



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

**Citation: 2010 TMOB 129**  
**Date of Decision: 2010-08-26**

**IN THE MATTER OF AN OPPOSITION  
by Advance Magazine Publishers Inc. to  
application No. 1,214,458 for the trade-  
mark EN VOGUE Design in the name of  
en Vogue Sculptured Nail Systems Inc.**

[1] On April 23, 2004, en Vogue Sculptured Nail Systems Inc. (the Applicant) filed an application to register the trade-mark EN VOGUE Design (the Mark), shown below, in association with wares on the basis of use in Canada since at least as early as 2000.



[2] The application was advertised in the *Trade-marks Journal* of August 31, 2005.

[3] On May 1, 2006, Advance Magazine Publishers Inc. (the Opponent) filed a statement of opposition. Generally speaking, the grounds of opposition are that: (i) the Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act); (ii) the Applicant is not the person entitled to the registration of the Mark pursuant to s. 16(1)(a) and 16(1)(b) of the Act; (iii) the Mark is not distinctive and is not capable of being distinctive of the wares of the Applicant; and (iv) the application does not conform to the requirements of s. 30 of the Act. In support of the registrability and non-entitlement grounds of opposition, in the statement of opposition the Opponent alleges ownership of seventeen registrations and four applications for trade-marks consisting of or comprising the word VOGUE as well as the previous use of these

trade-marks. The Opponent alleges that its trade-marks are “very well known and famous in Canada in association with the wares and services for which they are registered and applied for and on related wares and services”.

[4] On September 18, 2006, the Applicant filed a counter statement essentially denying each allegation contained in the statement of opposition.

[5] Pursuant to r. 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations), the Opponent filed the affidavit of Elenita Anastacio, dated October 17, 2006, together with Exhibits “A” through “C”, Ms. Anastacio, a trade-mark searcher employed by the firm representing the Opponent, was not cross-examined by the Applicant.

[6] Pursuant to r. 42 of the Regulations, the Applicant filed the affidavit of Arlene Janis Trapp, dated June 14, 2007, together with Exhibits “A” through “W”, and the affidavit of Karen E. Thompson, dated June 18, 2007, together with Exhibits “A” through “D”. Ms. Trapp has been the President of the Applicant since its incorporation on December 12, 1996. Ms. Thompson, a trade-mark searcher for over 30 years, has been employed by the firm representing the Applicant for about 22 years. Both affiants were cross-examined by the Opponent. The transcripts of the cross-examinations were filed by the Opponent on February 19, 2008. The answers to undertakings given during the Trapp and Thomson cross-examinations were filed by the Applicant on April 19, 2008.

[7] Only the Applicant filed a written argument. Both parties were represented at an oral hearing.

[8] As the application was amended during the course of the opposition proceeding (amended application filed on March 4, 2008 - accepted by the Registrar on April 1, 2008), the statement of wares of the application of record reads as follows:

Chemicals used in industry and photography, in particular light hardening gel; adhesives used in industry; adhesives used for a (*sic*) applying artificial finger nails; nail care products, namely, false nails, artificial fingernails and glue in kit form, emery boards, all for nail grooming; nail care preparations, namely, brush-on gels and resins for nail, curable nail gels; nail coating removers, artificial nails, nail adhesives; nail brush cleaners, nail forms; dust brushes; apparatus for lighting, namely, UV lamps (not for medical purposes).

### Preliminary Remark

[9] Rule 44(4) of the Regulations provides that “any documents or materials undertaken to be submitted by the party whose affiant or declarant is being cross-examined shall be filed with the Registrar by the party conducting the cross-examination, within the time fixed by the Registrar”. Thus, at the oral hearing, I noted to the parties that the answers to undertakings given during the Trapp and Thompson cross-examinations should have been filed by the Opponent, not the Applicant. The Opponent indicated that it had no objection to the Applicant filing the answers with the Registrar. Given the particular facts of this case, and as I indicated at the oral hearing, I accept the answers to undertakings as being of record in the present proceeding.

### 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. 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

### Material Dates

[11] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/s. 30 – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- s. 38(2)(b)/s. 12(1)(d) – the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/s. 16(1)(a) and s. 16(1)(b) – the date of first use claimed in the application [see s. 16(1)];

- s. 38(2)(d)/non-distinctiveness – the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Analysis of the Grounds of Opposition

[12] I will analyze the grounds of opposition in regard to the evidence of record, although not necessarily in the order they were raised in the statement of opposition. I will refer to the Trapp and Thomson cross-examinations only insofar as they are pertinent to my analysis of the evidence and the parties’ arguments.

