

**IN THE MATTER OF AN OPPOSITION by CANAL + to
application No. 744,237 for the trade-mark INDEX PLUS &
Design filed by Gemstar Development Corporation, A California
Corporation**

On December 24, 1993, the applicant, Gemstar Development Corporation, A California Corporation, filed an application to register the trade-mark INDEX PLUS & Design, a representation of which appears below, based upon proposed use of the trade-mark in Canada in association with:

“Video cassette recorders and players, and controllers therefor; magnetically prerecorded video cassette tapes; electronic coupons, namely, calculators, magnetic cards, smart cards, and coupon printers; data storage equipment for storing and retrieving information related to broadcast video programs and video programs stored on a video cassette tape; and equipment for insertion of data into a video signal”

and in association with the following services:

“Licensing and assisting others in the production of prerecorded video cassette tapes and in the production and broadcasting of video and television programs, video magazines, and text data related to video and television programs”.

The applicant disclaimed the right to the exclusive use of INDEX apart from its trade-mark.

The present application was advertised for opposition purposes in the *Trade-marks Journal* of December 7, 1994 and the opponent, CANAL +, filed a statement of opposition on November 8, 1995, a copy of which was forwarded to the applicant on December 19, 1995. The applicant served and filed a counter statement on January 19, 1996. Further, the opponent requested and was granted leave pursuant to Rule 40 of the *Trade-marks Regulations* to amend its statement of opposition and the applicant requested and was granted leave pursuant to Rule 40 to amend its counter statement. The opponent filed as its evidence the statutory declaration of Isabelle Aoustin and the affidavit of Denise Messier, the latter of which serves to introduce into evidence certified copies of the opponent’s registrations. The applicant submitted as its evidence the affidavit of Deborah M. Rathwell which has annexed to it certified copies of three trade-mark registrations standing in the name of the applicant. Both parties filed a written argument and both were represented at an oral

hearing.

The opponent has submitted the Aoustin statutory declaration in support of its opposition, Ms. Aoustin being identified as a lawyer employed by the opponent. As a preliminary comment, I would note that those portions of the Aoustin statutory declaration [paras. 3 - 18; 26 - 32; 44; and 49] which are directed to the opponent's activities abroad and, in particular, in France, are of little relevance to the issues in this opposition other than to provide background information concerning the opponent's reputation internationally. I will therefore limit my comments to those portions of the Aoustin statutory declaration which address the opponent's activities in Canada.

Paragraphs 19 to 21 of the statutory declaration refer to an international award received by the opponent in 1995 at an awards ceremony held in Banff, Alberta. There is no indication that the award related to any of the opponent's activities in Canada and the mere reference to the opponent receiving the award in Canadian publications does not constitute use of either the opponent's trade-marks or trade-name in Canada. In paragraphs 22, 23 and 25 of her statutory declaration, Ms. Aoustin refers to co-production activities involving the opponent and Canadian companies. However, there is no indication given by Ms. Aoustin as to either the manner in which or the extent to which the opponent's trade-marks or trade-name are brought to the attention of the Canadian public through such co-productions. At most, it can be concluded from this evidence that those Canadian companies which have been involved in co-productions with the opponent have become aware of the opponent's trade-name or trade-mark CANAL +.

In paragraph 24 of her declaration, Ms. Aoustin refers to an exchange of programs between the opponent and the Quebec television network, Le Réseau des Sports. Again, there is no indication given by the declarant as to the extent to which the opponent's trade-marks or trade-name are brought to the attention of the average Canadian as a result of this exchange. Further, there is no indication that the opponent's CANAL + magazines and video cassettes referred to in paragraph 33 or its stickers, cards, documents, video cassette packages, decoders, publicity posters or film booklets referred to in paragraphs 38 - 43 and 45 - 46 of the Aoustin declaration have been distributed in Canada. Thus, this evidence is of no relevance to the issues in this opposition.

The statement by Ms. Aoustin in paragraph 35 of her statutory declaration concerning use of the trade-mark CANAL + & Design in Canada is a conclusion of law and cannot be accorded any weight. Paragraph 36 of the Aoustin declaration fails to identify the manner of use of the opponent's trade-mark in Canada and also fails to identify when such activities occurred. I cannot therefore accord much weight to this evidence. Further, the opponent had not adduced any evidence to show that the comments made by Ms. Aoustin in paragraph 37 of her declaration are applicable to Canada.

Paragraph 47 of the Aoustin declaration refers to sales of CANAL + products in Canada from 1993 to 1995 although no breakdown is provided by the declarant as to the types of products covered by these sales and whether the sales therefore relate to any of the wares or services identified in the statement of opposition. In this regard, if the sales identified in paragraph 47 relate almost exclusively to the sale of video and television rights, it is unlikely that these sales would have brought the opponent's trade-mark or trade-name CANAL + to the attention of the average Canadian consumer to any measurable extent.

