

IN THE MATTER OF AN OPPOSITION
to application serial No. 600,008
by Clarco Communications Ltd.
for the trade-mark SASSY
filed by Matilda Publications Inc.
(successor in title to Fairfax Magazines Pty. Limited)

On February 1, 1988, Fairfax Magazines Pty. Limited filed an application to register the trade-mark SASSY for the wares "magazines." The basis for the application is that the mark SASSY was made known in Canada and was used in the United States of America since at least as early as "September, 1987."

The file record shows that the original applicant changed its name to Consolidated Magazines Pty. Limited ("Consolidated") on April 19, 1988 and that Consolidated assigned the subject application to Matilda Publications Inc. ("Matilda") on September 14, 1988.

The subject application was advertised for opposition purposes on September 21, 1988. The opponent Clarco Communications Ltd. ("Clarco") filed a statement of opposition on September 27, 1988, and later filed a revised statement in response to an objection raised by the Opposition Board - see the Office letter of October 21, 1988. A copy of the revised statement of opposition was forwarded to Matilda on February 23, 1989.

The grounds of opposition are summarized below:

(a) pursuant to Section 30(i), the applicant could not be satisfied that it was entitled to use the applied for mark SASSY because

(i) at the time of filing the application, the mark SASSY was confusing with the "trade mark SASS which had been previously applied for in Canada in association with identical wares,"

(ii) the applicant "knew that it had not made the trade mark known in Canada,"

(iii) the applicant did not use the applied for mark in the United States in association with magazines,

(iv) the applied for mark was not well known in Canada.

(b) the application does not comply with Section 30(c) because

(i) the application does not name "a country of the Union in which the applicant has used the mark,"

(ii) the application does not "contain the date from and the manner in which" the applicant made the mark known in Canada,

(c) pursuant to Section 16(1), the applicant is not the person entitled to registration because "the applicant had not made known the trade mark SASSY in Canada in association with magazines prior to November 27, 1987" and after November 27, 1987, the applied for mark was confusing with the opponent's trade-mark application serial No. 596,357 for SASS covering the same wares. [November 27, 1987 is the date the opponent Clarco filed its trade-mark application for the mark SASS.]

The applicant filed, and served, a counter statement generally affirming its entitlement to registration and the application's compliance with Section 30.

Clarco defaulted in filing evidence pursuant to Rule 43 of the Trade-mark Regulations but was granted leave pursuant to Rule 46(1) to file as its evidence the affidavit of Michael W. Clarke, President of Clarco. Matilda's evidence consists of the affidavit of Richard Latora, President of the opponent company.

There were no cross-examinations on the affidavit evidence. Both parties filed written arguments and both were represented at an oral hearing. The oral hearing in this matter was held concurrently with the oral hearing in Matilda's opposition to Clarco's application for the mark SASS - see Matilda Publications Ltd. v. Clarco Communications Ltd. (re application serial No. 596,357, September 30, 1992, yet unreported, TMOB).

Matilda's trade-mark application meets the formal requirements of Section 30(c) in (1) stating the date on which the mark was first made known in Canada, (2) naming the country of the Union in which the mark was used by the applicant, (3) describing the manner in which the applicant made the mark known in Canada, as can be seen from the following extract taken from the subject application:

"The Applicant has made the mark known in Canada ...by reason of having used the trade mark ... in the United States [condition (2) above] ... and advertising... in printed publications circulated in Canada [condition (3)] ... since at least as early as September 1987 [condition (1)]."

Matilda's evidence shows that the magazine SASSY was first advertised in Canada in the June 1, 1987 issue of ADWEEK magazine, Canadian circulation about 174 copies per issue. This was followed by advertising in the June 8, June 29, and August 24, 1987 issues of ADVERTISING AGE magazine, Canadian circulation about 1,483 copies per issue. There was further advertising in Canada via the August 24, 1987 issue of THE NEW YORK TIMES newspaper, Canadian circulation about 3,746 per issue, and in the magazine ADWEEK on September 7, 1987. A "preview" issue of the magazine SASSY (not the premiere issue) was distributed in Canada during the month of September, 1987; no circulation figures are given for the preview issue. The magazine SASSY has been available in Canada as a monthly publication since its premiere issue was distributed in Canada in February, 1988. The approximate circulation of SASSY magazine was 16,400 copies in September of 1988 increasing to 25,600 copies in August 1989.