Registrability pursuant to s. 12(1)(d) of the Act

[13] I first note that six trade-mark registrations alleged in the statement of opposition have been listed twice in the pleading. Second, given the Applicant’s written argument, it is apparent that the Applicant has accepted the reference to registration No. UCA19676 in the statement of opposition as a reference to registration No. TMDA19676. Third, contrary to the Applicant’s written argument, the Opponent did not allege ownership of registration No. TMA641,823 for the trade-mark TEEN VOGUE in the statement of opposition; the Opponent has only alleged its ownership of the corresponding application No. 1,199,858 and the Opponent did not seek leave to amend the pleading to rely upon the registration.

[14] Having regard to the foregoing, the registrability ground of opposition is based upon confusion with the following trade-mark registrations (the VOGUE Registrations):

<u>Registration No.</u>	<u>Trade-mark</u>
UCA4268	VOGUE
TMDA42009	VOGUE
TMDA19676	<b>VOGUE</b>
TMA346,637	VOGUE CAREER
TMA388,687	VOGUE DECORATION

TMA468,713



TMA398,729

VOGUE HOMBRE

TMA576,133

VOGUE

TMA561,966



TMA576,327

VOGUE HOMBRE

TMA595,505

VOGUE HOMMES INTERNATIONAL MODE

[15] The full particulars of the VOGUE Registrations, downloaded from the *CD Name Search* Canadian trade-marks database, are appended as Exhibit “A” to the Anastacio affidavit. I have exercised the Registrar’s discretion to confirm that the VOGUE Registrations are in good standing as of today’s date. I confirm that the VOGUE Registrations are extant, except for registration No. TMA398,729 for the trade-mark VOGUE HOMBRE, which was expunged on January 10, 2008. I therefore dismiss the registrability ground of opposition to the extent that it is based upon registration No. TMA398,729. Since the Opponent has discharged its initial evidential burden with respect to the remaining VOGUE Registrations, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the trade-marks at issue.

[16] 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.

[17] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in 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. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) [*Mattel*]].

[18] In my view, the Opponent's case is strongest when considering the word and design marks VOGUE of registration Nos. UCA4268, TMDA42009, TMDA19676, TMA561,966 and TMA576,133 for the following wares and services:

<u>Registration No.</u>	<u>Wares or Services</u>
UCA4268	<u>Wares</u> : Magazines and similar publications.
TMDA42009	<u>Wares</u> : Patterns.
TMDA19676	<u>Wares</u> : A trade journal.
TMA561,966	<u>Wares</u> : Printed publications, namely magazines, books and periodicals. <u>Services</u> : Internet services, namely providing fashion and style information via the internet.
TMA576,133	<u>Services</u> : 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.

[19] The determination of the issue of confusion between the Mark and these five registered trade-marks will effectively decide the registrability ground of opposition based upon the remaining VOGUE Registrations. Unless indicated otherwise, any reference to the VOGUE Marks throughout my assessment of the surrounding circumstances is a collective reference to the aforementioned word and design marks VOGUE.

[20] Prior to assessing the surrounding circumstances of this case, I shall deal from the outset with the Opponent's submissions in oral argument as to the notoriety of its VOGUE Marks. More particularly, the Opponent submits that since the fame of its VOGUE Marks has been recognized by case law, I must come to the conclusion that they are well known and famous in Canada. I disagree with the Opponent. The decisions from this Board and the Federal Court

referred to by the Opponent in oral argument are distinguishable; in all instances there was evidence of use of the Opponent's trade-marks whereas there is no such evidence in the present case. In fact, the Opponent has chosen not to file any evidence with respect to the use or promotion of its VOGUE Marks. The Opponent cannot rely on evidence that is not of record in the present proceeding to claim that its VOGUE Marks are famous. The most that I can presume from the mere existence of the Opponent's registrations is that there has been *de minimis* use of the VOGUE Marks in Canada [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[21] I would like to add that even if the Opponent was right in arguing that it may rely on existing case law as supporting the fame of its VOGUE Marks, it would still be necessary to assess all the surrounding circumstances of this case. As stated in *Mattel*, at paragraph 72: "[...] a difference in wares or services does not deliver the knockout blow, but nor does the fame of the trade-mark. Each situation must be judged in its full factual context."

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

[22] The word "vogue" is a common word in both the English and French languages. While Ms. Thompson provides definitions of the word "vogue", which she selected from English dictionaries listed at *www.onelook.com* [Exhibit "D"], I have referred myself to the *Oxford Canadian Dictionary*. The latter defines the word "vogue" as "(prec. by *the*) the prevailing fashion" or "popular use or currency". The same meaning is attached to the word "vogue" in French (*Le Petit Robert* dictionary). I would also note that the Mark is a French expression meaning "à la mode" (translation: fashionable).

