

IN THE MATTER OF AN OPPOSITION
by Time Incorporated to applica-
tion No. 544,979 for the trade-
mark WESTERN PEOPLE filed by
Saskatchewan Wheat Pool

On June 27, 1985, the applicant, Saskatchewan Wheat Pool, filed an application to register the trade-mark WESTERN PEOPLE for "periodical publications" based on use in Canada since 1978. The application was advertised for opposition purposes on January 15, 1986.

The opponent, Time Incorporated, filed a statement of opposition on December 8, 1986, a copy of which was forwarded to the applicant on January 26, 1987. The opponent was later granted leave to amend its statement of opposition to include an additional ground.

The first ground of opposition reads as follows:

The application does not comply with the requirements of Section 30(b) of the Trade Marks Act because the alleged trade mark has not been used in Canada as set forth in the application since the date alleged in the application. Specifically, WESTERN PEOPLE has not been used as a trade mark as defined by Section 4(1) of the Trade Marks Act in that the name appears on a supplement to a newspaper which is delivered gratuitously to buyers of the newspaper. Such delivery does not amount to a transaction in the normal course of trade as required by Section 4(1). Similarly, WESTERN PEOPLE has not been used in association with the wares of a printed periodical as alleged in the application, but is merely the name of a supplement to a newspaper.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark PEOPLE registered under No. 199,584 for "printed publications, namely periodicals" and with the opponent's trade-mark PEOPLE WEEKLY & Design registered under No. 312,402 for "printed publications, namely periodicals and board games." The third ground is that the applicant is not the person entitled to registration because, as of the applicant's claimed date of first use (December 31, 1978), the applied for trade-mark was confusing with the two registered marks previously used in Canada by the opponent with "printed publications, namely periodicals." The fourth ground is that the applicant's trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement and was subsequently granted leave to amend its counter statement. As its evidence, the opponent filed the affidavits of William deBar Murphy and G. Lindsay Valk. As its evidence, the applicant filed the affidavits of Allan W. Laughland and Brian L. Graham and two affidavits of Wayne de Rinzy. The applicant was subsequently granted leave to file the affidavit of William Ardell. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

I will first consider the opponent's third ground of opposition insofar as it is based on prior use of its mark PEOPLE. The opponent has met its initial burden of evidencing use of its trade-mark prior to the applicant's claimed date of first use of December 31, 1978. The opponent has also shown non-abandonment of its mark as of the applicant's advertisement date.

In view of the above, the third 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 claimed date of first use in accordance with the clear wording of Section 16(1)(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.

The opponent's mark PEOPLE possesses a low degree of inherent distinctiveness since it suggests that the subject of the opponent's periodical will be people: see the opposition decision in Time Inc. v. Moisescu (1990), 31 C.P.R. (3d) 255. However, as of the end of 1978, the opponent's periodical entitled PEOPLE had enjoyed widespread circulation throughout Canada. According to Mr. Valk, the total circulation for the period 1974 to 1978 was about 40 million copies. Thus, I am able to conclude that the opponent's mark had become very well known as of the material time.

The applicant's mark WESTERN PEOPLE is also inherently weak since it suggests that the subject of the applicant's periodical will be people from the West. Mr. Laughland states that "...WESTERN PEOPLE magazine is a supplement to the WESTERN PRODUCER which is a newspaper published by my company in Canada..." He also states that the applicant began including WESTERN PEOPLE magazine as a supplement on August 3, 1978 and that it was published on a bi-weekly basis. Mr. Laughland provides circulation figures for The Western Producer but he fails to provide any detail about those figures. Thus, it is difficult to determine the actual circulation of the supplement such that I can only ascribe a limited reputation to the applicant's mark WESTERN PEOPLE as of the material time.

The length of time the marks have been in use favors the opponent. The opponent has shown use of its trade-mark PEOPLE on a periodical publication, namely, a magazine. Since the applicant is seeking registration for "periodical publications", I must consider the wares of the parties to be the same. Likewise, I must conclude that the trades of the parties would be the same. One might argue that the markets of the parties differ and that the applicant's publication is different since it is distributed as a supplement to a newspaper rather than as a separate magazine. However, the applicant's statement of wares contains no such distinctions and that is what 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) of the Act, I consider there to be a fairly high degree of visual and phonetic resemblance between the marks; the applicant's mark includes the entirety of the opponent's mark. Furthermore, there is a fairly high degree of resemblance in the ideas suggested by the two marks. Similar conclusions were reached concerning the marks PEOPLE and OUR PEOPLE in the Time Inc. opposition decision noted above.

As an additional surrounding circumstance, the applicant sought to rely on the state of the register as evidenced by the de Rinzy affidavits. Mr. de Rinzy conducted a search of the register for trade-marks which include the word PEOPLE. However, only

a few of the registrations located by Mr. de Rinzy were for periodical publications and even fewer of those registrations were on the register as of December 31, 1978. In the absence of evidence of use of those few marks, I am unable to make any meaningful inferences about the state of the marketplace based on a handful of registrations.

The applicant also sought to rely on the Ardell affidavit which relates to the trade-mark COLES THE BOOK PEOPLE. However, there is no evidence as to the extent to which that mark was in use as of and prior to the material time. Furthermore, that mark relates to a different area of commerce from periodical publications.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I have also considered that consumers seeing the trade-mark WESTERN PEOPLE on a periodical similar to the opponent's PEOPLE magazine might well assume that the former is a new publication of the opponent's or that it is a special edition of the opponent's magazine. In view of my conclusions above, and particularly in view of the resemblance between the marks, wares and trades of the parties and the reputation associated with the opponent's mark, I find that the applicant has failed to satisfy the onus on it to show that its mark WESTERN PEOPLE for "periodical publications" is not confusing with the opponent's previously used mark PEOPLE. The third ground of opposition based on prior use of the opponent's mark PEOPLE is therefore successful.

In view of the above, it is unnecessary to consider the remaining grounds. However, in all likelihood, the opponent's ground of non-registrability based on its registration for the mark PEOPLE would also have been successful. As for the first ground of opposition, it would appear that the opponent had met the evidential burden on it by reference to the applicant's own evidence. The Laughland affidavit establishes that the applicant's mark has been used as the title of a newspaper supplement that is "...distributed without extra charge to all subscribers of The Western Producer" (see Exhibit A to the Laughland affidavit). Free distribution of the WESTERN PEOPLE supplement included inside another publication does not necessarily constitute use of WESTERN PEOPLE as a trade-mark in the normal course of trade. In other words, free distribution of that newspaper supplement does not, on its face, appear to be a transfer of wares for the purpose of acquiring profits and goodwill in the WESTERN PEOPLE trade-mark. Furthermore, it would appear that the use of WESTERN PEOPLE on a newspaper supplement would not result in the mark being brought to the notice of an individual to whom property in the wares was being transferred. It would appear that the applicant has failed to meet the onus on it to show otherwise but it is unnecessary to make a final determination on this issue.

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

DATED AT HULL, QUEBEC, THIS 28TH DAY OF JUNE 1991.

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