The first two grounds of opposition are based on Subsections 30(a) and 30(e) of the *Trade-marks Act*. As no evidence was submitted by the opponent in support of either of its Section 30 grounds, the opponent has failed to meet its evidential burden in relation to these grounds. In any event, the agent for the opponent withdrew these grounds at the oral hearing. As a result, the Section 30 grounds of opposition are unsuccessful.

The next ground is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent alleging that the applicant's mark INDEX PLUS & Design is not registrable in that it is confusing with the opponent's registered trade-mark LE STUDIO CANAL + Design, registration No. 438,232, a representation of which appears below, covering the following services:

“Conception, réalisation, production, location de toutes oeuvres audiovisuelles, notamment cinématographiques, télévisées, de films, téléfilms, d'émissions télévisées, journaux télévisés, interviews, informations, exposés, variétés, cassettes, conception, production, réalisation, édition de tous moyens de reproduction graphique, musico-mécanique, photographiques, sonore et visuelle, d'oeuvres cinématographiques, dramatiques, musicales, théâtrales, littéraires, publicitaires; location de tous moyens de reproduction graphiques, musico mécaniques, photographiques, sonores et visuels nommément: location d'appareils photographiques, de télé objectifs, de viseurs photographiques; location de

téléviseurs; location de magnétoscopes; location de magnétophones; location d'enregistreurs à bande magnétiques”

Registration No. 438,232 also includes the following disclaimer statement:

“Le droit l'usage exclusif du mot STUDIO en liaison avec les services: réalisation et production de toutes oeuvres cinématographiques, télévisées, de films, téléfilms, d'émissions télévisées, journaux télévisés, interviews, information, exposés, variétés et de cassettes; production, réalisation, édition de tous moyens de reproduction graphiques, musico mécaniques, photographiques, sonores et visuels, d'oeuvres cinématographiques, dramatiques, musicales et publicitaires en dehors de la marque de commerce n'est pas accordé.”

The opponent also alleged that the applicant's mark INDEX PLUS & Design is not registrable in that it is confusing with its registered trade-mark CANAL + & Design, registration No. 393,425, a representation of which also appears below, covering “Magazine de spectacles et de programmes télévisés; vidéo cassettes; décodeurs de programmes télévisés”, as well as the following services:

“Services d'une chaîne de télévision, la réalisation et la diffusion d'émissions télévisées; services d'abonnement d'une chaîne de télévision à péage; services télématiques”.

Further, the opponent disclaimed the right to the exclusive use of the word CANAL apart from its trade-mark and the registration includes the following colour claim: “Éllipse; jaune se fondant en vert, se fondant en bleu, se fondant en violet, se fondant en rouge se fondant en jaune”.

Registration No. 438,232

Registration No. 393,425

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date for considering the Paragraph 12(1)(d) ground of opposition [see

Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (F.C.A.).

With respect to the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)], I would note that the applicant has disclaimed the right to the exclusive use of INDEX apart from the trade-mark while the opponent has disclaimed the word CANAL apart from its trade-mark CANAL + & Design and the word STUDIO in association with its services other than the creation and rental services, and the theatrical, literary and publicity services, covered in its registration. These disclaimers are arguably to be taken as an admission by the parties that the disclaimed words are not independently registrable in relation to their respective wares and services and therefore may constitute admissions that the words are either clearly descriptive of the character or quality of their respective wares or services, or otherwise are common to the trade or are the name of such wares or services [see *Andres Wines Ltd. v. Les Vins La Salle Inc.*, 3 C.P.R. (3d) 272, at page 275].

While the applicant disclaimed the word INDEX apart from its trade-mark, I do not consider INDEX to be descriptive when applied to most of the wares and services covered in the present application although arguably the word INDEX may have a somewhat descriptive significance in relation to data storage equipment used for retrieving information stored on a video cassette tape. The word PLUS and the + design element suggest something additional and, in my view, these elements individually add little inherent distinctiveness to the applicant's mark although the combination of the two elements adds somewhat to the inherent distinctiveness to the applicant's mark. I have concluded therefore that the applicant's trade-mark INDEX PLUS & Design possesses a fair degree of inherent distinctiveness when considered in its entirety as applied to the applicant's wares and services, with the exception of its data storage equipment.

