

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 042

Date of Decision: 2022-03-10

IN THE MATTER OF AN OPPOSITION

Advance Magazine Publishers Inc.

Opponent

and

Brunswick Corporation

Applicant

1,704,746 for VOGUE

Application

OVERVIEW

[1] Brunswick Corporation (the Applicant) has applied to register the trademark VOGUE (the Mark) for use in association with boats. Filed on November 27, 2014, this application is based on the Applicant's registration and use of the Mark in the United States, and on use of the Mark in Canada since September 26, 2013.

[2] Advance Magazine Publishers Inc. (the Opponent) primarily alleges that the Mark is confusing with its VOGUE trademarks used in association with a famous fashion magazine and other goods and services. The Opponent also opposes the application on the basis of other technical grounds concerning the Applicant's use of the Mark.

[3] Given the differences in the nature of the applied-for goods and the Opponent's goods and services, I find that the Applicant has met its legal onus of proving that there is no

reasonable likelihood of confusion. The grounds of opposition based on the Applicant's use of the Mark also fail. Accordingly, the opposition is rejected for the reasons that follow.

THE RECORD

[4] The Opponent filed its statement of opposition on May 16, 2016 alleging that (i) the application does not conform to section 30 of the *Trademarks Act*, RSC 1985, c T-13 (the Act); (ii) the Mark is not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not the person entitled to the registration of the Mark under section 16 of the Act, and (iv) the Mark is not distinctive under section 2 of the Act. I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act).

[5] In support of its opposition, the Opponent filed the affidavits of Elenita Anastacio, a trademarks searcher and Nathan Fan, an associate. Both are employed by the Opponent's agent. Ms. Anastacio conducted a search in the *CD NameSearch* Canadian Trademarks Database for the Opponent's VOGUE trademarks and attaches their particulars. Mr. Fan provides evidence of use and promotion of the VOGUE trademark in association with watercrafts by Princecraft Boats Inc. which he located through Internet searches.

[6] In support of its application, the Applicant filed the affidavit of Jean-Philippe Martin-Dubois, the Marketing and Customer Experience Director of Princecraft Boats Inc. Mr. Martin-Dubois was cross-examined and provided answers to undertakings given in his examination. Mr. Martin-Dubois provides evidence on the trademark license between the Applicant and Princecraft Boats Inc., and information on the sales and promotion of the VOGUE aluminum pontoon boats sold by Princecraft Boats Inc. in Canada. Finally, Mr. Martin-Dubois also confirms that he is familiar with the VOGUE fashion magazine.

[7] Only the Opponent filed a written argument. Both parties attended a hearing.

JUDICIAL NOTICE

[8] The Opponent submits that the Registrar should take judicial notice of the fact that the Opponent's VOGUE magazine circulates in Canada and is devoted to women's fashion and fashion accessories to the extent that the Registrar is able to infer that the Opponent's VOGUE trademark has acquired distinctiveness in Canada (Opponent's written submissions, para 34). I am not satisfied that this is a notorious or generally accepted fact or one capable of immediate and accurate demonstration by resort to readily accessible sources of indisputable accuracy. Even if I took judicial notice that a magazine titled VOGUE circulated in Canada, that would not mean that I could take judicial notice that such use would enure to the benefit of the Opponent or that the Opponent's trademark had a reputation sufficient to affect the outcome of this opposition.

EACH PARTY'S RESPECTIVE BURDEN OR ONUS

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. 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].

ANALYSIS

[10] I will now consider each of the grounds of opposition.

Section 12(1)(d) Ground of Opposition is Rejected

[11] The material date for a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)]

[12] The Opponent relies on the registrations set out at Schedule A in support of its section 12(1)(d) ground of opposition. An opponent's initial burden is met with respect to this ground of

opposition if a registration upon which it relies is extant at the date of my decision. As each of the pleaded registrations is currently extant, the Opponent has met its initial evidential burden [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) which confirms the Registrar's discretion to check the register to confirm the status of the pleaded registrations].

