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

Citation: 2010 TMOB 207
Date of Decision: 2010-11-30

IN THE MATTER OF AN OPPOSITION by Quo Vadis International Ltée to Application No. 1,202,961 for the trade-mark AT-A-GLANCE EXECUTIVE filed by MeadWestvaco Corporation

[1] On January 8, 2004, MeadWestvaco Corporation (the Applicant) filed an application to register the trade-mark AT-A-GLANCE EXECUTIVE (the Mark) based upon proposed use of the Mark in Canada in association with the following wares: "professional organizers and planners in both dated and undated formats".

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 18, 2006.

[3] On March 19, 2007, Quo Vadis International Ltée (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 16(3)(a) and 38(2)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) in view of the fact that the Mark is confusing with the trade-marks EXÉCUTIF and EXECUTIVE used in Canada by the Opponent since at least as early as 1984 in association with personal agendas in paper format. The statement of opposition also claimed various grounds of opposition based on s. 38(2)(a) and 30 of the Act. However, all of these latter grounds of opposition were voluntarily withdrawn by the Opponent at the written argument stage.

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

[5] In support of its opposition, the Opponent filed the solemn declaration of Christian Froc, General Director of the Opponent, sworn February 20, 2008. In support of its application, the Applicant filed the affidavit of Robert J. Hodan, President and General Manager for Hilroy, a MeadWestvaco Company, LP (Hilroy), a wholly-owned subsidiary of the Applicant, sworn September 29, 2008.

[6] Both parties filed written arguments. Neither party requested an oral hearing.

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[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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) (*Dion Neckwear*)].

Summary of the parties' evidence

The Opponent's evidence - the Froc solemn declaration

[8] Mr. Froc states that the Opponent holds the rights in Canada to the trade-marks EXECUTIVE and EXÉCUTIF (the EXECUTIVE Marks), which are identified with agendas (diaries) in Canada as well as several other countries [paragraphs 4 and 5 of his declaration]. More particularly, Mr. Froc states that the EXECUTIVE Marks have been used by the Opponent in various ways, from being on covers of agendas, on the title pages on the inside of agendas and the address books integrated with the agendas, as well as in the Opponent's product catalogues [paragraph 6 of his declaration].

[9] Mr. Froc states that the agendas marketed and sold under the EXECUTIVE Marks in Canada are, since their launching, made under the control of the Opponent, with the promotion and distribution also insured by same [paragraph 7 of his declaration]. He further states that such agendas have been continuously sold in Canada since at least as early as 1984 [paragraph 8 of his declaration].

[10] Mr. Froc provides as Exhibit CF-1, samples of the covers of the agendas, the title pages on the inside of the agendas, the address books integrated with the agendas, and the Opponent's product catalogues, which he states are similar to the manner in which the EXECUTIVE Marks have been used since their launch in the Canadian marketplace [paragraph 9 of his declaration].

[11] Mr. Froc continues his declaration by stating that the specific methods utilized in Canada for the promotion of the agendas marked with the EXECUTIVE Marks include promotional catalogues and pamphlets, and advertisements on the radio and Internet [paragraph 10 of his declaration] and he attaches as Exhibits CF-2 to CF-7 samples of promotional materials used in Canada in association with the EXECUTIVE Marks for the years 2000 to 2008. These include the Opponent's product catalogues for the years 2000 to 2008, advertising leaflets of Lyreco, which is described by Mr. Froc as a large distributor of office furniture, for the years 2005 and 2006, as well as advertising leaflets of retailer Buro Plus, for the years 2005 to 2007. However, Mr. Froc has not provided information as to its radio advertising or any advertising expenditures whatsoever in association with the EXECUTIVE Marks.

[12] Mr. Froc then concludes his declaration by providing the Opponent's sales in both dollar value and number of units sold from 2000 to 2007 in association with the EXECUTIVE Marks, which amount to $690,864.50 and 79,908 respectively [paragraphs 12 and 13].

The Applicant's evidence - the Hodan affidavit

[13] Mr. Hodan first goes over the history of the Applicant, stating that it was founded in 1888 and is headquartered in Richmond, Virginia. He states that the Applicant is a global leader in

various sectors namely, packaging solutions, consumer and office products and specialty chemicals and has operations worldwide. Mr. Hodan states in that regard that the Applicant owns several "highly recognized consumer brands [which] include MEAD, AT-A-GLANCE, DAY RUNNER, CAMBRIDGE, COLUMBIAN, HILROY and FIVE STAR" [paragraphs 4 to 6 of his affidavit].

