

**IN THE MATTER OF AN OPPOSITION  
by Waterford Wedgwood PLC to Application  
No. 1013012 for the Trade-mark LISA  
MORI filed by Forma-Kutzscher GmbH**

**I      The Pleadings**

On April 23, 1999, Forma-Kutzscher GmbH (the “Applicant”) filed an application, based on proposed use, to register the trade-mark LISA MORI, application number 1013012, in association with glassware namely crystal and lead crystal glassware (the “Wares”). The Applicant claimed a priority date of February 26, 1999, based on an application filed in Germany for the registration of the Mark in association with the Wares. The present application was advertised on April 4, 2001 in the Trade-Marks Journal for opposition purposes.

Waterford Wedgwood PLC (the “Opponent”) filed, on September 4, 2001, a statement of opposition raising the following grounds of opposition:

- 1) In virtue of s. 38(2)(a) and 30(i) of the *Trade-Marks Act* R.S.C. 1985, c. T-13, (the “Act”) the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Wares since at the date of filing of the application, the Applicant was or should have been aware of the Opponent’s trade-mark LISMORE;
- 2) In virtue of s. 38(2)(c) and 16(2)(a) of the Act, the Applicant could not be the person entitled to the registration of the Mark:
  - i) as at the date of filing of the application, the Mark was confusing with the trade-mark LISMORE previously used in Canada and made known in Canada by the Opponent in association with crystal glassware namely goblets; glasses for champagne, claret, port, sherry, white wine and liqueur; tall stem hock glasses; old fashioned glasses; footed juice glasses; tumblers, grape fruit dishes; ice and salad plates; finger bowls, jugs and decanters, all made of glass (the “Opponent’s wares”);
- 3) In virtue of 38(2)(c) and 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark:
  - i) as at the date of filing of the application, the Mark was confusing with the trade-mark LISMORE previously used in Canada and made known in Canada by the Opponent in association with the Opponent’s wares;
- 4) In virtue of s. 38(2)(b) and 12(1)(a) of the Act, the Mark is not registrable being primarily merely the name or surname of an individual who is living or has died in the preceding thirty years;

- 5) In virtue of s. 38(2)(b) and 12(1)(d) of the Act, the Mark is not registrable being confusing with the Opponent's registered trade-mark LISMORE, certificate of registration TMA166374;
- 6) In virtue of s. 38(2)(d) and s. 2 of the Act, the Mark is not distinctive of the Wares nor is it adapted to distinguish, nor capable of distinguishing the Applicant's Wares from the Opponent's wares.

The Applicant filed on October 17, 2001 a counter statement essentially denying each ground of opposition and adding that the Opponent's trade-mark registration was not cited by the examination section and as such was not considered pertinent.

The Opponent's evidence consists of the affidavits of Peter D. Moore and Joanne B. Drogemuller, while the Applicant filed the affidavit of Jennifer Petras. The Opponent replied with the affidavit of Antonio Turco. Both parties filed written submissions.

On May 10, 2005 the Applicant requested leave to file additional evidence under rule 44 of the *Trade-marks Regulations (1996)*, in the form of the affidavit of Jocelyne Genest, in order to introduce as evidence a copy of a decision dated February 24, 2005, rendered by the Irish Patent Office concerning an opposition filed by the Opponent against the Applicant's Irish application for the registration of the Mark.

An oral hearing was held during which both parties made representations.

## **II The Opponent's evidence**

Mr. Moore is the President and CEO of Waterford Wedgwood Canada Inc ("Waterford Canada"), the exclusive Canadian distributor of the products of Waterford Crystal Limited of Kilbarry, Waterford, Ireland ("Waterford Crystal") which in turn is a wholly-owned subsidiary of the Opponent.

The Opponent has been selling, since 1953, its products in Canada. Waterford Canada has been, since 1987, the Canadian distributor of products bearing the Opponent's trade-marks. The Bay, Birks, Caplan-Duval and William Ashley, to name a few, are amongst Waterford Canada's customers.

The affiant alleges that the Opponent is the owner of the trade-marks LISMORE and WATERFORD. A Canadian certificate of registration, number TMA 166374 establishes the Opponent's ownership in the trade-mark LISMORE but there is no similar evidence in so far as the trade-mark WATERFORD is concerned.

The affiant filed samples of invoices to prove the sale, in Canada, of glassware bearing the trade-mark LISMORE. He also filed samples of the following physical exhibits:

- Boxes bearing the trade-mark LISMORE in which glassware is packaged;
- Catalogues distributed in Canada since at least 1988 illustrating glassware offered for sale in association with the trade-mark LISMORE;
- Panels and table cards bearing the trade-mark LISMORE used in Canada since at least 1990;
- Advertisements published in Canadian magazines.

