



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

**Citation: 2010 TMOB 49**  
**Date of Decision: 2010-04-15**

**IN THE MATTER OF AN OPPOSITION  
by Sun Media Corporation to application  
No. 1,226,345 for the trade-mark THE  
MONTREAL SUN & design in the name  
of The Montreal Sun (Journal  
Anglophone) Inc.**

The Pleadings

[1] On August 4, 2004, The Montreal Sun (Journal Anglophone) Inc. (the Applicant) filed an application to register the trade-mark THE MONTREAL SUN & design, application number 1,226,345, as hereinafter illustrated:



(the Mark).

[2] The right to the exclusive use of the word MONTREAL is disclaimed apart from the trade-mark. The application is based on proposed use in Canada and covers the following

services: Publication of a newspaper and magazine (the Services). The application was advertised on May 4, 2005 in the *Trade-marks Journal* for opposition purposes.

[3] Sun Media Corporation (the Opponent) filed a statement of opposition on July 4, 2005 which was forwarded by the Registrar on July 26, 2005 to the Applicant. On August 19, 2005 the Applicant filed what has been identified as a counter statement and that could be interpreted as a denial of all grounds of opposition.

[4] The Opponent filed as its evidence the affidavit of Josée Aubin while the Applicant filed the affidavit of Anne Grousset and a sworn statement of Mr. Ronald Cooney. None of the deponents were cross-examined.

[5] Both parties filed written arguments and no oral hearing was held.

#### 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 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 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 (TMA313825)
- (2) THE WINNIPEG SUN (TMA473276)
- THE TORONTO SUN SYNDICATE & Design (TMA239440)
- THE TORONTO SUN BINGOHHH! & Design (TMA320074)
- THE TORONTO SUN & Design (TMA239586)
- (3) THE TORONTO SUN & Design (TMA239437)
- THE TORONTO SUN & Design (TMA240110)
- THE SUNDAY SUN (TMA201948)
- THE SATURDAY SUN (TMA344103)
- THE OTTAWA SUNDAY SUN (TMA366907)
- (3) THE OTTAWA SUN & Design (TMA366923)
- THE OTTAWA SUN & Design (TMA386601)

- (2) THE OTTAWA SUN (TMA 366894)  
THE EDMONTON SUNDAY SUN (TMA235751)  
THE EDMONTON SUN Design (TMA244801)
- (2) THE EDMONTON SUN (TMA237431)  
THE EDMONTON DAILY SUN (TMA235559)
- (3) THE CALGARY SUN & Design (TMA276154)
- (2) THE CALGARY SUN (TMA250371)  
TELEVISION SUNDAY SUN & Design (TMA239593)  
SUNDAY SUN COMICS & Design (TMA239594)  
SUNDAY SUN & Design (TMA239438)  
SUN MEDIA (TMA538464)  
SUN & Design (TMA236427)  
SUNDAY SUN & Design (TMA241670)
- (3) THE EDMONTON SUN & Design (TMA236763)  
OTTAWA SUNDAY SUN & Design (TMA366906)  
OTTAWA SUNDAY SUN & Design (TMA366905)

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 as described in the application, from the wares of others, including from the wares in association 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 burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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 onus 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 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]. There is no such evidence in the record. The Opponent again failed to meet its initial onus of proof. In any event the ground of opposition as drafted refers to the Applicant's wares while the application covers only the Services. 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].

[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. Aubin has been a senior researcher employed by 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 register with respect to 28 registered trade-marks which are in fact the Opponent's trade-marks listed in the statement of opposition. There is no evidence of use of any of these trade-marks in the record.

[14] The Opponent has met its initial onus by filing the pertinent extracts of the register concerning each of the Opponent's registered trade-marks listed in its statement of opposition. However three registered trade-marks have been expunged and cannot be considered, namely: TMA366905, TMA366906 and TMA366907. The other registrations are in good standing.

[15] My analysis of the likelihood of confusion will consist in comparing the Mark with each of the Opponent's relevant registered trade-marks that I shall group into 3 different categories: THE SUN (word mark), THE [name of a city] SUN trade-marks (for example THE EDMONTON SUN), identified with "(2)" beside them in paragraph 6 above and THE [name of a city] SUN & circle Design trade-marks, THE EDMONTON SUN & Design being illustrated as an example:



(TMA236763), and identified with "(3)" beside them. If the Opponent is not successful under any of these groupings, it would not achieve a better result with any of its trade-marks not falling within one of these categories.