The opponent's trade-mark CANAL + & Design, also when considered in its entirety, possesses some measure of inherent distinctiveness in view of the design elements associated with the mark although the word CANAL is certainly descriptive when applied to the opponent's television programming and subscriber related services and wares although perhaps less so in relation to its video cassettes. Also, as noted above, the + design adds little inherent distinctiveness

to the opponent's mark. The opponent's trade-mark LE STUDIO CANAL + Design also possesses a fair degree of inherent distinctiveness when considered in its entirety and particularly in relation to the creation and rental services covered in its registration as the word CANAL does not convey the same descriptive significance in relation to the services covered in this registration as it does in relation to the wares and services associated with its CANAL + & Design trade-mark.

No evidence relating to its use of its proposed trade-mark INDEX PLUS & Design in Canada has been adduced by the applicant and its mark must be considered as not having become known to any extent in Canada. While the Aoustin declaration establishes that the opponent's trade-mark CANAL + & Design is perhaps well known in France in association with its pay television services, I cannot conclude that the mark has become known to the general public in Canada to any measurable extent. In my view, the opponent's co-production activities involving North American partners as described by Ms. Aoustin do not demonstrate that the opponent's trade-mark has come to the attention of the average Canadian consumer in association with either the wares or services covered in the opponent's registration. Likewise, the opponent's trade-mark LE STUDIO CANAL + Design has not been shown to have acquired any measure of a reputation in Canada in association with the services covered in the opponent's registration. Consequently, neither the extent to which the trade-marks at issue have become known [Para. 6(5)(a)] nor the length of time the trade-marks have been in use [Para. 6(5)(b)] are particularly relevant surrounding circumstances in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) grounds.

The applicant's prerecorded video cassette tapes are identical to the opponent's video cassettes covered by registration No. 393,425 while the remaining wares covered in the present application are at least somewhat related to the opponent's decoders. Further, the applicant's services of assisting others in the production broadcasting of video and television programs and video magazines are closely related to the opponent's services involving "la réalisation et la diffusion d'émissions télévisées" while the remaining services covered in the present application differ from the opponent's wares and services covered by this registration. Also, to the extent that there is an overlap in the respective wares and services of the parties [Para. 6(5)(c)], there could equally be an overlap in their respective channels of trade [Para. 6(5)(d)].

With respect to the registered trade-mark LE STUDIO CANAL + Design, registration No. 438,232, there is some measure of an overlap between the applicant's wares and, in particular, its video cassette recorders and players and its prerecorded video cassette tapes and the opponent's services relating to the rental of video cassette recorders and its rental of audiovisual works. Otherwise, the applicant's wares differ from the opponent's services. As well, the applicant's services of assisting others in the production and broadcasting of video and television programs and video magazines appear to be related to the opponent's services involving the creation and production of audiovisual works including *inter alia* television programs. However, the remainder of the applicant's services differ from those covered by registration No. 438,232. Again, to the extent that there is an overlap in or similarity between the applicant's wares and services and the services covered by the opponent's registration, there could potentially be an overlap in the respective channels of trade of the parties.

As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], and when the marks are considered in their entirety as a matter of immediate impression, I consider there to be very little resemblance between the applicant's trade-mark INDEX PLUS & Design and either of the opponent's registered trade-marks CANAL + & Design and LE STUDIO CANAL + Design in appearance, sounding or in the ideas suggested.

As a further surrounding circumstance, the applicant submitted evidence of its ownership of the registered trade-marks: VCR PLUSCODE, registration No. 429,352; PLUSCODE, registration No. 433,567; and VCR PLUS & Design, registration No. 418,092. The registered trade-mark VCR PLUS & Design, a representation of which appears below, covers "Controllers for programming of video cassette recorders and cable boxes", as well as services identified as: "Providing television and other communication device schedule information for programming recording devices".

As pointed out by the hearing officer in *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.*, 4 C.P.R. (3d) 108, at p. 115, Section 19 of the *Trade-marks Act* does not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see also *Groupe Lavo Inc. v. Proctor & Gamble Inc.*, 32 C.P.R. (3d) 533, at p. 538]. While the decision of the hearing officer was reversed on appeal [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 482], it was on the basis of new evidence filed on appeal that the applicant had used its previously registered trade-mark in Canada. Furthermore, in the present case, no evidence has been furnished by the applicant that it has commenced use of any of its registered trade-marks in Canada. As a result, the existence of the applicant's registered trade-marks is of limited relevance to the issues in this opposition although the opponent's adoption and registration of the trade-mark VCR PLUS & Design certainly limits the opponent's claim to a family of trade-marks each terminating with a + design.

As yet a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the opponent asserted that it has a family of trade-marks having the + mark termination. Apart from the applicant having shown that it is the registered owner of the trade-mark VCR PLUS & Design which has a + termination and the opponent's evidence pointing to the possible use of MUSIQUE PLUS in Canada to identify a cable television video music station [see Exhibit P-5, Aoustin statutory declaration], the opponent's evidence is, as noted above, deficient in failing to show any measure of use of its various marks in Canada. I find therefore that the opponent has failed to establish the existence of a family or series of trade-marks in the present case.