[23] Notwithstanding the meaning of the expression "en vogue", the Mark is not descriptive of the Applicant's wares and thus it possesses some measure of inherent distinctiveness. The design feature of the Mark does not increase its inherent distinctiveness since the fanciful script and the font employed are intrinsic to the words forming the Mark [see *Canadian Jewish Review Ltd. v. The Registrar of Trade Marks* (1961), 37 C.P.R. 89 (Ex. C.)].

[24] Likewise, the word "vogue" is not descriptive of the Opponent's registered wares or services. In its written argument, the Applicant submits that the VOGUE Marks "generally

exhibit a very low degree of inherent distinctiveness as the trade-marks suggest that the contents of the printed and online publications deal with fashion, style or beauty”. The Applicant further submits that the “lack of inherent distinctiveness associated with the Opponent’s use of the word VOGUE in association with fashion related wares was noted in several decisions”, including *Advance Magazine Publishers Inc. v. 412233 Ontario Inc.* (2002), 24 C.P.R. (4th) 96 (T.M.O.B.) and *Advance Magazine Publishers Inc. v. Reitmans (Canada) Inc.* (1997) 79 C.P.R. (3d) 341 (T.M.O.B.). I would remark that in these two cases, the Registrar was apparently provided with evidence as to the content of the publications associated with the Opponent’s trade-marks. I do not have such evidence in this case and each case must be decided on its own facts. That being said, the statement of services of registration No. TMA561,966 does refer to “providing fashion and style information via the internet”.

[25] Once again, as the fanciful script and the font employed are intrinsic to the word, I find that the design feature of the mark of registration No. TMDA19676 does not increase its inherent distinctiveness. I am also of the view that the design feature of the mark of registration No. TMA561,966 is not so significant as to increase its inherent distinctiveness.

[26] In the end, I assess the inherent distinctiveness of the Mark and the VOGUE Marks as about the same, although the inherent distinctiveness of the Opponent’s trade-marks of registration No. TMA561,966 for “Internet services, namely providing fashion and style information via the internet” and No. TMDA42009 for “patterns” is arguably less than the Mark.

[27] Since the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, I shall now turn to the extent to which the trade-marks have become known. I wish to remark that unless indicated otherwise, I will not discuss the evidence introduced by the Applicant with respect to other countries, as I find it is of little assistance in considering the extent to which the Mark has become known in Canada.

[28] Ms. Trapp describes the Applicant as a manufacturer and distributor of polymer resin nail enhancements and related products [paragraph 2]. At paragraph 3 of her affidavit, Ms. Trapp deposes that the first product was launched in 1997 in the Vancouver area through a distributor, Cosmetique International Beauty Supply & School (Cosmetique), which was ultimately acquired by the Applicant around 2002. The Applicant “continued to distribute products bearing the Mark



through Cosmetique, while adding new Canadian distributors to its network”. Ms. Trapp goes on to state that “[s]imultaneously, [the Applicant] also commenced selling its products to distributors in other provinces”. According to the Trapp cross-examination, Cosmetique was not the only distributor of the Applicant’s nail enhancement and related products before 2002; there were distributors in Winnipeg and Montreal and the products were also sold directly by the Applicant outside of Vancouver [Q122-Q133]. A listing of distributors “located across Canada” is appended as Exhibit “H” to the Trapp affidavit. I note that distributors are listed for each year between 2001 and 2007. Redacted samples of agreements between the Applicant and distributors were provided in response to undertakings given during the Trapp cross-examination [Q158, Q166]. The Applicant rightly argues that its evidence establishes that the agreement between the Applicant and its distributors is clearly one of distribution. Since any trade-mark use by a distributor is that of the owner of the mark, the provisions of s. 50(1) of the Act are not relevant in the present case.

[29] A listing of “esthetic and training centers which have carried or who carry products bearing” the Mark is appended as Exhibit “I” to the Trapp affidavit. I note that “training centers/schools” are listed for each year between 2001 and 2007.

[30] Images of product containers and packaging [Exhibits “F-1” through “F-4”] and containers [Exhibit “G”] displaying the Mark are filed as specimens of use of the Mark in association with nail enhancement and related products. Ms. Trapp specifically states that the specimens filed as Exhibit “G” are representative of the use of the Mark by the Applicant since 2000.

