LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 248
Date of Decision: 2011-12-13

IN THE MATTER OF AN OPPOSITION by Advance Magazine Publishers Inc. to application No. 1,347,756 for the trade-mark PRACTICAL GOURMET in the name of Company's Coming Publishing Limited.

[1] On May 16, 2007, Company's Coming Publishing Limited (the Applicant) filed an application to register the PRACTICAL GOURMET trade-mark (the Mark) in association with a variety of wares and services on the basis of its proposed use in Canada. The wares and services as advertised are set out below:

> Publications, namely cookbooks, periodicals, magazines and recipes in printed and electronic form; On-line publications, namely, cookbooks, periodicals, magazines and recipes; Cookbooks; Recipe books; Magazines; Periodicals; Kitchen appliances, namely small, electrically-operated kitchen appliances, namely, hand mixer, toaster oven, pizza oven, toaster, coffee maker, coffee grinder, coffee urn, coffee carafe, electric kettle, slow cooker, bread maker, food processor, food chopper, hand blender, hand chopper, two-sided grill, indoor grill, electric indoor grill, blender, waffle maker, standmixer, electric frying pan or skillet, griddle, fondue, juicer, food processor, sandwich maker, can opener, drink mixer and ice shaver; Kitchen utensils, namely apple corer; bamboo skewers; bamboo party picks; baster nylon; baster aluminum; cake server with teeth; cake decorator; can/bottle opener; can piercer; can opener; cheese knife; cheese slicer/server; cheese slicer; winged corkscrew; corkscrew; corkscrew with matt finish; dough/pastry blender; egg beater; egg slicer; egg whisk; food whip; cooking fork; mini forks; fondue forks; fruit/vegetable knife, laser; funnel set; garlic press; grater & slicer; grater, rotary cheese; grater, course; grater, flat deluxe; grater, 4 side; grater, mini; ice cream scoop; icing bag set; knife, bread laser; knife, all purpose; Ladle, melamine; Ladle, soup; ladle, gravy; Measuring spoon set; Measuring spoons; Meat tenderizer; Meat Hammer; Melon baller; Paring

knife, laser; Paring knife, wooden handle; Paring knife, long; Paring knife; Pastry Brush; Pastry brush, nylon; Pastry brush set; Pastry brush wood; Peeler, vegetable; Peeler, white carbon blade; Peeler, vegetable; Peeler/shredder; Pizza cutter; Potato peeler; Potato Masher; Rice skimmer; Rolling Pin; Scissors; Scoop, food; Scraper, plate; Scraper, rubber plate; Skewer set, metal; Skimmer; Spaghetti server; Spatula set; Spatula, slotted; Spatula; Spatula with handle; Spoon, melamine; Spoon, slotted melamine; Spoon set, wooden; Spoon cooking; Spoon; Spoon, slotted; Spoons, hardwood; Spreaders, mini melamine; Squeezer with measuring cup; Steamer, vegetable; Steamer; Strainer, mesh; Strainer; Tea ball; Thermometer, oven; Thermometer, meat; Thermometer, deep fry; Timer, mechanical; Tong with safety locking; tongs, grilling; Tongs, kitchen; Tongs, spaghetti; Tongs, salad; Toothpick holder crystalline; Toothpicks with holder; Turner, Slotted; Turner, melamine wide slotted; Turner, mini slotted; Turner; Waiter corkscrew; Whisk; Kitchen apparel and accessories, namely aprons, oven mitts and towels; Audio and/or visual recorded materials, namely, pre-recorded laser discs and digital video discs containing audio and video of cooking demonstrations, including instruction on ingredient selection, preparation, cooking and storage methods and serving suggestions, recipes, cooking tips and cooking information, pre-recorded videos and pre-recorded discs of reproduced television or web-based cooking programs (the Wares).

Operation of an Internet website providing an interactive medium for the exchange of recipes and information on cooking, food, nutrition, lifestyle and entertainment ideas; Internet services, namely operation of an Internet website providing information storage and retrieval and access to databases and information on cooking, food, nutrition, recipes, lifestyle and entertainment ideas; Computer services, namely providing an on-line magazine in the field of culinary arts, lifestyle and entertainment; Publishing services, namely providing a printed and an on-line magazine in the field of culinary arts, lifestyle and entertainment; Entertainment services, namely production and distribution of television programs and radio programs in the field of culinary arts, lifestyle and entertainment; Operation of consumer shows and public exhibitions in the field of culinary arts, lifestyle and entertainment (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 1, 2008.

