

**IN THE MATTER OF AN OPPOSITION by
Hunter Douglas Inc. and Hunter Douglas
Canada Inc. to Applications No. 1055204 and
1055206 for the Trade-marks SHADETTE and
VIEWETTE filed by Blinds To Go
Inc.**

I The Pleadings

On April 14, 2000 Blinds To Go Inc. (the “Applicant”) filed applications to register the trade-marks SHADETTE, application number 1055204 and VIEWETTE, application number 1055206 (collectively referred to as the “Marks”), on the basis of proposed use in Canada, in association with window blinds and window shades (the “Wares”). The applications were advertised on October 3, 2001 in the Trade-marks Journal for opposition purposes.

Hunter Douglas Inc. and Hunter Douglas Canada Inc. (I shall refer to either or both of them as the “Opponent” as the case may be, except where specified otherwise) filed on March 4th, 2002 identical statements of opposition, with respect to each of those applications, forwarded by the Registrar on March 12, 2002 to the Applicant.

The Applicant denied all grounds of opposition in counter statements filed on June 25, 2002 and added that the suffix ETTE is commonly used in the window coverings business.

The Opponent filed the affidavits of Sue Allison Rainville, Robert W. White and David Sloan while the Applicant filed the affidavit of Claire Gordon. The Opponent obtained permission to file, as additional evidence, the affidavit of Sharon Elliot. Only Sue Allison Rainville was cross-examined. I should add that the evidence is the same in both files.

Both parties filed written submissions and an oral hearing was held for both of these files as well as for application number 1055205 for the trade-mark CLAUDETTE and application number 1055207 for the trade-mark ANTOINETTE that are the subject of a separate decision.

II The statements of opposition

The Opponent amended its statements of opposition such that the grounds of opposition presently pleaded can be summarized as follow:

- (1) The applications do not comply with the provisions of s. 30(e) of the Trade-marks Act R.S.C. 1985 c. T-13 (the “Act”) in that the Applicant failed to specify whether or not it intends to use the Marks in Canada by itself or through a licensee, or by itself and through a licensee;
- (2) The applications do not comply with the provisions of s. 30(i) of the Act in that the Applicant could not have been satisfied that it is entitled to use the Marks in Canada in view of the Opponent’s applications previously filed in Canada including those for the registration of the trade-marks INTIMETTE and ALLOUETTE, the Opponent’s registrations and in view of the Opponent’s use and reputation of its family of ETTE trade-marks;
- (3) The Marks are not registrable pursuant to the provisions of s. 12(1)(d) of the Act as they are confusing with the following Opponent’s registered trade-marks:

TMA138666	SILHOUETTE
TMA316135	DUETTE
TMA401528	DUETTE & Design
TMA424758	DUETTE & Design
TMA427209	DUETTE CHINOISE
TMA396060	DUETTE CLASSIC
TMA396056	DUETTE DUOLITE
TMA396062	DUETTE EASY RISE
TMA396058	DUETTE ELITE
TMA402087	DUETTE EXPRESSIONS
TMA415307	DUETTE IMPRINTS
TMA396064	DUETTE MAJESTIC
TMA400874	DUETTE SHEER VISUALE
TMA396059	DUETTE SIMPLICITY
TMA396063	DUETTE SKYRISE
TMA396057	DUETTE SPLENDOR
TMA396061	DUETTE VERTIGLIDE
TMA359556	FABRETTE
TMA440170	VIGNETTE
TMA465445	LUMINETTE
TMA548828	SERENETTE

- (4) The Applicant is not the person entitled to the registration of the Marks, pursuant to the provisions of s. 16(3)(a) of the Act, as at the filing date of the applications the Marks were confusing with the Opponent’s trade-marks listed in the preceding paragraph all of which having been previously used and made known in Canada by the Opponent;

- (5) The Applicant is not the person entitled to the registration of the Marks, pursuant to the provisions of s. 16(3)(b) of the Act, as at the filing date of the applications the Marks were confusing with the Opponent's family of ETTE trade-marks for which applications for registration had been previously filed by the Opponent as well as with application number 866812 for the trade-mark INTIMETTE, application number 1019701 for the trade-mark ALLOUETTE and application number 1102215 for the trade-mark SONETTE;
- (6) The Marks are not distinctive within the meaning of s. 2 of the Act as they do not and cannot distinguish the wares of the Applicant from the wares of others, nor are they adapted so to distinguish them.

