IN THE MATTER OF AN OPPOSITION by
Now Communications Inc. to application No. 898,350
for the trade-mark NEWS NOW Design
filed by CHUM Limited

On December 3, 1998, the applicant, CHUM Limited, filed an application to register the trade-mark NEWS NOW Design. The trade-mark is shown below:

The application is based upon use of the trade-mark in Canada in association with the following services since at least as early as September 7, 1998:

> **(1) Television broadcasting services, interactive electronic communications services namely the operation of an Internet website for the purpose of providing on-line chats, e-mail, direct sales and television webcasts.**
> **(2) Providing information on music, health, fashion, medical, current events, business, financial, news, sports, games and concerts via the media of television, satellite, computer, telephone, audio, video, and/or via the World Wide Web on the global Internet (including narrow band and broad band applications) or through electronic mail.**
> **(3) Development, production, recording and distribution of television programs, audio and video tapes, cassettes and video discs on behalf of others.**

The application is also based on proposed use of the trade-mark in Canada in association with:

> **(1) Keychains, purse size mirrors, balloons, pens, magnetic memo boards, umbrellas, aprons, beach balls, visors, flying discs,**

keepmates namely plastic carrying containers for wearing around the neck, beach towels, mugs; graduated and ungraduated rulers, clocks, calculators, lapel pins, novelty buttons, stickers, paper banners, ice scrapers, oven mitts, letter openers, beach mats, record keeping kits namely monthly fillers and record forms.
(2) Pre-recorded CDs, pre-recorded CD-ROMS which are not software-related, pre-recorded computer disks and pre-recorded video discs for use in the entertainment and education industries featuring music, current events, games, concerts and matters of interest to families; pre-recorded audio and video tapes, cassettes and compact discs.
(3) Printed publications namely manuals, newsletters, brochures, magazines, pamphlets, flyers and postcards.

The applicant has disclaimed the right to the exclusive use of the word NEWS apart from the trade-mark with respect to the services and to the following wares only: pre-recorded CD-ROMS, pre-recorded computer disks, pre-recorded video discs, pre-recorded audio and video tapes, cassettes and compact discs and printed publications.

The application was advertised for opposition purposes in the Trade-marks Journal of March 15, 2000. The opponent, Now Communications Inc., filed a statement of opposition on May 10, 2000. In its statement of opposition, the opponent states that it is the owner of the following five Canadian trade-mark registrations: No. 432,886 for NOW in association with newspapers, periodical publications and magazines; No. 437,726 for NOW and Design in association with newspapers, periodical publications and magazines; No. 438,137 for NOW and Design in association with newspapers, periodical publications and magazines; No. 475,009 for NOW ON in association with electronic publishing and computerized information services; and No. 436,919 for NOW MAGAZINE in association with the publication of newspapers, periodical publications and magazines and with certain wares. The opponent submits that the applicant's

trade-mark is not registrable because it is confusing with each of the above-mentioned registered trade-marks.

The opponent's NOW and Design trade-mark is shown below:

The opponent also pleads that the applicant "is not the person entitled to registration of the said trade-mark NEWS NOW pursuant to Section 16(1), in that the same was confusing within the meaning of Sections 2 and 6 with the opponent's trade-mark NOW, NOW and Design and NOW ON and NOW MAGAZINE as referred to above as depicted in Registration Nos. 432,886, 437,776, 438,137, 475,009 and 436,919, which have been previously used in Canada and continue to be used in Canada."

In addition, the opponent pleads that the applicant's trade-mark is not distinctive in view of the opponent's trade-marks.

Finally, the opponent pleads that the application is contrary to subsection 30(i) because the applicant could not have been satisfied that it was entitled to use its mark in view of the opponent's previously used trade-marks.

The applicant filed and served a counter statement in which it denied the grounds of opposition.

The opponent filed as its evidence the affidavit of David Logan, the Vice-President, Operations of Now Magazine. He provides copies of the opponent's trade-mark registrations, information about the opponent's NOW magazine and NOW ON web site, and examples of how the opponent's marks are used.

