



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

Citation: 2012 TMOB 246
Date of Decision: 2012-12-14

**IN THE MATTER OF AN OPPOSITION
by 1772887 Ontario Limited to
application No. 1,264,530 for the trade-
mark PRESTIGE CANADIAN
FASHION MAGAZINE in the name of
Seyed Amir Mir Mohammadi**

File Record

[1] On July 12, 2005, Seyed Amir Mir Mohammadi (the Applicant) filed an application based on proposed use to register the trade-mark PRESTIGE CANADIAN FASHION MAGAZINE (the Mark). After responding to two office actions the application now covers the following wares and services:

Fashion magazine (the Wares); and
Advertising the messages of others, and advertising agency services; placing advertisements of others; preparing advertisements of others; electronic billboard advertisement for others; advertising the services of others through mail, email, phone, website, and printed publications; promoting and advertising the sale of goods and services of others through the distribution of printed material and promotional content; providing coupon programs pertaining to a line of food products of others; providing advertising and promotional space in a periodical; promoting and advertising the sale of goods and services of others through the administration of a consumer loyalty program; promoting and advertising the sale of goods and services of others by awarding purchase points for credit card use; promoting and advertising the sale of credit card accounts of others through the administration of incentive award programs; promoting and advertising the goods and services of others through the distribution of discount cards; promoting and advertising the goods and services of others by arranging for sponsors to affiliate goods and services with a specific activity, namely, fashion show / modeling events for both male and female models, music events for audiences, sport events in all areas for young people,

fundraising events for good causes, art events particularly painting, sculpture, photography and fashion show for new and existing talent artists, designers, and models (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 16, 2009. 1772887 Ontario Limited (the Opponent) filed a statement of opposition on November 20, 2009 which was forwarded by the Registrar to the Applicant on November 24, 2009.

[3] The grounds of opposition pleaded are:

1. The Application does not comply with the requirements of section 30(i) of the *Trade-marks Act*, RSC 1985 c T-13 (the “Act”) in that that the Applicant was well aware or ought to have been aware of the existence of the Opponent and the use and notoriety of its trade-marks in Canada;
2. Contrary to section 30(b) of the Act the Applicant used the Mark in Canada prior to the date of application and the use date is not stated in the application;
3. The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the registered trade-mark FASHION18, registration number TMA633,226 and the trade-mark FASHION, application 1,447,752;
4. The Applicant is not the person entitled to registration of the Mark pursuant to the provisions of sections 16(3)(a) and (b) of the Act because at the filing date of the application, the Mark was confusing with the Opponent’s trade-marks FASHION 18 and FASHION previously used in Canada and for which applications for registration were previously filed;
5. Pursuant to section 38(2)(d) and section 2 of the Act, the Mark is not distinctive of it, nor is it capable of becoming distinctive of it within the meaning of section 2 of the Act.

[4] In his counter statement filed on January 25, 2010 the Applicant essentially denied all grounds of opposition.

[5] The Opponent filed the affidavit of Elenita Anastacio while the Applicant filed the affidavit of Seyed Amir Mir Mohammadi. Mr. Mohammadi was cross-examined on his affidavit and the transcript is part of the record.

[6] Only the Applicant filed a written argument and both parties were represented at the hearing.

[7] The Opponent withdrew, at the hearing, the ground of opposition based on section 16(3)(b) of the Act. It also requested permission to amend its statement of opposition such that

reference to section 30(b) of the Act in the second ground of opposition would be substituted by section 30(e). I shall rule on the request when assessing the second ground of opposition.

Legal Onus and Burden of Proof

[8] The legal onus is upon the Applicant to show that the application complies with the provisions of the Act, but there is however 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

Ground of Opposition based on Section 30(i) of the Act

[9] Section 30(i) of the Act only requires the Applicant to declare itself satisfied that it is entitled to the registration of the Mark. Such a statement is included in the application. One may rely on section 30(i) in specific cases such as where fraud by the Applicant is alleged [see *Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. There is no allegation of that nature in the statement of opposition or any evidence in the record to that effect.

[10] The first ground of opposition is therefore dismissed.

The Second Ground of Opposition

[11] The Opponent argued at the hearing that there was a clerical error in the second ground of opposition and therefore the reference to section 30(b) should read “30(e)”. The Opponent’s agent made a verbal request to amend its statement of opposition in order to make such correction.

[12] It appears to me that the granting or not of leave to amend the statement of opposition to correct an allegedly clerical error is a red herring. No matter if the amendment is accepted or

refused the second ground of opposition would make specific reference to a sub-section number of the Act while part of the wording used does refer to a different sub-section of the Act. For ease of reference I reproduce herein below the relevant sub-sections of the Act:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing

(...)