[14] Mr. Hodan continues his affidavit by stating that the Applicant distributes its various AT-A-GLANCE time management products in Canada through Hilroy, and that Hilroy is licensed by the Applicant to use the AT-A-GLANCE trade-marks identified in paragraphs 9 and 12 of his affidavit. Pursuant to its license agreement with Hilroy, the Applicant maintains care and control over the nature and quality of the AT-A-GLANCE Time Management Products identified in paragraphs 9 and 12 of his affidavit [paragraphs 7 and 8 of his affidavit].

[15] More particularly, Mr. Hodan explains that the AT-A-GLANCE trade-mark has been used by the Applicant's predecessors-in-title in Canada since at least as early as January 1934. The AT-A-GLANCE trade-mark is registered under No. UCA05965 in association with, among other wares, "diaries; calendars; planners, namely, daily, weekly, monthly, yearly planners; telephone, address and record books." Mr. Hodan attaches as Exhibit A a printout of the registration particulars for this registration, as obtained from the Canadian Intellectual Property Office (CIPO) website, which shows that this registration went through several changes in title before being recorded in the name of the Applicant on July 17, 2006 [paragraphs 9 and 10 of his affidavit].

[16] Mr. Hodan further states that in addition to the AT-A-GLANCE trade-mark identified above, the Applicant owns a family of AT-A-GLANCE trade-marks for related wares, each having as their dominant portion, the component "AT-A-GLANCE". These include AT-A-GLANCE & Design (TMA490,934 - claiming use of the mark since February 19, 1998); MONTH-AT-A-GLANCE (TMA568,780 - claiming use of the mark since 1974); YEAR-AT-A-GLANCE (TMA568,782 – claiming use of the mark since April 1989); DAY-AT-A-GLANCE (TMA568,784 - claiming use of the mark since 1974); and WEEK-AT-A-GLANCE (TMA568,756 - claiming use of the mark since 1974) as well as the Mark which is the subject of

the present application (collectively referred to as the AT-A-GLANCE Marks). Mr. Hodan attaches as Exhibits B1 to B6 printouts of the registration particulars for these registrations, as obtained from CIPO website. The wares referred to in the aforementioned registrations and the present application are collectively referred to as the AT-A-GLANCE Time Management Products [paragraph 12 of his affidavit].

[17] Mr. Hodan then explains what he means by "use", "branding", "advertising" and "promotion" of a trade-mark, wherein any reference to same is with respect to at least one of the AT-A-GLANCE Marks [paragraphs 13 to 15 of his affidavit].

[18] Mr. Hodan states that the Applicant (through Hilroy), or its predecessors-in-title, have distributed and sold in Canada, the AT-A-GLANCE Time Management Products marked with the AT-A-GLANCE Marks since the dates claimed in the aforementioned trade-mark registrations. Concerning more particularly the Mark, he states that the Applicant has started using it since August 2004 [paragraph 16 of his affidavit].

[19] Mr. Hodan then provides the annual breakdown of the approximate sales figures in Canada by the Applicant of the AT-A-GLANCE Time Management Products in association with each of the marks defined as the AT-A-GLANCE Marks for the four-year period from 2004 to 2007, the total of which have been in excess of 12.3 million dollars. Mr. Hodan explains that due to system changes that went into effect with the purchase of the AT-A-GLANCE Marks by the Mead Corporation (and now the Applicant), the Applicant does not have data specific to the AT-A-GLANCE line of products nor broken down on a product line basis prior to 2004. Mr. Hodan states that to the best of his information and belief, since January 1934, and continuing since then to date, AT-A-GLANCE Time Management Products in association with the AT-A-GLANCE Marks have been sold in Canada [paragraphs 17 to 23 of his affidavit].

[20] Concerning more particularly the sales of Time Management Products in Canada by the Applicant from 2004 to 2007 in respect of the Mark, Mr. Hodan states that they have been in excess of 1 million dollars.

[21] In support of his statements of use of the AT-A-GLANCE Marks, Mr. Hodan attaches as Exhibits C1 to C5 photographs of a sampling of the Time Management Products marked with each of the AT-A-GLANCE Marks for the years 2008 to 2009. Mr. Hodan adds that these exhibits show the manner in which the AT-A-GLANCE Marks have been used in association with the AT-A-GLANCE Time Management Products and their packaging since their respective introduction in the Canadian marketplace.