[13] The Applicant must therefore establish, on a balance of probabilities, that as of today's date there is not a reasonable likelihood of confusion between the Mark and any one of the pleaded trademarks.

[14] I will focus my discussion of the likelihood of confusion with the Opponent's registrations for the trademark VOGUE (registration Nos. TMDA42009, UCA04268, TMA774,911, TMA576,133, TMA847,253) which cover a variety of goods and services. The Opponent highlights the following goods and services registered in association with its VOGUE trademarks: magazines, trade journals, books, periodicals – both in print and in electronic format distributed online, patterns, including sewing patterns for clothing, website and other online services in the field of fashion and style, and totebags, handbags, backpacks, cosmetic bags, laptop and wireless device cases. If confusion is not likely with any of these registered marks, then it is not likely with any of the other pleaded registered marks.

Test for Confusion

[15] Section 6(2) of the Act indicates that use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or in the same Nice class.

[16] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the

nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC), *Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

The inherent distinctiveness of the marks

[17] The parties' marks are not inherently strong, since they all consist of a suggestive word suggesting that the associated goods are fashionable, current or popular. *The Canadian Oxford Dictionary* provides the following definitions:

1. [prec. by *the*] the prevailing fashion.
2. popular use or currency: *has had a great vogue*.

The extent to which each mark has become known

[18] A mark's distinctiveness may be increased through use and promotion.

[19] The Opponent submits that I should find that its VOGUE mark has become known because it has been the subject of registrations for decades and because the Applicant's affiant acknowledged during cross-examination that he was aware of VOGUE magazine. I will, however, only assume *de minimis* use of the Opponent's trademark based on its registrations in the absence of any evidence showing that the Opponent has used or promoted its mark [*Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[20] Mr. Martin-Dubois provides evidence showing that the VOGUE trademark is featured on the Applicant's line of VOGUE boats (see, for example the photographs at Exhibit C) and sales figures showing in 2013 and 2014 over 100 VOGUE boats were sold, and over 50 were sold in each of 2015 and 2016 (Exhibits A-B). The Applicant's evidence allows me to conclude that the Mark is known to a limited extent in Canada.

The length of time the marks have been in use

[21] The particulars of the Opponent's registrations provide dates of first use that go back many years. However, in the absence of evidence of continuing use by the Opponent of its marks, the length of time the marks have been in use in Canada is not a material circumstance in this case.

[22] Mr. Martin-Dubois provides evidence that the Applicant has been using the Mark in Canada since 2013 (Exhibit A).

The nature of the goods, services, business and trade

[23] When considering the goods, services, business and trades of the parties, it is the statement of goods or services in the parties' trademark application and registrations that govern the issue of confusion arising under section 12(1)(d) of the Act [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna* (1984), 58 CPR (3d) 381 (FCA)].

[24] Magazines and periodicals and the Opponent's other registered goods are very different from boats and there is no reason to assume that they would travel in the same channels of trade.

[25] During his cross-examination, Mr. Martin-Dubois confirms that the promotional material for the Applicant's VOGUE model boats contains articles and descriptions with terminology such as luxury, sophisticated, elegant, design and style and the expression "The Vogue, a celebrity pontoon" (cross-examination pages 20-22). The Opponent submits that the Applicant's Vogue boats and associated promotional material therefore allude to the same idea of luxury, sophistication and elegance as the lifestyle and fashion products found in the Vogue magazine.

[26] While VOGUE may evoke the same connotation of being fashionable and luxurious for both the Applicant and Opponent, this does not mean that the nature of the goods, trade and business overlap. I am also not swayed by the argument that it is significant that the Applicant could advertise its Goods in the Opponent's publications or that the Opponent's publications may feature luxury boats. After all, it is not apparent that there is any restriction on the goods that might be advertised or featured in the Opponent's publications. Further, there is no evidence

from which I could base an inference that just because a consumer sees a boat featured in advertising or other content in the Opponent's magazine, this would lead a consumer to believe that the boats sold in association with the VOGUE trademark had the same source as or were otherwise related to the Opponent's fashion magazines and other goods. Likewise, I do not find the Opponent's submissions that the Applicant's dealers may have waiting rooms where the Opponent's magazines could be available means that the nature of the goods and trade overlaps or leads to the inference that there would be source confusion as between the Applicant's boats and the Opponent's magazines.

