

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

Citation: 2012 TMOB 260
Date of Decision: 2012-12-05

**IN THE MATTER OF AN OPPOSITION
by Advance Magazine Publishers Inc. to
application No. 1,410,321 for the trade-
mark VOGUE in the name of Miles
Industries Ltd.**

[1] On September 11, 2008, Miles Industries Ltd. (the Applicant) filed an application to register the VOGUE trade-mark with Fireplaces; fireplace insert heating units; fireplace parts namely, brick liners, andirons, doors, trim, hinges, magnets, bars, baffles (the Wares) on the basis of its proposed use in Canada.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 1, 2009.

[3] On November 17, 2009, Advance Magazine Publishers Inc. (the Opponent) filed a statement of opposition. An amended statement of opposition was filed on March 18, 2010 and accepted on June 16, 2010. The grounds of opposition are summarized below:

- (a) contrary to section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Mark is not registrable because it is confusing with registration Nos. UCA4268; TMDA42009; UCA19676; TMA346,637; TMA388,687; TMA468,713; TMA576,133; TMA561,966; TMA576,327; TMA595,905 and TMA641,823;

- (b) contrary to section 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date it was confusing with the Opponent's use of its VOGUE trade-marks;
- (c) contrary to section 16(3)(b) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date it was confusing with application Nos. 856,582; 1,198,832; 1,269,486; 1,418,746; 1,458,146; and 1,467,908 owned by the Opponent;
- (d) contrary to section 2 of the Act, the Mark is not distinctive of the Applicant; and
- (e) contrary to section 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark as a search of the Register would have located the Opponent's marks and the Applicant knew or ought to have known of the Opponent's use, registration and notoriety prior to its date of application.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed an affidavit of Elenita Anastacio. The Applicant filed affidavits of Mike Powell and Arwen Mendoza. Mr. Powell and Ms. Mendoza were cross-examined and the transcripts, answers to undertakings and exhibits were filed. The Applicant filed a written argument. The Opponent attended a hearing on July 24, 2012.

Preliminary Evidence Issue

[6] At the hearing, the Opponent raised several issues with the evidence of Mike Powell including that:

- it is based on hearsay since some of the information contained therein was requested by Mr. Powell as opposed to being known to him (cross-examination of Mr. Powell, Qs 61-63);
- some of the exhibits had been gathered by someone else (Qs 28-31); and
- there are inconsistencies in the exhibits as described (Qs 52-54).

Mr. Powell describes himself as the General Manager of the Applicant (para 1). In the Canadian Oxford Dictionary (1998 ed), the definition for “general” includes the following “chief or principal; having overall authority (*general manager; Secretary General*).” Given Mr. Powell’s position and explanations of how the evidence was gathered at his cross-examination, I am not prepared to disregard his evidence in its entirety. According Mr. Powell’s evidence some weight notwithstanding the fact that some of the exhibits and information contained therein was forwarded to him is consistent with previous decisions of the Registrar including *Cascades Canada Inc v Wausau Paper Towel & Tissue, LLC* (2010), 89 CPR (4th) 79 (TMOB). Paragraphs 29-31 of the *Cascades Canada* decision state:

[29] In *Union Electric Supply Co. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.) at pages 59-60, Mahoney J. made the following statement concerning knowledge to be attributed to an company's officer: "The deponent was manifestly in a position, both from the point of view of his experience with the appellant and his office, to know whereof he deposed." In *Scott Paper Ltd. v. Georgia-Pacific Consumer Products LP* (2010), 83 C.P.R. (4th) 273 (F.C.) at para. 35, O'Keefe J. stated: "Affiants may depose facts within their personal knowledge (see Rule 81, Federal Courts Rules , SOR/98-106). This Court has accepted that an affiant's office may manifestly put him or her in a position to have personal knowledge of facts without necessarily being a direct witness to the event (see *Philip Morris Inc. c. Imperial Tobacco Ltd.*, [1987] F.C.J. No. 26, 13 C.P.R. (3d) 289)."