III Preliminary issues

- i) Admissibility of an assignment of two trade-marks referred to in the state of the register evidence

Without going into details at this stage on the content of the Applicant's evidence, suffice to say that the main purpose of the allegations in Claire Gordon's affidavit is to introduce state of the register evidence to argue that the suffix ETTE is commonly used in the curtains and blinds industry. Such evidence included registration TMA517263 for the trade-mark PRIVETTE and application number 1092455 for the trade-mark ILLUSIONNETTE both in the name of George N. Jackson Limited. During the course of the hearing the Opponent requested leave to file a document issued by the Registrar attesting the entry on the register of an assignment of those trade-marks from George N. Jackson Limited to the opponent Hunter Douglas Inc., apparently recorded on the register on the morning of the hearing. As the Applicant was caught by surprise by such turn of event, I asked both parties to submit written submissions on its admissibility, at this very late stage of the opposition proceeding. Both parties did so.

The Opponent argues that such evidence is admissible as the relevant date to determine the issue of registrability of the Marks is the date of my decision. [See *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd et al* (1991), 37 C.P.R. 413] Moreover the Opponent relies on the case law that the Registrar will exercise his discretion to check the register in cases where the registrability of a trade-mark is at stake. In *Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 it was determined that the Registrar has discretion to look at the

register to determine if the marks cited by the opponent in support of a ground of opposition under s. 12(1)(d) were still on the register in the absence of such evidence on the part of an opponent. I do not interpret such decision to mean that the Registrar has discretion to verify the accuracy of the state of the register evidence filed by either party. If there are inaccuracies it is up to the party who wants to raise such issue to file evidence to support its contention.

The Opponent is trying to bring the Registrar's attention to the fact that two citations contained in the Applicant's evidence of the state of the register are trade-marks now owned by the Opponent.

- a) The criteria to determine if the Registrar should grant permission to a party to file additional evidence are: The stage the opposition proceeding has reached;
- b) Why the amendment was not made or the evidence not filed earlier;
- c) The importance of the amendment or the evidence;
- d) The prejudice that will be suffered by the other party.

It would appear that the Opponent was not in a position to act at an earlier stage as the assignment was recorded the day of the hearing. The proceedings are at the hearing stage. The Opponent is trying to limit the scope of the state of the register evidence filed by the Applicant. However, even if I dismiss the Opponent's leave to file the assignment, as it will be discussed hereinafter when assessing the relevancy of the state of the register evidence, exhibit A to Ms. Gordon's affidavit would only establish the existence on the register of two trade-marks (PRIVETTE and ILLUSIONNETTE) having the suffix "ETTE" in association with blinds or shades. Such number is clearly insufficient to infer wide use on the marketplace in Canada of trade-marks composed of the suffix "ETTE". As it will appear afterward, the majority of the citations raised by the Applicant do not support an argument that the average consumer is accustomed to see trade-marks having the suffix "ETTE" in association with blinds and shades. Therefore the first and third criteria listed above are in favour of the Applicant and outweigh the others. I therefore maintain the Applicant's objection to the late filing of evidence attesting the assignment of the trade-marks PRIVETTE and ILLUSIONNETTE.

- ii) Documents referred to during the cross-examination of Ms. Rainville

The Applicant tried to rely on registrations obtained in the United States by introducing such evidence during the cross-examination of Ms. Rainville held on April 21, 2005. By decision rendered on September 15, 2004 subsequent to a request for leave to file an additional affidavit, the Registrar had already ruled that such documents were not relevant to the issues raised in these proceedings. I therefore maintain the Opponent's objection formulated during such cross-examination.

The Applicant attempted to file a copy of Mr. D. Jackson's affidavit during the aforesaid cross-examination. Such affidavit consists of evidence filed in the context of a s. 45 proceeding concerning the trade-mark PRIVETTE, certificate of registration TMA517263. By referring to this document the Applicant is trying to establish use of a trade-mark having the suffix "ETTE" by a third party in the marketplace in Canada. The content of this document is inadmissible evidence in these proceedings. It is a photocopy of an affidavit filed by a third party in another proceeding involving different parties to this opposition.