The degree of resemblance between the marks

[27] The Mark is identical to the Opponent's trademarks consisting of VOGUE in appearance and as sounded. The parties' marks also evoke the same idea – goods and services which are fashionable or are for fashionable people.

Expansion of brand

[28] The Opponent submits that the fame of its trademark and its applications and registrations show that there is a natural expansion of the VOGUE brand into a variety of areas. In the absence of evidence showing goods and services being sold by the Opponent, I do not believe that the existence of a variety of goods and services being applied-for or registered with the Opponent's VOGUE trademark results in the inference that consumers would perceive the natural expansion of the Opponent's VOGUE brand to include boats [see, also, *Joseph E. Seagram & Sons Ltd. v Seagram Real Estate Ltd.* (1990), 33 CPR (3d) 454 (FCTD)].

Conclusion

[29] Having considered all of the surrounding circumstances, I find that the Applicant has established, on a balance of probabilities, that confusion is not likely between the Mark and any of the Opponent's marks. The common feature among the marks, the word "vogue", is an ordinary dictionary word that is a reference to being fashionable, popular and current. As there is no evidence that the Opponent's trademark is known to a significant extent, I find that the differences between the parties' goods is more than sufficient to make confusion unlikely. In the

absence of evidence, speculation on the advertising in the Opponent's magazine or expansion of the brand, is not sufficient to demonstrate a nexus between the parties' goods.

[30] I note that the Opponent has relied on six cases where the Opponent (or its predecessor) was successful against a third party VOGUE mark. With respect to five of the cases, there was evidence that the Opponent's goods were well-known in Canada [*Advance Magazine Publishers Inc v Masco Building Products Corp* (1999), 86 CPR (3d) 207 (FCTD); *Advance Magazine Publishers Inc v Peintures MF (1972) Inc* (1996), 66 CPR (3d) 375 (TMOB); *Conde Nast Publications Inc v Hanz Schwarzkopf GmbH* (1988), 20 CPR (3d) 176 (TMOB); *Advance Magazine Publishers Inc v Vög Fashion Design Accessories*, 2005 CanLII 78283 (TMOB); *Conde Nast Publications Inc v Gozlan Brothers Ltd*, [1980] FCJ No 502] while there is no such evidence here.

[31] With respect to the sixth case *Advance Magazine Publishers Inc v Australian Gold, LLC*, 2012 TMOB 157, the goods at issue (skin tanning preparations) were much more closely related with the Registrar finding that "the applicant's wares are of the type that would be featured or advertised in the opponent's magazine. Thus, there is a connection in the parties' wares and trades." In this case, other than the speculative submissions by the Opponent's counsel about articles and advertisements depicting images of individuals on or operating luxury watercrafts including boats, there is no such connection between the parties' goods, services and trades.

[32] The section 12(1)(d) ground of opposition is therefore rejected.

Section 30 Grounds of Opposition are Rejected

[33] The material date for assessing a section 30 ground is the filing date of the application, namely November 27, 2014 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

Section 30(i) Ground of Opposition

[34] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act

can be found only where there are exceptional circumstances that render an applicant's statement untrue [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[35] The Opponent pleads with respect to section 30(i) of the Act:

At the date of application a search of the Trade-mark Register would have located the marks of the Opponent ... in any event, the Applicant was well aware of the Opponent's use of its trade-marks, and therefore, it could not have been satisfied under Section 30(i) of its entitlement to use the said mark. The Applicant knew at all material times of the Opponent's use of the VOGUE Registrations and VOGUE Applications and the notoriety of their marks referred to therein, prior to its date of application.

The use of the Offending Mark by the Applicant will depreciate the value of the goodwill of the Opponent's VOGUE registrations contrary to Section 22 and Section 30(i) of the Act.