[3] On March 2, 2009, Advance Magazine Publishers Inc. (the Opponent) filed a statement of opposition pleading the grounds summarized below:

(a) contrary to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable because it is confusing with registration Nos.

TMA392,189 and TMA576,562 for GOURMET and registration No. TMA277,151 for GOURMET Design (set out below);

(b) contrary to s. 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date it was confusing with the use of the GOURMET and GOURMET Design trade-marks of the Opponent;

(c) contrary to s. 2 of the Act, the Mark is not distinctive of the Applicant;

(d) contrary to s. 30(i) of the Act, the Applicant could not have been satisfied that it was entitled to use the Mark as a search of the Register would have located the Opponent's marks and the Applicant knew or ought to have known of the Opponent's use, registration and notoriety of its marks prior to its date of application; and

(e) contrary to s. 30(e) of the Act, the Applicant did not intend to use the Mark.

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

[5] The Opponent filed the affidavit of Elenita Anastacio. The Applicant did not file any evidence. No written arguments were filed; both parties were represented at an oral hearing.

Onus and Material Dates

[6] 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].

[7] The material dates with respect to the grounds of opposition are as follows:

- Section. 38(2)(a)/30 of the Act - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- Section. 38(2)(b)/12(1)(d) of the Act - the date of my decision [*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.)];
- Section 38(2)(c)/16(3)(a) of the Act - the filing date of the application;
- Section. 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Grounds of Opposition Summarily Dismissed

[8] The s. 30(e) ground alleges that the Applicant did not intend to use the Mark. Since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the Mark in Canada, it formally complies with s. 30(e). The Opponent may rely on the Applicant's evidence to meet its initial burden in relation to this ground but the Opponent must show that the evidence is clearly inconsistent with the Applicant's claim [*Molson Canada v. Anheuser-Busch Inc*. (2003), 29 C.P.R. (4th) 315 (F.C.T.D.), and *York Barbell Holdings Ltd. v. ICON Health and Fitness, Inc*. (2001), 13 C.P.R. (4th) 156 (T.M.O.B.)]. Since there is no evidence suggesting that the Applicant did not actually intend to use the Mark when it filed its application, the s. 30(e) ground of opposition is dismissed on the basis that the Opponent has not met its initial evidential burden.

[9] The s. 30(i) ground alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as the Applicant knew or ought to have known of the Opponent's use, registration and notoriety of its trade-marks and trade-names. Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the s. 30(i) ground is dismissed.

[10] The s. 16(3)(a) and s. 2 grounds are also dismissed because the Opponent has not met its initial burden. Notwithstanding the fact that the Opponent's registration No. TMA277,151 was registered on the basis of s.14 of the Act, the Opponent has not evidenced that its marks were used or known in Canada as of the applicable material dates in this proceeding. The mere fact that the Opponent's registrations for GOURMET and GOURMET Design refer to use is not sufficient to meet the initial onus on the Opponent [*Rooxs, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.) at para. 4].

Section 12(1)(d) Ground of Opposition

[11] The Opponent filed the affidavit of Elenita Anastacio, a trade-mark searcher employed by its agents. Ms. Anastacio provides print-outs of the particulars of registration Nos. TMA277,151; TMA392,189 and TMA576,562. I have exercised my discretion and checked the register to confirm that each of these registrations is extant. Therefore, the Opponent has met its initial burden with respect to this ground. The particulars for these trade-marks are set out below:

Reg. No.	Trade-mark	Wares and Services
TMA277,151	Gourmet	Magazines.
TMA392,189	GOURMET	
TMA576,562	GOURMET	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.

[12] I will focus my discussion on the likelihood of confusion with the GOURMET trade-mark as this is the Opponent's strongest case since the resemblance between these trade-marks is slightly higher than between the Mark and the Gourmet Design trade-mark.

[13] The test to determine the issue of confusion is set out in s. 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the wares and services are of the same general class.

[14] In making such assessment consideration must be given to all the relevant surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[15] These criteria are not exhaustive and different weight will be given to each one depending on the circumstances of the case [*Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 (2006), 49 C.P.R. (4th) 321 (S.C.C.) at para. 54]. I also refer to *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.) at para. 49, where the Supreme Court of Canada states that s. 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis:

> ...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.

