



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 4
Date of Decision: 2012-01-12

**IN THE MATTER OF AN OPPOSITION
by Sun Media Corporation to application
No. 1,353,764 for the trade-mark
SUNWEEKLY & design in the name of
The Montreal Sun (Journal Anglophone),
inc.**

Introduction

[1] On June 22, 2007, The Montreal Sun (Journal Anglophone), inc. (the Applicant) filed an application to register the trade-mark SUNWEEKLY & design, application number 1,353,764, as hereinafter illustrated:



(the Mark)

[2] The application is based on proposed use in Canada and covers the following wares: Souvenir articles promoting a newspaper (primarily in Quebec), namely mugs, plastic-bottles, shirts; advertising-materials (leaflets, business-cards and posters) (the wares); and the publication of a newspaper relating to Montreal published primarily in Quebec distributed in electronic form over the internet (the Services). The application was advertised on July 23, 2008 in the *Trade-marks Journal* for opposition purposes.

[3] Sun Media Corporation (the Opponent) filed a statement of opposition on September 11, 2008 which was forwarded by the Registrar on October 9, 2008 to the Applicant. On November 28, 2008 the Applicant filed what has been identified as a counter statement. It contains no direct denials of the Opponent's allegations. It also contains evidence and arguments to support the Applicant's application.

[4] The Opponent filed as its evidence the affidavit of Liza Saltzman while the Applicant filed the sworn statement of Mr. Ronald Cooney. None of the deponents were cross-examined.

[5] Both parties filed written arguments. The Applicant requested a hearing but informed the Registrar that it could not attend such hearing at the scheduled date. Therefore the hearing was cancelled and the parties were informed on December 15, 2011 that a decision would be issued in the near future.

The Grounds of Opposition

[6] The grounds of opposition pleaded are:

1. The application does not comply with the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985 c. T-13 (the Act) in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the wares and services described in the application;
2. The application does not comply with the requirements of s. 30(a) of the Act in that the Applicant has not provided a statement in ordinary commercial terms of the specific wares and services in association with which the Mark is proposed to be used;
3. The Mark is not registrable in view of s. 12(1)(d) of the Act because it is confusing with the following Opponent's registered trade-marks:

THE SUN (TMA313,825)
THE WINNIPEG SUN (TMA473,276)
THE TORONTO SUN SYNDICATE & Design (TMA239,440)
THE TORONTO SUN & Design (TMA239,586)
THE TORONTO SUN & Design (TMA239,437)
THE TORONTO SUN & Design (TMA240,110)
THE SUNDAY SUN (TMA201,948)
THE SATURDAY SUN (TMA344,103)
THE OTTAWA SUN & Design (TMA366,923)
THE OTTAWA SUN & Design (TMA386,601)
THE OTTAWA SUN (TMA 366,894)
THE EDMONTON SUNDAY SUN (TMA235,751)

THE EDMONTON SUN Design (TMA244,801)
THE EDMONTON SUN (TMA237,431)
THE EDMONTON DAILY SUN (TMA235,559)
THE CALGARY SUN & Design (TMA276,154)
THE CALGARY SUN (TMA250,371)
TELEVISION SUNDAY SUN & Design (TMA239,593)
SUNDAY SUN COMICS & Design (TMA239,594)
SUNDAY SUN & Design (TMA239,438)
SUN MEDIA (TMA538,464)
SUN & Design (TMA236,427)
SUNDAY SUN & Design (TMA241,670)
THE EDMONTON SUN & Design (TMA236,763)
SUN COUNTRY (TMA518,719)
SUN SAVER (TMA608,044)
THE ITALIAN SUN (TMA677,089)

registered and used in association with periodical publications;

4. Pursuant to s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive within the meaning of s. 2 of the Act because it does not distinguish and is neither adapted to distinguish nor capable of distinguishing the wares and services of the Applicant as described in the application, from the wares and services associated with which the Opponent's aforementioned trade-marks are and have been used in Canada.

Burden of Proof in Trade-marks Opposition Proceedings

[7] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [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].

Disposition of Certain Grounds of Opposition

[8] All that is required from an applicant under s. 30(i) of the Act is to provide a statement that it is satisfied that it is entitled to use the trade-mark applied for in Canada in association with the wares and services described in the application. The application filed does contain such statement. A s. 30(i) ground of opposition should only succeed in exceptional cases such as

where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155]. Therefore the first ground of opposition is dismissed.

[9] The Opponent has failed to meet its initial onus of proof with respect to the second ground of opposition. There is no evidence to support its contention that the Wares or the Services would not be defined in ordinary commercial terms. The second ground of opposition is also dismissed.