As its evidence, the applicant filed the affidavits of Imtyaz Sattar and Donald Mumford. Mr. Sattar is a trade-mark agent in training. He provides details about other trade-marks sharing the design used in the present application and a copy of the opposition decision regarding application No. 734,554 for the word mark NEWS NOW, which is also owned by CHUM Limited. This unreported decision, dated January 31, 2000, will be hereinafter referred to as the "NEWS NOW Word Mark Decision". Application s.n. 734,554 was filed on August 11, 1993 based on proposed use in association with "videotape recordings, cassettes, and films of television programs" and "educational and entertainment services, namely the production, broadcast, transmission and distribution of television programming; and the operation of television news gathering organizations and television stations". It was unsuccessfully opposed by the present opponent.

Mr. Mumford is the Program and Promotion Manager at three television stations operated by

the applicant. He provides information about the applicant's trade-mark NEWS NOW, as well as its NEWS NOW Design mark, including evidence of their use and promotion. He also provides his opinion that the "NEWS NOW Design mark is not confusing with the magazine titled NOW MAGAZINE published weekly and to my knowledge distributed free in the Toronto vicinity." The opponent has put Mr. Mumford forward as an expert; however, Mr. Partington's comments at page 6 of the NEWS NOW Word Mark Decision, concerning the "expert" that the same party put forward in that case, apply equally here:

> **Further, in addition to not being an independent witness in these proceedings, [he] has not been shown to be an expert in human behaviour and is therefore not qualified to render an opinion that the public would not be confused by the trade-marks at issue. Also, the likelihood of confusion between the trade-marks of the parties is the ultimate issue for determination by the Registrar in this opposition and, even if opinion evidence on the ultimate issue were considered admissible, I would not accord it any weight.**

No reply evidence was filed and none of the affiants was cross-examined on their affidavits. Only the applicant filed a written argument. An oral hearing was not requested.

In its written submissions, the applicant relied on the NEWS NOW Word Mark Decision in support of its submission that the Board should reject this opposition simply through the application of *res judicata*, *stare decisis*, or judicial comity. I have declined to do so, primarily because of the many differences between the two proceedings. These include differences in the material dates, the trade-marks at issue, and the evidence.

In its written argument, the applicant also submitted that the opponent's evidence is inadmissible in its entirety because the heading of Mr. Logan's affidavit refers incorrectly to

another opposition, namely the one that was decided in the NEWS NOW Word Mark Decision. The argument as I understand it is that the affidavit should not be considered because it was clearly sworn for a completely different proceeding. I do not subscribe to the applicant's line of logic. It is not clear that the affidavit was sworn for a different proceeding. The other proceeding was already concluded at the date that Mr. Logan's affidavit was sworn and it appears much more likely that the incorrect heading resulted simply from a clerical error or oversight. The contents of the affidavit clearly relate to the present proceedings and the result that the applicant proposes is far too severe a penalty for such an inconsequential error, particularly at this late stage in the proceedings.

The material dates with respect to each ground of opposition are as follows: paragraph 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)]; paragraph 16(1) - the date of first use set out in the application; non-distinctiveness - the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.)]; section 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475].

With respect to the ground of opposition based on subsection 30(i), the opponent has not furnished any evidence to show that the applicant could not have been satisfied as of December 3, 1998 that it was entitled to use the NEWS NOW Design mark in Canada. Moreover, to the

extent that the subsection 30(i) ground is founded upon allegations set forth in the other grounds of opposition, its success would be contingent on a finding that the NEWS NOW Design mark is not registrable or not distinctive or that the applicant is not the person entitled to its registration [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (2d) 191 at 195; *Sapodilla Co. Ltd. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152 at 155].

I consider the word mark NOW, as registered under No. 432,886, to be the most relevant of the opponent's trade-marks. I will focus my discussion of the likelihood of confusion on that mark. In the event that NEWS NOW Design is not confusing with NOW, then NEWS NOW Design is not confusing with any of the other marks of the opponent.

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293]. However, the opponent has an initial burden to prove the allegations of fact supporting its grounds of opposition.

With respect to the entitlement ground of opposition, there is an initial burden on the opponent to evidence use of its trade-marks prior to the applicant's date of first use (September 17, 1998) and to establish non-abandonment of its marks as of the date of advertisement of the applicant's application (March 15, 2000). The opponent has evidenced use of its NOW trade-mark only in association with magazines as of September 17, 1998.

Consequently, its subsection 16(1) ground of opposition is restricted to consideration based only on such wares. I am satisfied that the opponent had not abandoned its NOW trade-mark in association with magazines as of March 15, 2000.