III Analysis of the various grounds of opposition

The legal burden is upon the Applicant to show that its applications comply with the provisions of the Act, but there is however an initial onus on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial onus is met, the Applicant still has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Marks [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

The Opponent informed the Registrar, at the oral hearing, that it was no longer relying on the first two grounds of opposition and therefore they will not be addressed in this decision. With respect to the fifth ground of opposition, the Opponent is no longer referring to its applications number 866812 for the trade-mark INTIMETTE and number 1019701 for the trade-mark ALLOUETTE.

As for application number 1102215 for the trade-mark SONETTE, it has a filing date subsequent to the present application and cannot be considered for the purpose of this decision. [See s. 16(3)(b) of the Act].

i) Registrability

The material time for considering the issue of the registrability of the Marks is the date of the Registrar's decision. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)]

Ms. Sue Alison Rainville is the Marketing Director of Hunter Douglas Canada Inc. ("Hunter Canada") and has held this position since 1990. Hunter Canada is an affiliated company and licensee of Hunter Douglas Inc., the owner of the registered trade-marks listed under the third ground of opposition. She filed certified copies of these registrations to support such allegation. Therefore the Opponent has met its initial onus of proof.

The test for confusion is set forth in s. 6(2) of the Act and I must have regard to all the surrounding circumstances, including those listed in s. 6(5): the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

The Supreme Court of Canada through Mr. Justice Binnie in *Mattel, Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321 described the test of confusion as follow:

What, then, is the perspective from which the likelihood of a "mistaken inference" is to be measured? It is not that of the careful and diligent purchaser. Nor, on the other hand, is it the "moron in a hurry" so beloved by elements of the passing-off bar: *Morning Star Co-Operative Society Ltd. v. Express Newspapers Ltd.*, [1979] F.S.R. 113 (Ch. D.), at p. 117. It is rather a

mythical consumer who stands somewhere in between, dubbed in a 1927 Ontario decision of Meredith C.J. as the “ordinary hurried purchasers”: *Klotz v. Corson* (1927), 33 O.W.N. 12 (Sup. Ct.), at p. 13. See also *Barsalou v. Darling* (1882), 9 S.C.R. 677, at p. 693. In *Delisle Foods Ltd. v. Anna Beth Holdings Ltd.* (1992), 45 C.P.R. (3d) 535 (T.M.O.B.), the Registrar stated at p. 538:

When assessing the issue of confusion, the trade marks at issue must be considered from the point of view of the average hurried consumer having an imperfect recollection of the opponent’s mark who might encounter the trade mark of the applicant in association with the applicant’s wares in the market-place.

(...)

In opposition proceedings, trade-mark law *will* afford protection that transcends the traditional product lines unless the applicant shows the likelihood that registration of its mark will *not* create confusion in the marketplace within the meaning of s. 6 of the *Trade-Marks Act*. Confusion is a defined term, and s. 6(2) requires the Trade-marks Opposition Board (and ultimately the court) to address the *likelihood* that in areas where both trade-marks are used, prospective purchasers will infer (incorrectly) that the wares and services - though not being of the same general class - are nevertheless supplied by the same person. Such a mistaken inference can only be drawn here, of course, if a link or association is likely to arise in the consumer’s mind between the source of the well-known BARBIE products and the source of the respondent’s less well-known restaurants. If there is no likelihood of a link, there can be no likelihood of a mistaken inference, and thus no confusion within the meaning of the Act.

It is with these general principles in mind that I shall review the pertinent evidence and assess each relevant factor identified above. I shall compare the Marks with the Opponent’s word marks DUETTE, SILHOUETTE, LUMINETTE, VIGNETTE and SERENETTE (“Opponent’s Trade-marks”) as I consider them to be the best-case scenario for the Opponent. I am voluntarily omitting the Opponent’s trade-mark FABRETTE as there is no evidence of its use within the meaning of s. 4(1) of the Act. Thus the Opponent would not be in any better position with such trade-mark than with its trade-mark SILHOUETTE for example, when applying the test for confusion between the Marks and any of the Opponent’s trade-marks. I decided to compare the Opponent’s Trade-marks with the Marks as there is some reference to these trade-marks in the Opponent’s evidence, without concluding at this stage that such evidence constitute proper evidence of use of the Opponent’s Trade-marks.

During the oral hearing the Applicant conceded that the following factors favour the Opponent: nature of the wares, nature of the trade and length of time the relevant trade-marks have been in use. I shall therefore concentrate my analysis on the inherent distinctiveness, the degree of resemblance of the marks in issue as well as the state of the register evidence and finally whether or not there is proper evidence establishing a family of “ETTE” trade-marks owned by the Opponent that would enable it to widen the scope of protection of these trade-marks.