[36] The mere fact that Mr. Martin-Dubois and others at the Applicant were aware of the Opponent's trademarks is not by itself sufficient to put into question the Applicant's statement that it was entitled to use the Mark.

[37] With respect to the ground of opposition based on sections 30(i) and 22 of the Act, the Opponent fails to meet its evidential burden as the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée. supra*].

[38] Consequently, I reject the section 30(i) grounds of opposition in view of the Opponent's failure to meet its evidential burden.

Section 30(d) Ground of Opposition

[39] The Opponent alleges that the Applicant does not and has not used the Mark in the United States as claimed in the application as any use is by Princecraft Boats Inc. who is not licensed by the Applicant to use the Mark.

[40] The Opponent submits that it meets its evidential burden with respect to the section 30(d) ground of opposition as the evidence of use of the Mark by Princecraft Boats Inc. does not enure

to the Applicant by virtue of section 50 of the Act. The Opponent focusses on the following in support of meeting its evidential burden: (i) the lack of a specific reference to the Applicant in Princecraft's promotional materials, and (ii) that references to a "Princecraft A Brunswick Company" could refer to at least three different Brunswick Companies namely, Brunswick Corporation; Brunswick International Group S.A.R.L; and Brunswick International Limited with the latter appearing on the Princecraft invoices in Canada.

[41] The initial burden on an opponent is light respecting the issue of non-conformance with section 30(d) of the Act because the facts regarding an applicant's use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB) at 89]. To meet its burden, an opponent must show that an applicant's evidence is clearly inconsistent with the claimed date of first use or raises doubt as to the veracity of the claimed date of first use [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), at 565 -6, aff'd (2001), 11 CPR (4th) 489 (FCTD); *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323; *Reitmans (Canada) Limited v Atlantic Engraving Ltd*, 2005 CanLII 78234 (TMOB)].

[42] If the Opponent succeeds in discharging its initial evidential burden, the Applicant must then, in response, substantiate its claim of use and registration in the United States. However, while the Opponent is entitled to rely on the Applicant's evidence to meet its evidential burden, the Applicant is under no obligation to evidence its use and registration abroad as of the material date unless the Opponent actually meets its evidential burden.

[43] The Opponent fails to meet its evidential burden as the evidence of Mr. Martin-Dubois summarized below clearly shows that use of the VOGUE trademark by Princecraft Boats Inc. enures to the Applicant.

- In para 2 of his affidavit, Mr. Martin-Dubois explains that Princecraft Boats Inc. was founded in 1954 as a manufacturer of aluminum fishing and deck boats and expanded its product line to aluminum pontoon boats.
- In response to an undertaking after the cross-examination, a License Agreement between the Applicant and Princecraft Boats Inc. was provided by Mr. Martin-

Dubois. While this License Agreement does not include the trademark VOGUE, it does reference the trademark PRINCECRAFT which appears on the VOGUE line of boats (see, for example, the pictures of the 2013 VOGUE boats in Exhibit C). The License Agreement includes the following (para 7):

LICENSEE agrees to cooperate with LICENSOR in facilitating LICENSOR’s control of the nature and quality of the boats manufactured, distributed and sold in connection with the Licensed Marks ... by permitting the LICENSOR to inspect at regular intervals ...

- Mr. Martin-Dubois’ evidence is that in 2001 Princecraft Boats Inc. (which he defines in para 1 of his affidavit as “my company”) was acquired by the Applicant. Mr. Martin-Dubois states in para 7 that “in 2001, my company was acquired by Brunswick Corporation, having its business address at One North Field Court, Lake Forest, IL ... (hereinafter referred to as “head office”).” He then provides the following evidence:

Para 12	... My company has been licensed by head office to use the VOGUE trademark for “boats” in Canada. Head office maintains direct or indirect control over all use of the VOGUE trademark by my company in Canada, namely over the character and quality of the VOGUE Boats that my company manufactures.
Para 15	Head office maintains indirect control over the character and quality of the VOGUE Boats through ongoing regular contacts between my company’s and head office’s management and employees ...
Para 18	... at least 10 times per year my company is visited by managers or employees from head office for plant visits, financial audits, annual IT budget discussions or human resources issues. ...