[30] ... Overall, it seems to me on balance that Mr. Tocchet was manifestly in a position from the standpoint of his office and experience with the Original Opponent "to know whereof he deposed". There is no reason to assume that Mr. Tocchet would not have been in a position to provide background evidence to support the statements made within his affidavit, if the Applicant had sought to have him produce such (e.g. business records concerning the Opponent's sales). I therefore reject the Applicant's submission that his evidence should be disregarded in its entirety. However, I agree that some of his evidence should be accorded reduced weight.

[31] I will add that I do not consider it a problem that Mr. Tocchet did not personally take the photographs of the OPTIMA product, print the website pages or put together the sales figures that he provided with his affidavit. Clearly such information was well within his knowledge.

Notwithstanding the above, I am of the view that some of Mr. Powell's evidence should be disregarded where the cross-examination of Mr. Powell revealed inconsistencies. At the outset, I note that none this evidence was relied upon in reaching my decision in the subject case.

Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[8] The material dates with respect to the grounds of opposition are as follows:

- section 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- section 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- section 38(2)(c)/16(3) of the Act - the filing date of the application; and
- section 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].


Grounds of Opposition that Can be Summarily Dismissed

[9] The section 30(i) ground alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as the Applicant knew or ought to have known of the Opponent's use, registration and notoriety of its trade-marks. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, this ground is dismissed.

[10] The section 16(3)(a) and section 2 grounds are rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its marks were used or known in Canada as of the applicable material dates. Although many of the Opponent's registrations for trade-marks consisting of or including VOGUE refer to use, that is not sufficient for the Opponent to meet its burden for these grounds of opposition [*Roxxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268].

Section 12(1)(d) Ground of Opposition

[11] The Opponent filed as its evidence an affidavit of Elenita Anastacio, an employee of its agent. Ms. Anastacio provides print-outs of the particulars of each of the relied upon registrations. The most similar registrations are listed below. If I find that there is no confusion between the Mark and these registrations, there can be no confusion between the Mark and the Opponent's other registrations. I have exercised my discretion and checked the register to confirm that each of these registrations is extant [*Quaker Oats Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

| Reg. No. | Trade-mark | Wares and Services |
|------------|---|--|
| UCA4268 | VOGUE | Magazines and similar publications. |
| TMA388,687 | VOGUE DECORATION | Printed publications, namely magazines. |
| TMA576,133 | VOGUE | Online magazine and publications distributed in electronic format via the internet; operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet. |
| TMA561,966 |  | Printed publications, namely magazines, books and periodicals. Internet services, namely providing fashion and style information via the internet. |

[12] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both

trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, sound or in the ideas suggested by them.

[13] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

inherent distinctiveness

[14] I can take judicial notice of dictionary definitions [*Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) at para 29]. The Canadian Oxford Dictionary (1998 ed) defines “vogue”, in part, as “the prevailing fashion” and “decoration”, in part, as “a thing that decorates or serves as an ornament”. Given these definitions, neither party’s marks have a high degree of distinctiveness.

degree of resemblance

[15] The Mark is identical to the Opponent’s VOGUE registrations (Nos. UCA4268, TMA576,133) and is identical as sounded to the Opponent’s VOGUE design registration (No. TMA561,966). The Mark has a high degree of resemblance to the Opponent’s VOGUE DECORATION trade-mark. The word DECORATION in the Opponent’s mark does not diminish the resemblance between the parties' marks as it is descriptive of a characteristic of the registered wares [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) at para 58]. With respect to the ideas suggested, the parties’ marks suggest different ideas when considered in conjunction with their respective wares and services. The Mark suggests a fashionable or stylish fireplace and

related components, whereas the Opponent's marks suggest periodicals and magazines regarding fashion and style.

extent known and length of time in use

[16] While the Opponent's registrations are based on use, this only entitles me to assume de minimis use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. De minimis use does not support a conclusion that the marks have become known to any significant extent, nor that the marks have necessarily been used continuously since the date stated.