[22] Mr. Hodan states that Hilroy distributes the AT-A-GLANCE Time Management Products in association with the AT-A-GLANCE Marks to Canadian retailers such as Staples, Wal-Mart, Zellers, London Drugs and Office Depot as well as to Canadian commercial accounts such as Basics, CIS, Grand & Toy, Lyreco and Corporate Express [paragraph 25 of his affidavit].

[23] Mr. Hodan attaches as Exhibit D copies of cover pages for the various AT-A-GLANCE Product Catalogues featuring the AT-A-GLANCE & Design trade-mark covered by registration No. TMA490,934 for the years 1999 to 2002, 2004 to 2007 and 2009 and as Exhibit E, a copy of page 61 of the 2009 Product Catalogue featuring the AT-A-GLANCE EXECUTIVE daily desk calendar box. Mr. Hodan states that the advertising expenditures incurred by Hilroy for the production of such catalogues from 2004 to 2007 have been approximately $200,000, with approximate expenditures of $50,000 per year [paragraphs 26 to 28 of his affidavit].

[24] Mr. Hodan then concludes his affidavit by stating that as of 1984, the date since the Opponent began using its EXECUTIVE Marks in Canada, the typical consumer would be aware that the Applicant and its predecessors-in-title made and sold a variety of AT-A-GLANCE Time Management Products in association with the AT-A-GLANCE Marks and that as of January 8, 2004, the filing date of the application, a typical consumer would assume that the time management products under the Mark would be another product line under its AT-A-GLANCE family of trade-marks [paragraphs 29 and 30 of his affidavit]. I am not prepared to accord weight to these two statements of Mr. Hodan, which constitute inadmissible opinion evidence.

Analysis of the remaining grounds of opposition

Section 16(3)(a) ground of opposition

[25] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark having regard to the provisions of s. 16(3)(a) of the Act in that at the date of filing of the application, the Mark was confusing with the EXECUTIVE Marks used in Canada by the Opponent since at least as early as 1984 in association with personal agendas in paper format.

[26] An opponent meets its evidential burden with respect to a s. 16(3)(a) ground if it shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [s. 16(5) of the Act]. As per my review above of Mr. Froc's solemn declaration, the Opponent has met this burden.

[27] The Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks.

[28] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[29] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and

are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc*. (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

(a) The inherent distinctiveness of the trade-marks and the extent to which they have become known

[30] The Opponent submits that the inherent distinctiveness of the EXECUTIVE Marks is average whereas the inherent distinctiveness of the Mark is much less given the highly suggestive connotation of the component "AT-A-GLANCE" in the context of the Applicant's wares, which suggests to the everyday user of the wares that he will be able to find, immediately upon looking, the information contained in his planner.

[31] The Opponent further submits that the distinctiveness of the EXECUTIVE Marks has been enhanced by reason of their use in association with agendas since well prior to the Applicant's date of filing of the present application.

[32] By contrast, the Applicant submits that the word "EXECUTIVE" [and its French translation "EXÉCUTIF"], on its own, is descriptive of something that is designed for, used by, or is suitable for a person having administrative or supervisory authority. As such, the Applicant submits that the Opponent's EXECUTIVE Marks are not inherently distinctive given their descriptive connotation.

[33] The Applicant further submits that the component "AT-A-GLANCE" dominates the Mark and has been used extensively by the Applicant. More particularly, the Applicant submits that the Hodan affidavit establishes that the Applicant and its predecessors-in-title have owned and used the AT-A-GLANCE trade-mark in Canada for over 75 years in association with diaries, calendars, planners and the like as well as the following other AT-A-GLANCE trade-marks wherein the predominant portion of each trade-mark comprises "AT-A-GLANCE": MONTH-A-GLANCE since 1974; DAY-AT-A-GLANCE since 1974; WEEK-AT-A-GLANCE since 1974; AT-A-GLANCE & DESIGN since February 1988; YEAR-AT-A-GLANCE since April 1989;

and the applied for Mark since August 2004. Accordingly, the Applicant submits that its AT-A-GLANCE Marks have become inherently distinctive of the Applicant through their long and continuous use in Canada.