- With respect to the issue of three different Brunswick companies being referenced in the evidence, I do not find that this assists the Opponent meet its evidential burden while the public may have difficulty identifying the various Brunswick entities (cross-examination pages 17-

18), only Princecraft Boats sells the VOGUE line of boats in Canada (affidavit para 3, Exhibit A cross-examination pages 9-10) and use of the trademark by Princecraft Boats enures to the Applicant.

[44] As I have found the Opponent fails to meet its evidential burden, this ground of opposition is rejected.

Section 30(b) Ground of Opposition

[45] I have real doubt as to whether the Opponent has included a ground of opposition based on section 30(b) of the Act in its statement of opposition as neither this section of the Act, nor the wording of this section is referenced in it. If I am incorrect, I would have rejected this ground of opposition on the basis that the Opponent failed to meet its evidential burden for the reasons discussed with respect to the section 30(d) ground of opposition. In addition, Mr. Martin-Dubois' evidence shows sales of boats with the Mark in Canada prior to September 26, 2013 the date claimed in the application by Princecraft Boats Inc. (Exhibit A), with such use enuring to the Applicant for the aforementioned reasons.

Section 16(1)(a) Ground of Opposition is Rejected

[46] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act, on the grounds that it is confusing with the use of the Opponent's VOGUE registrations and applications. The Opponent has the initial burden of proving that one or more of its trademarks were used or made known, in Canada prior to the material date and had not been abandoned at the date of advertisement of the application for the Mark [see section 16 of the Act and *Roxxs, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268]. The material date for considering this ground of opposition is the date of first use in the subject application, September 26, 2013.

[47] The Opponent submits that the following evidence of Mr. Martin-Dubois is sufficient to meet the Opponent's burden:

Para 25 of the affidavit

... I am familiar with the VOGUE fashion magazine published by the Opponent. ...

Cross-examination

180 Q. How long have you known of the Vogue magazine?

A. I can't remember exactly. Vogue, in my mind, is a fashion magazine since many, many years.

181 Q. Most of your life?

A. Almost since – yes, since I'm enough old to know about magazines.

182 Q. Would that be the same with many of your friends, to your knowledge?

A. I assume that.

183 Q. Business Associates?

A. I assume.

[48] Knowledge of the publication and circulation of the VOGUE magazine is insufficient to prove that the Opponent had used the Mark in accordance with section 4 by the material date as required by section 16.

Section 2 Ground of Opposition is Rejected

[49] The material date for assessing distinctiveness is the date of filing of the opposition, which is May 16, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (FCTD)].

[50] The Opponent's statement of opposition alleges that the Mark is not distinctive and is not capable of being distinctive of the goods of the Applicant. The statement of opposition also references that the application is contrary to section 50 of the Act. The Opponent submits at para 97 of its written submissions:

the use by Princecraft is not licensed in compliance with section 50 of the Act and as a result of the advertising, promotion, invoicing and sales, consumers are led to believe that Princecraft is and was the owner of the VOGUE mark in Canada at all material times. Therefore, the VOGUE mark was not and is not distinctive of the Applicant at anytime since the mark was used in Canada or the U.S.

[51] The Opponent focusses on the following in support of meeting its evidential burden with respect to this ground of opposition: (i) the lack of a specific reference to the Applicant in Princecraft's promotional materials, and (ii) that references to a "Princecraft A Brunswick Company" could refer to at least three different Brunswick Companies namely, Brunswick Corporation; Brunswick International Group S.A.R.L; and Brunswick International Limited with the latter appearing on the Princecraft invoices in Canada (Opponent's written submissions, paras 93-95). Assuming that this is sufficient to meet the Opponent's evidential burden, I find that the Applicant's evidence is sufficient to meet its legal onus that the use of the Mark by Princecraft Boats Inc. enures to the Applicant for the same reason as with respect to the section 30(d) ground of opposition.