[17] Mr. Powell states that in 2009 the Applicant launched its VOGUE series of gas fireplaces (para 8). At the outset, I note that I consider use of the VOGUE SERIES trade-mark to be use of the Mark [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. The VOGUE trade-mark appears on brochures, price lists, and packaging (Exhibits A-C). Since the introduction of the VOGUE series the Applicant has sold 900 units (para 20). However, no information has been given as to whether these sales have occurred in Canada so I am unable to conclude whether the Mark is known to any real extent in Canada.

nature of wares and services

[18] In his affidavit, Mr. Powell states that the Applicant is a manufacturer of fireplaces (para 3). The VOGUE brand includes fireplaces, liners, surrounds, decorative rocks, wall switch kits, and glass panels (Exhibit B). The Applicant's products are promoted as being decorative: "for a contemporary sleek design, you can't beat the Valor Vogue" (Exhibit B); and are featured in magazines such as *Patio & Hearth Products Report* (Exhibit 2 from the cross-examination of Mike Powell). The Applicant's products are only sold through dealers and require specialized installation (Qs 39-44; 49), however, there is no restriction in the Wares requiring this.

[19] The Opponent's registered wares and services are magazines, books, and periodicals and providing fashion and style information via the internet. While these wares and services may include features and advertising concerning interior design, there is no evidence that they in fact do

or that the Opponent sells any such items. The Opponent's wares and services are very different from fireplaces and fireplace parts and there is no reason to assume that they have overlapping channels of trade.

[20] While magazines and the services of providing information are very different from fireplaces and fireplace parts, the Opponent argues that there may be a link in that the Applicant's fireplaces may be of the type of high quality, stylish, decorative products featured, advertised or written about in the Opponent's magazines and on their web-sites [see, for example, *Advance Magazine Publishers Inc v Peintures MF (1972) Inc* (1995), 66 CPR (3d) 375 (TMOB) at 379; *Advance Magazine Publishers Inc v Masco Building Products Corp* (1999), 86 CPR (3d) 207 at 218-219]. However, in the absence of evidence of such features or advertisements being placed such that consumers find the nature of the wares overlapping, I do not agree. I adopt the comments of Member Bradbury in *Advance Magazine Publishers Inc v Louver-Lite Ltd* 2012 TMOB 161 (TMOB) at para 44.

I am also not swayed by the argument that it is significant that the Applicant could advertise its wares in the Opponent's publications. After all, it is not apparent that there is any restriction on the wares that might be advertised in the Opponent's publications and so once again accepting such an argument would give the Opponent's marks a broad scope of protection that is not supported by the evidence at hand.

surrounding circumstances – family of marks

[21] At the hearing, the Opponent submitted that it was relying on the cumulative effect of each of its VOGUE marks which would result in confusion. The Opponent appears to be arguing that it owns a family of VOGUE marks which would entitle it to a broader scope of protection. However, there is no evidence of a family before me. An opponent must evidence of use of the members of an alleged family of marks in order for the benefits of a family to apply [*Ulramar Ltd. v. Gold Eagle Co.*; 2011 TMOB 149 at para 26]. As the Opponent has not done so, it cannot rely on any such cumulative effect of its VOGUE trade-marks.

surrounding circumstance – existence of TEEN VOGUE application

[22] The Opponent submits that the Opponent's other applications including VOGUE attached to Ms. Anastacio's affidavit show that there is a natural expansion of the VOGUE brand into a variety of areas. The most relevant of these applications is application No. 1,458,146 for TEEN VOGUE for use in association with the following goods. I note that the particulars attached to Ms. Anastacio's affidavit show this application is in the examination stage.