[16] The Mark is a weak trade-mark. When used in association with the Services it suggests that the content of the newspaper will mainly focus on news concerning the Montreal area. The design portion of the Mark may add some distinctiveness to it but to a very limited extent as it is not a dominant feature of the Mark.

[17] The trade-mark THE SUN is an inherently strong trade-mark since it is not suggestive of publications. As for the trade-marks falling in the categories of THE [name of the city] SUN and THE [name of the city] SUN & circle design, my remarks on the distinctiveness of the Mark would be equally applicable to them.

[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 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.

[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.

[21] There is an overlap in the nature of the Services and the wares covered by the Opponent's registrations. The Applicant is arguing that, through the affidavit of Mr. Cooney who describes himself as the Applicant's owner, it undertook not to use the Mark outside the Province of Quebec. Therefore there would be no overlap in the channels of trade. As mentioned by the Opponent in its written argument, the only facts to consider when assessing this factor are those contained in the application and the Opponent's registrations [see *Miss Universe, Inc. v. Bohna* (1995) 1 F.C. 614]. There is no such restriction in the application. If the Applicant is successful in this proceeding, it will be at liberty to use the Mark all across Canada as per the terms of s. 19

of the Act. Under these circumstances and in the absence of evidence to the contrary, I have to presume that the channels of trade would also be similar. Those factors favour the Opponent.

[22] The degree of resemblance between two trade-marks is one of the most important criteria when assessing the likelihood of confusion between them [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145]. 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.

[23] Mr. Cooney's sworn statement deals mainly with the issue of the degree of resemblance between the Mark and the Opponent's registration TMA236736. Mr. Cooney makes the following admission:

And I also swear that the idea was taken from Sun Media's Trademark (TMA236763) as both "Edmonton" and "Montreal" each have eight letters in their respectful names;

[24] As for the documents annexed to his sworn statement, they have not been sworn as prescribed by the Federal Court Rules which are, in general, followed in opposition proceedings where there are no specific provisions in the Act, the *Trade-marks Regulations* or the Practice Notices issued from time to time dealing with a procedural or evidential issue. I do not need to rule on this technical issue as I do not consider the documents annexed thereto to be of any assistance to the Applicant's case. The first document is a photocopy of the Applicant's certificate of incorporation, which is not relevant. The second document is a reproduction of the Mark, which is not necessary and the last document is a modified version of the Mark, which is irrelevant.

[25] In Mr. Cooney's sworn statement and in the Applicant's written argument emphasis is put on the differences in the design portion of the parties' respective trade-marks: the different font used, the word "MONTREAL" allegedly stands out as it is not dominated by the word "SUN". I do not agree with the Applicant's submissions. The word "MONTREAL" does not stand out as suggested by the Applicant. It is written in a smaller font than the word SUN. As stated earlier, the decision will not turn around on the design portion of the marks in issue.

[26] When comparing the Mark to the Opponent's trade-mark THE SUN, it does contain the entirety of the Opponent's aforesaid trade-mark. It has an additional element, MONTREAL, but it is a weak component. In fact the Applicant had to disclaim the right to the exclusive use of the word MONTREAL apart from the trade-mark as a whole. Moreover the circle design, as mentioned before, is not a dominant factor. A consumer, in all likelihood, will not remember such feature as a distinct characteristic of the Mark. It is the word portion of the Mark that a consumer will keep in mind as its dominant portion.

[27] It is therefore the name of a particular Canadian city that differentiates the Mark from the Opponent's registered trade-mark THE SUN. A consumer vaguely familiar with the Opponent's aforesaid trade-mark may well think that the Services are merely a local version of the Opponent's newspaper sold in association with the trade-mark THE SUN.

[28] As a whole the Mark does resemble to the Opponent's registered trade-mark THE SUN as it does incorporate the totality of the Opponent's registered trade-mark. The additional elements "MONTREAL" and the circle design are not distinctive enough to distinguish the Mark from the trade-mark THE SUN.

[29] A trade-mark serves, amongst others, to identify the source of the wares or services. The only element that is different between the Mark and the Opponent's second and third categories of registered trade-marks is the name of a Canadian city (leaving aside the differences in the design portion of the third category). Both the Applicant and the Opponent had to disclaim the name of the city included in the marks in issue as being descriptive of the place of origin of the wares or services.