[52] With respect to a distinctiveness ground of opposition based on an allegation of confusion, to meet its initial burden with respect to the non-distinctiveness ground of opposition, the Opponent was required to show that at least one of its trademarks had become known sufficiently in Canada to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185; *Motel 6, Inc v No 6 Motel Ltd* (1981), 1981 CanLII 2834 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* 2006 FC 657]. In the absence of evidence of use and/or reputation of any of its trademarks, the Opponent has not met its initial evidential burden with respect to the non-distinctiveness ground.

[53] As such, this ground of opposition is rejected.

Section 16(1)(b) Ground of Opposition is Rejected

[54] The Opponent has met its initial burden under this ground because each of the pleaded VOGUE applications at Schedule A was filed before September 26, 2013 and was pending as of December 16, 2015. However, I am satisfied on a balance of probabilities that the Mark is not likely to be confused with any of these marks for reasons similar to those discussed with respect to the section 12(1)(d) ground. The applications pleaded under section 16(1)(b) which were filed before the material date cover the following:

TEEN VOGUE (appl No. 1,458,146) covers bedding, furniture, lamps

TEEN VOGUE (appl No. 1,521,538) covers cases for mobile phones and computers, jewelry, handbags, t-shirts, and footwear;

TEEN VOGUE (appl No. 1,573,778) totebags and handbags, accessory cases, and t-shirts

TEEN VOGUE (appl. No. 1,517,011) covers stationery

TEEN VOGUE (appl No. 1,598,521) for hair tools, computer storage devices, luggage, room organizers, furniture, pet accessories, room décor

VOGUE (appl No. 1,524,925) for clothing, footwear, headwear and promotional items and a variety of services including real estate, personal care, and hospitality services and other services in the field of fashion

[55] None of these marks are for goods or services that are any more similar to those of the Applicant than those of the registered marks pleaded under section 12(1)(d). The section 16(1)(b) ground is therefore dismissed in its entirety.

DISPOSITION

[56] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the grounds of opposition pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Trademarks Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: November 10, 2021

APPEARANCES

Kenneth D. McKay

FOR THE OPPONENT

Peter J. Pribil

FOR THE APPLICANT

AGENTS OF RECORD

Marks & Clerk



FOR THE OPPONENT


Finlayson & Singlehurst

FOR THE APPLICANT

Schedule A

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Opponent's Registered Trademark	Registration no.	Goods and Services
VOGUE	UCA4268	Goods: (1) Magazines and similar publications.
"VOGUE"	TMDA42009	Goods: (1) Patterns.
	TMDA19676	Goods: (1) A trade journal
VOGUE CAREER	TMA346,637	Goods: (1) Books and paper patterns.
VOGUE DECORATION	TMA388,687	Goods: (1) Printed publications, namely magazines.
	TMA468,713	Goods: (1) Paper sewing patterns for making clothes. (2) Paper sewing patterns.
VOGUE	TMA576,133	Services: (1) 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.

Opponent's Registered Trademark	Registration no.	Goods and Services
	TMA561,966	Goods: (1) Printed publications, namely magazines, books and periodicals. Services: (1) Internet services, namely providing fashion and style information via the internet.
VOGUE HOMBRE	TMA576,327	Services: (1) Online magazines 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.
VOGUE HOMMES INTERNATIONAL MODE	TMA595,905	Goods: (1) Magazines, newspapers and pamphlets.
TEEN VOGUE	TMA641,823	Goods: (1) Printed matter, namely periodic publications, namely a fashion and entertainment magazine; newspapers, books, magazines Services: (1) Operating online retail services featuring beauty, fashion and entertainment; (2) Disseminating a wide range of information all relating to fashion, beauty and entertainment by means of computer databases available via a global computer network, wireless, satellite, and other communication media; operating interactive forums and chatrooms all relating to a fashion, beauty and entertainment; transmitting and broadcasting live action entertainment services all relating to fashion, beauty and entertainment by means of computer databases available via a global computer network, wireless broadcast, satellite, internet, CD-ROMs, electronic publications and multimedia interactive software, telephonic and cable; (3) Computer services, namely providing fashion, beauty and entertainment information and instruction over the internet
VOGUE	TMA774,911	Goods: (1) Electronic publications, namely magazines, computer software, namely periodicals and magazines in electronic form.