(b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of wares or services described in the application;

(...)

(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;

[13] In both situations, amendment or not, the wording of the ground of opposition would not cover the argument presented by the Opponent at the hearing, namely that the Applicant could not have had the intention to use the Mark at the filing date of the application as the evidence shows that the Mark was used by a corporate entity and not the Applicant.

[14] Under these circumstances, taking into consideration the stage of the proceedings, the fact that the Opponent has failed to explain why the amendment was not made earlier, and that in any event the amendment sought would not cover the argument developed at the hearing, I refuse the Opponent's request to amend its statement of opposition.

[15] Given that the Applicant stated in its counter statement that the Opponent's allegation that the Applicant has used the Mark prior to the filing date of the application was inaccurate, I shall determine if the Opponent has met its initial burden with respect to a ground of opposition alleging that the Applicant has already used the Mark at the filing date of the application and as such the date of first use has not been stated in the application. An argument could be made that such issue is covered by the last portion of the second ground of opposition as pleaded.

[16] Mr. Mohammadi is the Applicant. He alleges in paragraph 3 of his affidavit that:

3. Prestige Canadian Fashion Magazine Inc. was registered with the Library and Archives Canada under International Standard Serial Number (ISSN): 1718-3308 in

year 2006, began with its Winter/Spring 2006 issue. Attached hereto as Exhibit “B” is the record of this registration of the International Standard Serial Number (ISSN) with the Library and Archives Canada.

[17] During his cross-examination he confirmed that Prestige Canadian Fashion Magazine Inc. is an entity incorporated by him and he filed as a reply to an undertaking a copy of its certificate of incorporation. It was incorporated on July 7, 2005, thus 5 days prior to the filing date of this application. Exhibit B does not make reference to a specific date of publication except for the mention “Began with winter/spring 2006 issue”. This certainly does not establish use of the Mark prior to the filing date of the application.

[18] During his cross-examination Mr. Mohammadi also stated that the first publication was for promotion. When asked to produce a copy he replied by stating that a hard copy is available at the Library of Canada. He also stated that it was published on the website prestigecfm.com owned by Prestige Canadian Fashion Magazine Inc. There were no specific questions asked to Mr. Mohammadi as to when such publication was first published or put on Prestige Canadian Fashion Magazine Inc’s website.

[19] The Opponent did not raise, as a ground of opposition, that the Applicant did not himself intend to use the Mark as the use, if any, had been by a separate entity, namely Prestige Canadian Fashion Magazine Inc. The Opponent had the opportunity after the cross-examination of Mr. Mohammadi to amend its statement of opposition to bring forward this additional issue. Moreover it decided not to file a written argument where it could have been raised and brought to the Applicant’s attention. Instead it decided to wait until the hearing to bring it forward and claim that there was a clerical error in the statement of opposition. It is more than just a simple clerical error. In any event the Applicant does state in its application that he “by itself (sic) or through a licensee, or by itself (sic) and through a licensee intends...”. Prestige Canadian Fashion Magazine Inc. could very well be a licensee.

[20] For all these reasons I dismiss the second ground of opposition.

Entitlement under Section 16(3)(a) and Distinctiveness of the Mark

[21] Under the ground of entitlement the Opponent has the initial burden to prove that it has used or made known its trade-marks FASHION 18 and FASHION in Canada prior to the filing date of the Applicant's application, namely July 12, 2005 and that it had not abandoned such use at the advertising date of the application [see sections 16(3) and (5) of the Act].

[22] Ms. Anastacio has been a trade-mark searcher employed by the Opponent's agent for 18 years. On May 5, 2010 she conducted a search in the CD NameSearch Canadian Trade-marks Database to obtain the full particulars of the following trade-mark application and registration:

Application 1,447,752 for the trade-mark FASHION covering magazines and Internet services in the nature of electronic magazines and publishing services through the use of worldwide web; Registration TMA633,226 for the trade-mark FASHION 18 covering printed publications, namely a magazine and newsletters and Internet services, namely electronic magazine and website services available over the worldwide web to consumers; media services, namely educational and informational services all relating to magazine; entertainment services, namely the creation and production of consumer television and radio broadcast shows and pre-recorded CD and DVD media for purchase by the consumer.

[23] There is no evidence of use of any of these trade-marks in Canada except for an admission by the Applicant during his cross-examination that he has seen FASHION magazine which is the Opponent's magazine. However there is no reference to a date and thus it is impossible to determine if he saw the Opponent's magazine before or after the relevant date. It is clear however, from his deposition, that he found out after the filing date of this application that FASHION was a magazine published by the Opponent.