Waterford Canada has sold since 1998 close to 60,000 glassware products bearing the trade-mark LISMORE for a net wholesale value of over \$3,6 million. Mr. Moore does provide approximate advertising and promotional expenditures for the period of 1998 to 2001 but since there is no breakdown by trade-mark, I will not give great weight to such evidence.

Joanne B. Drogemuller is a trade-mark agent working for the Opponent's agent firm. She was asked to perform searches to determine how common was the name Lisa Mori in Canada and elsewhere. She conducted four (4) searches using the following search engines: Canada 411, Infospace, Google, Lycos and Dogpile.

Using Canada 411, she found 263 listings in Canada under the name Mori, including ten (10) L. Mori. With Infospace, she found 200 listings under the name Mori, including ten (10) listings under L. Mori.

She was able to find on the World Wide Web reference to individuals with the name Lisa Mori including a professor at California State University. There is another professor with the same name at Queens University but we do not know if she is the same individual listed on the California State University website. There was also a reference to an individual with the name Lisa Mori on the website [www.missoulia.com](http://www.missoulia.com). She concluded her affidavit by stating that, as an ordinary Canadian, even before

conducting the searches she performed, the combination of the words Lisa and Mori would represent to her the name of a person.

### **III The Applicant's evidence**

Jennifer Petras has been a paralegal employed by the Applicant's agent firm. She filed an extract of the Trade-mark Examination manual discussing s. 12(1)(a) preliminary objections. According to such extract the examiner will raise an objection to the registrability of the trade-mark applied for only if the exact combination can be found in directories, books of names or similar reference source. I do not consider myself bound by the decision of an examiner not to raise s. 12(1)(a) of the Act, as the examiner did not have on hand the evidence filed by the Opponent on this issue. Moreover the test applied by the Registrar under s. 37 of the Act differs from the test used in opposition proceedings.

She filed the results of a search conducted on the Internet using the key word "Lismore". It would appear from the results of such search that LISMORE is a location in Ireland. She also filed a copy of a decision she located on the Internet, without identifying the website source, that appears to be in relation to opposition proceedings in the United Kingdom involving the same parties and trade-mark. Pertinent extracts of the Applicant's website were annexed to her affidavit. Finally she produced extracts of the Webster's dictionary to establish the pronunciation of the word "more".

### **IV The Reply evidence**

Mr. Turco is a lawyer at the Opponent's agents firm. He conducted a search on the Internet using the Google and Canada 411 search engines to determine how many residents of Canada bore the name Lisa Mori. He located the website of the Armstrong Spallumcheen Museum and Art Gallery, in Armstrong, British Columbia which identified Lisa Mori as the curator-administrator of the museum. He called her and left a message. She called back and spoke to him. He asked her if she would be interested in participating in these opposition proceedings. She wrote back by way of an email informing him that she was not prepared to take part in these proceedings. A copy of this email was filed in the record. From this information, Mr Turco firmly believes that there is an individual living in Canada bearing the name Lisa Mori.

## **V Analysis of the legal issues**

I shall deal first with the issue of the additional evidence filed by the Applicant. The Opponent withdrew at the hearing the objection it made when the Applicant sought leave to file such evidence. As it will appear from my decision such evidence will not be a determining factor in the outcome of this opposition. I shall allow the filing of such evidence, reserving my comments on its relevancy in due course.

The legal onus is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial burden is met, the Applicant still has to prove 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; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293].

As for the first ground of opposition, being aware of the Opponent's trade-marks would not necessarily prevent the Applicant from being satisfied that it was entitled to use the Mark. It could well be that the Applicant did not believe that the marks in issue were confusing. There has been no allegation of bad faith on the part of the Applicant in the statement of opposition. [See *Sapodilla Co. Ltd. v. Bristol Myer Co.* (1974), 15 C.P.R. (2d) 152] I therefore dismiss, as drafted, this ground of opposition.

The fifth ground of opposition (registrability under 12(1)(d)) must be determined as of the date of my decision. [See *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)]. It has been established that the likelihood of confusion between the Mark and the Opponent's registered trade-mark must be assessed by taking into consideration all surrounding circumstances including the criteria listed under s. 6(5) of the Act which are: 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. They are not exhaustive. Moreover it is not necessary to give each one of them

equal weight. [See *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.) and *Gainers Inc. v. Marchildon* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.)]

During the oral hearing the Applicant admitted that the first three criteria favoured the Opponent. I shall therefore analyse only the last two for the purpose of my decision. With respect to the nature of the trade, the Applicant, in its written submissions, is arguing that the evidence shows that the Opponent's wares can be considered as luxury items while the Applicant's Wares are relatively cheap in comparison with the Opponent's wares. The evidence filed by the Applicant does not support such conclusion. In the absence of evidence on the Applicant's channel of trade, I have to presume, in view of the fact that the wares of the parties are identical, that their channels of trade would be identical or at least similar. This factor also favours the Opponent.

