



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

Citation: 2012 TMOB 158
Date of Decision: 2012-08-27

**IN THE MATTER OF AN
OPPOSITION by Advance
Magazine Publishers Inc. to
application No. 1,380,778 for the
trade-mark THE HEART
GOURMET in the name of
0761962 B.C. Ltd.**

FILE RECORD

[1] On January 25, 2008, 0761962 B.C. Ltd. filed an application to register the trade-mark THE HEART GOURMET, based on proposed use in Canada, for use in association with the following services:

- (1) entertainment services, namely, a health lifestyle program for television and for the global computer network.
- (2) marketing services through a website on the global computer network promoting the goods and services of others relating to a healthy lifestyle.
- (3) retail sales through a website on the global computer network selling products of others relating to a healthy lifestyle.
- (4) a website on the global computer network for displaying advertisements, information and menus of restaurant services of third parties and for promoting the restaurant services of third parties through links to their websites.
- (5) providing a website directory on the global computer network listing goods and services of others relating to a healthy lifestyle.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 25, 2009 and was opposed by Advance Magazine Publishers Inc. on July 24, 2009. The Registrar forwarded a copy of the statement of opposition to the applicant on August 11, 2009, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavit of Elenita Anastacio, a trade-marks searcher. The applicant's evidence consists of the affidavit of Mark Ian McCook, President of the applicant company. Mr. McCook was cross-examined on his affidavit, the transcript thereof and answers to undertakings given at the cross-examination forming part of the evidence of record. Neither party submitted a written argument, however, both parties attended an oral hearing held on July 11, 2012.

STATEMENT OF OPPOSITION

[4] The opponent pleads that (i) it is the owner of the registered trade-marks GOURMET (two registrations) and GOURMET Design, illustrated below,



which marks have been used in Canada for over forty years in association with a magazine, (ii) the public, upon seeing the applied-for mark THE HEART GOURMET in association with the applicant's services, would assume that the services originate with or were licensed or authorized by the opponent, (iii) the applicant "knew or ought to have known of the Opponent's use, registration and notoriety [of the opponent's marks] prior to its date of application," (iv) the applicant could not have been satisfied of its entitlement to use the applied-for mark because the applicant knew or ought to have known of the opponent's mark, and (v) the applicant did not intend to use the applied-for mark.

[5] In view of the above, the opponent alleges that:

1. the applied for mark is not registrable pursuant to s.12(1)(d) of the *Trade-marks Act*,

2. the applicant is not entitled to register the applied-for mark pursuant to s.16(3)(a) of the *Act*,
3. the applied-for mark is not capable of being distinctive of the applicant's services,
4. the application does not conform to s.30(e) or to s.30(i).

[6] In respect of the mark GOURMET Design illustrated in paragraph 4, above, the elaborate shaping of the individual letters of the opponent's mark does little to add to the inherent distinctiveness of the mark. That is, the design features of the mark are intrinsic with the word GOURMET and it is the word which forms the essential part of the mark: see *Canadian Jewish Review Ltd. v. The Registrar of Trade Marks* (1961) 37 CPR 89 (ExC). Thus, for the purposes of this proceeding, the opponent's use of the mark GOURMET in elaborate script form is essentially equivalent to use of the mark GOURMET in block form.

OPPONENT'S EVIDENCE

Elenita Anastacio

[7] Her affidavit serves to introduce into evidence, by way of exhibit material, particulars of the opponent's trade-mark registrations relied on by the opponent in the statement of opposition.

APPLICANT'S EVIDENCE

Mark Ian McCook

[8] Mr. McCook identifies himself as President of the applicant company. His affidavit serves to introduce into evidence the exhibits described below:

Exhibit A - Particulars of the subject application accessed from the Canadian Intellectual Property Office (an agency of Industry Canada).

Exhibit B - Documentation showing registration of the website domain name "theheartgourmet.com" in the name of Mark McCook. Mr. McCook attests that he is holding the website for future use by the applicant herein.

Exhibit C - A printout from the website Dictionary.com showing the definition of the word “gourmet.” As a noun, it is defined as “a connoisseur of fine food and drink.”