[30] I conclude that the Mark does resemble each of the Opponent's trade-marks falling under the second and third categories identified above. As for the second category, the addition of a circle design and the use of a different city's name would not be sufficient to distinguish the Mark from the Opponent's trade-marks grouped under that category. Finally with respect to the third category the only difference between the Mark and the Opponent's registered trade-marks would be the name of the city included in the Mark. I may add that, even if the size and the font of the letters are different in the parties' respective trade-marks, I do not consider such distinction to be a major factor such that a consumer would likely think that the Services do



originate from a different source than the Opponent. One must not lose sight of the fact that the applicable test is the imperfect recollection by an average Canadian consumer of the Opponent's trade-marks and not a detailed analysis of the marks in issue by putting them side by side.

[31] As an additional surrounding circumstance the Applicant has provided state of the register evidence through the affidavit of Ms. Grousset, an employee of CPI Centre de propriété intellectuelle. The Applicant requested two searches of the register: the first one concerning trade-marks having as a component the words "SOLEIL" or "SUN" in the field of printed publications (exhibit A to her affidavit) and the second one for all trade-marks having as a component a circular design in the same field. I already ruled that the circle design is not a determining component of the Mark. Therefore I do not consider exhibit B to Ms. Grousset's affidavit to be an important factor to consider.

[32] Unfortunately neither in Ms. Grousset's affidavit nor in the Applicant's written argument is there an analysis of the results found in exhibit A. There are a great number of citations in exhibit A. It is in the best interest of a party supplying this type of evidence to make its own analysis of the results in order to present a sound argument in its favour. I looked at the registrations and applications that received final allowance that are part of exhibit A to Ms. Grousset's affidavit and have determined that the following citations are the most pertinent:

TRADE-MARK	Appl. or Registration no.	Owner
BRANDON SUN	601296	FP Newspapers Limited partnership
BURNABY SUN	1,134,875	Can West Media Works Publications Inc. (CWM)
LE SOLEIL & Design	190431	3834310 Canada Inc.
MARKHAM ECONOMIST SUN	554559	Metroland Printing, Publishing & Distributing Inc.
NORTH SHORE SUN	1,134,876	CWM
RICHMOND SUN	1,134,873	CWM
SUDBURY SUN	551218	Laurentian Media Group Inc.
SUN SPORTS	496754	CWM

SURREY SUN	1,134,877	CWM
THE VANCOUVER SUN	454949	CWM
THE VANCOUVER SUN & Design	503006	CWM
VANCOUVER SUN	454950	CWM
FRASER VALLEY SUN	1,134,874	CWM

[33] It should be noted that I did not include the Mark and the Opponent's trade-marks. There are therefore 13 relevant citations, as they are all registered or applied for (in which cases the applications have been allowed), in association with newspapers or magazines. However they are owned by only 5 different entities.

[34] So in total we have 25 registered trade-marks owned by the Opponent, 9 registered trade-marks or applications that have received final allowance that are owned by CWM and 4 other registrations owned by different entities. Despite the great number of marks on the register that are relevant to this case, there are only 6 different owners (including the Opponent). I do not consider such number to be sufficient to infer that trade-marks having as a component the word "SUN" and/or the combination "SUN" with the name of a city to be commonly used in the trade such that Canadian consumers are accustomed to distinguish amongst them and are aware that the wares and services associated with each one of them come from a different source [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 and *T. Eaton Co. v. Viking GmbH & Co.* (1998), 86 C.P.R. (3d) 382]. Had the Applicant filed evidence of use of these registered trade-marks or applied for, it might have been a relevant factor in its favour. Finally, I noted that none of the third parties' applications or registrations listed above were opposed.

[35] The Applicant has failed to discharge its burden of proving that there is no likelihood of confusion between the Mark and the Opponent's trade-mark THE SUN, as well as with the Opponent's registered trade-marks that fall within the second and third category of trade-marks as defined above. I reach this conclusion based on the fact that the Services are similar to the wares covered by the Opponent's registrations, that their channels of trade would be similar and that there is a resemblance between the Mark and the trade-mark THE SUN and any of the Opponent's trade-marks falling in the second or third category as defined above.

[36] The best case scenario for the Applicant would have been that I had a doubt that the Mark would be registrable. But in case of doubt, the issue must be resolved against the Applicant [see *Conde Nast Publications Inc. v. Union des Éditions Modernes* (1979), 46 C.P.R. (2d) 183].

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

#### Conclusion

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.

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