I will therefore commence with the issue of degree of resemblance, as this will influence the need for consideration of the other factors.

degree of resemblance in appearance or sound or in the ideas suggested

[16] It must first be noted that both party's marks are comprised of dictionary words. The *Canadian Oxford Dictionary* (1998 ed.) includes the following definitions:

a) GOURMET: "*n.* a connoisseur of good food, having a discerning palate; *attrib. adj.* (of food) of very high quality, suitable to refined tastes"

b) PRACTICAL: "*adj*. of or concerned with practice or use rather than theory; suited to use or action; designed mainly to fulfill a function".

[17] Given these definitions, it is clear that neither party's marks possess much inherent distinctiveness and therefore small differences in the marks will be sufficient to distinguish them [*Provigo Distribution Inc. v. Max Mara Fashion Group SRL* (2006), CarswellNat 3870 (F.C.) at para. 31].

[18] Accordingly, while the common element GOURMET results in some degree of resemblance, being a weak mark, the addition of the word PRACTICAL is sufficient to distinguish the Mark in appearance and sound. Furthermore, the first element is likely to be emphasized by consumers and therefore this also serves to differentiate the marks [*Conde Naste Publications Inc. v. Union des editions modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

[19] With respect to the ideas suggested, I find that the marks at issue suggest different ideas. The GOURMET trade-mark in association with magazines and electronic publications suggests information relating to food of high quality of interest to a connoisseur of good food. I take it as self-evident that such food would not be simple to prepare. In contrast, in the subject Mark, the inclusion of PRACTICAL to describe GOURMET suggests, in effect, that the subject wares and services are concerned with quicker, more efficient, thereby more *practical* preparation of high quality food. In my view PRACTICAL GOURMET is essentially an oxymoron, suggesting simple or quick preparation of "fancy food"; as such, I find there is a difference in the ideas suggested by the marks at issue.

[20] At the oral hearing the Agent for the Opponent argued that the *Masterpiece* decision supports a finding of confusion on the basis that the degree of resemblance would be greatly increased if the Mark appeared in a similar font as the GOURMET Design mark and/or emphasized the GOURMET component by, for example, decreasing the size of PRACTICAL relative to GOURMET. I do not agree. In *Masterpiece,* the Supreme Court was commenting on whether the manner of actual use could be considered to the exclusion of all potential uses of a

trade-mark as registered in the context of assessing entitlement in an expungement action under s. 57 of the Act. I am of the view that this approach is limited to such actions; it is not appropriate to extend this to analysis of confusion in this opposition proceeding as to do so would give an unreasonably broad scope of protection to the Opponent's marks. I would observe that if the Applicant were to use its mark in the Opponent's stylized font or where GOURMET were to be the only dominant portion of the mark, the resulting mark would arguably not be the Mark applied for, and the Opponent would have other legal recourse, without being prejudiced by the findings of this opposition.

remaining s. 6(5) factors

[21] In *Masterpiece* the Supreme Court stated that the other s. 6(5) factors would only become significant once the marks are found to be identical or very similar (at para. 49). In this case, none of the other factors assist the Opponent in overcoming the differences between the marks. The Opponent has not evidenced that its trade-marks have acquired any distinctiveness through use or promotion. While the Opponent's registrations are based on use, this only entitles me to assume *de minimis* use [*Entre Computer Centers Inc. v. Global Upholstery Co*. (1991), 40 C.P.R. (3d) 427 (T.M.O.B.) at 430]. *De minimis* use does not support a conclusion that the mark has become known to any significant extent, nor that the marks have been used continuously since the date stated. The ambit of protection of the Opponent's marks is very narrow. Therefore while the Wares and Services are all food related and overlap directly with respect to various publication related services and the Internet, this overlap is insufficient to result in a likelihood of confusion given the differences between the marks.

Conclusion

[22] I conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the trade-marks at issue. Given that the Opponent's GOURMET and GOURMET Design trade-marks have little inherent distinctiveness and there is no evidence that these trade-marks have acquired any distinctiveness, the differences between the Opponent's marks and the Applicant's Mark is sufficient to make confusion unlikely. This ground of opposition is therefore dismissed.

Disposition

[23] 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.

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P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office