[10] As for the fourth ground of opposition (distinctiveness), the Opponent has to prove that any of its trade-marks had become sufficiently known at the relevant date to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58(F.C.T.D.)]. There is no such evidence in the record. This ground of opposition is as well dismissed.

Registrability of the Mark under s. 12(1)(d)

[11] The relevant date for the analysis of a ground of opposition based on s. 12(1)(d) of the Act 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)].

[12] The test to determine if there is a likelihood of confusion is set out in s. 6(2) of the Act and I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5) of the Act: 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 in the ideas suggested by them. I refer to the decision of the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 for an analysis of those criteria.

[13] Ms. Saltzman has been the Director of the trade-marks searches at Marque d'Or Inc. She states that she has access to a database containing the Canadian register of trade-marks which is updated on a weekly basis. Her services were retained by the Opponent's agent. She was asked

to obtain extracts of the Canadian register of all active and inactive registered trade-marks of the Opponent having the component SUN as part of the trade-mark. She filed the results as Exhibit A to her affidavit. There is no evidence of use of any of these trade-marks in the record. The extracts filed include the registrations listed under this ground of opposition but also others. I shall only consider those listed under the third ground of opposition.

[14] The registered trade-marks listed above can be grouped into different categories: THE SUN (word mark), THE [name of a city] SUN trade-marks (for example THE EDMONTON SUN), THE [name of a city] SUN & circle Design trade-marks, (THE OTTAWA SUN & Design being illustrated as an example:



TMA366,923). There are also trade-marks that incorporate the combination of the name of a day of the week (SUNDAY for example) with the word SUN. I refer to THE SUNDAY SUN, THE SATURDAY SUN, SUNDAY SUN & Design and SUNDAY SUN COMICS & Design. In view of the relevant date (date of my decision) registration TMA TMA344,103 for the trade-mark THE SATURDAY SUN & Design shall not be considered as part of the last group as it has been expunged.

[15] The best case scenario for the Opponent is by comparing the Mark with the Opponent's registered trade-marks that have a day of the week designation as opposed to a location designation, namely THE SATURDAY SUN and THE SUNDAY SUN. If the Opponent is not successful with any of them, it would not achieve a better result with the remaining registered trade-marks, because they suggest a location as opposed to a time period.

[16] I checked the register and registrations TMA201,948 for the trade-mark THE SUNDAY SUN and TMA344,103 for the trade-mark THE SATURDAY SUN are in good standing. Consequently the Opponent has met its initial burden of proof. The Applicant has now the onus

to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's aforesaid trade-marks.

Inherent distinctiveness of the marks and the extent to which they have become known

[17] I note that the Mark is a coined word but composed of the English words SUN and WEEKLY. The word SUN has no meaning when used in association with periodical publications. However the addition of the words WEEKLY, SUNDAY or SATURDAY makes the combination suggestive of the day or frequency of the publication. The addition of a design element in the Mark makes it more distinctive than the Opponent's aforesaid trade-marks. Nonetheless I do not consider the design portion of the Mark to be a strong and dominant feature of the Mark.

[18] The degree of distinctiveness of a trade-mark may be enhanced through use or promotion. The Applicant's application is based on proposed use and there is no evidence in the record of its use in Canada. There is also no evidence of use or making known of any of the Opponent's registered trade-marks.

[19] The Opponent has established ownership of at least 25 registered trade-marks. Even though it does represent a significant number of registrations which could infer that the Opponent may have a certain presence in the Canadian marketplace, the existence of these registrations, without any actual evidence of use, is not sufficient to draw any conclusion in favour of the Opponent as to the extent to which these trade-marks have become known.

Length of time the trade-marks have been in use

[20] There is no evidence of use of the Mark. For the purpose of determining the length of time the Opponent's trade-marks have been use, the Registrar may refer to the information contained in the registrations [see *Cartier Men's Shops Ltd. v. Cartier Inc.* (1981), 58 C.P.R. (2d) 68, at 71]. The Opponent's registrations do contain a statement of use of the trade-marks or a claimed date of first use. However, the Registrar can only conclude to *de minimis* use of those trade-marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d)

427]. Even though this factor might slightly favour the Opponent I do not consider it as a determining factor.

Nature of the wares and services and their channels of trade

[21] For the purpose of this criterion I shall refer to THE SATURDAY SUN registration as it covers not only periodical publications, as with THE SUNDAY SUN, but also other relevant wares that overlap with the Wares and Services as discussed hereinafter.

[22] There is definitely an overlap in the nature of the Services and periodical publications covered by the Opponent's registrations. The fact that the Applicant intends to publish a newspaper and distribute it by way of electronic means does not alter the fact that such service overlap the nature of the Opponent's wares, namely a periodical publication. The Opponent has not limited its registration to conventional paper form.

