



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

**Citation: 2011 TMOB 156**  
**Date of Decision: 2011-08-31**

**IN THE MATTER OF AN OPPOSITION  
by InterMedia Vibe Holdings, LLC to  
application No. 1,144,436(1) for the trade-  
mark VIBE in the name of Vibe Studio  
Productions Inc.**

[1] On July 7, 2005, Vibe Studio Productions Inc. (the Applicant) filed an application to extend the statement of wares and services in its registration No. TMA606,432 for the trademark VIBE (the Mark). The Applicant seeks to extend its registration to cover the following wares and services, on the bases set out below:

wares

(1) Headwear, namely, headbands and hats; dancewear, namely, dance body suits and dance costumes – based on use in Canada since at least June 2002

(2) Electronic media, namely, dance, fitness, health, wellness, stretch and strength DVDs and videos for children, teens and adults – based on proposed use in Canada

services

(1) Dance, fitness, health, wellness, stretch and strength classes for children, teens and adults – based on use in Canada since at least November 2001

(2) Retail sales of headwear, namely, headbands and hats; retail sales of dancewear, namely, dance body suits and dance costumes – based on use in Canada since at least June 2002

(3) Retail sales of electronic media, namely, dance, fitness, health, wellness, stretch and strength DVDs and videos for children, teens and adults – based on proposed use in Canada.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 5, 2008.

[3] On October 6, 2008, Vibe Media Group LLC (the Original Opponent) filed a statement of opposition. The Applicant filed and served a counter statement.

[4] An affidavit of Steve Aaron, the Original Opponent's Chief Executive Officer, was filed in support of the opposition. No evidence was filed in support of the application and Mr. Aaron was not cross-examined.

[5] On October 21, 2009, the Original Opponent was granted leave to amend the statement of opposition to replace the Original Opponent with its successor in title, Vibe Media Group LLC (the Opponent).

[6] Only the Opponent filed a written argument. An oral hearing was not held.

#### Summary of Grounds of Opposition and Applicable Material Dates

[7] The grounds of opposition pleaded by the Opponent pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) are summarized below:

- i. s. 38(2)(a)/s. 30(b): the statement of use is invalid – in particular, and without limiting the generality of the foregoing, the Applicant's use did not in fact commence on the date alleged, the Applicant's alleged use did not constitute "use" within the meaning of the Act, nor did it constitute use on behalf of the Applicant. In addition, the Mark was not in fact properly displayed at the time of the alleged transfer of the wares or the performance of the services, and there was no use in the normal course of trade.
- ii. s. 38(2)(a)/s. 30(e): the statement of intent to use is invalid – in particular, and without limiting the generality of the foregoing, the Applicant did not have the necessary intention as of the filing date. In the alternative, such use had already commenced.
- iii. s. 38(2)(a)/s. 30(i): 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 “including, for among other reasons, the facts stated [in the statement of opposition].”

- iv. s. 38(2)(b)/s. 12(1)(d): the Mark is confusing with one or more of the following trade-mark applications and registrations for VIBE: registration No. TMA526,485; application No. 1,163,727; application No. 1,357,303.
- v. s. 38(2)(c)/s. 16 (1)(a): the Applicant is not the person entitled to registration because the Mark was, as of the date on which the Applicant allegedly first used it, confusing with one or more of the VIBE trade-mark(s) referred to above which had been previously used or made known in Canada by the Opponent and/or its predecessors or affiliates.
- vi. s. 38(2)(c)/s. 16 (1)(c): the Applicant is not the person entitled to registration because the Mark was, as of the date on which the Applicant allegedly first used it, confusing with the trade-name VIBE that had been previously used in Canada by the Opponent and/or its predecessors or affiliates.
- vii. s. 38(2)(c)/s. 16 (3)(a): the Applicant is not the person entitled to registration because the Mark was, as of the date of filing the application, confusing with the trade-mark VIBE which had been previously used or made known in Canada by the Opponent and/or its predecessors or affiliates.
- viii. s. 38(2)(c)/s. 16 (3)(b): the Applicant is not the person entitled to registration because the Mark was, as of the date of filing the application, confusing with the trade-mark VIBE in respect of which an application for registration had been previously filed, namely application No. 1,163,727.
- ix. s. 38(2)(c)/s. 16 (3)(c): the Applicant is not the person entitled to registration because the Mark was, as of the date of filing the application, confusing with the trade-name VIBE that had been previously used in Canada by the Opponent and/or its predecessors or affiliates.
- x. s. 38(2)(d)/s. 2: the Mark is not distinctive in that it does not actually distinguish, nor is it adapted to distinguish, the wares or services of the Applicant from the wares, services or business of the Opponent and its predecessors and affiliates.

[8] The material dates with respect to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 16(1) – the Applicant’s claimed date of first use;
- s. 16(3) – the filing date of the application;
- s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Onus

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

### Likelihood of Confusion

[10] The main issue to be decided in this proceeding is whether the Applicant’s Mark is confusing with the Opponent’s VIBE trade-mark or trade-name. The issue of confusion particularly underlies grounds of opposition iv) through x).

