

**IN THE MATTER OF AN OPPOSITION
by VV Publishing Corporation to applica-
tion No. 681,821 for the trade-mark
THE VOICE filed by Hossam Shaltout**

On May 10, 1991, the applicant, Hossam Shaltout, filed an application to register the trade-mark THE VOICE for "newspapers and magazines" based on proposed use in Canada. The application was advertised for opposition purposes on December 18, 1991.

The opponent, VV Publishing Corporation, filed a statement of opposition on April 15, 1992. A copy of the statement of opposition was forwarded to the applicant on May 29, 1992 and a further copy was forwarded on June 10, 1992. The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Trade-marks Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-marks THE VILLAGE VOICE and VOICE previously used in Canada by the opponent in association with "printed publications in the nature of newspapers." The second ground is that the applied for trade-mark is not distinctive in view of the opponent's use of its two trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of its President, David Schneiderman. As its evidence, the applicant filed several items but they were not in the form of an affidavit or statutory declaration as required by Rule 44 of the Trade-marks Regulations. The applicant's evidence is therefore inadmissible. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

During the course of the oral hearing, the opponent's agent sought to rely on three trade-mark registrations owned by the opponent. The applicant objected to the opponent's reliance on those registrations. I indicated that I would not have regard to those three registrations because it would be unfair since the opponent did not previously evidence their

existence. In this regard, reference may be made to the opposition decision in Realestate World Services (1978) Ltd. v. Realcorp Inc. (1993), 48 C.P.R.(3d) 397 at 403-404.

As part of his submissions at the oral hearing, the applicant contended that the Schneiderman affidavit was not a proper affidavit since it was executed in the United States and it contained no reference to perjury as a possible punishment for false statements. The applicant, however, did not provide any authority for such a requirement. Since Mr. Schneiderman swore his affidavit before a notary public in New York State, I consider that it is admissible in this proceeding: see the opposition decision in Panzani Milliat Frere v. Vagos' Importers and Distributors Ltd. (1988), 19 C.P.R.(3d) 463.

As for the first ground of opposition, the opponent has the initial burden of evidencing use of its trade-marks prior to the applicant's filing date and to show non-abandonment of its marks as of the applicant's advertisement date. Appended to Mr. Schneiderman's affidavit is a copy of the December 15, 1992 issue of his company's publication The Village Voice. That copy illustrates use of both the trade-marks VOICE and THE VILLAGE VOICE. The applicant contended that the December 15, 1992 issue of the opponent's newspaper does not satisfy the initial burden on the opponent since the publication date is after the applicant's filing date. However, in paragraph 4 of his affidavit, Mr. Schneiderman states that the December 15, 1992 issue is a "typical issue" of his company's newspaper and he has evidenced steady sales of that paper in Canada for many years prior to the applicant's filing date. Thus, I consider that the opponent has shown prior use and non-abandonment of its two marks. If the applicant had doubts about the accuracy of Mr. Schneiderman's statements, he could have cross-examined Mr. Schneiderman on his affidavit. (The applicant contends that he was denied an opportunity to cross-examine Mr. Schneiderman but he did not make a timely request for an order.)

In view of the above, the first ground remains to be decided on the issue of confusion between the marks of the parties. The material time for considering the circumstances respecting this issue is as of the applicant's filing date in accordance with the clear wording

of Section 16(3)(a) of the Act. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive. However, to the extent that each mark includes the word "voice", each mark is at least slightly suggestive of newspapers or magazines which typically are expected to publicize or "voice" a particular point of view. Thus, none of the marks at issue is inherently strong.

There being no admissible evidence from the applicant, I must conclude that his mark had not become known at all in Canada as of the material time. The Schneiderman affidavit establishes that the opponent has published a New York City-based weekly newspaper bearing the trade-marks THE VILLAGE VOICE and VOICE for a number of years and that the newspaper has a steady, although not extensive, circulation throughout Canada. I can therefore conclude that the opponent's two marks had become known to some extent in Canada as of the applicant's filing date.

The length of time the marks have been in use favors the opponent. The wares of the parties are essentially identical. Therefore, the trades of the parties would, or could, overlap. The possibility that the applicant's publications might be restricted to different subject matter than that contained in the opponent's newspaper is immaterial since the applicant's statement of wares contains no such restriction and it is the statement of wares that governs: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.).

As for Section 6(5)(e), I consider that there is a fairly high degree of resemblance between the applicant's mark THE VOICE and the opponent's mark THE VILLAGE VOICE.

In fact, the opponent's mark contains both elements of the applicant's mark as its first and last components. The degree of resemblance between the applicant's mark and the opponent's mark VOICE is even greater.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, trades and marks of the parties and the reputation associated with the opponent's marks, I find that the applicant has failed to satisfy the onus on it to show that its proposed mark is not confusing with the opponent's two previously used marks. The first ground of opposition is therefore successful.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 22nd DAY OF NOVEMBER, 1995.

**David J. Martin,
Member,
Trade Marks Opposition Board.**