

O P I C



C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 065

Date of Decision: 2022-03-31

IN THE MATTER OF AN OPPOSITION

ZoomerMedia Limited

Opponent

And

Vibrant Holdings LLC

Applicant

1,693,385 for ZOOMER

Application

INTRODUCTION

[1] Vibrant Holdings LLC (the Applicant) has applied to register the trademark ZOOMER for use in association with diagnostic tests for the detection of disease and related software services on the basis of proposed use in Canada.

[2] ZoomerMedia Limited (the Opponent), has extensively used the ZOOMER mark (and other marks that contain the word ZOOMER) in Canada since 2008 in association with providing information, benefits and entertainment services to individuals over the age of 45, as well as advertising and promotional services to businesses that wish to target this demographic. Through its extensive use as well as extensive media, public relations and advertising campaigns, the Opponent's ZOOMER trademark has become very well known in Canada.

[3] The Opponent submits that Canadian consumers, upon seeing the Applicant's ZOOMER mark, would think that it is somehow related, associated or approved by the Opponent given the fame it has achieved with all of its ZOOMER trademarks.

[4] After considering all of the surrounding circumstances, I conclude that the Applicant has not met its legal onus of proving that there is no likelihood of confusion between the parties' trademarks for the reasons that follow.

FILE RECORD

[5] The Applicant filed the application for ZOOMER on September 11, 2014, and claims a priority filing date of March 12, 2014, in the United States.

[6] The Opponent opposed the application on September 6, 2017, pursuant to section 38 of the *Trademarks Act*, RSC 1985, C T-13 (the Act). This Act was amended on June 17, 2019. All references are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act before it was amended (see section 70 of the Act).

[7] The grounds of opposition may be summarized as follows: the Applicant's application does not conform to the requirements of sections 30(b), 30(d), or 30(i) of the Act, the Mark is not registrable pursuant to section 12(1)(d) of the Act since it is confusing with the Opponent's registrations for its ZOOMER trademarks, the Applicant is not the person entitled to registration of the Mark pursuant to sections 16(3)(a), 16(3)(b) and 16(3)(c) since the Mark is confusing with the Opponent's previously used ZOOMER Marks and ZoomerMedia trade name, and the Mark is not distinctive.

[8] The Opponent's evidence consists of the affidavit of David Vickers, Chief Financial Officer of the Opponent. Mr. Vickers was not cross-examined. The Applicant elected not to file any evidence.

[9] Only the Opponent filed a written argument and no hearing was conducted.

ONUS

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, S.A.* (2002), 20 CPR (4th) 155 (FCA)].

GROUND OF OPPOSITION

Non-Registrability – Section 12(1)(d)

[11] The Opponent pleads that the Mark is not registrable because it is confusing with the following trademarks owned by the Opponent: ZOOMERLIFE (TMA918,284); ZOOMER BOOKS (TMA934,036); ZOOMER WIRELESS (TMA919,952), ZOOMER (TMA930,332), ZOOMERSHOW (TMA930,330); ZOOMER (TMA893,557); ZOOMER (TMA942,023), ZOOMER (TMA922,188), ZOOMERTV (TMA878,586) and ZOOMER (TMA740,123), set out in the attached schedule A and referred to collectively as “the ZOOMER family of trademarks”.

[12] I consider that the Opponent’s best case is its registration No. TMA740,123 for the trademark ZOOMER and will concentrate my analysis on it. The particulars of this registration are set out in the attached schedule B.

[13] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trademarks* (1991), 37 CPR (3d) 413 (FCA)].

[14] I have exercised my discretion and have checked the Register to confirm that the Opponent’s registration is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with this registered trademark.

Test for confusion

[15] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class.

[16] 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 or trade names 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 or trade names in appearance or sound or in the ideas suggested by them. This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)].

[17] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trademarks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf. 60 C.P.R. (2d) 70 (FCTD)]. In *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC), the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[18] In this proceeding, it is self-evident with regard to section 6(5)(e), that the trademarks at issue are identical in sound, appearance and in ideas suggested. Accordingly, as reasoned in *Masterpiece, supra*, the remaining factors must be carefully considered since they take on added significance in these circumstances.

Section 6(5)(a) - inherent distinctiveness of the trademarks and the extent to which each trademark has become known

[19] Both parties' trademarks are inherently strong as the word ZOOMER is a coined word that is not suggestive of their respective goods and services.

[20] With respect to the extent known of the parties' marks, the Mark is based on proposed use and the Applicant has not evidenced use to date.

[21] In contrast, the Opponent's evidence of Mr. Vickers, its Chief Financial Officer, shows that its ZOOMER trademark has been used extensively in Canada:

- In February, 2008, the Opponent launched the ZOOMER concept and began using the ZOOMER trademark in association with information, benefits and entertainment services catered to men and women over the age of fifty (now 45) (para 9, Exhibits 1E-G and 1M).
- The Opponent's ZOOMER trademarks are seen by millions of customers on a daily basis, through extensive use as well as extensive media, public relations and advertising campaigns (para 16).
- The ZOOMER mark has expanded into radio, television, digital, advertising and expo services and also sells a number of goods that cater to the over 45 year old demographic (para 116).
- Revenue for various of the goods and services offered in association with the ZOOMER trademark and the ZOOMER family of marks in Canada has ranged between over \$9,000,000 for the fiscal year ending June 30, 2009 to over \$48,000,000 for the fiscal year ending August 31, 2017 (para 118).