[31] According to the yearly breakdown provided in the Trapp affidavit [paragraph 12], the Applicant’s approximate sales figures for products bearing the Mark in Canada totaled \$4,830,000 from 2000 to the date of the affidavit. Samplings of representative invoices issued by the Applicant from 1998 to 2007 for the sale of wares associated with the Mark were provided through the Trapp affidavit [Exhibit “J”] and cross-examination [Q111, reply to undertaking].

[32] At paragraph 14 of her affidavit, Ms. Trapp states that the Applicant “has extensively advertised, and continues to advertise its nail enhancement and related products by itself, through its distributors, and through the various training centers that carry products” bearing the Mark

and “offer services relating to nail enhancement by licensed technicians”. She goes on to state that since 2000, the Applicant “has spent at least \$300,000 in advertising (print publications, web banner placement on websites like [www.beautytech.com](http://www.beautytech.com)) and the promotion (including trade show representation) of nail enhancement and related products in Canada”.

[33] At paragraph 15 of her affidavit, Ms. Trapp deposes that the Applicant distributes “to all of its Canadian distributors a catalogue from which distributors may order products for resale in their distribution centers”. Ms. Trapp files as Exhibit “K” a “printed version of the [Applicant’s] catalogue featuring various nail enhancement and related products” bearing the Mark. Ms. Trapp also states that Exhibit “K” is representative of the “catalogues” distributed by the Applicant to its distributors and dealers since 2000. For all purposes, I note that during the cross-examination of Ms. Trapp, the Opponent’s counsel correctly remarked that Exhibit “K” is not a catalogue. It is a folder containing inserts or brochures, as the case may be [Q212-Q215, Q239-Q234].

[34] According to the Trapp affidavit and cross-examination, since 2000 the Applicant has participated in trade shows to promote the wares associated with the Mark. Ms. Trapp provides a listing of trade shows in which the Applicant participated as an exhibitor between 2002 and 2007 [paragraph 19]. I note that although not all the listed trade shows were held in Canada, some clearly were. In reply to an undertaking, the Applicant indicates that it could not find “all files for trade shows between 2000 and 2002”, but it provides excerpts from the booklet for the trade show Esthétique Spa International held in Vancouver in 2002 [Q233]. In cross-examination, Ms. Trapp testifies that the Applicant has attended a number of trade shows that have occurred on an annual basis since 1997, although these were not specifically listed in her affidavit [Q225-Q227].

[35] According to the Trapp affidavit and cross-examination, the Applicant operates a website located at [www.envoguenails.com](http://www.envoguenails.com) for its Canadian customers. This is the successor website to the Applicant’s initial website located at [www.envogue.com](http://www.envogue.com) [paragraph 17, Q4]. Ms. Trapp files pages from the website [Exhibit “M”], including pages from versions of the website for the years 2000-2006 [Exhibits “M-1” through “M-7”]. Pages from the website dating from September 29, 2000 were provided in response to an undertaking [Q224]. I note that the pages from the website show images of products, containers and packaging products displaying the Mark. Even if I

accept the Trapp affidavit and cross-examination as evidence that the Applicant has operated its website since 2000, the operation of the Applicant's website is of little assistance, if any, in considering the extent to which the Mark has become known. Indeed, there is no evidence establishing that Canadians have accessed the Applicant's website [see *Candrug Health Solutions Inc. v. Thorkelson* (2008), 64 C.P.R. (4th) (F.C.A.)]. For all intents and purposes, I remark that there is also no evidence that Canadians have accessed the Applicant's European website at *www.envogueeurope.com* [paragraph 17, Exhibit "N"].

[36] Ms. Trapp deposes that nail enhancement products bearing the Mark "have been featured in a number of articles and ads in magazines" and files "copies of a sampling of advertisements and articles" [paragraph 18, Exhibit O]. In its written argument, the Applicant contends that a number of ads "were placed in industry specific magazines/publications such as *Nailpro*, *Esthemag Pro*, *ExceptionNail*, *Nails Career Handbook*, *Nails Magazine* – all having circulation in Canada". (I understand the reference to Exhibit "N" in the written argument as a reference to Exhibit "O".) Suffice it to say that there is no evidence directed to Canadian circulation of these magazines or publications. Further, magazine articles do not constitute advertisement of the Mark [see *Williams Companies Inc. et al. v. William Tel Ltd.* (2000), 4 C.P.R. (4th) 253 (T.M.O.B.)].

[37] Ultimately, when I consider the Trapp affidavit and cross-examination in their entirety, I am satisfied that the Mark has become known to some extent in Canada. By contrast, there is no evidence in the present proceeding allowing me to determine the extent to which each of the VOGUE Marks has become known in Canada.

