



Jewellery, printed, lithographed and engraved material namely books, brochures, pamphlets, postcards, calendars, pictures and posters, memo paper and note paper (the Goods); and

the following services:

Wholesale sale of jewellery to jewellers, jewellery manufacturers, jewellery designers, goldsmiths and to other retail outlets, retail jewellery sales, marketing of jewellery of third parties by means of magazine advertisements, brochures and promotional videos (the Services).

[3] The application was filed by Star-Set Jewellers Ltd. (the Applicant) on February 27, 2013 on the basis of proposed use in Canada.

[4] The Opponent filed a statement of opposition on August 23, 2013 under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded are based on sections: 30 (requirements), 12(1)(d) (registrability), 16(3) (non-entitlement), and 2 (distinctiveness). Except for the grounds based on section 30 of the Act, they all turn on the issue of likelihood of confusion with the Opponent's trade-marks MEMORIA and COLLECTION MEMORIA. The grounds of opposition are detailed in Annex A to this decision.

[5] For the reasons explained below, I refuse the application.

#### The Record

[6] The application was advertised in the *Trade-marks Journal* on June 26, 2013. The Opponent filed its statement of opposition on August 23, 2013. The Applicant filed and served a counter statement on October 10, 2013 in which it denied each and every ground of opposition pleaded by the Opponent.

[7] The Opponent filed as evidence the affidavit of Jocelyne Dallaire Légaré dated February 10, 2014 while the Applicant elected not to file any evidence.

[8] Only the Opponent filed written arguments and both parties were represented at the hearing.

The parties' respective burden or onus

[9] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Preliminary remarks

[10] I wish to point out that in reaching my decision I have considered all the evidence in the file but I will only refer in my reasons for this decision to the relevant portions of the evidence.

[11] This file was heard together with application No. 1615907, identical to the present one save and except for the trade-mark applied for and that the Applicant filed some evidence. Obviously, I cannot take into consideration the evidence filed by the Applicant in application No. 1615907. Since the content of those files is different, I decided to issue two distinct decisions.

[12] One of the Applicant's main arguments is that it already owns registration No. TMA861,951 for the trade-mark MEMORIA JEWELERY covering the same goods and services as those covered by the present application. Since the dominant word portion of the Mark and the trade-mark MEMORIA JEWELERY is the word MEMORIA and that the goods and services covered by the aforesaid registration are identical to the Goods and Services, the Applicant argues that it should obtain the registration of the Mark.

[13] There is no evidence in the record that the Applicant is the owner of such registration. I am not prepared to use the Registrar's discretion to consult the register in order to obtain the details of that registration. If the Applicant intended to refer to such registration to support its argument,

it had to file an extract of the register. In any event, on numerous occasions the Registrar has stated that ownership of a registration does not automatically grant to an applicant the right to obtain registration of another trade-mark, no matter how closely the trade-marks may be related [see *American Cyanamid Co v Stanley Pharmaceuticals Ltd* (1996), 74 CPR (3d) 571 (TMOB) and *Ralston Purina Canada Inc v HJ Heinz Co of Canada* (2000), 6 CPR (4th) 394 (TMOB)].

[14] Consequently, I shall review the grounds of opposition based on the likelihood of confusion with the Opponent's trade-marks by applying the criteria enunciated in section 6(5) of the Act and detailed hereinafter.

#### Grounds of opposition summarily dismissed

##### Section 30 grounds of opposition

[15] In its statement of opposition, the Opponent raised as grounds of opposition sections 30(e), (h), and (i) of the Act. These grounds of opposition have not been addressed by the Opponent in its written argument. Moreover, at the hearing the Opponent's agent informed me that he did not intend to make any representations about them.

[16] There is no evidence in the record that supports any of these grounds of opposition.

[17] Consequently, they are all dismissed, as the Opponent failed to meet its initial burden of proof.

[18] Therefore, the only grounds of opposition to be discussed hereinafter are those based on sections 12(1)(d), 16(3) and 2 (distinctiveness) of the Act.

