

**SECTION 45 PROCEEDINGS
TRADE-MARK: YOUR YEAR'S HORIZONTAL PLANNING
AT A SINGLE GLANCE
REGISTRATION NO.: 257,847**

On December 28, 1995, at the request of Cullman Ventures Inc., represented by the firm Bennett Jones Verchere, the Registrar forwarded a Section 45 notice to Quo Vadis International Ltée, the registered owner of the above-referenced trade-mark registration.

The trade-mark YOUR YEAR'S HORIZONTAL PLANNING AT A SINGLE GLANCE is registered for the wares: "Printed publications, namely, diaries and calendars".

In response to the Registrar's notice, the registrant furnished the affidavit of Docteur Francis Beltrami. Each party filed a written submission and was represented at an oral hearing. The hearing was in respect of three separate Section 45 proceedings involving the same parties and similar marks; however, a separate Section 45 decision is being issued in each case.

In his affidavit, Mr. Beltrami alleges continuous use of the trade-mark in association with "diaries and calendars". He attaches as Exhibit A, specimens of "diaries" and he submits that pages of the diaries bearing the trade-mark have been "identifiées d'un auto-collant". He attaches as Exhibit B, a photograph and a photocopy of a calendar. He explains that the diaries of Exhibit A and the calendars of Exhibit B are sold and offered for sale on the Canadian market through "papetiers, librairies, et fournisseuristes de bureau". At paragraph 7, he provides the Canadian sales figures concerning such diaries and calendars and the figures with respect to the quantities of diaries and calendars sold in 1993, 1994 and 1995, which he states bore the trade-mark.

The requesting party's arguments may be summarized as follows:

1. The bare allegations of use in the affidavit are insufficient to show use as required by the Act;
2. a) Concerning the wares diaries, none of the diaries bear the trade-mark on their covers or on the inside front cover. The mark (if it is used at all) is somewhere in the interior of the diary, and such use is not use in a trade-mark sense with wares, i.e., to distinguish the registrant's diaries. At most, it distinguishes certain pages within the diary from other pages in the same diary;

b) That to be used as a trade-mark, the mark must be something that can be seen (*Playboy Enterprises Inc. v. Germain* (No.1), 16 C.P.R.(3d) 517 at page 523); that here the mark is not brought to the attention of persons to whom the property or possession in the diary is transferred as required pursuant to Section 4(1) of the Act;

c) Furthermore, the mark as it appears in the interior of the diary is not the mark as registered;

3. a) Concerning the wares calendars, only Exhibit B purports to show use of the mark with such wares. However, Exhibit B does not show use of the trade-mark as registered;

b) Even if considered use of the trade-mark as registered, there is no evidence of how possession or property of the calendars is transferred in the normal course of trade, and consequently, no evidence that the wording on the calendar is visible to a purchaser at the time of transfer;

4. The affidavit contains false statements in view of the particular words in the affidavit concerning the trade-mark appearing in the diaries and on the calendars, therefore the balance of the evidence is untrustworthy (see *Aerosol Fillers Inc. v. Plough (Canada) Ltd.*, 53 C.P.R.(2d) 62).

Concerning the wares “diaries”, I agree with the requesting party that the diaries show marks that differ from the registered mark. The diary marked “Planning 66” shows the following:

The words “YEAR” and “HORIZONTAL” have been inverted vis-à-vis the registered mark.

The other diaries show:

The word “HORIZONTAL” has been omitted.

Concerning this latter mark, as I consider the word “HORIZONTAL” in the registered mark to be one of the main and dominant element of the registered mark, the use of the expression YOUR YEAR’S PLANNING AT A SINGLE GLANCE, which omits the word “HORIZONTAL”, in my view, results in the use of a mark that deviates *substantially* from the trade-mark as registered; particularly since the phrase being used has a meaning that is different from the phrase that is registered. Consequently, the use of the words “YOUR YEAR’S PLANNING AT A SINGLE GLANCE” would not be perceived as use of the registered trade-mark, YOUR YEAR’S HORIZONTAL PLANNING AT A SINGLE GLANCE.

Concerning the use of the expression “YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE” as found in the diary marked “Planning 66”, I find the inversion of the words HORIZONTAL and YEAR to consist of a minor modification and I am of the view that such deviation would not deceive or injure the public in any way. The dominant elements of the trade-mark have all been preserved and therefore I conclude that the mark YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE is not substantially different from the trade-mark as registered and would be perceived as use of the registered mark (see *Munsingwear Inc. v. Promafil Canada Ltée*, 44 C.P.R.(3d) 59).

However, the requesting party submits that it is the phrase DIARIZON ® YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE, that is used in the diary marked “Planning 66”, and that it is the word DIARIZON that would be perceived as the trade-mark used, while the expression YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE would only be perceived as descriptive matter; alternatively, it submits that it is the whole expression “DIARIZON” YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE that would be perceived as the trade-mark being used. In support of its argument, it relies on *Compagnie Internationale pour l’Informatique CII Honeywell Bull v. Herridge, Tolmie and Registrar of Trade-marks*, 4 C.P.R.(3d) 523, and *Burroughs Wellcome Inc. v. Kirby, Shapiro, Eades & Cohen*, 73 C.P.R.(2d) 13.

In my view, the present case can be distinguished from the *Honeywell Bull* case as the phrase “YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE” and the word “DIARIZON” do not appear so closely together as to only be seen as forming one composite trade-mark. I find it is quite probable that the two expressions would also be seen as two separate expressions and this impression is reinforced by the appearance of the ® indicia after the word “DIARIZON” which would serve as an indicator that the word “DIARIZON” is a separate trade-mark from the expression “YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE”.