[38] Having regard to the foregoing, the overall consideration of s. 6(5)(a) favours the Applicant.

*The length of time each trade-mark has been in use*

[39] The Applicant did not state in its application a precise date of first use during the calendar year of 2000. Under this circumstance, the Registrar considers the alleged date of first use to be December 31, 2000 [see *Khan v. Turban Brand Products* (1984), 1 C.P.R. (3d) 388 (T.M.O.B.)].

[40] The VOGUE Marks were registered on the basis of use in Canada, as detailed hereafter:

- UCA4268: Used since December 17, 1892.
- TMDA42009: Used since 1908.
- TMDA19676: Used since 1908.
- TMA561,966: Used since at least as early as November 1, 1943 (for wares) and Declaration of Use filed on May 3, 2002 (for services).
- TMA576,133: Used in Canada since at least as early as July 1997.

[41] If one accepts that the VOGUE Marks have been used in Canada since the dates stated in the registrations, this factor would favour the Opponent. However, as there is no evidence directed to the extent of use of the VOGUE Marks, which as a result is assumed to be only *de minimis*, the length of time the trade-marks have been in use is not a significant factor in this case.

*The nature of the wares, services or business and the nature of the trade*

[42] When considering the nature of the wares and the nature of the trade of the parties, it is the statement of wares in the application and the statement of wares or services in the registrations that govern the assessment of the likelihood of confusion under s. 12(1)(d) of the Act [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[43] In oral argument, the Opponent submitted that both parties operate in the field of fashion. This contention is disputed by the Applicant. The latter submits that it carries on business in the cosmetic and beauty industry, which is not the business of the Opponent. In the absence of evidence from the Opponent as to the nature of its business, I find that a consideration of the statement of wares in the application and the statement of wares or services in the registrations for the VOGUE Marks lends support to the Applicant's position.

[44] The wares identified in the application for the Mark differ from the wares identified in registration Nos. UCA4268, TMDA42009, TMDA19676 and TMA561,966 as well as from the services identified in registration Nos. TMDA561,966 and TMA576,133. Further, there is no

evidence to conclude to an overlap between the Applicant's wares and the Opponent's registered wares or services.

[45] Ms. Trapp deposes that the wares associated with the Mark are not sold directly to consumers; they are only sold, either by the Applicant or through distributors, to "licensed nail technicians", esthetics schools and training centers for nail technicians. Ms. Trapp confirms in cross-examination that an individual who goes to a nail salon cannot buy the wares associated with the Mark [Q154]; "all the products are sold only to the professionals and the professionals use them on the consumer" [Q155]. Ms. Trapp further deposes that any nail salon, esthetic salon or spa can order the wares associated with the Mark to the extent that they offer services by "licensed nail technicians" [paragraphs 3, 12]. In cross-examination, Ms. Trapp clarified her reference to "licensed nail technicians". More particularly, she indicated that nail technicians are professionals but not all requiring licensing, as licensing is governed by the province [Q4, Q149]. Relying on the Applicant's price list in effect as of January 1, 2007 [Exhibit "L" to the Trapp affidavit], the Applicant notes that the price of its wares vary between \$4.00 and \$385.00. In reply to an undertaking, the Applicant filed a price list dated February 23, 2000 on which items associated with the Mark have been highlighted.

[46] The Opponent has failed to introduce any evidence allowing me to conclude to similarities or overlap between the parties' channels of trade.

[47] Based on the evidence furnished by the Applicant and the lack of evidence by the Opponent, I agree with the Applicant that the factors listed at s. 6(5)(c) and (d) significantly favour the Applicant.

*The degree of resemblance between the marks in appearance or sound or in the ideas suggested by them*

[48] The Applicant submits that there are differences between the Mark and the VOGUE Marks, when considered in their totality. It submits that the first element of its Mark is "EN" and that the font employed for the Mark is not featured in the VOGUE Marks.

[49] Neither the first component of the Mark (a preposition in the French language), nor the font employed for the Mark is a distinctive feature of the Mark. Clearly, the Mark incorporates each of the Opponent's VOGUE word marks (registration Nos. UCA4268, TMDA42009 and TMA576,133).

[50] In the end, I find that there is a significant degree of similarity between the Mark and each of the VOGUE Marks in appearance, sound and idea suggested. Thus, s. 6(5)(e) of the Act favours the Opponent.