##### Registrability of the Mark under section 12(1)(d) of the Act

[19] The relevant date for the analysis of this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[20] Ms. Dallaire Légaré has been the Opponent's President since May 3, 2002. She filed a certificate of authenticity for the trade-mark MEMORIA (registration No. TMA647,454) registered in association with:

Urns, reliquaries, caskets, bookmarks, guest books, thank-you cards, picture frames and votive candles (MEMORIA Products); and

Funeral home services; prepaid funeral services; cremation services; mausoleum, burial plots and columbariums; funeral arrangement services, reception room rental, photographic and videographic tribute services, mourning follow-up services, inheritance assistance services, repatriation services, art therapy services, psychological and legal assistance services, sale of funerary products (MEMORIA Services).

[21] Ms. Dallaire Légaré also filed a certificate of authenticity for the trade-mark COLLECTION MEMORIA (registration No. TMA786,566) registered in association with:

Cinerary urns, reliquaries, crosses, original works of art, namely sculpture, paintings, photographs, works of art on paper, silkscreen prints and lithographs; antique furniture, namely desks, chairs, tables, buffets, armchairs, stools, chesterfields, sofas, divans, benches, commodes, wardrobes, shelves, bookcases, secretary desks, chests; books, bookmarks, registers, reading lights, thank-you cards, condolence cards, Chinese lanterns, frames (COLLECTION MEMORIA Products); and

Documentation centre for consulting books, musical works, movies, research findings, compilation and archives of extracts of texts on death and grieving; genealogical service (COLLECTION MEMORIA Services).

[22] Therefore, the Opponent has met its initial burden with respect to this ground of opposition.

[23] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006),

49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[24] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-marks, who sees the Applicant's Goods and Services in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

[25] The Opponent has its best chances of success with its registered trade-mark MEMORIA. I will therefore limit my analysis of the relevant criteria to that mark. If the Opponent is not successful with this trade-mark, it would not achieve a better result with its registered trade-mark COLLECTION MEMORIA.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[26] Even though MEMORIA is a coined word, it is suggestive of 'memorial' when used in association with the MEMORIA Products and the MEMORIA Services. As for the Mark, it does contain a stylized M, as well as a design element. In all, I consider the Mark to be slightly more inherently distinctive than the Opponent's trade-mark MEMORIA. However, it will not be a determining factor in this decision.

[27] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. The application is based on proposed use. As for the evidence of use of the Opponent's registered trade-mark MEMORIA, it is contained in Ms. Dallaire Légaré's affidavit.

Evidence of use of the Opponent's registered marks

[28] Ms. Dallaire Légaré states that the Opponent is a family business going back four generations, created by Alfred Dallaire and carrying on business in the field of funerals. The Opponent is now presently located in most areas of Montreal Métropolitain, Laval and Repentigny, with a dozen of branches, complexes and mausoleums.

[29] Ms. Dallaire Légaré affirms that, in 2003, the Opponent's predecessor in title Alfred Dallaire Inc (ADI) went through a corporate restructure such that half of its assets were transferred to the Opponent, incorporated on May 3, 2002, which was then known as 9116-2644 Quebec Inc. and now known under the Opponent's name. It was soon thereafter that the Opponent adopted the trade-mark MEMORIA.

[30] Ms. Dallaire Légaré alleges that the MEMORIA Products and MEMORIA Services are displayed on the Opponent's website located at *www.memoria.ca*. She states that the website has been in operation since December 2003.

[31] Ms. Dallaire Légaré filed as exhibit JDL-2 extracts of the website illustrating MEMORIA Products sold since 2003 in Canada such as cinerary urns, reliquaries, caskets, bookmarks, guest books, thank-you cards, picture frames and votive candles. She also filed as exhibit JDL-3 extracts of the website describing the MEMORIA Services offered in Canada since at least 2003 such as funeral home services; prepaid funeral services; funeral arrangement services, reception room rental, mausoleum, columbarium, inheritance assistance services, repatriation services and art therapy services.

[32] At this stage I wish to illustrate what appears on the extracts of the webpages and I will discuss later if this representation constitutes use of the trade-mark MEMORIA:

**Alfred Dallaire | MEMORIA**

Also, on most of the exhibits filed, the trade-mark MEMORIA appears in the same format as illustrated above, except where stated otherwise in my decision.

