

**IN THE MATTER OF AN OPPOSITION
by Travis Wagner doing business as 604
Clothing Company to application No.
1,140,322 for the trade-mark 604
RECORDS in the name of 604 Records
Inc.**

On May 8, 2002, 634300 B.C. Ltd. (the “Applicant”) filed an application to register the trade-mark 604 RECORDS (the “Mark”) based upon proposed use of the Mark in Canada. The current statement of wares and services in the application reads:

Wares:

Pre-recorded compact discs featuring musical sound recordings.

Services:

Music production services; producing musical and dramatic performances, exhibitions and shows; promotion of musical performers and other entertainers; entertainment services in the nature of the production and distribution of pre-recorded musical sound recordings and video recordings.

The Applicant has disclaimed the right to the exclusive use of the word RECORDS apart from the Mark.

The application was advertised for opposition purposes in the Trade-marks Journal of September 17, 2003. On February 17, 2004, Travis Wagner doing business as 604 Clothing Company, (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement, under strict reserve of its rights and recourses, in which it denied the Opponent’s allegations. Contemporaneously, the Applicant objected to some of the Opponent’s grounds of opposition and requested an interlocutory ruling from the Board in respect thereof. The Opponent made submissions in response and also filed an amended statement of opposition. By letter of July 7, 2004, the Board issued an interlocutory ruling, striking paragraph 2(c) of the amended statement of opposition and accepting the remainder of the amended statement.

On October 4, 2004, the Applicant’s change of name to 604 Records Inc. was recorded in the Canadian Intellectual Property Office.

The Opponent elected to not file any evidence in support of its opposition.

The Applicant filed the affidavit of Jonathan Simkin in support of its application. The Opponent did not seek to cross-examine Mr. Simkin on his affidavit.

Only the Applicant filed a written argument; an oral hearing was not requested.

Grounds of Opposition

There are five grounds of opposition remaining in the statement of opposition. The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

1. Entitlement under Sections 16(3)(a) and (c)

The Opponent pleads that the Applicant is not the person entitled to register the Mark because, at the date of filing of the application, the Mark was confusing with the mark VIOIV 604 CLOTHING CO., which the Opponent had previously used or made known in Canada in association with “printed matter” and “wearing apparel”.

The Opponent has an initial burden to show that it had in fact used or made known its mark as claimed in this pleading. In the absence of any evidence filed by the Opponent, this ground fails on the basis that the Opponent has not satisfied its initial burden.

2. Entitlement under Section 16(3)(b)

The Opponent pleads that the Applicant is not the person entitled to register the Mark because, at the date of filing of the application, the Mark was confusing with the mark VIOIV 604 CLOTHING CO., which is the subject of an application previously filed by the Opponent under s.n. 1,139,083 on April 26, 2002.

The initial onus on the Opponent with respect to this ground is to demonstrate the existence of its application and that it was still pending at the date of advertisement of the Applicant's application (s. 16(4)). Although the Opponent has not filed any evidence, I can and have exercised the Registrar's discretion to check the Register to determine the status of application s.n. 1,139,083 [see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.) at p. 529]. I confirm that the application was pending in the name of the Opponent when the present application was advertised. It was declared abandoned on August 9, 2005, but that does not preclude this ground of opposition from being assessed. Moreover, its abandonment is not a factor to be considered in assessing the likelihood of confusion under s. 16(3) since it occurred after the material date. [See *ConAgra Inc. v. McCain Foods Ltd.* (2001), 14 C.P.R. (4th) 288 (F.C.T.D.).]

the test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. 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. Those criteria are not exhaustive and 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.)].

The Supreme Court of Canada through Mr. Justice Binnie in *Mattel, Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321 elaborated on the test of confusion as follow:

What, then, is the perspective from which the likelihood of a “mistaken inference” is to be measured? It is not that of the careful and diligent purchaser. Nor, on the other hand, is it the “moron in a hurry” so beloved by elements of the passing-off bar: *Morning Star Co-Operative Society Ltd. v. Express Newspapers Ltd.*, [1979] F.S.R. 113 (Ch. D.), at p. 117. It is rather a mythical consumer who stands somewhere in between, dubbed in a 1927 Ontario decision of Meredith C.J. as the “ordinary hurried purchasers”: *Klotz v. Corson* (1927), 33 O.W.N. 12 (Sup. Ct.), at p. 13. See also *Barsalou v. Darling* (1882), 9 S.C.R. 677, at p. 693. In *Delisle Foods Ltd. v. Anna Beth Holdings Ltd.* (1992), 45 C.P.R. (3d) 535 (T.M.O.B.), the Registrar stated at p. 538:

When assessing the issue of confusion, the trade marks at issue must be considered from the point of view of the average hurried consumer having an imperfect recollection of the opponent’s mark who might encounter the trade mark of the applicant in association with the applicant’s wares in the market-place.

(...)