[34] The existence of a family of trade-marks is one of the surrounding circumstances that may impact the analysis carried on under s. 6(5) of the Act. However, it does not come into play under s. 6(5)(a). The inherent distinctiveness of the trade-marks under review and the extent to which they have become known are to be assessed as of the material date looking at the marks themselves and their associated wares or services. I will revert to the existence of the AT-A-GLANCE family of trade-marks later on in my analysis of the additional surrounding circumstances.

[35] The parties' marks have a limited degree of inherent distinctiveness. As stressed by the Applicant, the word "EXECUTIVE" in the context of the parties' wares has a descriptive connotation in that it is descriptive of something that is designed for, used by, or is suitable for a person having administrative or supervisory authority. As for the expression "AT-A-GLANCE", it suggests, as stressed by the Opponent, to the everyday user of the Applicant's wares that he will be able to find, easily and quickly, the information contained in his professional organizer or planner, which is what is expected from such wares or what their basic purpose is. As such, neither mark can be said to be inherently strong. To the contrary, I consider both marks as inherently weak marks.

[36] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The present application has been filed based on proposed use of the Mark. While Mr. Hodan states in his affidavit that the Mark has been used in Canada by the Applicant since August 2004 and that sales from 2004 to 2007 in respect of the Mark have been in excess of 1 million dollars, such sales postdate the material date of January 8, 2004. Accordingly, the extent to which the Mark has become known cannot be taken into consideration for assessing the present ground of opposition.

[37] By comparison, while the evidence of use of the EXECUTIVE Marks provided by

Mr. Froc in this proceeding does not establish continuous use of the EXECUTIVE Marks in Canada in association with agendas since the date of first use alleged by the Opponent, the sales figures provided for the years 2000 to 2007 amounting to $690,864.50 together with the statements of facts and exhibits discussed above, support the Opponent's contention that its EXECUTIVE Marks have become known to some extent in Canada in association with agendas.

[38] Although such use increases the distinctiveness of the EXECUTIVE Marks, I am of the view that they nonetheless remain rather relatively weak marks given their descriptive connotation.

(b) The length of time the trade-marks have been in use

[39] The Applicant's application is based upon proposed use of the Mark whereas the Opponent's evidence establishes use of the EXECUTIVE Marks since at least 2000.

(c) The nature of the wares, services or business; and (d) the nature of the trade

[40] The Applicant's application covers "professional organizers and planners in both dated and undated formats", whereas the Opponent's EXECUTIVE Marks are being used in association with agendas. The parties' wares are either identical or closely related.

[41] As per my review of the evidence above, it would appear that the parties are competitors for the same commercial accounts (re Lyreco) or that at least there is the potential for overlapping channels of trade (re similar retailers).

(e) The degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[42] As indicated above, the word "EXECUTIVE" in the context of the parties' wares has a descriptive connotation in that it is descriptive of something that is designed for, used by, or is suitable for a person having administrative or supervisory authority, whereas the expression "AT-A-GLANCE" suggests to the everyday user of the Applicant's wares that he will be able to find, easily and quickly, the information contained in his professional organizer or planner,

which is what is expected from such wares or what their basic purpose is.

[43] While the Mark incorporates the Opponent's EXECUTIVE trade-mark in its entirety, the prefix "AT-A-GLANCE" differentiates to some extent the Mark from the Opponent's EXECUTIVE Marks visually, phonetically and in the idea suggested.

Additional surrounding circumstances – the AT-A-GLANCE family of trade-marks

[44] As indicated above, it is the Applicant's position that its AT-A-GLANCE Marks are highly distinctive of it. The Applicant submits that its ownership of such a family of marks is a significant factor that assists the Applicant's Mark in being distinguished from the Opponent's EXECUTIVE Marks.

[45] Commenting first on the Applicant's ownership of registrations for its various AT-A-GLANCE Marks, it is trite law that s. 19 of the 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 [*Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.*, 4 C.P.R. (3d) 108 (T.M.O.B.); *Groupe Lavo Inc. v. Proctor & Gamble Inc.*, 32 C.P.R. (3d) 533 (T.M.O.B.)].

[46] Secondly, there can be no presumption of the existence of a family of marks in opposition proceedings. A party seeking to establish a family of marks must establish that it is using more than one or two trade-marks within the alleged family (a registration or application does not establish use) [*Techniquip Ltd. v. Canadian Olympic Assn* (1998), 145 F.T.R. 59 (F.C.T.D.), aff'd 250 N.R. 302 (F.C.A.); *Now Communications Inc. v. CHUM Ltd* (2003), 32 C.P.R. (4th) 168 (T.M.O.B.)].