[33] Ms. Dallaire Légaré filed as exhibit JDL-5 extracts of the website showing keepsake jewellery (in French 'bijoux reliquaires') sold in association with the trade-mark MEMORIA since at least as early as 2003 in Canada. The trade-mark appearing on each of the pages filed is in the form illustrated above. She filed as exhibit JDL-6 a photograph taken in 2003 showing different keepsake jewellery in the form of necklaces sold in Canada since as early as 2003.

[34] Ms. Dallaire Légaré alleges that some of the necklaces, part of the new line created in 2013 sold in association with the trade-mark MEMORIA, are shown on the website as well, and she filed as exhibit JDL-7 extracts illustrating them. However, the trade-mark appearing beside the photograph of the necklace is MEMORIA HARRICANA. I will also discuss later if use of that trade-mark constitutes use of the trade-mark MEMORIA. I noticed that each webpage filed does have the trade-mark Alfred Dallaire | MEMORIA as illustrated above.

[35] Ms. Dallaire Légaré affirms that, in the normal course of business, the trade-mark MEMORIA appears on the MEMORIA Products or on the bags or pouches in which those products are sold in Canada since as early as 2003. She filed as exhibit JDL-8 a sampling of pictures showing the trade-mark MEMORIA on some of the MEMORIA Products such as cards, bookmarks and votive candles. Again, on most of these pictures, the trade-mark appearing is Alfred Dallaire | MEMORIA. However, on some of the pictures the words Alfred Dallaire and MEMORIA are separated by a horizontal line instead of a vertical line as illustrated above.

[36] As for the use of the trade-mark MEMORIA in association with keepsake jewellery, Ms. Dallaire Légaré states that the mark appears on boxes, bags and pouches in which they are sold and she referred to the pictures of those packaging filed as exhibit JDL-8, all bearing the trade-mark Alfred Dallaire | MEMORIA as illustrated above.

[37] Ms. Dallaire Légaré filed as exhibit JDL-9 a box in which the necklaces created in collaboration with a third party identified as Harricana are sold, since as early as 2013, in association with the trade-mark MEMORIA. However, the trade-mark appearing on the box is MEMORIA HARRICANA.

[38] As an illustration of the use of the trade-mark MEMORIA in association with the MEMORIA Services since 2003, Ms. Dallaire Légaré filed as exhibit JDL-10 a pamphlet distributed by the Opponent in its branches, complexes and mausoleums, through kiosks operated in shopping centres, during special events held outside its branches, complexes and mausoleums, or during conferences given by Opponent's employees.

[39] Ms. Dallaire Légaré further alleges that all of the Opponent's goods and services are offered for sale and sold in Canada in association with its trade-marks in its various complexes and

branches located in the Montreal Metropolitan area as well as through its website as it appears from the various extracts filed.

[40] Ms. Dallaire Légaré asserts that the trade-mark MEMORIA appears on the façade of the complexes and branches wherein the MEMORIA Products and MEMORIA Services are sold since 2003 and she filed as exhibit JDL-12 a picture of the façade of its head office located on Laurier Street in Montreal.

[41] As for the sales figures, Ms. Dallaire Légaré simply states that the annual sales figures of the goods and services sold in association with the trade-marks MEMORIA and COLLECTION MEMORIA are in the millions of dollars. However, there is no breakdown, per year, per trade-mark, per product and service. She filed samples of invoices as exhibit JDL-13 issued between 2010 and 2013 to Canadian customers for the sale of MEMORIA Products and MEMORIA Services. The invoices filed do refer to some of the MEMORIA Products and there is a reference number beside the goods described therein that corresponds to the reference number identified on the webpages filed and described above.

[42] In addition, she filed as exhibit JDL-14 samples of invoices issued between 2004 and 2013 for the sale of keepsake jewellery in association with the trade-mark MEMORIA. That trade-mark is overprinted on each invoice.

