men’s headwear; PLAYGIRL, registration No. TMA589,600 for magazines and PLAYGIRL, application No. 1,156,508 for various women’s clothing wares. Out of these four marks, there was only one registered mark that had the component PLAY and was registered in association with clothing related wares (i.e. registration No. TMA159,285). The existence of one trade-mark on the register is of no significance in respect of the issue of confusion between the trade-marks of the parties.

[26] In his affidavits sworn June 16 and 19, 2006, Mr. Worobec submitted evidence pertaining to use of PLAYGIRL in the marketplace. Hearsay deficiencies aside, the evidence of Mr.

Worobec, at best, establishes that PLAYGIRL clothing was on sale at certain specified retail outlets in British Columbia and Alberta in March and/or June of 2006. No evidence regarding the extent of those sales or the length of time such items were available for sale was provided. The evidence of Mr. Worobec is therefore insufficient to show that marks with the component PLAY have been commonly adopted in Canada in association with clothing. Consequently, the evidence of Mr. Worobec does little to assist the Applicant's case.

[27] As a further surrounding circumstance, the Opponent submits that, as a famous mark, the PLAYBOY mark should be afforded a broader ambit of protection compared to non-famous marks. The Opponent relies on the following evidence of use of the mark PLAYBOY to support its argument:

- The trade-mark has been used by the Opponent for more than 55 years in association with the PLAYBOY magazine and more than 49 years in association with clothing;
- PLAYBOY magazine has become the world's best selling men's magazine and one of the most successful periodicals ever printed, with almost 15 million monthly readers worldwide, including 65,000 monthly readers in Canada;
- PLAYBOY DVDs and home videos are sold in 200 countries and territories, including Canada;
- The Opponent's business generates in excess of \$600 million (US) in global retail sales and average net revenues in excess of \$310 million US per year; and
- Millions of dollars are spent every year to publicize the trade-mark PLAYBOY in many mediums including television, magazine, print, billboard, e-mail and Internet, including by the Opponent's Canadian licensees.

[28] The courts have recognized that the Opponent's PLAYBOY mark is well known – see *Playboy Enterprises v. Germain* (1978), 39 C.P.R. (2d) 32 (F.C.T.D.); *Playboy Enterprises Inc. v. Astro Tire & Rubber Co. of Canada Ltd.* (1978), 46 C.P.R. (2d) 87 (T.M.O.B.). In those cases, however, the fact that the Opponent's mark was world renowned could not be a factor so important as to make the differences in wares and services irrelevant (i.e. magazine v. barbering/hair dressing services and magazine vs. automobile tires). The fact that the Opponent's mark was well known, combined with the similarities in the parties' wares did, however, assist the Opponent in the *Tattilo* case, where the applied for mark PLAYMEN for

magazines was found likely to be confused with the Opponent's PLAYBOY mark for magazines.

[29] The Opponent also relies on a decision of the United States Trade-mark Trial and Appeal Board (TTAB) respecting an opposition by the present Opponent to the present Applicant's corresponding U.S. application. In that decision, the Board wrote as follows at p.16-17:

“In view of the fame of opposer's PLAYBOY mark, the identity of the goods, and the similarity of the marks, we find that applicant's use of PLAY BODY, in connection with “clothing, namely undergarments, swimwear; footwear, namely shoes” is likely to cause confusion with the mark PLAYBOY for clothing, including lingerie, briefs, bathing suits and footwear.”

Playboy Enterprises International, Inc. v. Rick Worobec, (March 18, 2008 T.T.A.B. (unreported), opposition No. 91165814, March 18, 2008, p. 16-17).

[30] It should be noted that a foreign decision has little probative value in a Canadian opposition [see *Cantine Torresella S.r.L. v. Carbo* (1987), 16 C.P.R. (3d) 137 (F.C.T.D.)]. I also note that Canadian law and U.S. law differ, and that the evidence presented in the U.S. case would likely have been different from the evidence provided in the present case. However, given that the TTAB considered many of the same issues that are at play in the present case, I am guided by the U.S. case to some extent.

[31] In view of the above, I am satisfied that the Opponent's mark is very well known in Canada, and that such factor is a relevant surrounding circumstance in the present case.

Conclusion Re: Likelihood of Confusion

[32] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees PLAY BODY on the Applicant's undergarments, swimwear or footwear, at a time when he or she has no more than an imperfect recollection of the Opponent's PLAYBOY trade-marks, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[33] In view of my findings above, and in particular the Opponent's extensive reputation of its PLAYBOY mark, the fact that some of the wares are identical, and the high degree of

resemblance between the marks in appearance, it seems to me that such a consumer would, as a matter of first impression, be likely to believe that the wares associated with the PLAYBOY and PLAY BODY trade-marks were manufactured, sold or performed by the same person.

[34] The s. 12(1)(d) ground of opposition therefore succeeds.

Remaining Grounds of Opposition

[35] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and the Opponent's marks. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the trade-marks are likely to be confused applies to these grounds of opposition which also succeed.

Disposition

[36] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office