Concerning the requesting party’s argument that the phrase “YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE” would not be perceived as a trade-mark but would be

perceived as merely descriptive matter, I find the matter is not easily answered. In my view, the trade-mark is highly suggestive in association with diaries. Consequently, I find it is arguable whether the phrase as used would be perceived as a trade-mark. Nevertheless, this phrase is registered as a trade-mark and I must say that although I have some doubts, I am not convinced that as used, it would not be perceived as functioning as a trade-mark, i.e., to distinguish the registrant's wares from the wares of others. I would add that the fact that the word "DIARIZON" is followed by the ® symbol while the phrase "YOUR HORIZONTAL YEAR'S PLANNING AS A SINGLE GLANCE" is not so identified is not determinative of the issue. As clearly pointed out by the registrant, the use of the ® or any other indicia to identify a trade-mark on wares or packaging is not necessary in law (see *A.W. Allen Ltd. v. Warner-Lambert Canada Inc.*, 6 C.P.R.(3d) 270).

The next issue is whether the phrase is used as trade-mark for "diaries". The requesting party then argued that in view of the location of the mark inside the diary, the phrase does not function as a trade-mark for diaries as it is not used to distinguish the diaries in question but, at most, certain pages within the diaries; it adds that there is no evidence that it would be seen at the time of transfer or brought to the attention of the purchaser to whom the property in or possession of the wares is transferred and therefore, as it would not be visible, it is not a mark and it relies on the *Playboy* case, *supra*.

At the outset, I would agree with counsel for the registrant that the *Playboy* case is not applicable to the present situation. The *Playboy* case stands for the principle that the use of a verbal description is not use as a trade-mark since a mark must be something that can be represented visually. In the present case, the trade-mark is represented visually inside the diary. Consequently, the *Playboy* case is far removed from what we are dealing with here.

It is true the trade-mark does not appear on the cover of the diaries; it appears inside the diaries, i.e., on certain pages of the registrant's diaries. Consequently, the trade-mark is not visible on the outside. Therefore, one issue is whether the use shown meets the requirements of Section 4(1) of the Act. The registrant submits that because of the nature of the wares, the trade-mark would be seen by the purchaser of the wares at the time of transfer. It submits that a customer wishing to purchase

a “diary” would, prior to purchasing the wares, probably flip through the pages of the diary to determine whether it is the type of diary the customer wishes to purchase. It points out that “diaries” are wares bought for their features and usefulness.

Although this is not in evidence, I find it reasonable to infer that a “diary” would be a product purchased for its features. Consequently, I accept the registrant’s argument that the purchaser of a diary would probably have flipped the pages of the diary prior to purchasing it, and because the trade-mark appears right at the beginning of the diary, the purchaser would probably have noticed the trade-mark in association with the wares prior to having purchased the diary.

Concerning the requesting party’s argument that the diaries may be packaged and therefore the trade-mark would not be visible, as the evidence does not show this to be the case, I am not prepared to conclude as such.

As to whether the mark as it appears inside the registrant’s diaries is used as a trade-mark for “diaries”, again I must say that this question is not easily answered. I would agree that the mark would probably be seen as distinguishing a particular feature of the registrant’s diaries. However, it may be that the registrant’s customers would then come to associate such phrase with certain diaries of the registrant and therefore would recognize it as a trade-mark for some of the registrant’s diaries. Consequently, for purposes of Section 45, I am prepared to conclude but not without difficulty that the use shown is use as a trade-mark for diaries.

Concerning the wares “calendars”, I conclude that the phrase YOUR HORIZONTAL YEAR’S PLANNING AT A SINGLE GLANCE as used on the registrant’s calendars (Exhibit B) constitutes use of the registered trade-mark, and is use as a trade-mark for calendars for reasons similar to that found for the diaries.

Concerning the requesting party’s submissions that it is unclear whether the trade-mark is visible to a purchaser at the time of transfer, I am satisfied that Exhibit B clearly shows that the trade-mark appears on the front of the “calendars” and, I see no basis for concluding that this is not how the

mark would be presented to the public. Consequently, I conclude that the evidence shows the required association between the trade-mark and the wares “calendars” at the time of transfer.

As for the requesting party’s argument that the affidavit contains false statements with respect to the trade-mark shown in the diaries and on the calendars submitted in evidence, although I agree that the affiant has alleged that the diaries and calendars submitted in evidence bore the phrase YOUR YEAR’S HORIZONTAL PLANNING AT A SINGLE GLANCE while in effect, the diaries and calendars bear variations of the trade-mark, I accept the explanations given by counsel for the registrant to the effect that the affiant is not an “expert” in trade-mark matters and therefore would not have been aware of the issue of the “deviation” of the mark. In my view, the affidavit must be taken at its face value, and good faith must be presumed. I see no basis here for concluding otherwise.

Considering the sales figures, I accept that a portion of the figures provided with respect to the diaries and calendars submitted in evidence, would be in respect of the diary that I have concluded shows use of the trade-mark as registered and with calendars bearing the trade-mark. Consequently, I am satisfied that the evidence shows that the registered trade-mark was used in association with diaries and calendars during the relevant period.

In view of the evidence furnished, I conclude that the subject trade-mark ought to be maintained on the register.

Registration No. 257,847 will be maintained in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 28th DAY OF APRIL 1997.

D. Savard
Senior Hearing Officer
Section 45 Division