[24] The filing of a certificate of registration of a trade-mark is not sufficient for the Opponent to meet its initial evidential burden under section 16(3) of the Act [see *Groupe Videotron Ltée v Adamik* (1990), 29 CPR (3d) 568 (TMOB)].

[25] I dismiss the fourth ground of opposition based on section 16(3)(a) of the Act for failure by the Opponent to meet its initial evidential burden.

[26] As for the ground of opposition based on lack of distinctiveness of the Mark, the Opponent has an initial burden to prove that its trade-marks FASHION and FASHION 18 had become sufficiently known in Canada at the filing date of the statement of opposition (November

20, 2009) to negate any distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. Once this burden is met, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely creating confusion with the Opponent's trade-marks such that it was adapted at the relevant date to distinguish or actually distinguished throughout Canada the Wares and Services from the Opponent's wares and services [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[27] The evidence described above does not establish that the Opponent's trade-marks had become sufficiently known in Canada to negate any distinctiveness of the Mark. I therefore dismiss the fifth ground of opposition for failure by the Opponent to meet its initial evidential burden.

Registrability of the Mark under Section 12(1)(d) of the Act

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

[29] A pending application cannot form the basis of a ground of opposition under section 12(1)(d) of the Act and as such the Opponent cannot rely on application 1,447,752 to support this ground of opposition [see *Caribbean Cultural Committee-Caribana v Khan* (1999), 3 CPR (4th) 101 (TMOB)]. As for registration TMA633,226 for the trade-mark FASHION 18, Ms. Anastacio has filed an extract of the register. I checked the register and it is extant. Consequently the Opponent has met its initial burden with respect to this ground of opposition in so far as the likelihood of confusion with registration TMA633,226 is concerned.

[30] The test to determine if there is a likelihood of confusion between two trade-marks is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is

not necessary to give each one of them equal weight [See *Clorox Co v Sears Canada Inc* (1992), 41 CPR (3d) 483 (FCTD) and *Gainers Inc v Marchildon* (1996), 66 CPR (3d) 308 (FCTD)]. I also refer to the judgments of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée et al* (2006), 49 CPR (4th) 401 and *Mattel Inc v 3894207 Canada inc* (2006), 49 CPR (4th) 321 where Mr. Justice Binnie commented on the assessment of the criteria enumerated under section 6(5) of the Act.

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

[31] The Opponent's trade-mark FASHION 18 is highly suggestive of the content of printed publications sold in association with such trade-mark. I do not consider this trade-mark to be inherently distinctive. The Mark is not inherently distinctive either. It is composed of common English words, the combination of which suggests that the content of the magazine relates to prestigious Canadian fashion. The word "prestige" is simply a laudatory term.

[32] The distinctiveness of a trade-mark can be enhanced through its use or promotion in Canada. The Opponent has not provided any evidence of use or promotion of its trade-mark FASHION 18 in Canada in association with the Wares and Services.

[33] As for the Applicant's use of the Mark, it is important to remember that the word "use" is a legal term defined in section 4 of the Act. I must determine if the facts described in Mr. Mohammadi's affidavit can lead to a legal conclusion that there has been use of the Mark in Canada. But before going into the details of his affidavit I must determine if its content is admissible evidence as the Opponent argues that it has not been properly sworn.

[34] The Opponent is relying on the following excerpts of Mr. Mohammadi's cross-examination:

Q. [13] Do you know who the commissioner of oaths was that you signed it in front of?

A I don't remember in mind, but, I, it is in Montreal, I went and ask for, yes.

Q. [14] Okay, and what, if anything, did he or she say to you before you signed it?

A. No, just it was a matter of affidavit, signing affidavit, evidence, what you call as a regular lawyer to sign affidavit, and read, and whatever the procedure is, yes (my underlines).

Q. [15] Okay, so you signed your name, and then he or she signed her name?

A. And, of course, she read it, she read things before she signed, yes (my underlines).

Q. [16] Yes, okay, and that was it, that's all?

A. Yes.

[35] I fail to see how the answers to the questions asked show that the deponent was not properly sworn. Mr. Mohammadi did state that the Commissioner of Oaths did read some material and that the usual procedure was followed. Finally the affidavit does contain the statement "Solemnly declared before me in the City of Montreal, Province of Quebec this 14th day of September 2010." Therefore Mr. Mohammadi's affidavit does constitute proper evidence.

[36] Mr. Mohammadi filed an extract of Library and Archives Canada's website relating to the publication of a Canadian fashion magazine under the Mark. Such document does not establish use of the Mark within the meaning of section 4 of the Act. It does not meet the requirements set out in section 4(1) of the Act in as far as the Wares are concerned and those set out in section 4(2) for the Services.