[22] Although a breakdown of sales for each of the Opponent's trademarks was not provided, I am prepared to infer from the significant amount of total sales and extensive media, public relations and advertising campaigns that the Opponent's ZOOMER trademark has become very well known in Canada.

[23] Overall, this factor favours the Opponent.

Section 6(5)(b) - the length of time each trademark has been in use

[24] The application for the Mark is based upon proposed use and the Applicant has not adduced any evidence of use. In contrast, the Opponent's evidence is that the trademark ZOOMER has been used in Canada since 2008.

[25] In *Pink Panther Beauty Corp v United Artists Corp*, [1998] 3 FC 534 (FCA), the Federal Court of Appeal confirms that the length of time a trademark has been in use is a factor which must be given weight in assessing confusion:

The length of time that a mark has been used is obviously a factor which will contribute to confusion on behalf of the consumer in determining the origin of wares or services. A mark that has been in use a long time, versus one newly arrived on the scene, is presumed to have made a certain impression which must be given some weight.

Sections 6(5)(c) and (d) - the nature of the goods, services or business; the nature of the trade

[26] When considering the goods and services of the parties, it is the statement of goods and services in the parties' trademark application and registration that govern in respect of the issue of confusion arising under section 12(1)(d) [see *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna* (1984), 1994 CanLII 3534 (FCA), 58 CPR (3d) 381 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA)].

[27] The Applicant has applied to register the Mark in association with the following goods and services:

Goods

(1) Diagnostic apparatus and kits for the detection of disease, namely, allergies, autoimmune disorders, cancer, cardiac diseases, diabetes, genetic disorders, hematological diseases, hormone disorders, infectious diseases, liver diseases, renal diseases, and thyroid disorders; medical diagnostic apparatus and kits comprised of diagnostic apparatus for medical diagnostic use, namely for detecting allergies, autoimmune disorders, cancer, cardiac diseases, diabetes, genetic disorders, hematological diseases, hormone disorders, infectious diseases, liver diseases, renal diseases, and thyroid disorders; diagnostic kits consisting of plate-mounted bio-chips, microarrays, reagents, and protein arrays for diagnostics in the medical and healthcare fields.

Services

(1) Software as a service (SAAS) services featuring software for diagnostics in the medical and healthcare fields; software as a service (SAAS) services featuring software for use in detection and diagnosis of disease in humans; software as a service (SAAS) services featuring software for medical monitoring and analysis of medical data; software as a service (SAAS) services featuring software for controlling the operation of medical diagnostic devices; software as a service (SAAS) services featuring software for microarray and bio-chip based diagnostics.

[28] The Opponent's registration No. TMA740,123, as set out in the attached Schedule A, covers a number of goods and services including providing information to individuals over the age of 45 in the field of medical services, health, aging and fitness, among others. The evidence of the Opponent's use of its family of ZOOMER marks in association with these services, as set out in paragraphs 23-30 of the Vickers affidavit, includes the following:

- In recent years, the Health & Vitality Stage at the ZoomerShow expos hosted presentations on a number of medical and wellness topics.
- The Canadian Association of Retired Persons (CARP), has affinity partners that offer health and medical goods and services to consumers; the affinity partners provide a discount to CARP members and receive advertising services from both CARP and the Opponent.
- The Opponent provides print advertising services for a number of health and medical businesses, goods and services in its Zoomer magazine.

- The Opponent provides information services regarding medical issues in association with the ZOOMER trademark on ZOOMER radio stations and related websites; examples of such services are stories about Crohn's and Colitis and about tools for the diagnosis of Alzheimer's.
- As part of a campaign conducted in cooperation with Bayer and Shoppers Drug Mart, bottles of aspirin marked with the ZOOMER trademark were distributed at Shoppers Drug Mart outlets throughout Canada.

[29] I do not find that the parties' goods and services are the same. Having said that, they are related to the extent that the Opponent provides information in the field of medical services in association with its ZOOMER trademark.

[30] With respect to the parties' channels of trade, the Opponent's evidence shows that its goods and services are marketed to: individuals over the age of 45, potential advertisers who wish to market their goods and services to this demographic; and entities that provide services and benefits to these individuals who will potentially work in affiliation with the Opponent as a trademark licensee or as a strategic partner (Vickers, para 15).

[31] There is no evidence regarding the Applicant's channels of trade. Given the nature of the Applicant's goods and services, I am prepared to infer that these goods and services would be targeted to medical professionals and researchers. However, the applied for goods and services are not restricted to any particular channel of trade. Therefore, and in the absence of evidence to the contrary from the Applicant, I assume the parties' channels of trade could overlap.