[43] Moreover, Ms. Dallaire Légaré affirms that the Opponent invested in Canada annually, on average, between 500,000\$ and 700,000\$ in publicity and for the promotion of the trade-mark MEMORIA in the form of ads in printed publications (newspapers and magazines), on radio and television. She filed as exhibit JDL-15 an advertisement for funeral services published in the December 5, 2012 issue of the newspaper *La Presse* and as exhibit JDL-16 a sampling of printed advertisements for the trade-mark MEMORIA published in 2009 and 2012 in local Italian newspapers which circulated in the Italian community. However no French or English translation of these advertisements have been provided. Moreover, there is no information provided on the extent of the distribution of those Italian local newspapers.

[44] When the Opponent launched its line of MEMORIA necklaces, it issued flyers and she filed as exhibit JDL-17 a sample of such flyer. There is no information on the circulation figures of

this flyer. I also note that the trade-marks appearing on it are: Alfred Dallaire | MEMORIA, Alfred Dallaire MEMORIA, and MEMORIA HARRICANA.

[45] Ms. Dallaire Légaré explains that the Opponent promotes cultural and artistic events and she filed as exhibit JDL-18 a sampling of books, films, music records and cultural events to which the trade-mark MEMORIA is associated with. However, various versions of the trade-mark Alfred Dallaire MEMORIA appear on the documentation filed.

[46] The trade-mark MEMORIA is also promoted since 2003 through the distribution of promotional items such as calendars, note pads, promotional bookmarks, greeting cards and umbrellas and she filed as exhibit JDL-19 pictures of such promotional material. There is no information on the extent of its distribution and the period of time during which it was distributed. Finally the trade-mark appearing on most of the pictures is Alfred Dallaire | MEMORIA as illustrated previously.

[47] Ms. Dallaire Légaré then filed a sample of an article published in the newspaper *La Presse* on November 10, 2007 concerning a prize won by the Opponent with respect to the interior decoration of one of its places of business located in Montreal. Again, the trade-mark or trade name referred to is Alfred Dallaire MEMORIA. Finally, she filed as exhibit JDL-21 extracts of articles published in 2013 in the newspapers *La Presse* and *Journal de Montréal* on the necklaces MEMORIA. However, the trade-mark referred to is HARRICANA X MÉMORIA.

[48] As it appears from the above detailed summary of the Opponent's evidence, there is very little use of the trade-mark MEMORIA alone. I have to determine if the use of the different variations of Alfred Dallaire MEMORIA, as described above, can be considered evidence of use of the trade-mark MEMORIA. The answer to this question will have a direct bearing on the degree of acquired distinctiveness of the trade-mark MEMORIA.

Does use of Alfred Dallaire | MEMORIA constitute use of  
MEMORIA

[49] At the hearing, the Applicant argued that the trade-marks Alfred Dallaire | MEMORIA and MEMORIA HARRICANA or any versions of these marks are composite marks. Therefore, any

reputation through use of these marks is with Alfred Dallaire | MEMORIA and MEMORIA HARRICANA and not MEMORIA alone.

[50] The Opponent argued that Alfred Dallaire | MEMORIA consists of two distinct trade-marks, namely Alfred Dallaire and MEMORIA. To support such contention the Opponent points out to the facts that both marks are written in different font; and there is a vertical (or horizontal in certain instances) line separating each trade-mark giving the clear impression to the consumer that they are two distinct trade-marks.

[51] It has been mentioned on numerous occasions that it is possible to use simultaneously two or more trade-marks [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985) 6 CPR (3d) 270 (FCTD) and *Mantha & Associates v Old Time Stove Co Inc* (1990), 30 CPR (3d) 574 (TMOB)]. Also, the Opponent relies on the first principle enunciated in *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) where the Registrar stated:

Use of a mark in combination with additional material constitutes use of the mark per se as a trade mark if the public, as a matter of first impression, would perceive the mark per se as being used as a trade mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing (see e.g., *Standard Coil Products (Can.) Ltd. v. Standard Radio Corp.* (1971), 1 C.P.R. (2d) 155 at p. 163, [1971] F.C. 106 (Fed. T.D.)), or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name: see e.g., *Carling O'Keefe Ltd. v. Molson Cos.* (1982), 70 C.P.R. (2d) 279 (T.M. Opp. Bd.), at pp. 280-1, applying *Bulova Accutron Trade Mark* (1968), [1969] R.P.C. 102 (Eng. Ch. Div.), at pp. 109-10.