*Other surrounding circumstances*

*No instances of confusion*

[51] Ms. Trapp concludes her affidavit by stating at paragraph 20: "I am not aware of any instances of confusion between my company's [Mark] and my company's business as it relates to products bearing [the Mark] and the trade-marks and associated business of the Opponent." In cross-examination, Ms. Trapp was asked whether there is any system in place whereby the distributors and beauty schools can advise her of an instance of confusion or where somebody confused the Opponent's trade-marks with the Mark. While Ms. Trapp testifies that all complaints come to her, she also testifies that there is no formal complaint mechanism in place other than having any complaints directed to her [Q186-Q194].

[52] It has often been said that an opponent needs not to prove instances of confusion. The burden is on an applicant to demonstrate the absence of likelihood of confusion. In other words, neither Ms. Trapp's testimony, nor the absence of evidence of confusion relieves the Applicant from its burden of proof.

[53] In *Mattel*, the Supreme Court of Canada recited the remarks made by Décary J. in *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 in reference to the implication of "actual confusion" [paragraph 89]:

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” (My underlining).

[54] In view of the Applicant’s evidence and the presumption of *de minimis* use of the VOGUE Marks in Canada, it appears that the trade-marks have coexisted in the marketplace for a good number of years. However, as there is no evidence as to how extensive the use of the VOGUE Marks is, the lack of actual instances of confusion between the Mark and the VOGUE Mark is not a significant factor.

*State of the register evidence and common law search*

[55] Ms. Thompson introduces into evidence the results of a search of the Name Reporter Database that she conducted on June 14, 2007. She states that the Name Reporter Database “is compiled using information supplied by the Canadian Intellectual Property Office” and “contains a record of all active and inactive indexed trade-marks, both registered and pending” [paragraph 3]. Her search, which was conducted “with the objective of locating active trade-marks consisting of or including the element \*VOGUE\* for goods and services in all international classes” [paragraph 4] resulted in a finding of 41 marks [paragraph 5, Exhibit “A”]. She files the register pages of the marks [Exhibit “B”].

[56] State of the register evidence is usually introduced to show the commonality of a trade-mark or a portion of a trade-mark in relation to the register as a whole. Since it is only relevant insofar as one can make inferences from it about the state of the marketplace, it should be comprised of trade-marks which include both the applied for mark or portion of the applied for mark and that are used with wares or services similar to those at issue [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[57] Ms. Thompson also introduces into evidence a copy of a common law search for “vogue”, which also includes a domain name search [Exhibit “C”]. She explains that she

requested the search from Onscope, a division of Marque d'Or, on or about June 13, 2007. Information on the databases consulted by Onscope for the common law search is provided through the Thompson affidavit [paragraph 7] and cross-examination [Q50-Q67].

[58] I do not consider it necessary to assess either the admissibility or the weight of the evidence introduced by the Thompson affidavit to find in favour of the Applicant.

*Conclusion on the likelihood of confusion*

[59] 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, I am satisfied that the Applicant has met its burden to show that there is no reasonable likelihood of confusion between the Mark and each of the VOGUE Marks. Notwithstanding the degree of similarities between the Mark and the VOGUE Marks, in my view the extent to which the Mark has become known, the nature of the wares or services and the nature of the trade, are all circumstances that tip the balance of probabilities in favour of the Applicant.

[60] As previously mentioned, the determination of the issue of confusion between the Mark and the word and design marks VOGUE of registration Nos. UCA4268, TMDA42009, TMDA19676, TMA561,966 and TMA576,133 effectively decides the registrability ground of opposition.

[61] Having regard to the foregoing, the ground of opposition based upon s. 12(1)(d) of the Act is dismissed.

Non-conformity to s. 30(b) of the Act

[62] To the extent that the relevant facts are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to the ground of opposition based upon s. 30(b) of the Act is lower [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)]. Also, the Opponent may rely upon the Applicant's evidence to meet its initial onus, but the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. In addition, s. 30(b) of the Act requires that there be



continuous use of the trade-mark applied for in the normal course of trade since the date claimed [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 C.P.R. (3d) 258 (F.C.T.D.)].

[63] In the statement of opposition, the Opponent pleads that the Applicant “has not used the [Mark] in Canada, nor has it used it since the date of first use alleged”, contrary to s. 30(b) of the Act.

[64] At the outset, I recognize that the Applicant’s evidence shows that the Mark was first used in 1997. However, I do not consider that the issue of the first use of the Mark being earlier than the date claimed was pleaded as part of the ground of opposition. For all intents and purposes, I note that the case law recognizes that an applicant can claim a date of first use after the effective date of first use in the interests of greater certainty [see *Marineland v. Marine Wonderland and Animal Park* (1974), 16 C.P.R. (2d) 97 (F.C.T.D.)].