In opposition proceedings, trade-mark law *will* afford protection that transcends the traditional product lines unless the applicant shows the likelihood that registration of its mark will *not* create confusion in the marketplace within the meaning of s. 6 of the *Trade-Marks Act*. Confusion is a defined term, and s. 6(2) requires the Trade-marks Opposition Board (and ultimately the court) to address the *likelihood* that in areas where both trade-marks are used, prospective purchasers will infer (incorrectly) that the wares and services - though not being of the same general class - are nevertheless supplied by the same person. Such a mistaken inference can only be drawn here, of course, if a link or association is likely to arise in the consumer's mind between the source of the well-known BARBIE products and the source of the respondent's less well-known restaurants. If there is no likelihood of a link, there can be no likelihood of a mistaken inference, and thus no confusion within the meaning of the Act.

It is with these general principles in mind that I shall review the pertinent evidence and assess each relevant factor identified above.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

Numerals possess very little inherent distinctiveness, but both parties’ marks have some degree of inherent distinctiveness since 604 has no apparent relationship to either of the parties’ wares/services. The inclusion of VIOIV in the Opponent’s mark further increases its inherent distinctiveness.

There is no evidence that the Opponent's mark has become known. Although the Applicant has filed evidence concerning its use of its Mark, such use postdates the material date.

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

The Applicant had not begun use of its Mark as of the material date (May 8, 2002), whereas the Opponent's application claims use in association with printed material namely stickers since March 20, 2002 and in association with sweatshirts since April 26, 2002.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

Mr. Simkin, the Applicant's President, says that the Applicant is in the business of music production, promotion and distribution. The Applicant works with both musical artists and compact disc distributors, each of which it enters into contracts with. Through the compact disc distributors, the Applicant provides pre-recorded compact discs featuring musical sound recordings of its contracted artists to retail outlets in Canada as well as to online distributors such as iTunes Canada.

We do not know what the Opponent's business is or what channels of trade its wares would travel; however, none of its wares are music-related. Clothing and stickers are quite distinct from musical recordings.

The Applicant's clientele for its services would appear to be primarily musical artists. It seems fair to presume that such individuals would be fairly careful in their selection of a company to produce, promote and distribute their music, that is, more careful than an individual who is buying clothing or stickers.

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

In *Polo Ralph Lauren Corp. v. United States Polo Association et al.* (2000), 9 C.P.R. (4th) 51 (F.C.A.) at 58-59, Malone J.A. stated:

With respect to the degree of resemblance in appearance, sound or ideas under

subparagraph 6(5)(e), the trade-marks at issue must be considered in their totality. As well, since it is the combination of elements that constitutes a trade-mark and gives distinctiveness to it, it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks when applying the test for confusion.

“Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade-mark is the most relevant for purposes of distinction.” [*K-Tel International Ltd. v. Interwood Marketing Ltd.* (1997), 77 C.P.R. (3d) 523 (F.C.T.D.) at 527]

The first portions of the two marks are not the same. On further reflection, VIOIV in the Opponent’s mark can be understood to represent a Roman numeral-type version of 604, but this is not obvious at first glance.

As mentioned earlier, the number 604 does not appear to have any meaning in association with either of the parties’ wares or services. The idea suggested by the Opponent’s mark may therefore simply be “clothing”, while that of the Applicant’s Mark may simply be “records”.

Overall, the degree of resemblance between VIOIV 604 CLOTHING CO. and 604 RECORDS is not high visually, aurally or in idea suggested.

other surrounding circumstances

The Applicant has made submissions in its written argument concerning the state of the register. However, since the third party marks that it refers to have not been entered into evidence, I cannot consider them.

conclusion re confusion

In view of the inherent weakness of numerals, the differences between the parties’ marks, the differences between their wares/services, and the lack of evidence and argument on the part of the Opponent, I find that there was not a reasonable likelihood of confusion between the mark that is the subject of application s.n. 1,139,083 and the Mark as of May 8, 2002.

This ground of opposition is accordingly rejected. To find otherwise would, in my view, make

the Opponent the possessor of an exclusive property right in relation to the number 604.

3. Non-compliance with Section 30(e)

The Opponent pleads that the Applicant did not intend to use the Mark in the normal course of trade with the applied for wares and services. The Opponent has not filed any evidence to substantiate this claim and so this ground is dismissed on the basis that the Opponent failed to meet its initial burden.

4. Non-compliance with Section 30(a)

The Opponent pleads that the following services are not in ordinary commercial terms: music production services; producing musical and dramatic performances, exhibitions and shows. However, the Opponent has filed neither evidence nor argument to support this claim. Therefore, this ground is also dismissed on the basis that the Opponent failed to satisfy its initial burden.

5. Distinctiveness pursuant to Section 2

The Opponent pleads that the Mark does not actually distinguish the Applicant's wares and services, nor is it adapted to distinguish them, from the Opponent's VIOIV 604 CLOTHING CO. wares.

The material date with respect to this ground is the filing date of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

In order to meet its initial burden with respect to distinctiveness, the Opponent must show that its trade-mark was "known to some extent at least" as of the filing of its opposition [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58]. As the Opponent has not filed any evidence to show that its mark had become known as of any date, this ground is dismissed on the basis that the Opponent has not satisfied its initial burden.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 27th DAY OF APRIL 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board