

IN THE MATTER OF AN OPPOSITION  
by Matilda Publications Inc.  
to application serial No. 596,357  
for the trade-mark SASS  
filed by Clarco Communications Ltd.

On November 27, 1987, Clarco Communications Ltd. ("Clarco") filed an application to register the trade-mark SASS for "magazines" based on proposed use in Canada. The application was advertised for opposition purposes on March 16, 1988. Fairfax Publications Pty Ltd., the original opponent, filed a statement of opposition on March 30, 1988.

The grounds of opposition are that Clarco is not the person entitled to registration, pursuant to Section 16(3)(a) of the Trade-marks Act, that the applied for mark SASS is not distinctive of the applicant's magazines, and that Clarco could not have been satisfied that it was entitled to use the mark SASS, pursuant to Section 30(i). The last ground of opposition, as pleaded, does not stand alone but depends on a finding for the opponent on either of the other grounds.

The above grounds are based on the opponent's allegations that another mark, namely SASSY, was used or made known in Canada in association with magazines prior to Clarco filing its application for SASS. The opponent's allegations are pleaded in general terms and do not limit the opponent to relying on its own use or making known of the mark SASSY.

Clarco requested and was granted a retroactive extension of time to file and serve its counter statement - see the Office letter dated August 26, 1988.

In its counter statement, Clarco generally affirms that its application is in compliance with Section 30, that it is the person entitled to registration, and that the applied for mark SASS is distinctive of its magazines. Clarco also pleads that the mark SASSY "had not been previously made known in Canada within the meaning of Section 5 of the Act."

By letter dated October 31, 1988, the opponent advised the Office that the statement of opposition originally filed erroneously named "Fairfax Publications Pty. Ltd." as the opponent. The opponent should have been identified as "Fairfax Magazines Pty Limited." Apparently, the error occurred because of a mix-up with the name of the (correct) opponent's subsidiary company. The opponent also advised that it changed its name to Consolidated Magazines Pty Limited ("Consolidated") on April 19, 1988, and further, that Consolidated assigned its rights in the mark SASSY to Matilda Publications Inc. ("Matilda") on September 14, 1988.

Clarco filed a cursory and unsubstantiated objection to the opposition continuing in Matilda's name - see its letter dated November 4, 1988. The Office accepted the opponent's above representations - see the Office letter dated November 18, 1988 - and the opposition continued in Matilda's name.

Matilda filed the affidavit of Sandra Yates, President of the opponent company, in support of its opposition. Clarco filed the affidavit of Kelly A. Falls, its Account Manager, in support of its application. Matilda subsequently filed the affidavit of Richard Latora, its successor President, in reply to Clarco's evidence.

There were no cross-examinations on the affidavit evidence filed. 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 Clarco's opposition to Matilda's application for the mark SASSY (serial No. 600008), referred to earlier.

Clarco's magazine SASS was first advertised in Canada in the December 1987 issue of MARKETING magazine, circulation about 11,000 per issue, as well as in Clarco's own trade magazine COSMETICS, circulation about 12,000 per issue. SASS magazine appeared as a

supplement to the March/April 1988 issue of COSMETICS BEAUTY GUIDE magazine, circulation about 225,000 per issue.

A further 150,000 copies of the above mentioned SASS supplement circulated independently in Canada, in or about the month of April, 1988, as the premiere "Summer 1988" issue of SASS magazine. There is no evidence that a second issue of SASS magazine ever appeared.

SASS magazine is a "lifestyle" publication concerning itself with fashion, beauty, health, sex, music, and other topics particularly of interest to teenage girls. In this respect, SASS magazine is indistinguishable from SASSY magazine.

Matilda's evidence is that SASSY magazine 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 SASSY magazine (not the premiere issue) was distributed in Canada during the month of September, 1987; no circulation figures are given for the preview issue. SASSY magazine 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.

In the parallel proceeding referred to earlier, see Clarco Communications Ltd. v. Matilda Publications Inc. (re application serial No. 600008 for the mark SASSY, September 30, 1992, yet unreported, TMOB), Clarco opposed Matilda's trade-mark application

for SASSY. Briefly, Clarco's pleadings in its statement of opposition alleged that Matilda's predecessor in title did not use the mark SASSY as claimed in the trade-mark application. Clarco was able to rely on Matilda's own evidence to support its allegation. Matilda was unable to establish that its predecessor in title Fairfax Magazines Pty Limited used the mark SASSY as claimed. The application was refused for that reason.

Matilda's evidence as opponent in this proceeding is essentially the same as its evidence qua applicant in the above mentioned proceeding. Moreover, in the instant proceeding, Matilda relied on alleged use of the mark SASSY by its predecessor in title Fairfax Magazines Pty Limited in order to gain standing as the opponent. The issue of whether Matilda was entitled to rely on use of the mark SASSY by Fairfax Magazines Pty Limited in order to gain standing as opponent did not arise. Clarco might have raised the above issue in an amended counter statement, or otherwise, prior to the oral hearing at any time after Matilda filed its evidence. Clarco did not do so. Accordingly, Matilda's standing as opponent is not in issue in this proceeding.

With respect to the ground of opposition pursuant to 16(3) (a), the opponent Matilda is required to show that it or its predecessor in title used or made the mark known, and did not abandon the mark, as set out in Sections 17(1) and 16(5), respectively. Section 17(1) reads as follows:

No application for registration of a trade-mark...shall be refused...on the ground of any previous use or making known of a confusing trade-mark by a person other than the applicant, **except at the instance of that other person or his successor in title...**

(emphasis added)

Matilda's evidence is vague as to which person used and made the mark SASSY known in Canada prior to and at the relevant date

November 27, 1987. As best as I am able to determine from the evidence, it was Fairfax Publications (US) Inc. that used and advertised the applied for mark prior to, and for a period of time after, the material date. Mr. Latora asserts that Matilda was formerly Fairfax Publications (US) Limited but no date or circumstances surrounding the change, or the corporate histories of those companies, are disclosed in the evidence. I am not satisfied that Matilda has established that it, or its predecessor in title Fairfax Magazines Pty Limited, used or made the mark SASSY known in Canada as required by Section 17(1). Accordingly, the ground of opposition pursuant to Section 16(3)(a) need not be considered further.

With respect to the ground of opposition alleging that the applied for mark SASS is not distinctive, the opponent Matilda is not limited to relying on its own use or making known of the mark SASSY - it may rely on third party use or making known. The onus or legal burden is on the applicant Clarco to show that its mark SASS is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada, and the material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case March 30, 1988 - see Faber-Castell Canada Inc. v. Dixon Ticonderoga Inc. (1992) 41 C.P.R.(3d) 284 at 287 (TMOB). In deciding the issue of distinctiveness, I am permitted to consider both parties' sales and advertising under their marks SASS and SASSY in the time period between the filing of the application and the statement of opposition - see Castle & Cooke, Inc. v. Popsicle Industries Ltd. (1990) 30 C.P.R.(3d) 158 (TMOB).

I conclude from the evidence that the marks SASS and SASSY had become known in Canada to a limited extent at the material date March 30, 1988. The marks became known in Canada as a result of advertisement in printed publications circulated in Canada, and as a result of actual distribution of the magazines SASS and SASSY in

Canada. Considering that there is a high degree of resemblance between the marks SASS and SASSY in all respects, that the marks appear on identical wares which would travel through the same channels of trade, and that the marks were first used and made known in Canada at about the same time, I find that the applicant has not met the onus on it to show that the applied for mark SASS was distinctive of its magazine at the material date. The outcome would likely have been the same had I not considered the parties' evidence relating to the time after the date of filing the subject application.

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