[65] Ms. Anastacio introduces into evidence the result of searches that she conducted in October 2006. More particularly:

- she found and downloaded the Applicant’s website through an Internet search for the Mark. She then conducted a search of *www.envoguenails.com* in the Internet Archive Wayback Machine [paragraph 4]. Appended as Exhibit “B” are the result summary of the search and “a copy of the oldest reference webpage for the website dated January 26, 2001”;
- she files the results of her search of EN VOGUE SCULPTURED NAIL SYSTEMS INC conducted in the FPInformat database [Exhibit “C”]. At paragraph 6 of her affidavit, Ms. Anastacio states: “FPInformat.ca is Canada’s largest provider of media monitoring and corporate information, including more than 275 news sources from coast to coast, plus the authoritative company data for which the Financial Post DataGroup is renowned.” ;
- she concludes her affidavit by stating [paragraph 8]: “As a result of my internet searching on the various websites above, I could not locate any reference to the

trade-mark logo which is the subject of application No. 1,214,458 prior to January 26, 2001.”

[66] It is not necessary for me to consider the Applicant’s submissions as to the unreliability of the WayBack Machine to find that Exhibit “B” to the Anastacio affidavit is not sufficient for the Opponent to discharge its initial onus. First, the affiant’s testimony is clearly discredited by the Applicant’s evidence as to the operation of the Applicant’s website. Second, the display of a trade-mark on a website does not necessarily amount to use in association with wares pursuant to s. 4(1) of the Act. Thus, even if one accepts the Anastacio affidavit as evidence establishing that the Mark was not displayed on the Applicant’s website at the claimed date of first use, such evidence would not be sufficient in the circumstances for the Opponent to discharge its evidentiary burden under the s. 30(b) ground of opposition.

[67] As for the results of the search of the FPInformat database, I find these to be of no assistance to the Opponent’s case. For one thing, Ms. Anastacio states that her search was for the Applicant. In other words, her search was not conducted for the Mark. I wish to add that since Ms. Anastacio identifies FPInformat as a database for “media monitoring and corporate information” it is not apparent to me how data on the use of trade-marks in association with wares would be provided in such a database. Thus, I would not have afforded any significance to the results of the search even if it had been conducted for the Mark.

[68] Having regard to the foregoing, I am not satisfied that the Opponent may rely on the Anastacio affidavit to discharge its initial evidentiary burden under the s. 30(b) ground of opposition.

[69] It is worth recalling that in view of the initial evidential burden on an opponent, the fact that an applicant does not file evidence showing use of a trade-mark in Canada since the date claimed in the application does not automatically lead to a successful s. 30(b) ground of opposition. In any event, one cannot reasonably argue that the Applicant has failed to evidence any use of the Mark in Canada within the meaning of s. 4(1) of the Act at the material date.

[70] I shall consider whether the evidence furnished by the Applicant is sufficient for the Opponent to discharge its evidentiary burden. I would first remark that an important part of the

cross-examination of Ms. Trapp, which was conducted on January 16, 2008, is devoted to the first use of the Mark in association with the wares identified in the application of record at the time [Q21-Q111]. Obviously, any part of the Trapp cross-examination relating to wares no longer in the application is a moot point.

[71] At the oral hearing, most of the submissions of the agent for the Opponent were devoted to identifying various invoices and exhibits to the Trapp affidavit as supporting the contention that the Applicant's evidence either does not establish use of the Mark in association with the wares listed in the application since the claimed date of first use, or is unclear as to the wares for which there has been use of the Mark. In reply, the agent for the Applicant made submissions directed to showing that its evidence supports the Applicant's position that the Opponent cannot rely on the Applicant's evidence to meet its initial evidentiary burden.

[72] In the end, having considered both parties' submissions, I agree with the Applicant that its evidence is not clearly inconsistent with its claim of use of the Mark since 2000 in association with the wares listed in the application of record.

[73] In view of the above, I find that the Opponent has failed to meet its evidentiary burden with respect to the ground of opposition based on non-conformity to s. 30(b) of the Act and I dismiss the ground of opposition.

#### Non-conformity to s. 30(i)

[74] The pleading of the ground of opposition reads as follows:

At the date of the application a search of the Trade-mark Register would have located the marks of the Opponent relied on herein and, 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 alleged adoption and use and its date of application.

[75] The Opponent did not make any submissions at the oral hearing on this ground of opposition.