Surrounding Circumstances – Opponent's Family of Trademarks

[32] The Opponent relies on its family of ZOOMER trademarks as a surrounding circumstance which increases the likelihood of confusion. The Opponent has evidenced at least some use of its other ZOOMER trademarks, namely, ZOOMERSHOW, ZOOMER REPORT, ZOOMERTV, ZOOMER RADIO, and ZOOMER LIFE, among others. The use of this family of trademarks does increase the likelihood of consumers assuming that the Applicant's ZOOMER goods and services are another one of the Opponent's ZOOMER goods or services or are related

to them [*McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD); *Air Miles International Trading BV v SeaMiles LLC* (2009), 76 CPR (4th) 369 (TMOB) at para 46].

Further, there is no evidence that the family's common feature ZOOMER is registered or used by others [*Thomas J Lipton Inc v Fletcher's Fine Foods Ltd* (1992), 44 CPR (3d) 279 (TMOB) at 286-7]. Therefore, as an additional surrounding circumstance, I have considered the Opponent's family of marks.

Conclusion

[33] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, and in particular, the extensive use shown by the Opponent of its ZOOMER trademarks, the fact that the Mark is identical to the Opponent's inherently distinctive trademark, the parties' goods and services are somewhat related and there is a potential for overlap in the parties' channels of trade, and in the absence of any evidence or argument from the Applicant, I conclude that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the Opponent's trademark.

[34] The section 12(1)(d) ground is therefore successful.

Non-distinctiveness – Section 2

[35] The Opponent also pleads that the Mark is not distinctive and is not capable of distinguishing the Applicant's goods and services from the goods and services of the Opponent.

[36] The material date for assessing distinctiveness is the date of filing of the opposition, which is September 6, 2017 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (FCTD)].

[37] 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 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185; *Motel 6, Inc v No 6 Motel Ltd*, 1981 CanLII 2834

(FCTD); *Bojangles' International LLC v Bojangles Café Ltd* 2006 FC 657]. Given the evidence summarized above at paragraph 21, the Opponent has met its burden under this ground.

[38] As the differences in material dates between this ground and the section 12(1)(d) ground do not have had a significant impact on the determination of the issue of confusion between the trademarks of the parties, this ground of opposition succeeds.

Remaining grounds of opposition

[39] As the Opponent has already succeeded under two grounds of opposition, there is no need to address the remaining grounds of opposition.

DISPOSITION

[40] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No hearing held

AGENTS OF RECORD

Chitiz Pathak LLP

For the Opponent

Bereskin & Parr, LLP

For the Applicant

Schedule A – The Opponent’s Registered Trademarks

Trademark	Registration No.
ZOOMER	TMA740,123
ZOOMERTV	TMA878,586
ZOOMERLIFE	TMA918,284
ZOOMER WIRELESS	TMA919,952
ZOOMER	TMA930,332
ZOOMERSHOW	TMA930,330
ZOOMER	TMA893,557
ZOOMER	TMA942,023
ZOOMER	TMA922,188

Schedule B

Opponent's Registration No. TMA740,123 - ZOOMER

Goods

(1) Publications in printed form, namely, printed publications directed at mature individuals in the form of magazines, books, newsletters, brochures and pamphlets; publications in electronic form, namely, electronic publications directed at mature individuals in the form of magazines, books, newsletters, brochures and pamphlets; promotional items and novelty wares, namely, pens, pencils, pen holders, desk sets, letter openers, rulers, mouse pads, note pads, memo cubes, note stickers, name tags, bookmarks, calendars, refrigerator magnets, memo boards, key chains, key fobs, key tags, money clips, luggage tags, mirrors, buttons, pins, tie clips, cuff links, jewelry boxes, wooden boxes, candle holders, scarves, lighters, clocks, calculators, ice scrapers, flashlights, pocket knives, oven mitts, mugs, beer steins, bottle openers, drink holders, bottles and flasks for wine, water, liquor or other beverages, coolers, lunch boxes, patio umbrellas, balloons, stickers, banners, flags, decals, posters, plaques, trophies, plastic bags, cloth bags, tote bags, beach towels, beach mats, binoculars, beach balls, flyer discs, board games, jigsaw puzzles, bath toys, playing cards, shirts, t-shirts, polo shirts, tank tops, sweaters, sweat shirts, jackets, coats, headgear, namely, caps, hats, visors, toques.

Services

(1) Entertainment services, namely, production and distribution of programming, namely, television, radio, internet and wireless portable device programming, directed at mature individuals; information services, namely, providing information to mature individuals in the field of employment, business and consumer issues, insurance, real estate, finance, economics, travel and tourism, education, retirement, lifestyles, relationships, politics, social issues, sports, music, art, medical services, health, aging and fitness; internet services, namely, providing online chat rooms, bulletin boards and community forums for the transmission of messages among computer users on topics of interest to mature individuals.