Opponent's Registered Trademark	Registration no.	Goods and Services
VOGUE PATTERNS	TMA781,295	<p>Goods: (1) Printed and electronic publications, namely, books, catalogues, directories, journals, magazines, manuals, newsletters and periodicals; Sewing patterns, patterns, namely, for clothes making, craft, embroidery design and knitting.</p> <p>Services: (1) Operating websites which provide information in the field of patterns for knitting and making clothes.</p>
VOGUEPEDIA	TMA857,115	<p>Goods: (1) Software products, namely downloadable computer software for mobile phones, personal computers, consoles and tablets, for downloading, transmitting, receiving, providing, publishing extracting, encoding, decoding, reading, storing and organizing audio visual, videographic and written data all in conjunction with a global computer network.</p> <p>Services: (1) Providing an online interactive encyclopaedia and providing information in the field of fashion, style, people and entertainment; providing electronic publishing services; electronic transmission of data and documents, namely audio clips, video clips, photographs, articles and text in the field of beauty, fashion, fashion shows, publishing, photography, modelling entertainment and pop culture, via the internet and other databases.</p>

<p>VOGUE</p>	<p>TMA847,253</p>	<p>Services: (1) Broadcasting services, namely the operation of a television channel; cable transmission services, namely the electronic transmission of television and radio programming, and video, audio and voice clips over a cable system; satellite transmission services, namely the transmission of television via satellite; providing downloadable ring tones, music, MP3's, graphics, games, videos, pictures and information in the field of fashion and style 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 and communication services, namely streaming live, pre-recorded and downloadable video and audio signals, namely musical performances, music videos, radio shows, television shows, video clips, audio clips and film clips, via the Internet; educational, teaching and training services, namely organizing, presenting, sponsoring, providing and staging conferences, training sessions, seminars, courses, workshops and conventions on topics in the field of fashion, style, television, movies, live performances, sports, and culture; production, distribution and transmission of radio and television programs; production, distribution of films and live entertainment features, namely musical performances, comedic performances and plays; production, distribution and transmission of animated motion pictures and television programs; scheduling, distribution, transmission and broadcast of motion pictures, television programs and live entertainment performances, namely musical performances, concerts, comedic performances and plays, and shows; production and distribution and publishing of books, magazines and periodicals; providing information on the applicant's television programming services to multiple users via the world wide web or the internet or other on-line databases, on-line voting system; production, distribution and transmission of dance shows, music shows and video award shows; broadcasting of live and pre-recorded comedy shows, game shows and sports events before live audiences; live musical concerts; TV news shows; organizing talent contests and music and television award events; production and distribution of information in the field of entertainment,</p>
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Opponent's Registered Trademark	Registration no.	Goods and Services
		namely fashion, style and culture, by means of a global computer network; entertainment services, namely the development, production, scheduling, distribution, transmission and broadcast of television programming; television programming services, namely the provision of television programs featuring a wide range of cultural, educational and entertainment topics; online services, namely the operation of an Internet website containing audio clips, video clips, musical performances, musical videos, film clips, photographs, text and links to other websites in the field of television, fashion, style, culture and haute couture.
TEEN VOGUE	TMA821,328	Goods: (1) Totebags, handbags, backpacks; cosmetic bags; accessory cases for laptops and wireless handheld telecommunications devices.