Exhibits D and E - Exhibit D concerns a GOOGLE search for the word “gourmet” in the domain name, indicating over 105 million results. Exhibit E provides a sampling of the results.

Exhibit F - A copy of an announcement at the website www.gourmet.com that “*Gourmet* magazine will cease publication after the November issue.”

Exhibit G - A printout from the website www.theglobeandmail.com of an article published on October 5, 2009 discussing the closure of the magazine *Gourmet* owing to “a devastating advertising slump.”

[9] The evidence elicited from Mr. McCook on cross-examination is not particularly probative of the issues in dispute.

LEGAL ONUS AND EVIDENTIAL BURDEN

[10] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant 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, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

MAIN ISSUE & MATERIAL DATES

[11] The main issue in this proceeding is whether the applied-for mark THE HEART GOURMET is confusing with the opponent’s mark GOURMET. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the

meaning of s.6(2) of the *Trade-marks Act*, shown below, between the applied-for mark and the opponent's mark:

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

[12] Thus, s.6(2) 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 s.6(2) is whether there would be confusion of the applicant's services provided under the mark THE HEART GOURMET as emanating from or sponsored by or approved by the opponent: see *Glen-Warren Productions Ltd. v. Gertex Hosiery Ltd.* (1990), 29 CPR(3d) 7 at 12 (FCTD).

[13] The material dates to assess the issue of confusion are (i) the date of decision, with respect to the ground of opposition alleging non-registrability; (ii) the date of filing of the application, in this case January 25, 2008, with respect to the ground of opposition alleging non-entitlement; and (iii) the date of filing the statement of opposition, in this case July 24, 2009, in respect of the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD).

TEST FOR CONFUSION

[14] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not

necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trademarks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

[15] The opponent's mark GOURMET possesses a relatively low degree of inherent distinctiveness as "gourmet" is a dictionary word in common usage and is highly suggestive of the subject matter of the opponent's magazine, that is, fine food and beverages. Initially it would appear that the applied-for mark THE HEART GOURMET also possesses a relatively low degree of inherent distinctiveness as the dominant components of the mark, that is, the words "heart" and "gourmet" are dictionary words in common usage. Further, the mark as a whole suggests the subject matter of the applicant's services as discussed by Mr. McCook at his cross-examination, that is, information relating to healthy eating and healthy lifestyle specifically directed to heart health: see page 9 of the transcript of cross-examination. However, the mark THE HEART GOURMET as a whole may also be understood as a double entendre, that is, it suggests either (i) a discerning person who chooses fine food and drink that is conducive to a healthy heart or (ii) a health minded person who chooses food and drink that is particularly conducive to a healthy heart. The double entendre aspect of the applied-for mark enhances its inherent distinctiveness. From Exhibits F and G of Mr. McCook's affidavit, I infer at least some reputation for the opponent's GOURMET mark at all material times. There is no evidence to show that the applied-for mark THE HEART GOURMET had acquired any reputation at any material time. Thus, the first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, is about equal for each party.

[16] From Exhibits F and G of Mr. McCook's affidavit, I infer that the length of time the parties' marks have been in use favours the opponent. In this regard, there is at least some evidence of prior use of the opponent's mark GOURMET but no evidence of any

use of the applied-for mark THE HEART GOURMET. However, the second factor is only of minor significance in the absence of comprehensive evidence regarding the extent of use of the opponent's mark.

[17] With respect to the nature of the parties' wares, services, business and trades, there are overlaps as well as differences. It appears that the applicant intends to provide information, in an electronic format, in a specialized area of interest (namely, food and drink for a healthy heart) while the opponent provides information in a more general area of interest (namely, fine food and drink) predominantly in a physical form (a magazine) as well as electronically. In other words, the information being provided by the parties is somewhat different while there is overlap in the media being used to convey the information. I have therefore concluded that the third and fourth factors taken together do not significantly favour either party or possibly slightly favour the applicant.