Having regard to the above and, in particular, to the fact that there is little resemblance between the trade-marks at issue, I find that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks at issue in relation to the Paragraph 12(1)(d) ground. This ground of opposition is therefore unsuccessful.

The next grounds are based on Paragraph 16(3)(a) of the *Trade-marks Act*, the opponent

alleging that the applicant is not the person entitled to registration of the trade-mark INDEX PLUS & Design in that the applicant's mark is confusing with its trade-marks CANAL + & Design, LE STUDIO CANAL + Design, CANAL +, CANAL + VIDEO and CANAL + MAGAZINE which the opponent alleges were previously used in Canada in association with the wares and services identified in the amended statement of opposition. With respect to the Paragraph 16(3)(a) grounds, there is a initial burden on the opponent in view of Subsections 16(5) and 17(1) of the *Trade-marks Act* to establish its prior use of its trade-marks in Canada, as well as to show that it had not abandoned its trade-marks as of the date of advertisement of the present application [December 7, 1994].

My previous comments concerning the likelihood of confusion between the applicant's trade-mark INDEX PLUS & Design and the opponent's trade-marks CANAL + & Design and LE STUDIO CANAL + Design in relation to the Paragraph 12(1)(d) ground likewise apply to this ground even though the material date for considering the non-entitlement ground is the applicant's filing date [December 24, 1993]. I have therefore rejected the non-entitlement ground as its relates to these marks. Further, the opponent's evidence does not establish that it has used the trade-marks CANAL + VIDEO as applied to video cassettes or CANAL + MAGAZINE as applied to a magazine in Canada prior to December 24, 1993 within the scope of Subsection 4(1) of the *Act*. I have therefore dismissed the non-entitlement grounds which are based on these marks.

The only remaining mark relied upon by the opponent in relation to the Paragraph 16(3)(a) ground is its trade-mark CANAL +. The opponent's evidence at most shows prior use and non-abandonment of the mark CANAL + in association with the distribution of television programs and the production of audiovisual works through co-production arrangements, such that the opponent has arguably met its burden under Subsections 16(5) and 17(1) of the *Act* in relation to the mark CANAL +. However, having regard to all the surrounding circumstances including the fact that there is little resemblance between the applicant's trade-mark INDEX PLUS & Design and the opponent's mark CANAL + when the marks are considered in their entirety as a matter of immediate impression, I have concluded that there would be no reasonable likelihood of confusion between these marks and have rejected the Paragraph 16(3)(a) ground as it relates to the mark

CANAL +.

The next ground is based on Paragraph 16(3)(b) of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark INDEX PLUS & Design in that the applicant's mark is confusing with its previously filed application for registration of the trade-mark LE STUDIO CANAL + Design, filed October 16, 1991. A review of the certified copy of registration No. 438,232 which is annexed as an exhibit to the Messier affidavit reveals that this application only proceeded to registration on January 27, 1995. Since this application was still pending as of the date of advertisement of the present application, the opponent has met the burden upon it under Subsection 16(4) of the *Trade-marks Act*. As a result, this ground remains to be decided on the issue of confusion between the trade-marks INDEX PLUS & Design and LE STUDIO CANAL + Design as determined as of the applicant's filing date. However, having regard to my previous comments concerning the issue of confusion between these marks in relation to the Paragraphs 12(1)(d) and 16(3)(a) grounds, I have likewise rejected this ground of opposition.

The opponent's next ground is based on Paragraph 16(3)(c) of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to registration of the trade-mark INDEX PLUS & Design in that the applicant's mark is confusing with its previously used trade-name CANAL +. Assuming that the opponent has met its initial burden under Subsections 16(5) and 17(1) in relation to its trade-name, and having regard to the previous comments concerning the likelihood of confusion between the applicant's mark and the opponent's trade-mark CANAL +, I am of the view that the same conclusion applies to the issue of confusion under this ground, bearing in mind that there is, in my view, little resemblance between the applicant's trade-mark and the opponent's trade-name. As a result, this ground is also unsuccessful.

The opponent's final ground relates to the alleged non-distinctiveness of the trade-mark INDEX PLUS & Design in view of the likelihood of confusion between the applicant's mark and the opponent's trade-marks. Having concluded that there would be no reasonable likelihood of confusion between the trade-marks at issue, and since this conclusion would also apply as of the date of opposition, the material date for considering the non-distinctiveness ground, I have likewise

rejected this ground.

In view of the above, and having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 19th DAY OF FEBRUARY, 1999.

G.W. Partington
Chairperson
Trade-marks Opposition Board