[52] I agree with the Opponent that the use of Alfred Dallaire | MEMORIA as illustrated above or with a horizontal line separating Alfred Dallaire and MEMORIA combined with the use of different fonts give a clear indication to the consumers that they constitute two separate trade-marks.

[53] However, in so far as the use of the trade-marks MEMORIA HARRICANA and HARRICANA X MÉMORIA is concerned, there are no vertical or horizontal lines to separate MEMORIA and HARRICANA, and those words are written in the same font. I conclude that the use of MEMORIA HARRICANA or HARRICANA X MÉMORIA does not constitute use of the Opponent's trade-mark MEMORIA.

[54] In view of these conclusions, I also conclude that the trade-mark MEMORIA is known to some extent in the Montreal area.

Length of time the marks have been in use

[55] From the evidence described above, this factor favours the Opponent in so far as its registered trade-mark MEMORIA is concerned.

The nature of the goods and services and their channels of trade

[56] A great deal of the parties' argumentation relate to these factors.

[57] Under section 12(1)(d) ground of opposition, I must compare the goods as described in the application with the goods and services covered by the Opponent's registrations [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[58] The Applicant argues that:

- it is the owner of registration No. TMA861,951 for the trade-mark MEMORIA JEWELRY covering the same goods and services as those covered by the present application;
- the Opponent's registration No. TMA647,454 for the trade-mark MEMORIA was amended in August 2010 to add certain goods but not jewellery, while reliquaries are covered by that registration. Consequently, according to the Applicant, there is a distinction between jewellery and reliquaries.

[59] I already disposed of the argument about the existence of a registration owned by the Applicant for a similar trade-mark covering the same goods and services. I will discuss now the nature of the Goods versus the goods and services covered by the Opponent's registration.

[60] The Applicant argues that reliquaries and jewellery are not the same. In fact it argues, as it appears from the extracts of Opponent's website filed by Ms. Dallaire Légaré as exhibit JDL-2, under the heading 'Produits', on the scroll down menu, there is a title 'Bijoux et reliquaires' which suggests that they are two distinct products. Under the scroll down menu there are different categories of products. The fact that there are grouped together under one heading can imply that they belong to the same category of goods.

[61] I used my discretion to consult English or French dictionaries. In the *Canadian Oxford Dictionary*, 2d the word 'reliquary' is defined as 'a receptacle for relics'. A receptacle can take many forms.

[62] Ms. Dallaire Légaré filed as exhibit JDL-6 pictures of keepsake jewellery in the form of pendants sold in association with the trade-mark MEMORIA since 2003. She also filed as part of exhibit JDL-8 different type of bags or pouches bearing the trade-mark Alfred Dallaire | MEMORIA in which are sold the MEMORIA Products, including keepsake jewellery.

[63] From these pictures, it appears that the Opponent's reliquaries sold in association with the trade-mark MEMORIA are keepsake jewellery in the form of pendants and necklaces. Consequently, there is an overlap between the Applicant's jewellery and the Opponent's reliquaries.

[64] As for the other Goods, there is an overlap between the printed, lithographed and engraved material and the Opponent's bookmarks, guest books and thank-you cards.

[65] With respect to the parties' respective businesses, the Applicant argues that clearly the Opponent is in the funeral services business while the Applicant is selling jewellery. Therefore this factor should favour the Applicant.

[66] It appears, from the evidence described above, that the Opponent is selling, through its funeral homes and website, necklaces and pendants in association with the trade-mark

MEMORIA which can contain ashes of a beloved one. On the other hand, I have no evidence of the Applicant's business and channels of trade. However, the description of the Services leads me to conclude that the Applicant is in the business of selling jewellery. Therefore, I conclude that there is some overlap in the parties' businesses.