[76] The Applicant rightly submits that the Opponent did not file any evidence from which it can be concluded that the Applicant was aware of any of the VOGUE Marks at the material date (April 23, 2004). I wish to add that the mere fact that an applicant was aware of an opponent's trade-mark does not necessarily preclude it from truthfully making the statement required by s. 30(i) of the Act. Once an applicant has provided the statement required by s. 30(i) of the Act, in my opinion the ground of opposition should succeed only if there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. Even if one argues that the Trapp affidavit and cross-examination suggest that the Applicant might have known about the Opponent or some of the VOGUE Marks at the material date, there is no evidence that this is a case of bad faith on the part of the Applicant.

[77] Having regard to the foregoing, I dismiss the ground of opposition based on non-conformity to s. 30(i) of the Act.

Non-entitlement pursuant to s. 16(1)(b) of the Act

[78] The following trade-mark applications have been alleged in the statement of opposition (the VOGUE Applications):

<u>Application No.</u>	<u>Trade-mark</u>
1,199,858	TEEN VOGUE
856,582	VOGUE
1,180,261	VOGUE
1,198,832	VOGUE CAFÉ

[79] Despite the onus resting on the Applicant, the Opponent has the initial onus of proving that its VOGUE Applications were filed prior to the material date, which I consider to be December 31, 2000, and had not been abandoned at the date of advertisement, namely August 31, 2005 [s. 16(4) of the Act].

[80] The particulars of three of the VOGUE Applications, downloaded from the *CD Name Search* Canadian trade-marks database, were provided as part of Exhibit "A" to the Anastacio affidavit.

[81] In the absence of Certificates of Authenticity, I have exercised my discretion to check the Registrar's records for the VOGUE Applications [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.); *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B)]. While Application No. 856,582 was filed prior to the material date, the remaining VOGUE Applications were filed after the material date. Thus, to the extent that it is based upon Application Nos. 1,119,858 (TEEN VOGUE), 1,180,261 (VOGUE) and 1,198,832I (VOGUE CAFÉ), I dismiss the non-entitlement ground of opposition for having been improperly pleaded.

[82] Since the Opponent has discharged its initial evidential burden with respect to application No. 856,582, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that as of the material date there was no reasonable likelihood of confusion between the Mark and the trade-mark VOGUE applied for registration based on proposed use in association with "CD-Roms relating to periodicals and magazines, prerecorded compact discs, prerecorded audio and video cassettes, electronic publications, namely magazines, computer software, namely periodicals and magazines in electronic form".

[83] When considering the statement of wares of application No. 856,582, I find that my conclusions with respect to the nature of the wares and the nature of the trade under the registrability ground of opposition remain applicable. Given the material date, I recognize that the extent to which the Mark has become known is not a significant factor under the s. 16(1)(b) ground of opposition. Still, there is no evidence to conclude on the extent to which the Opponent's trade-mark VOGUE had become known in Canada as of December 31, 2000, nor can *de minimis* use of the trade-mark VOGUE be presumed from the mere existence of application No. 856,582.

[84] Having considered all of the surrounding circumstances, I am satisfied that the Applicant has met its burden to show that there was no reasonable likelihood of confusion between the Mark and the trade-mark VOGUE of application No. 856,582 as of December 31, 2000.

[85] In view of the above, I dismiss the ground of opposition based upon non-entitlement pursuant to s. 16(1)(b) of the Act.

Non-entitlement pursuant to s. 16(1)(a) of the Act

[86] Despite the onus resting on the Applicant, the Opponent has the initial onus of proving that the trade-marks alleged in the statement of opposition were used prior to the date of first use claimed in the application and had not been abandoned at the date of advertisement of the application [s. 16(5) of the Act].

[87] In the absence of any evidence of use of its alleged trade-marks, within the meaning of s. 4 of the Act, I find that the Opponent has not discharged its evidentiary burden to show use of any of the its alleged trade-marks prior to the material date.

[88] In view of the above, I dismiss the ground of opposition based upon non-entitlement pursuant to s. 16(1)(a) of the Act.

Non-distinctiveness

[89] This ground of opposition essentially turns on the issue of confusion between the Mark and the trade-marks alleged in the statement of opposition.

[90] There is an initial burden on the Opponent to show that one or more of its alleged trade-marks had become known sufficiently as of May 1, 2006 to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.*, 56 C.P.R. (2d) 44 (F.C.T.D.); *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)].

[91] In the absence of any evidence directed to the use or promotion of the Opponent's alleged trade-marks, I find that the Opponent has failed to satisfy its initial evidentiary burden. Thus, I dismiss the ground of opposition based upon non-distinctiveness.

Disposition

[92] Having regard to the foregoing, 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.

---

Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office