[23] As for the Wares, there is also an overlap with some of the wares covered by THE SATURDAY SUN registration: mugs and insulated bottles. Finally, it appears from a reading of the description of the Wares and Services that the advertising material's primary purpose is to promote the Services. Since I already ruled that there is a connection between the Services and the Opponent's periodical publications, if I conclude that there is a likelihood of confusion between the Mark and THE SATURDAY SUN in so far as the Services are concerned, the same conclusion would apply for the advertising material used to promote the Services.

[24] The Applicant is arguing that the Mark, as described in the application, is restricted to the Province of Quebec while the Opponent's registrations include the names of Canadian Cities outside the province of Quebec such as Ottawa, Toronto, Winnipeg, Edmonton and Calgary. However the Opponent's registrations for THE SATURDAY SUN and THE SUNDAY SUN do not contain a territorial reference or restriction. Therefore there is a potential overlap in the parties' respective channels of trade.

[25] In its recent judgment in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.* 2011 S.C.C. 27 the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under s. 6(5) of the Act is often the degree of resemblance between the marks. It becomes

even more important when the wares and/or services are similar. One must look at the marks in their totalities and should not dissect each one of them into its components.

[26] The distinctive element of the parties' trade-marks is the word SUN. The word WEEKLY added to SUN, when used in association with the Services suggests that the periodical is issued on a weekly basis while the addition of the words SATURDAY or SUNDAY to SUN, suggests that such periodicals are issued on those days of the week. Therefore a consumer, familiar with the Opponent's trade-marks, may very well think when seeing the Mark, that the Opponent is the source of this new periodical which would issue on a weekly basis. I do not consider the design portion of the Mark to be so highly distinctive that it could serve to distinguish it from the Opponent's trade-marks THE SATURDAY SUN or THE SUNDAY SUN.

[27] Mr. Cooney's sworn statement deals mainly with the state of the register. He filed extracts of the register. In its written argument the Applicant does refer to some of the extracts annexed to Mr. Cooney's sworn statement. I eliminated those owned by the Opponent. I am also disregarding those that contain the name of a Canadian city between THE and SUN as they are easily distinguishable from the Mark. There remains 9 potential relevant citations which are:

SUNPLAZA, TMA500,626 for online catalogue featuring computer hardware;
SUN BLADE, TMA650,434 for computer related services including the design of web pages;
SUN, TMA523,554, for newsletters relating to the nursing profession;
SUN, TMA605,552 for printed publication in the field of computer and information technology;
SUNSCAPE, TMA500,372 for magazines, brochures and pamphlets relating to solar energy;
SUNBEAMS, TMA535,817 for printed publications relating to pedagogy, education, teaching and learning all aspects of music;
SUN CRUISES, TMA543,873 for printed publications relating to travel, holidays and leisure activities;
SUN-PROOF SUN-SMART, TMA520,366 for educational material on solar protection, namely: books and magazines;
SUN SPORTS, TMA496,754 for newspaper published primarily in British Columbia.

[28] Most of these citations are without any doubt distinguishable. The only common element is SUN. The Applicant is trying to argue that such word is a weak trade-mark when used in association with printed material. However the additional component(s) makes these trade-marks different visually, in sound and ideas suggested. Moreover the wares and services covered by

these registrations are printed publications in a specific area. The only relevant citation is SUN SPORTS. However only one citation from the register is not sufficient to draw any inferences about the state of the marketplace [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[29] I wish to refer to the following extracts of the judgment of the Supreme Court of Canada in *Mattel, Inc. supra*:

25 The onus remained throughout on the respondent [the applicant] to establish the absence of likelihood, but the Board was only required to deal with potential sources of confusion that, in the Board's view, have about them an air of reality.

(...)

31 The respondent is not entitled to registration of its trade-mark unless it can demonstrate that use of both trade-marks in the same geographic area will not create the likelihood of confusion, i.e. mistaken inferences in the marketplace. If, on a balance of probabilities, the Board is left in doubt, the application must be rejected.

[30] There is a similarity in the nature of the parties' respective wares and services. There is some similarity in the marks in issue as they both include the distinctive word SUN. I acknowledge the fact that the Mark contains a design feature but the idea suggested by the word portion is that the newspaper would be published on a weekly basis while the Opponent's trade-marks suggest that the publications associated with those marks issue on Saturday and Sunday. Consequently, I conclude that the Applicant has not discharged its burden to prove, on a balance of probabilities, that the Mark would not likely cause confusion with the Opponent's registered trade-marks THE SATURDAY SUN and THE SUNDAY SUN. At the very best for the Applicant I would be in doubt and such situation must be resolved in favour of the Opponent.

[31] For all these reasons, the third ground of opposition is maintained.

Conclusion

[32] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office