[11] The test for confusion is one of first impression and imperfect recollection. Section 6 of the Act indicates that use of a trade-mark causes confusion with another trade-mark or trade-name if the use of both in the same area would be likely to lead to the inference that the wares or services associated with them are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[12] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight; in most instances, the degree of

resemblance in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

[13] I note that Mr. Aaron has provided the following information concerning the use of the Opponent's VIBE mark/name in Canada:

- The VIBE mark has been continuously used in Canada in association with a general interest magazine relating to music, fashion, urban culture and entertainment since 1992.
- Copies of VIBE magazines have been provided dated January 2001, May 2009, Fall 1992, October 1993, January 1994, March 1995, November 1995, November 2002, February 2003, and two illegible dates – VIBE appears prominently on the front covers – Canadian prices are indicated on the issues dated 2001 and later. (In addition to showing use of VIBE as a trade-mark, the magazines also show use of VIBE as a trade-name.)
- The number of VIBE magazines sold in Canada annually between 1996 and 2008 exceeded 40,000, with a retail value in the millions of Canadian dollars.
- A television program called VIBE has been broadcast or available for viewing in Canada in 1998 and other years. In addition, since 2003 the Opponent has produced several televised awards shows for urban music, called the VIBE AWARDS show.
- The Opponent's VIBE mark has been used on the Internet.
- The Opponent's VIBE mark has been associated with books relating to music, entertainment and urban culture; no exhibits have been provided but Mr. Aaron

states that over 2800 copies of one particular book were sold in Canada in or around 2001/2002.

- VIBE has been used in Canada in connection with the sale of musical recordings, namely pre-recorded CD's, sold in part through special offers mailed to VIBE magazine subscribers.
- Fashion and style have been a feature of the Opponent's VIBE magazines over the years, with clothing ads representing a third of the magazine's ads.
- The Opponent has sold clothing, namely caps, t-shirts and sweatshirts that display the VIBE mark; these items have been advertised and offered for sale in Canada since at least as early as 1999 through the Opponent's VIBE magazine. (The order forms also show use of VIBE as a trade-name.)

[14] I will begin by assessing the likelihood of confusion between the parties' VIBE marks under the s. 2 ground of opposition. The Opponent's evidence indicates that its VIBE mark was known to a sufficient extent in Canada as of October 6, 2008 to meet its initial onus under this ground of opposition [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

*6(5)(a) - the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[15] "Marks are inherently distinctive when nothing about them refers the consumer to a multitude of sources. Where a mark may refer to many things or ... is only descriptive of the wares or of their geographic origin, less protection will be afforded the mark. Conversely, where the mark is a unique or invented name, such that it could refer to only one thing, it will be extended a greater scope of protection." [*United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at para. 23]

[16] The Opponent submits that the Applicant has not filed any evidence that VIBE describes any of the Applicant's or Opponent's wares or services. It also notes that Mr. Aaron attested that VIBE does not appear in all dictionaries, in particular it is not listed in *The Concise Oxford*

*English Dictionary*, Ninth Edition, *The Shorter Oxford English Dictionary*, Third Edition, and *Cambridge Dictionary of American English*, 2009 Edition.

I have previously considered the inherent distinctiveness of the word VIBE in *CTV Limited v. InterMedia Vibe Holdings, LLC* (2010), 88 C.P.R. (4th) 188 (T.M.O.B.), where I stated at paragraph 62:

Both parties' marks [MUCHVIBE and VIBE] consist of ordinary dictionary words. The *Oxford Canadian Dictionary* defines "vibe" as "vibration, esp. in the sense of feelings or atmosphere communicated". The word can thus be considered to be slightly suggestive of both parties' wares/services. I note that Mr. Justice Harrington stated, "There is nothing inherently distinctive in the word "VIBE". [*Vibe Ventures LLC v. 3681441 Canada Inc.* (2005), 45 C.P.R. (4th) 17 (F.C.)] Overall, neither mark is inherently strong.

[17] However, a mark may acquire distinctiveness through use or promotion and only the Opponent has provided evidence of the extent to which its mark has become known.

[18] As the Applicant has not provided any evidence of the use or promotion of its Mark, overall s. 6(5)(a) favours the Opponent.

*6(5)(b) - the length of time each mark has been in use*

[19] The Applicant claims in its application that it has used the Mark in Canada since at least as early as November 2001 for some of its services and since at least as early as June 2002 for some of its wares. The length of time that each party's mark has been in use therefore favours the Opponent.

*6(5)(c) and (d) - the nature of the wares, services, business and trade*

[20] There is no information about the Applicant's wares, services, business or channels of trade other than what we can infer from its statement of wares and services. However, there appears to be an overlap or connection with the Opponent's wares, services, business and channels of trade because i) both parties' businesses are connected to music/dance and fashion, ii) both parties sell clothing and electronic media, and iii) both parties are retailers.

[21] Therefore, overall s. 6(5)(c) and (d) favour the Opponent.

*6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[22] As the marks at issue are identical, s. 6(5)(e) favours the Opponent.

*conclusion re s. 2 ground*

[23] The surrounding circumstances listed in each of the subparagraphs of s. 6(5) appear to favour the Opponent and, in the absence of any evidence or argument from the Applicant, I see no basis on which to find that the Applicant has met its legal burden. The tenth ground of opposition therefore succeeds.

*conclusion re s. 16 grounds based on the Opponent's trade-name VIBE*

[24] The Opponent has met its initial burden by demonstrating use of VIBE as a trade-name in Canada prior to the material dates and non-abandonment of its trade-name as of the advertisement of the Applicant's application. On the other hand, the Applicant has done nothing to meet its legal burden. Accordingly, based on the reasoning set out with respect to the s. 2 ground of opposition, the sixth and ninth grounds of opposition succeed.

*remaining grounds of opposition*

[25] As I have already refused the application under more than one ground, I see no need to rule on the remaining grounds of opposition.

### Disposition

[26] 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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Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office