[18] With respect to the degree of resemblance between the marks in issue, the applicant has incorporated the whole of the opponent's mark GOURMET and has added the phrase THE HEART which effectively acts as an adjective to modify the noun GOURMET. Thus, there is a fair degree of resemblance between the marks in issue visually and in sounding owing to the dominant component GOURMET present in each mark. There is less resemblance in ideas suggested as one of the double entendre meanings of the applied-for-mark suggests a person who is concerned with choosing food and drink that is particularly conducive to a healthy heart, as discussed in paragraph 14, above. When the last factor in s.6(5) is considered in each of its three aspects, that is, in appearance, in sounding and in ideas suggested, I conclude that the resemblance between the marks favours neither party to a significant extent or possibly slightly favours the applicant.

[19] I would add that the cessation of print publication of the opponent's magazine GOURMET in November 2009 (as indicated in Exhibits F and G of Mr. McCall's affidavit) occurred after the material dates in respect of the second and third grounds of opposition, and is therefore not relevant to the issue of confusion for those grounds. While the cessation of publication of the opponent's magazine GOURMET is relevant to the issue of confusion with respect to the first ground of opposition, its impact is minor as

the opponent has not established that its mark had acquired a significant reputation at any material time.

Jurisprudence

[20] I also take into consideration the approach adopted by the Federal Court when dealing with an opponent's mark that is not inherently strong and that has not acquired distinctiveness through use or advertising or other means, as discussed in *Sarah Coventry Inc. v. Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at paragraph 6:

The trade mark SARAH is a commonly used female Christian name and as such offers little inherent distinctiveness: *Bestform Foundations Inc. v. Exquisite Form Brassiere (Canada) Ltd.* (1972), 34 CPR (2d) 163. Such marks are considered to be weak marks and are not entitled to a broad scope of protection; *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 7 CPR (2d) 1, [1972] FC 1271; and *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 CPR (2d) 154. In the case of a weak mark, small differences will be sufficient to distinguish it from another mark: *American Cyanamid Co.*, supra, at p. 5. Zaréh, which is also a Christian name, but the name of a male Lebanese, is not commonly used in this country. Obviously, there are at least small differences to distinguish those two names. However, the degree of distinctiveness attributed to a weak mark may be enhanced through extensive use: *GSW Ltd. v. Great West Steel*, supra. Most of the evidence led by the appellant show considerable use and publicity for the trade name Sarah or Sarah Coventry or Sarah Fashion Show, etc., but very limited use of the trade mark SARAH. And it has been well established that it is not sufficient for the owner of the trade mark to make a statement of use, he must show use: *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 CPR (2d) 62, [1981] 1 FC 679, 34 N.R. 39.

(underlining added)

Similarly, in the instant case, the opponent's mark GOURMET is a weak mark and I am unable to conclude that its distinctiveness has been enhanced by extensive use.

Accordingly, I find that the differences between the applied-for mark THE HEART GOURMET and the opponent's mark suffice to distinguish the applied-for mark from the opponent's mark.

DISPOSITION

[21] Considering the factors in s. 6(5) as discussed above, and taking into account in particular that the opponent's mark is a weak mark and that differences in the parties'

marks are sufficient to distinguish them, I find that at all material times the applicant has met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied-for mark THE HEART GOURMET and the opponent's mark GOURMET. Accordingly, the first, second and third grounds of opposition are rejected. I would add, however, that I likely would have found for the opponent had it established a significant reputation for its mark at any of the material dates. In finding for the applicant on the issue of confusion on the basis of the evidence before me, my decision is consistent with analogous cases decided by this Board in *Advance Magazine Publishers, Inc. v. Wise Gourmet* 2008 CanLII 88261, reversed (on the basis of additional evidence) (2009), 81 CPR(4th) 179 (FCTD), concerning the applied-for mark WISE GOURMET; and *Advance Magazine Publishers, Inc. v. Company's Coming Publishing Ltd.* (2011), 98 CPR(4th) 217 concerning the applied-for mark PRACTICAL GOURMET.

[22] The fourth ground of opposition pursuant to s.30(e) is rejected because the opponent has not met its evidential burden to put the allegation into issue. The fifth ground of opposition pursuant to s.30(i) is rejected because the pleadings do not support the allegation: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 CPR (3d) 221.

[23] In view of the foregoing, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office