[67] I have no evidence of the Applicant's channels of trade. However, from the description of the Services, I can infer that the Applicant will be offering for sale its Goods through jewellery stores while the Opponent's reliquaries are sold through its funeral homes. Therefore, the parties' channels of trade are different.

[68] I wish to point out that I give little probative value to the content of exhibit JDL-22 to Ms. Dallaire Légaré's affidavit. The Opponent relied on this exhibit to argue the similarity in nature of the parties' goods and services. It is an extract of a third party's website, a magazine entitled *Funeral (Business Advisor)*, consisting of an alleged advertisement of the Applicant's jewellery in association with the Mark. The Opponent also relies on the content of that exhibit to argue confusion in the marketplace as the Opponent's website address appears at the bottom of the ad instead of the Applicant's website address.

[69] It has been decided that, in general, the searches of third parties' website constitutes evidence that such websites exist but do not make proof of their content [see *Envirodrive Inc v 836442 Canada Inc* 2005 ABQB 446] or does not make proof of its content.

#### Degree of resemblance

[70] As stated by the Supreme Court of Canada in *Masterpiece*, in the majority of cases, the degree of resemblance between the marks in issue is the most important factor.

[71] The Applicant argues that there cannot be confusion between the parties' marks as the Applicant's Mark consists of a large, stylized M, a crest design and the words 'for all the memories', all absent from the Opponent's trade-mark MEMORIA.

[72] The Opponent submits that the parties' marks have a common denominator, namely the word 'memoria'. It is the distinctive and dominant portion of each of these marks. The additional

features mentioned by the Applicant are written in much smaller script and in gray (or pale). The idea suggested by all the marks is the same namely, ‘keep something from a beloved one’.

[73] The test for confusion has been set out in the following terms by Mr. Justice Binnie in *Veuve Clicquot, supra*, at para 20:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark], at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[74] The Applicant tried to distinguish the marks in issue by pointing out the differences described above. No matter what are the differences between the marks of the parties, it is the first impression of the Mark that needs to be considered and not a detailed analysis of each element of the Mark. There is no doubt in my mind that the dominant portion of the Mark is the word ‘memoria’. It is also the first portion of the Mark.

[75] The idea suggested by the marks in issue is the same. Both the Mark and MEMORIA suggests the idea of ‘in memory’.

[76] Consequently, the marks do resemble one another visually with the presence of the dominant first word ‘memoria’, in sound and in the idea suggested by them. This factor also favours the Opponent.

### Additional Surrounding Circumstances

#### Instances of confusion

[77] As discussed above, the Opponent refers to exhibit JDL-22 to argue that there has been an instance of confusion between the marks in issue. I already ruled that such exhibit constitutes inadmissible hearsay evidence.

### Applicant's registration for a similar trade-mark

[78] I already discussed the effect of an existing registration for a trade-mark similar to the Mark. I do not need to consider such fact as an additional surrounding circumstance.

### Conclusion

[79] From this analysis of the relevant criteria, I conclude that the Applicant has failed to meet its legal onus to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's MEMORIA trade-mark. I base my decision on the fact that the Opponent's trade-mark is known to some extent in association with keepsake jewellery, reliquaries and funeral services; there is an overlap in the parties' goods and services and their channels of trade; and there is a fair degree of resemblance between the marks in sound, appearance and the ideas suggested by them. As for the differences between the Mark and the Opponent's trade-mark MEMORIA described in paragraph 70 above, I do not consider them to be sufficient to enable a consumer, who is vaguely aware of the Opponent's trade-mark MEMORIA, on a first impression basis, to infer that the Applicant is the source of the Goods and Services.

[80] Consequently I maintain the ground of opposition based on section 12(1)(d) of the Act.

### Lack of distinctiveness of the Mark

[81] This ground of opposition must be assessed as of the filing date of the statement of opposition (August 23, 2013) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 CF 1185, 34 CPR (4th) 317 (FC)].