The degree of resemblance between trade- marks is most important especially when the wares are identical or there is some overlap between them. [See *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 at 149 (F.C.T.D.)] The test is one of first impression in the mind of an ordinary consumer having a vague recollection of the Opponent's trade-mark. [See *Miss Universe v. Bohna* (1995), 58 C.P.R. (3d) 381at 387]

There is no degree of resemblance in the ideas suggested. The Applicant's mark suggests that it is the name of a person while, as argued by the Applicant, the word LISMORE could be viewed by the average consumer as a coined word, despite the evidence filed by the Applicant that Lismore could have some geographical significance. I do not think that the average Canadian consumer would associate Lismore to a place located in Ireland. Visually there is some degree of resemblance even though the Mark is composed of two words as opposed to one word for the Opponent's trade-mark. The marks in issue do not appear to me to be phonetically similar. The respective parties' marks must be viewed as a whole and I shall not dissect the marks into their components to stress the similarities and/or the differences. On a balance of probabilities, I conclude that overall, this factor favours slightly the Opponent because of the visual similarity between the marks.

As an additional surrounding circumstance, the Applicant is relying on two foreign decisions involving the same parties and trade-marks. In both cases the Applicant was successful in obtaining the registration of its

Mark. In an unreported decision of *Spirits International N.V. v. SC Prodal 94 SRL*, application No. 1,033,359 and dated November 9, 2005, my colleague Jill W. Bradbury addressed a similar issue in those terms:

“Foreign decisions are not binding on this Board, but that does not mean that they cannot be persuasive. [see *Neutrogena Corp. v. Guaber SRL* (1993), 49 C.P.R. (3d) 282 (T.M.O.B.); *Origins Natural Resources v. Warnaco U.S.* (2000), 9 C.P.R. (4<sup>th</sup>) 540 (T.M.O.B.) at 548] In the present case, no evidence has been presented concerning how closely the law of the United Kingdom coincides with Canadian trade-mark law. The opponent asks me to take judicial notice of the similarities. While I agree that every Canadian lawyer knows of the relationship between British and Canadian law, it cannot be said that they are the same. For example, the decision being relied upon makes it clear that in the United Kingdom the likelihood of confusion “must be appreciated globally”. In addition, the evidence before the U.K. Trade Marks Registrar is not identical to that presented in the present proceedings.”

There is no evidence of the law of trade-marks applicable in Ireland and the United Kingdom. Foreign law is considered facts that must be proven. In the absence of such evidence it is difficult to give any weight to those decisions. In any event, a reading of the Irish decision does show that the hearing officer came to the conclusion that the average Irish consumer would not be confused because the trade-mark LISA MORI suggests the name of an individual while LISMORE is the name of a place in Ireland. I do not have any evidence that the Canadian consumer would associate LISMORE to a place in Ireland. This important distinction is sufficient to distinguish the present case from the Irish decision. As for the decision in the United Kingdom, a review of that decision shows that many factors were taken into consideration for which we have no evidence in this file. Therefore I do not think that those foreign decisions could be viewed as a surrounding circumstance in support of the Applicant’s position.

I therefore conclude that, on a balance of probabilities, there is a likelihood of confusion between the Mark and the Opponent’s trade-mark LISMORE. I reach this conclusion based on the fact that the first four criteria are clearly in favour of the Opponent and that there are some visual similarities between the marks of the parties. Therefore I maintain the fifth ground of opposition.

I shall now discuss the fourth ground of opposition (s. 12(1)(a) of the Act) in relation with the evidence described above. First, I must determine the relevant date under which this ground of opposition must be determined. In the past, the courts and the Board have adopted the date of the decision as the relevant date for any grounds of opposition under s. 12 of the Act. In fact, in 1991, the Federal Court of Appeal in *Park*

*Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al* (1991), 37 C.P.R. (3d) 413 enunciated the general rule that when the relevant date is not identified in the Act, the date of the decision should be used as the relevant date. It should be noted that in *Park Avenue* the Court did not have to deal with the various grounds of opposition under s. 12 of the Act. Lately, the Federal Court, trial division, in *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4<sup>th</sup>) 60, ruled that the relevant date under s. 12(1)(b) should be the filing date of the application. The Registrar has since then followed that approach. [See *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4<sup>th</sup>) 90; *Havana Club Holdings S.A. v. Bacardi & Company Limited* (2004), 35 C.P.R. (4<sup>th</sup>) 541 and *Eloyalty Corporation v. Loyalty Management Group Canada Inc* re application No. 860,274, decision rendered on May 28, 2004]. To further justify the use of the filing date of the application as the relevant date when s. 12(1)(b) is raised as a ground of opposition, the Board has noted the relationship between such section and s. 12(2). It is therein provided that a trade-mark not registrable under 12(1)(b) could be registrable if the applicant can demonstrate to the Registrar that, as of the filing date of its application, the trade-mark applied for has become distinctive because of its use in Canada.