The Marks consist of coined words. However when used in association with blinds they are suggestive of “little shade” and “little view”. The Opponent’s trade-marks SILHOUETTE and VIGNETTE are words in the English or French language but the trade-mark VIGNETTE has no relation whatsoever with blinds. The trade-mark SILHOUETTE might suggest that you will see only a “silhouette” through the blinds. The trade-marks DUETTE, SERENETTE and LUMINETTE are coined words. The trade-mark DUETTE might be suggestive of “duet” but has no connotation with blinds. The same reasoning applies to SERENETTE as it might suggest a “serenade”. The only other suggestive trade-mark would be “LUMINETTE” as it suggests that only a small quantity of light might go through the blinds. Overall, the Opponent’s trade-marks DUETTE, VIGNETTE and SERENETTE are inherently distinctive and thus, in so far as these trade-marks are concerned, the first relevant factor described in s. 6(5) of the Act favours the Opponent. However in the case of the trade-marks SILHOUETTE and LUMINETTE, this factor does not favour any party.

It has often been said that the degree of resemblance is the most important factor when assessing the likelihood of confusion between two trade-marks, especially as in this case where the wares are similar. Mr. Justice Cattanach in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 defined the issue in the following terms:

Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.

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

The trade-mark SHADETTE suggests that you will see “small shade” through the blinds while the trade-mark VIEWETTE suggests that you will have a “small view” through the blinds. The ideas and characteristics suggested by those trade-marks are similar to the idea and characteristic suggested by the Opponent’s trade-mark SILHOUETTE that suggests that you will see a “silhouette” through the blinds. I consider that there exists some similarity between “small shade”, “small view” and “silhouette” when those ideas are associated with blinds. This factor favours the Opponent.

The Opponent has put a lot of emphasis on the existence of a family of trade-marks identified as “ETTE” trade-marks. The Opponent cited *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R.(2d)101 to support its contention. After explaining the consequences of the existence of a family of trade-marks owned by an applicant when it files a subsequent application for the registration of a trade-mark having the same characteristic(s) found in its family of trade-marks, Mr. Justice Cattanach made the following observation:

“I quite agree with the conclusion of the chairman that a straightforward comparison of the trade mark MCYOGURT with the trade marks EGG MCMUFFIN, MACSUNDAE, MCCHEESE and MCTREATS individually leads to the conclusion that the trade marks are not confusing. Certainly yogurt is not confusing with muffin or cheese or sundaes or treats, any more than any one of the four words "muffin", "cheese", "sundae" or "treats" is confusing with any one of the other three

But that is not the substance of the principal argument advanced before me on behalf of his clients by counsel for the appellants. His contention is that the appellants have created "a family of trade marks". That the appellants have done this follows in logical sequence from the initial use of the trade marks MCDONALDS and MCDONALD's HAMBURGERS followed by BIG MAC to the use of the prefix "Mc", with the one time exception of "Mac", followed by the name of a food product.
(...)

Thus when trade marks which have common characteristics are registered in the name of one owner as in the case of the marks EGG MCMUFFIN, MACSUNDAE, MCCHEESE and MCFEAST, that circumstance gives rise to the presumption that such marks form a series of marks used by the one owner and the registration of such marks is tantamount to a single registration combined of those several marks.
(...)

While the presumption of the existence of a series of trade marks can arise at the time of an application for the registration of a trade mark with the consequence indicated the same presumption does not arise in opposition proceedings. Before any similar inference as would arise from the presumption can arise in the opposition proceedings based upon the use of other marks any such use must be established by evidence.

The question therefore is whether the appellants have discharged the onus cast upon them of establishing the existence of a series of marks owned by the corporate appellant with which the application by the corporate respondent for the registration of the trade mark MCYOGURT may conflict. That is to be discharged by the establishment of the use of the trade marks sufficient to constitute a family.”