[37] Mr. Mohammadi also filed extracts of the register which is of no help to prove the use of the Mark. Consequently there is no evidence in the record of the use or promotion of the Mark in Canada by the Applicant in association with the Wares or the Services.

[38] The first factor listed in section 6(5) of the Act favors neither party.

The length of time the trade-marks or trade-names have been in use

[39] It has been held that the Registrar can refer to the certificate of registration to establish a period of use of the Opponent's trade-mark. [See *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68] According to certificate of registration TMA633,226 the trade-mark

FASHION 18 has been used since March 18, 2002 but I can only presume from such evidence *de minimis* use. This factor favours the Opponent as there is no evidence of use of the Mark as discussed previously. However this factor will not be a determining factor in this file.

The nature of the wares, services, or business; the nature of the trade

[40] There is clearly an overlap between the Wares and Services on one hand and the wares and services covered by the Opponent's registration TMA633,226. There is no description of the parties' respective channels of trade. In view of the clear overlap between the wares and services of the respective parties I can infer that the channels of trade are similar. These factors favor the Opponent.

The degree of resemblance

[41] In its judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. The marks in issue must be looked at in their totalities and should not be dissected into their components.

[42] As stated by Mr. Justice Denault of the Federal Court in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359, the first portion of a trade-mark is the most relevant for purposes of distinction.

[43] The Opponent takes the position that the Applicant has taken the dominant portion of its trade-mark, namely the word "fashion" and added laudatory and descriptive words which do not render the Mark distinctive of the Applicant.

[44] If the dominant portion of a trade-mark used in association with magazines is the word "fashion", such word is at least suggestive of the content of such magazine. The idea suggested by the trade-mark FASHION 18 is that, when used in association with a magazine, its content relates to fashion intended for those of the age of 18 years while the idea suggested by the Mark is that its content relates to luxurious Canadian fashion items. The ideas suggested by the marks in issue are therefore different.

[45] As an additional surrounding circumstance the Applicant argues the state of the register. In his affidavit Mr. Mohammadi makes reference to 4 registrations where the trade-marks comprise the word “fashion” in association with magazines. This number of citations is not sufficient to infer a wide use in the market place of the word “fashion” as part of a trade-mark used in association with magazines. [See *Welch Foods Inc v Del Monte Corp* (1993), 44 CPR (3d) 205]. At the hearing the Applicant alleged that he found numerous citations on the register but limited his affidavit to those 4 entries mentioned therein. He had other extracts of the register with him at the hearing and was prepared to file them if need be. I refused the filing of any documents at the hearing. They were not part of an affidavit and because of the late stage of the proceedings, it would have caused prejudice to the Opponent.

[46] As a further additional surrounding circumstance the Applicant filed a copy of a judgment of the Federal Court maintaining the Registrar’s decision, pursuant to section 38(4) of the Act, refusing a statement of opposition filed by the Opponent, in a file totally unrelated to this one, as it did not raise a substantial issue for decision. I fail to understand how such decision of the Court would have an impact on this file which involves a different applicant and more importantly a completely different trade-mark (the judgment concerned the trade-mark MIKIT maisons prêtes à finir & Design). The Registrar may have concluded that a statement of opposition filed by the Opponent in another file did not raise a single substantial issue for decision but such ruling has no effect in the present, totally unrelated, opposition.

[47] Ultimately, the test to determine if there is a likelihood of confusion is: as a matter of first impression, would a consumer with an imperfect recollection of the Opponent’s trade-mark FASHION 18, who is in contact with the Wares and Services offered in association with the Mark, likely think that those Wares and Services originate from the Opponent.

[48] The only resemblance between the marks is the word “fashion” which is highly suggestive of the content of the magazines bearing the marks in issue. The marks as a whole are different in appearance, sound and in the ideas suggested by them. This most important factor does favour the Applicant.

Conclusion

[49] From this analysis of the relevant criteria, I conclude that the Applicant has demonstrated, on a balance of probabilities, that the Mark would not likely cause confusion with the Opponent's trade-mark FASHION18 when used in association with the Wares and Services. The Opponent's trade-mark is not inherently distinctive and despite the fact that there is an overlap in the parties' wares and services the differences in appearance, sound and the ideas suggested by the marks are sufficient to enable a consumer to distinguish the origin of one's magazine over the other. As for the Services, they are ancillary to the Wares. Having found that there would be no likelihood of confusion between the marks in issue in so far as the Wares are concerned, the same conclusion is applicable to the Services.

[50] The third ground of opposition is also dismissed.

Disposition

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

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