It appears that the intention in publicising SASSY magazine in trade publications such as ADWEEK and ADVERTISING AGE was to solicit advertising for the new magazine. The target market for SASSY magazine is teenage girls.

Exhibit A-1 to Mr. Latora's affidavit is a copy of a "media

note" appearing in the June 1, 1987 issue of ADWEEK magazine. It announces that "Fairfax Magazines" plans to launch the magazine SASSY in the United States by March 1988. Fairfax Magazines is described as a subsidiary of the Australian company "John Fairfax."

Exhibit A-3 comprises copies of extracts from ADVERTISING AGE and ADWEEK magazines, and from the newspaper THE NEW YORK TIMES. THE N.Y. TIMES, August 24, 1987, extract relates that "John Fairfax Ltd." is starting the magazine SASSY in the United States. The ADWEEK extract dated September 7, 1987, relates that "John Fairfax & Sons" is starting the magazine. Two extracts from ADVERTISING AGE relate that "Fairfax Magazine Pty. Ltd." (apparently the original applicant herein) will be starting the magazine SASSY in the United States through its subsidiary "Fairfax Magazines (U.S.)." Fairfax Magazine Pty. Ltd. is described as "a division of John Fairfax Ltd."

It would appear from the above exhibit material, assuming that it has some reliability, that John Fairfax Ltd., an Australian company, was planning to introduce the magazine SASSY in the United States. What is not apparent is which corporate body was to carry out the plans of the parent company John Fairfax Ltd.

Mr. Latora's testimony, in paragraphs 1 to 4 of his affidavit, refers to various companies owned or associated with the Australian company John Fairfax Limited, including some of the above mentioned companies. However, his testimony is vague on which corporate entity was actually using the applied for mark SASSY prior to, and at, the date of use and making known claimed in the subject application, namely September 30, 1987.

As best as I am able to determine from Mr. Latora's testimony, it was Fairfax Publications (US) Inc., an affiliate of the original applicant Fairfax Magazines Pty. Ltd., that used the applied for mark in the United States prior to, and for a period of time after,

the relevant date September 30, 1987.

Mr. Latora states in paragraph 1 of his affidavit that the present applicant Matilda Publications Inc. was formerly Fairfax Publications (US) Inc.; however, no date for or circumstances surrounding the change, or corporate histories for those companies, are disclosed. It may be that the assignment dated September 14, 1988 from Consolidated to Matilda, referred to at the beginning of these reasons, was an attempt to "perfect" an application erroneously filed in the name of the original applicant. If so, the attempt does not succeed. An error in identifying an applicant in a trade-mark application cannot be rectified by a subsequent assignment to the proper applicant. An assignee cannot claim better rights in a trade-mark application than its assignor.

I find that the applicant Matilda has been unable to meet the onus on it to establish that its predecessor in title Fairfax Magazines Pty. Limited used the mark SASSY in the United States, and made the mark known in Canada, as claimed in the subject application. Accordingly, the opposition succeeds pursuant to Section 30(i).

If I am wrong in refusing the application for the above reasons, then I would be inclined to refuse the application for the reason that Matilda's evidence falls short of establishing that the applied for mark SASSY had become "well known" in Canada, as required by Section 5, at the relevant date September 30, 1987. For guidelines on criteria that qualify a mark as "well known" in Canada, see Re Andres Wines Ltd and E. & J. Gallo Winery (1975) 25 C.P.R.(2d) 126 at 136 (F.C.A) and Marine Inc. v. Marine Wonderland (1974) 16 C.P.R.(2d) 97 at 111 (F.C.T.D.).

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 30th DAY OF September, 1992.

Myer Herzig,
Member,
Trade-marks Opposition Board