(My underlining)

Therefore there must be evidence of use of its trade-marks part of the alleged family of trade-marks. As pointed out by the Applicant, notwithstanding the voluminous evidence filed by the Opponent, the latter failed to discharge such burden. We have no evidence of use of the trade-marks LUMINETTE, FABRETTE and SERENETTE in Canada within the meaning of s. 4 of the Act. Packaging of products bearing the trade-marks SILHOUETTE, VIGNETTE and DUETTE have been filed. Ms. Rainville reveals the total units sales figures in Canada for the years 1995 to 2002 for what she defines as “the ETTE Products”, namely products bearing any one of the Opponent’s trade-marks identified as “the ETTE trade-marks”. Assuming that such packaging has been in use since the date of first use alleged in Ms. Rainville’s affidavit (1964 for the trade-mark SILHOUETTE and 1985-86 for the trade-mark DUETTE), we have no information on the quantities sold under each of these trade-marks. We also have no information on the date of first use of the trade-mark VIGNETTE. Advertising and promotional material (affidavit of David Sloan and Robert White), per se, do not constitute proper evidence of use of a trade-mark in association with wares as defined in s. 4(1) of the Act.

In view of these important deficiencies in its evidence, I cannot conclude that the Opponent has established the existence of a family of “ETTE” trade-marks in support of its opposition that would enable to treat its trade-marks as a single trade-mark having a wider scope of protection.

The Applicant is arguing that if I maintain this opposition it would be tantamount to give to the Opponent a monopoly over a grammar rule as the suffix “ETTE” stands for “small”. I do not agree with the Applicant. Each case must be evaluated based on the evidence filed. My decision

must be based on the legal principles outlined above and one should not generalize a conclusion reached on the basis of facts presented before the Registrar.

As an additional surrounding circumstance, the Applicant has introduced state of the register evidence through the affidavit of Claire Gordon, employed by the Applicant's agent firm. She filed extracts of the register consisting of seventeen (17) trade-mark applications or registrations. All of these extracts have the common suffix "ETTE". The Opponent is arguing that three citations have been either expunged or an application was abandoned since the date of execution of her affidavit (February 25, 2004), as appears from extracts of the register annexed to the its written argument. Such evidence was not introduced properly. Even if I was to consider those three citations, two of them namely PARADIS-MILLETTE TAPIS-DÉCOR & Design, and MARIETTE CLAIRMONT & Design are easily distinguishable. As for UNE VIE DOUILLETTE it is highly suggestive.

There are only two pertinent citations, namely registration number TMA517263 for the trade-mark PRIVETTE and application number 1092455 for the trade-mark ILLUSIONNETTE, both including blinds in their list of wares. I agree with the Opponent that none of the remainder of the citations cover the relevant class of wares, namely window blinds and shades. The Applicant attempted to categorize the wares covered by the other citations and those sold by the Opponent in association with its trade-marks as decorative accessories. However such categorization is too broad and does not represent the proper general class of wares. [See *Park Avenue, op.cit.*].

Finally, the Applicant was able to establish proper evidence of use of only one third party trade-mark having the suffix "ETTE", namely SOFETTE, through an admission of Ms. Rainville during her cross-examination. Two citations on the register and evidence of use of one trade-mark is certainly not enough to conclude that there is a wide spread use in the marketplace in Canada of trade-marks having the suffix "ETTE" in association with blinds or shades such that the average consumer has been accustomed to distinguish those trade-marks.

Applying the principles set out in *Beverley Bedding and Mattel op.cit.*, I reach the conclusion that, on a balance of probabilities, the average consumer having an imperfect recollection of the

Opponent's trade-mark SILHOUETTE, certificate of registration TMA138666 would likely be confused as to the source of origin of the Wares when confronted with the Marks. Except for the first criteria, all the other relevant factors enunciated in s. 6(5) of the Act favour the Opponent. I therefore maintain the third ground of opposition.

ii) Entitlement

The Opponent filed packaging illustrating the use of the trade-marks SILHOUETTE, VIGNETTE and DUETTE. In paragraph 6 of her affidavit, Ms. Rainville alleges that Hunter Canada commenced in late 1985/early 1986 to sell in Canada venetians blinds and shades under the trade-mark DUETTE. She also alleges that Hunter Canada and its predecessor in title has been selling blinds in Canada since 1964 in association with the trade-mark SILHOUETTE. She does not provide the date of first use in Canada of the trade-mark VIGNETTE. As for the trade-marks DUETTE and SILHOUETTE, s. 16(5) of the Act imposes on the Opponent an evidential onus to prove that it has not abandoned the use of those trade-marks in Canada as of the advertisement date of the present applications.