With respect to the paragraph 12(1)(d) grounds of opposition, the opponent has met its initial burden by furnishing copies of its trade-mark registrations.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act,* the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act.* Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has 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 in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

At page 6 of the NEWS NOW Word Mark Decision, former Chairperson Partington discussed the inherent distinctiveness of the applicant's word mark NEWS NOW and the opponent's NOW mark as follows:

> **With respect to Paragraph 6(5)(a) of the *Act*, the applicant's trade-mark**

> **NEWS NOW is highly suggestive when applied to broadcast services and is suggestive when applied to the wares in the present application. As a result, the applicant's mark possesses relatively little inherent distinctiveness. On the other hand, the opponent's registered trade-mark NOW and NOW & Design are inherently distinctive when applied to the opponent's T-shirt, coffee mug, baseball cap, sweatshirt, watch, keychain, leather jacket, hockey puck, pen, beer stein, note pad" and possess some measure of inherent distinctiveness when applied to its "Newspapers, periodical publications, magazines" and to the "Publication of newspapers, periodical publications and magazines".**

In the present case, the applied for mark incorporates design features but those features are not significant enough to add more than a very small amount of inherent distinctiveness to the applicant's mark. In addition, the applicant's wares and services in the present proceeding are broader than they were in the NEWS NOW Word Mark Decision, but that does not prevent me from reaching a conclusion similar to that expressed in the above quote.

Mr. Mumford attests that the applicant began use of its NEWS NOW Design mark at least as early as September 7, 1998 in association with the applied-for services. He has shown use of the trade-mark on broadcasts from 2000, web sites dated 2000, and an undated promotional brochure. The trade-mark is used, *inter alia*, by being prominently displayed on the sets during news broadcasts. Mr. Mumford states that there were an average number of 146,500 viewers per newscast during any quarter hour segment during the fall of 2000. He also provides various other viewing statistics, such as that there were approximately 170,000 viewers of the 6 p.m. broadcast of the NEWS NOW show in the spring and fall of 1998. The NEWS NOW show, which since December 7, 1998 has used both the NEWS NOW and NEWS NOW Design marks, is broadcast on three television stations in southwestern Ontario everyday at 6 a.m. and 6 and 11 p.m. and weekdays at 7, 7:30, 8 and 8:30 a.m. and at noon.

There are also 8 additional updates daily.

Mr. Logan attests that the opponent commenced use of NOW in August 1981 and he provides a copy of the cover and masthead of the September 10, 1981 NOW magazine. He also states that the opponent has operated a web site since April 19, 1996. As Exhibit "I", Mr. Logan has provided a copy of the first page for the web site of July 27, 2000, which shows the opponent's NOW ON trade-mark at the top.

NOW magazine is published weekly in Toronto. Mr. Logan states that the audited circulation for the period January 2000 to March 2000 was 106,065 per week. He further states that the opponent's "Now web site" received 350,000 hits per month as of August 2000. We have not been provided with the numbers for either the magazine or the web site for any other time periods. (I take this opportunity to note that the opponent relied on use of only its NOW ON trade-mark in association with any Internet associated wares or services in its statement of opposition, not any of its other NOW marks.)

Mr. Logan states that t-shirts, coffee mugs, baseball caps, sweatshirts, watches, keychains, leather jackets, hockey pucks, pens, beer steins, and notepads are distributed for marketing purposes and that approximately 100 t-shirts and 100 hats were sold in 1999/2000. He has not however provided any evidence to show how the opponent's mark(s) are associated with such wares.

The length of time that the marks have been in use favours the opponent but the extent to which each of the marks NOW and NEWS NOW Design has become known favours the applicant.

In the NEWS NOW Word Mark Decision, Mr. Partington made the following comments about the wares and services at issue in that case, at page 7-8:

> **I find there to be little similarity in the applicant's wares and services and the opponent's "publication of newspapers, periodical publications and magazines". While the wares and services of both parties are directed to the dissemination of news and information, the media through which the information is transmitted by the parties to their respective clientele are quite distinct. Thus, the channels of trade of the parties generally appear to differ even though the opponent's magazine includes news articles and the applicant advertises its services in newspapers and other publications.**

To the extent that the parties' wares and services are similar in the present case to those at issue in the NEWS NOW Word Mark Decision, Mr. Partington's comments apply to the present case. However, it cannot be forgotten that the applicant has in this case also applied to register its mark for the opponent's primary wares, magazines.