Opponent's Applied For Trademark	Application no.	Goods and Services
TEEN VOGUE	1,521,538	Goods: (1) Cases for mobile phones and tablet computers. (2) Jewelry, namely costume jewelry items such as bracelets, necklaces, earrings, rings, key chains as jewelry. (3) Handbags, tote bags, backpacks, travel bags, laptop bags, cosmetic bags, wristlet bags, wallets. (4) T-shirts, footwear, namely, casual footwear; scarves, gloves, belts.
TEEN VOGUE	1,458,146	Goods: (1) Bedding; sheets, comforters, quilts, throws, blankets, bed skirts, pillows, furniture, namely desks, chairs, bookcases; window treatments, namely cotton fabrics for use in connection with window frame decoration; rugs, chairs, ottomans, bean bag chairs storage products, namely storage containers made out of plastic, rubber, wood and/or metal; drawers, hampers, namely laundry baskets and laundry storage containers; Table and floor lamps, lava lamps, night lights.
TEEN VOGUE	1,573,778	Goods: (1) Totebags, handbags, backpacks; cosmetic bags; accessory cases for laptops and t-shirts.
TEEN VOGUE	1,598,521	Goods: (1) Hair tools, namely, flat irons, hair dryers, hair curlers; Computer storage devices, namely, USB flash drives, thumb drives, headphones, earbuds; luggage, rolling luggage, suitcases, travel bags, duffle bags; room/dorm room organizers, namely, plastic and cardboard shelf and closet organizers, storage containers, shoe racks, desk organizers; furniture, namely, headboards, desks, bookcases, stools, dressers, tables; pet accessories, namely, collars, leashes, pet apparel, travel crates, carrying bags; room decor, namely, picture frames, jewelry boxes, ceramic jars, wall art.
TEEN VOGUE	1,597,011	Goods: (1) Stationery, namely, note paper, diaries, note cards, calendars, daily planner books, personal organizers, agendas, binders, labels, pens, pencils, envelopes, note pads, adhesive-backed notes and note pads containing adhesive on one side of the sheets; paper, folders, notebooks, binders, organizers, planners, calendars, dry erase boards, pens, pencils, highlighters and markers

VOGUE	1,524,925	<p>Goods:</p> <p>(1) Clothing, footwear, headwear and promotional items, namely bathrobes, towels, face cloths, hand soaps, shampoo, conditioners, skin lotions, skin creams, t-shirts, bath sheets, beach towels, hats, caps, visors, golf towels, golf balls, sandals, flip flops and beach balls.</p> <p>Services:</p> <p>(1) Hotel services featuring a reward program for use in hotels, restaurants, shopping and resorts.</p> <p>(2) Providing meeting facilities featuring an incentive award program directed to users of the facilities.</p> <p>(3) Health club services, namely providing instruction and equipment in the field of physical exercise; health clubs providing physical fitness facilities for recreational purposes.</p> <p>(4) Health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being; resort, health and day spa services.</p> <p>(5) Beauty salon and health spa services, namely, facials, body massages, mineral baths, cosmetic body care services.</p> <p>(6) Arranging meetings, conferences, seminars and social functions in the field of fashion and style, arranging seminars/classes in the field of arts, crafts, wine, food, travel, culinary arts, sports, yoga and physical fitness.</p> <p>(7) Real estate development services; real estate brokerage, real estate and land acquisitions, real estate equity sharing, namely, managing and arranging for ownership of real estate, condominiums, apartments; real estate investment, real estate management, real estate time sharing and leasing of real estate and real property, including condominiums and apartments; hotel services, motel services, resort lodging services, motor inn services; restaurant, café, cafeteria, cocktail lounge services; temporary accommodation services, namely, hotels, motels, motor inns and resorts accommodation services; concierge services; casino and gaming services.</p> <p>(8) Restaurant, bar, cocktail, catering, and food and beverage services, namely preparation of and serving food and beverages.</p> <p>(9) Entertainment services namely live entertainment services, namely fashion</p>
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Opponent's Applied For Trademark	Application no.	Goods and Services
		<p>shows, provision of night club services; provision of amusement arcade services; health and sport club services; discotheque services, production of plays and cabarets, gaming services, bowling centres.</p> <p>(10) Arranging and organizing conferences, seminars in the field of fashion and style.</p>