The Opponent, as mentioned earlier, has referred to numerous trade-marks that Ms. Rainville has defined as the "ETTE Trade-marks" and the products sold under those trade-marks as "ETTE Products". The affiant provides the unit sales between 1995 and 2002 of the ETTE Products under the ETTE Trade-marks. However she did not break down the numbers per trade-mark listed in the statement of opposition. Therefore it is impossible to conclude that those units sales for the year 2000 refer to sales of ETTE Products bearing the trade-marks DUETTE, VIGNETTE and/or SILHOUETTE. It could be that during those years the Opponent did not sell blinds in association with the trade-marks DUETTE, SILHOUETTE or VIGNETTE but sold what has been defined as ETTE Products in association with any other trade-marks listed in the definition of ETTE Trade-marks. Such ambiguity must be resolved against the Opponent. However did the Opponent establish that any of its trade-marks were made known in Canada as of the relevant date (April 14, 2000) pursuant to s. 16(3) (a)?

The concept of making known is defined in s. 5 of the Act. Not having proper evidence of use of any of its trade-marks at the relevant time, I have to determine if the Opponent has advertised any of its trade-marks in publications circulated in Canada in the ordinary course of commerce among potential users of the Wares in such a way that they were well known in Canada at the material date by reason of such advertising. Exhibits C, D and E to Ms. Rainville's affidavit are advertisements published in Canada after the relevant date and therefore cannot be considered.

Mr. Sloan was an articling student employed by the Opponent's agent firm at the time of execution of his affidavit. He filed one hundred extracts of different magazines that circulated in Canada in which one of the Opponent's trade-marks was advertised. In fact the trade-mark SILHOUETTE has been advertised in various issues of *Canadian Living* (exhibits 3, 4, 6, 7, 9 and 10), *Style Home* (exhibits 14, 15, 17, 18 and 20), *Canadian House and Home* (exhibits 37, 39, 40, 43 and 47), *Western Living* (exhibit 56), *Décormag* (exhibits 58 and 61), *Les Idées de ma Maison* (exhibits 80 and 81) and in *Décoration chez soi* (exhibit 93). The trade-mark LUMINETTE has been advertised in various issues of *Canadian Living* (exhibits 5 and 8), *Style Home* (exhibits 13, 16, 21 and 22), *Canadian House and Home* (exhibits 31 to 36, 38, 41 and 44), *Western Living* (exhibits 52, 53, 55 and 57), *Décormag* (exhibits 62 to 72) and in *Décoration chez soi* (exhibit 83 to 92, 94 and 95). All these advertisements were published prior to the relevant date.

Mr. White of the Audit Bureau of Circulation has provided the circulation figures across Canada of these magazines during the publication period of these advertisements. There were at least 500,000 copies circulated of each issue in which an advertisement was published in *Canadian Living*, close to 150,000 copies circulated of each issue in which an advertisement was published in *Canadian House and Home* and approximately 200,000 copies circulated of each issue in which an advertisement was published in *Style at Home*, to name a few.

From this evidence I conclude that the Opponent has met its initial onus to prove that its trade-marks SILHOUETTE and LUMINETTE were made known in Canada pursuant to s. 16(3) of the Act at the advertisement date of this application (s. 16(5) of the Act). Therefore the Applicant has to prove, on a balance of probabilities, that the Marks were not confusing with the

Opponent's aforesaid trade-marks at the relevant date. The fact that such date is earlier than the relevant date associated with the registrability ground of opposition would not alter my analysis of the likelihood of confusion between the Marks and the Opponent's trade-mark SILHOUETTE that I made when assessing the registrability of the Marks. Therefore for the same reasons detailed under such ground of opposition I maintain the fourth ground of opposition when comparing the Marks with the Opponent's trade-mark SILHOUETTE.

As for the fifth ground of opposition, the Opponent has not established that there was an application for the registration of at least one of its trade-marks that was pending at the advertisement date of these applications. Therefore such ground of opposition is dismissed. [S. 16(4) of the Act and *Governor and Co. of Adventurers of England trading into Hudson's Bay v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526]

iii) Distinctiveness

As I already concluded in favour of the Opponent on two separate grounds of opposition it is not necessary to assess this final ground of opposition.

IV Conclusion

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the Applicant's applications for the registration of the trade-marks SHADETTE, application number 1055204 and VIEWETTE, application 1055206, the whole pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS 8th DAY OF MARCH 2007.

Jean Carrière,
Member,
Trade-marks Opposition Board