The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Effem Foods Ltd. v. Export/Import Clic* (1993) 53 C.P.R. (3d) 200 at 203-4 (F.C.T.D.); *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd*. (1980), 47 C.P.R. (2d) 145 at 149 (F.C.T.D.), affirmed 60 C.P.R. (2d) 70]. The marks NOW and NEWS NOW Design resemble each other somewhat in appearance and sound but do not suggest any readily apparent ideas in common. Although marks should be

assessed in their entirety when determining matters of confusion, the first component of a mark is nevertheless considered more important for the purpose of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.), *K-Tel International Ltd. v. Interwood Marketing Ltd.* (1997), 77 C.P.R. (3d) 523 at 527 (F.C.T.D.)]. The fact that the word NOW appears larger than the word NEWS in the applied for mark does however negate this assumption to some degree.

As a surrounding circumstance, I note that Mr. Mumford has stated that he is not aware of any confusion between the applicant's NEWS NOW marks and the opponent's NOW magazine. It is of course not necessary for the opponent to evidence confusion in order for me to find that there is a likelihood of confusion but I am prepared to accord at least some weight to this surrounding circumstance with respect to the wares and services in use to date because both parties have carried on business concurrently in southern Ontario.

As a further surrounding circumstance, Mr. Mumford has introduced considerable evidence concerning the applicant's use of its word mark NEWS NOW. I agree that the NEWS NOW Design mark that is the subject of the present application would benefit from the reputation acquired by the associated mark NEWS NOW. However, I do not agree with the applicant's submission that it has a family of NEWS NOW marks, given that the alleged family consists solely of the word mark and one design version of the word mark [see *British Columbia Hydro and Power Authority v. Union Gas Limited* (1998), 85 C.P.R. (3d) 231].

According to the applicant, an additional surrounding circumstance is the fact that the Examiner did not cite any of the opponent's trade-marks during the prosecution of this application. However, a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have precedential value for this Board. [see *Interdoc Corporation v. Xerox Corporation*, unreported decision of the Trade-marks Opposition Board dated November 25, 1998 re application s.n. 786,491; *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 at 277; *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 at 386] Moreover, although the Examiner did not cite the opponent's marks, he/she did identify such marks as doubtful cases pursuant to subsection 37(3) of the *Trade-marks Act.*

Having considered all of the surrounding circumstances, I am satisfied that the applicant has met the legal onus on it to show that there is no reasonable likelihood of confusion between the applicant's NEWS NOW Design mark and each of the opponent's trade-marks NOW and NOW and Design, as of each of the material dates set out above, with respect to all of the services and wares, other than magazines. With respect to magazines, I am not satisfied on a balance of probabilities that an average consumer who has an imperfect recollection of the opponent's NOW trade-mark in association with magazines would not conclude on first impression that a magazine sold in association with the NEWS NOW Design mark shared the same source as the NOW magazine. There is no evidence that the applicant has used either its NEWS NOW or NEWS NOW Design mark with magazines. Nor is there any evidence that anyone has diluted the opponent's rights with respect to its NOW trade-mark in the field of magazines or that it is common for television broadcasters to also use their trade-marks in

association with magazines. Therefore, based on the opponent's NOW mark, the paragraph 12(1)(d) and non-distinctiveness ground of opposition succeed with respect only to magazines. The paragraph 12(1)(d) and non-distinctiveness grounds of opposition fail with respect to each of the remaining wares and services. The subsection 16(1) ground of opposition fails in its entirety, as it does not challenge the applicant's proposed use wares.

Before concluding, I wish to add that the applicant has satisfied me that there is not a reasonable likelihood of confusion between its NEWS NOW Design mark and the opponent's NOW ON trade-mark in respect of web sites. Although the opponent has the longer and more extensive use with respect to Internet services, the differences between these two marks, in appearance, sound and idea suggested, are more than sufficient to prevent confusion. In addition, I am satisfied that there is not a reasonable likelihood of confusion between NEWS NOW Design mark and the opponent's NOW MAGAZINE trade-mark. I reach this conclusion for reasons similar to those set out above with respect to the trade-mark NOW, but strengthened further by the fact that the opponent has not evidenced any use of its NOW MAGAZINE trade-mark.

In view of the above, and having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act,* pursuant to subsection 38(8) of the *Act* I refuse the application with respect only to magazines and reject the opposition with respect to each of the remaining wares and services. Authority for a split decision is set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

DATED AT TORONTO, ONTARIO, THIS 15TH DAY OF SEPTEMBER, 2003.

Jill W. Bradbury
Hearing Officer