Section 12(2) of the Act equally applies to trade-marks not registrable in view of s. 12(1)(a). Therefore it is only logical to adopt, as the relevant date, the filing date of the application when s. 12(1)(a) is raised as a ground of opposition. [See *Calvin Klein Trademark Trust v. Wertex Hosiery Inc.* (2005), 41 C.P.R. (4<sup>th</sup>) 552]

The leading cases on the issue of non-registrability of a trade-mark consisting of primarily merely the name or surname of an individual who is living or has died in the preceding thirty years are *Gerhard Horn Investments Ltd. v. Registrar of Trade-marks* (1983), 73 C.P.R. (2d) 23 and *Standard Oil Company v. The Registrar of trade-marks*, (1968) 2 Ex. C. R. 523. The Applicant has argued, and I do not think the Opponent has disputed such issue, that the test under s. 12(1) (a) is two fold:

- 1) the first and foremost condition is whether the Mark is the name or surname of a living individual or an individual who has recently died;
- 2) if the answer to the first question is affirmative, then the Registrar must determine if the Mark is “primarily merely” a name or surname rather than something else.

[ See *Gerhard Horn* supra at par. 40 and 41]



The Applicant argued at the hearing that the content of the Turco and Drogemuller affidavits constitutes inadmissible hearsay evidence. Ms. Drogemuller conducted her search after the relevant date. It is however reasonable to assume that a similar result would have been obtained if the search had been done in January 1999 in view of the number of listings obtained. Still I am not prepared to conclude, from her evidence alone, that there are individuals living in Canada named Lisa Mori. The reliability of her searches on the Internet has not been established. She has not conducted follow up investigation, as did Mr. Turco. So I am giving little weight to the results of her searches that there exists at least one individual with the name Lisa Mori. Nonetheless I accept the fact that her search does establish that Mori is a surname of individuals living in Canada.

The content of the Turco affidavit is not hearsay evidence. He does explain how he located an individual by the name of Lisa Mori. He spoke to her and received correspondence from her. He was not cross-examined and as such his allegations must be taken at their face value. The content of Mr. Turco's affidavit clearly establishes that there is at least one individual living in Canada bearing the name Lisa Mori. Even though this evidence is subsequent to the relevant date, it is sufficient to meet the first part of test enunciated hereinabove.

The Applicant is arguing that there is no evidence that the average Canadian consumer would consider the Mark as the name of an individual as opposed to a trade-mark. Since the Opponent did not meet such alleged burden, the ground of opposition under 12(1)(a) should be dismissed. Certainly there is no survey in the file that would show what perception the average Canadian consumer has of the Mark. But is the absence of such survey fatal to the Opponent? I do not think so. In *Standard Oil supra*, and cited in *Gerhard Horn supra*, Mr. Justice Jaccett phrased, on page 532, the second part of the two-fold test in the following terms:

“The test must be what, in the opinion of the respondent [i.e., the Registrar of Trade-marks] or the Court, as the case may be, would be the response of the general public of Canada to the word.”

Therefore the Registrar must determine if, in his opinion, the general public of Canada would think first that the Mark is the name of a living individual. In making his decision, the evidence provided by the Opponent may assist the Registrar. However, I do not consider the absence of evidence on what the Canadian

consumer would think of the Mark equates to an automatic dismissal of this ground of opposition. The combination of the fact that Lisa is a well-known first name and that there is a good number of listings in Canada under the name Mori leads me to conclude that the average Canadian consumer would associate first the name Lisa Mori to an individual as opposed to a trade-mark used to distinguish one's wares or services from those of others. Therefore, on a balance of probabilities, the Mark is "primarily merely" a name or surname and as such the Opponent has met its initial burden. The Applicant has not adduced any evidence to rebut such conclusion. I therefore maintain the Opponent's fourth ground of opposition.

Having already concluded in favour of the Opponent on two separate grounds of opposition, it is not necessary to assess the remaining grounds of opposition.

#### **VI Conclusion:**

Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the Applicant's application for the registration of the Mark in association with the Wares, the whole pursuant to s. 38(8) of the Act.

DATED, IN BOUCHERVILLE, QUEBEC, THIS 9th DAY OF JANUARY 2006.

Jean Carrière,  
Member of the Trade-marks Opposition Board