- (1) Bedding; sheets, comforters, quilts, throws, blankets, bed skirts, pillows.
- (2) Furniture; window treatments, rugs, chairs, ottomans, bean bag chairs.
- (3) Storage products, collapsible baskets, cubes, drawers, hampers.
- (4) Table and floor lamps, lava lamps, night lights.

[23] In the absence of evidence showing such home decoration goods being sold by the Opponent, I do not believe that the existence of this application results in the inference that consumers would perceive the natural expansion of the Opponent's VOGUE brand to include the Wares.

surrounding circumstances: state of the register and marketplace

[24] The Applicant filed the affidavit of Arwen Mendoza who obtained and attaches to her affidavit copies of various trade-mark applications and registrations (para 1; Exhibit A), GOOGLE searches and websites (paras 2-7, Exhibits B-G), and corporate searches (paras 8-9; Exhibits H-I). The state of the register evidence does not assist the Applicant since it only identifies two trade-marks registered in association with decorative products for the home [*Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. Furthermore, the GOOGLE searches, web-pages and corporate searches do not assist the Applicant in demonstrating that there has been widespread use of the word VOGUE as a trade-mark or trade-name in Canada by third parties in the decorative products field

since this evidence is insufficient to show that there has been any such use in Canada [*Conde Nast Publications Inc v Hanz Schwarzkopf GmbH* (1988), 20 CPR (3d) 176 (TMOB) at 180; *Mondo Foods Co v Coppola* (2011), 99 CPR (4th) 20 (TMOB) at paras 57-58].

surrounding circumstances: co-existence without confusion

[25] Mr. Powell states that “no hint of any confusion between Miles’ gas fireplaces and a magazine by the same name has come to Miles’ attention” (para 21). An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the opponent [*Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA) at para 19]. However, in the present case, I cannot draw such an inference because there is no evidence of concurrent use.

conclusion

[26] I conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the Mark and the Opponent’s four VOGUE registrations. Given that the Opponent’s VOGUE trade-marks do not have a high degree of inherent distinctiveness and there is no evidence that these trade-marks have acquired any distinctiveness, the differences between the parties’ wares and services is sufficient to make confusion unlikely.

Section 16(3)(b)

[27] The Opponent has pleaded that the Applicant is not the person entitled to register the Mark as it is confusing with application Nos. 856,582; 1,198,832; 1,269,486; 1,418,746; 1,458,146; and 1,467,908. All but application nos. 1,418,746; 1,458,146 and 1,467,908 were pending as of the filing and advertisement dates of the application [section 16(4) of the Act]. As such, the Opponent has met its burden with respect to application Nos. 856,582; 1,198,832; and 1,269,486, the particulars of which are set out below:

| No. | Trade-mark | Wares and Services |
|---------|------------|--|
| 856,582 | VOGUE | ... Electronic publications, namely magazines, computer software, namely periodicals and magazines in electronic form. |

| No. | Trade-mark | Wares and Services |
|-----------|------------|---|
| 1,198,832 | VOGUE CAFÉ | Restaurant and bar services, night clubs and cafes. |
| 1,269,486 | VOGUE | Broadcasting services ... telecommunication services ... cable transmission services, ... satellite transmission services, ... providing downloadable ring tones, music, MP3's, graphics, games, videos, pictures and information for wireless mobile communication devices; providing wireless transmission services to enable the uploading and downloading of ring tones, voice clips, music, MP3's, graphics, games, videos, pictures, information in the field of fashion and style and news via a global computer network to a wireless mobile communication device; voting and polling through a wireless mobile communication device; sending and receiving voice and text messages between wireless mobile communications; providing on-line voting system via the internet or a wireless communication device; internet services ... entertainment services ... |

[28] Given my findings with respect to the section 12(1)(d) ground of opposition concerning inherent distinctiveness, the extent known, and the surrounding circumstances, and the differences in the Wares and the Opponent's applied-for wares and services, I do not find that the Mark was confusing with any of the relevant applications as of the material date. Accordingly, this ground of opposition is dismissed.

Disposition

[29] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office