[82] To meet its initial burden under this ground of opposition the Opponent had to prove that its trade-mark MEMORIA had become sufficiently known in Canada on August 23, 2013, to negate any distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[83] The evidence described under the ground of opposition of registrability is sufficient to conclude that the Opponent's trade-mark MEMORIA was known in Canada or at least in

Montreal Metropolitan area at the relevant date. Therefore the burden shifts on the Applicant to show that, on a balance of probabilities, the Mark was not likely to create confusion with the Opponent's aforesaid trade-mark such that it was adapted, at the relevant date, to distinguish or actually distinguished throughout Canada the Goods and Services from the Opponent's MEMORIA Products and MEMORIA Services [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[84] The earlier material date under this ground of opposition would not materially affect my analysis of the relevant criteria to assess the likelihood of confusion between the marks in issue. Therefore my analysis of the relevant criteria to determine if the Mark is likely to cause confusion with the Opponent's trade-mark would generate similar results to those described under the registrability ground of opposition.

[85] Under these circumstances, I conclude that the Applicant has failed to prove that the Mark was distinctive or was adapted to distinguish the Goods and Services from the Opponent's MEMORIA Products and the MEMORIA Services. Consequently I maintain this ground of opposition.

#### Other Grounds of opposition

[86] The Opponent having been successful under two separate grounds of opposition, it is not necessary to assess the remaining grounds of opposition.

#### Disposition

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

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Hearing Date: 2015-08-13

Appearances

Mr. Barry Gamache

For the Opponent

Ms. Stephanie Roberts

For the Applicant

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For the Opponent

Sim & McBurney

For the Applicant

## Annex a

The grounds of opposition now pleaded can be summarized as follow:

1. The application does not comply with the requirements of section 30(e) of the *Trade-marks Act* RSC 1985, c T-13, (the Act) in that the Applicant at the filing date of the application was already using the Mark in Canada in association with each of the Goods or each of the Services;
2. The application does not comply with the requirements of section 30(e) and (h) of the Act in that the trade-mark proposed to be used in Canada is not the Mark but another, different from the one referred to in the application;
3. The application does not comply with the requirements of section 30(e) of the Act in that the Applicant, at the filing date of the application, never intended to use the Mark in Canada with each of the Goods or the Services;
4. The statement that the Applicant is satisfied as to its entitlement to the use of the Mark in Canada is false in view of the content of the present opposition, including the Applicant's knowledge of the Opponent's rights as herein alleged and the unlawfulness of said use, if any, as:
  - a. such use would be violating the Opponent's rights as detailed therein, the whole at the Applicant's knowledge;
  - b. such use would have the effect of depreciating the value of the goodwill attached to the trade-marks alleged by the Opponent, contrary to section 22 of the Act;
  - c. such use would, at the Applicant's knowledge, direct public attention to Applicant's goods, services or business in such a way as to cause confusion in Canada between these goods, services or business and those of the Opponent contrary to section 7(b) of the Act;
5. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's registered trade-marks;
  - MEMORIA, certificate of registration No. TMA647,454 owned by the Opponent in association with various goods and services;
  - COLLECTION MEMORIA certificate of registration No. TMA 786,566 owned by the Opponent in association with various goods and services;

6. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with the trade-marks mentioned above that had been previously used in Canada or made known in Canada by the Opponent or its predecessors in title in association with the goods and services covered by the registrations identified above as well as in association with jewellery such as bracelets and necklaces;
7. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(c) of the Act in that the Mark was creating confusion at the filing date of the application with the Opponent's trade name MEMORIA previously used in Canada by the Opponent and its predecessors in title and its licensees in association with the goods and services covered by the abovementioned registrations as well as in association with jewellery such as bracelets and necklaces;
8. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the goods or services of the Applicant since:
  - a. The Mark does not actually distinguish the goods or services in association with which the Mark would have been used or proposed to be used by the Applicant from the goods or services of others, including those of the Opponent, nor is adapted to so distinguish them;
  - b. The Applicant has allowed third parties to use the Mark in Canada and in fact those have used it outside the confine of the provisions governing the use under license of a trade-mark, the whole contrary to the provisions of section 50 of the Act;
  - c. Subsequent to its transfer, there were rights in the use of the Mark remaining in the hands of two or more persons and those rights were exercised concurrently by those persons contrary to the provisions of section 48(2) of the Act.