[47] That said, I agree with the Applicant that it has established the existence of its family of AT-A-GLANCE Marks.

[48] While Mr. Hodan has not provided exhaustive evidence establishing use of the AT-A-

GLANCE Marks since the very first dates of use claimed in each of the Applicant's trade-mark registrations described above, he did provide photographs of a sampling of the Time Management Products marked with each of the marks forming the AT-A-GLANCE family of marks for the years 2008 and 2009, which he states show the manner in which these marks have been used in association with the AT-A-GLANCE Time Management Products and their packaging since their respective introduction in the Canadian marketplace. He did also provide copies of cover pages for the various AT-A-GLANCE Product Catalogues featuring the AT-A-GLANCE & Design mark for the years 1999 to 2002, 2004 to 2007, and 2009.

[49] While the sales figures provided for each of the AT-A-GLANCE Marks pertain to the years 2004 to 2007 only, and as such postdate the material date, Mr. Hodan did provide satisfactory explanation as to the reason why the Applicant does not have data specific to the AT-A-GLANCE line of products nor broken down on a product line basis prior to 2004. I see no reason why I could not afford weight to Mr. Hodan's uncontested sworn testimony.

Conclusion regarding the likelihood of confusion

[50] As indicated above, the test for confusion is whether someone who has an imperfect recollection of the Opponent's EXECUTIVE Marks might conclude upon seeing the Applicant's Mark as a matter of first impression that the source of the Opponent's wares and that of the Applicant's are either the same or somehow related.

[51] Having carefully considered all the surrounding circumstances, I find that the Applicant has met its legal burden to show that there was no reasonable likelihood of confusion between the Mark and the Opponent's EXECUTIVE Marks as of the filing date of the application. I reach this conclusion in view of the narrow ambit of protection to be afforded to weak marks, the differences existing between the parties' marks as well as the existence of the Applicant's family of AT-A-GLANCE Marks, which tip the balance of probabilities in the Applicant's favour.

[52] Accordingly, the s. 16(3)(a) ground of opposition is dismissed.

Non-distinctiveness ground of opposition

[53] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act in that it does not distinguish and is not adapted to distinguish the Applicant's wares from the wares of the Opponent sold in association with its EXECUTIVE Marks.

[54] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition (in this case, March 19, 2007) its trade-mark had become known to some extent at least to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. The Opponent has met this burden.

[55] However, as indicated above, the Applicant's evidence shows that it has used its Mark quite extensively since August 2004, with sales from 2004 to 2007 in excess of 1 million dollars. Another surrounding circumstance that must be considered as of the later material date of March 19, 2007 is the lack of confusion between the marks despite their coexistence in Canada in overlapping channels of trade for over four years. As stated in *Dion Neckwear* supra:

> With respect to the lack of evidence by the opponent of actual confusion, the Registrar expressed the view that an opponent does not need to file that kind of evidence. This is true in theory, but once an applicant has filed some evidence which may point to unlikelihood of confusion, an opponent is at great risk if, relying on the burden of proof the applicant is subject to, it assumes that it does not need to file any evidence of confusion. While the relevant issue is "likelihood of confusion" and not "actual confusion", the lack of "actual confusion" is a factor which the courts have found of significance when determining the "likelihood of confusion". An adverse inference may be drawn when concurrent use on the evidence is extensive, yet no evidence of confusion has been given by the opponent. (See *Pink Panther Beauty Corp. v. United Artists Corp.,* [1998], 80 C.P.R. (3d) 247 (F.C.A.) ; *Multiplicant Inc. v. Petit Bateau Valton S.A.* (1994), 55 C.P.R. (3d) 372 (F.C.T.D.); *Bally Schuhfabriken AG/Bally's Shoe Factories Ltd. v. Big Blue Jeans Ltd.* (1992), 41 C.P.R. (3d) 205 (F.C.T.D.); *Monsport Inc. v. Vêtements de Sport Bonnie (1978) Ltée* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.).)

[56] Furthermore, the Hodan affidavit establishes extensive use of the AT-A-GLANCE family of marks for the years 2004 to 2007, the total of which exceeds 12.3 million dollars.

[57] In view of the foregoing and bearing in mind my comments made above in respect of the s. 16(3)(a) ground of opposition, I find that the Applicant has also satisfied its legal burden with respect to this ground. This ground of opposition is accordingly dismissed.

Disposition

[58] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office