



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

Citation: 2012 TMOB 42
Date of Decision: 2012-03-02

**IN THE MATTER OF AN OPPOSITION
by 1772887 Ontario Limited and its
predecessor in title Toronto Life
Publishing Company Limited to
application No. 1,453,378 for the trade-
mark FASHIONISM & Design in the
name of Bell Canada**

[1] On September 28, 2009, Bell Canada (the Applicant) filed an application to register the trade-mark FASHIONISM & Design (the Mark), shown below, based on use in Canada since at least as early as August 31, 2008 in association with the “operation of an entertainment website offering information in the field of lifestyle, namely, fashion and beauty featuring text articles, blogs, photos gallery, contests, newsletters and user-generated content; advertising services namely, advertising the wares and services of others; promotional services namely, promoting goods and services of others by arranging for sponsors to affiliate its goods and services with internet content” (the Services).



[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 24, 2010.

[3] On August 24, 2010, 1772887 Ontario Limited and its predecessor in title Toronto Life Publishing Company Limited (collectively the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Contrary to s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) the Applicant has not used the Mark as and from the date of first use alleged on any of the Services.
- At the date of filing the application for the Mark, the Applicant was well aware or ought to have been aware of the existence of the Opponent and the use and notoriety of its trade-marks referred to below in the s. 12(1)(d) and non-entitlement grounds of opposition. As a result, the Applicant could not have been satisfied under s. 30(i) of the Act of its entitlement to use the Mark.
- The Mark is not registrable contrary to s. 12(1)(d) of the Act as the Mark is confusing with the Opponent's registered mark, FASHION18, registered on February 21, 2005 under registration No. TMA633,226.
- The Applicant is not entitled to registration of the Mark pursuant to s. 16(1)(a) and (b) of the Act as at claimed date of first use for the Mark it was confusing with the following trade-marks which the Opponent had applied for and/or used in Canada since a date well prior to the claimed date of first use for the Mark:
 - TMA633,226 – FASHION18 – registered February 21, 2005 for the wares “printed publications, namely a magazine and newsletters” and the services “Internet services, namely electronic magazine and website services available over the worldwide web to consumers; media services, namely educational and informational services all relating to magazine; entertainment services, namely the creation and production of consumer television and radio broadcast shows and pre-recorded CD and DVD media for purchase by the consumer”; and
 - Application No. 1447752 – FASHION – applied for July 31, 2009 for the wares “magazines” and the services “Internet services, namely, informational services in the form of electronic magazines and publishing services through the use of the worldwide web”.
- In view of the facts set out in the s. 12(1)(d) and s. 16 grounds of opposition, the Mark is not distinctive of nor is it capable of becoming distinctive of the Applicant within the meaning of s. 2 of the Act.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof. I note that in its counter statement, the Applicant also includes what would be classified as evidence and argument. Specifically, the Applicant: (a) references state of the register evidence for the term FASHION; (b) refers to the fact that the Examiner failed to cite the Opponent's marks against the application for the Mark

during examination; and (c) refers to the fact that since the date of filing the application for the Mark, the Applicant has obtained the following registrations: FASHIONISM.CA (TMA780,887); FASHIONISM.CA & Design (TMA780,886) and FASHIONISM.CA LOVE YOUR LOOK & Design (TMA780,885) and attaches particulars of these registrations to the counter statement. I refuse to place any weight on these submissions and evidence as it has not been properly made of record.

[5] The Opponent filed an affidavit of Elenita Anastacio, sworn April 4, 2011 with Exhibits A – E as its evidence pursuant to r. 41 of the *Trade-marks Regulations* SOR/96-195 (the Regulations). Ms. Anastacio was not cross-examined on her affidavit. Ms. Anastacio is a trade-mark searcher employed by the Opponent's agent. Ms. Anastacio attaches to her affidavit particulars of registration No. TMA633,226 for the trade-mark FASHION18 and application No. 1,447,752 for the trade-mark FASHION. Ms. Anastacio also attaches results from searches of the FPInfomart database and the Internet archival service Wayback Machine.

[6] The Applicant did not file any evidence in support of its application.

[7] Only the Applicant filed a written argument.

[8] An oral hearing was held at which both parties were represented.

Onus and Material Dates

[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].

[10] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/30(b) and (i) - the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].

- s. 38(2)(b)/12(1)(d) - the date of my decision [see *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. 38(2)(c)/16(1)(a) and (b) - the claimed date of first use [see s. 16(1) of the Act].
- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30 Grounds

Section 30(i) of the Act

[11] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the s. 30(i) ground is accordingly dismissed.

Section 30(b) of the Act

[12] The Opponent relies on Exhibits B – D of the Anastacio affidavit in support of its s. 30(b) ground of opposition.

[13] Ms. Anastacio conducted a search of the FPIInfomart database on March 14, 2011 for the term “FASHIONISM” in association with “Bell Canada”. Ms. Anastacio states that the FPIInfomart database is “Canada’s largest provider of media monitoring and corporate information, including more than 275 news sources from coast to coast [...] FPIInfomart.ca offers archival access to over 1100 full text newspapers, magazines, newswires, transcripts and blogs, national, regional and international sources [...]”. Ms. Anastacio states that she found no references to FASHIONISM in association with Bell Canada prior to September 1, 2008 (Exhibit B). Ms. Anastacio’s search of the database (covering the time period from January 1, 2007 to the date she conducted her search) revealed one reference to Bell Canada and the website *www.fashionism.ca* (Exhibit B). This reference is dated July 12, 2010.

[14] Ms. Anastacio also conducted a search of the Internet archival system Wayback Machine for the website *www.fashionism.ca*. Ms. Anastacio provides the results of a WHOIS ownership search which reveals that the *fashionism.ca* domain name is owned by the Applicant and was created on January 28, 2008 (Exhibit C). Ms. Anastacio was tasked with printing the August 31, 2008 archived version of the *www.fashionism.ca* website as well as materials which could be obtained by clicking links on this archived website. Ms. Anastacio stated that most of the links did not reveal any additional material (Exhibits C, D). I note that, as submitted by the Applicant at the oral hearing, Exhibit C to Ms. Anastacio's affidavit displays the Mark alongside fashion-related content.

[15] The Applicant objects to the materials attached to the Anastacio affidavit as being inadmissible hearsay. I am satisfied that Ms. Anastacio has established the reliability of the FPIInfomart database. Furthermore, I note that the evidence produced by the Wayback Machine indicating the state of websites in the past has been found to be generally reliable [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.); reversed on other grounds 2008 F.C.A. 100]. Based on the foregoing, I do not accept the Applicant's submissions regarding the inadmissibility of Ms. Anastacio's affidavit as a whole.

[16] The Opponent submits that Ms. Anastacio's statement that most of the links on the August 31, 2008 archived version of the Applicant's website did not reveal any additional material should enable me to infer that the Applicant's website was under construction at that time and that the Applicant was therefore not offering the Services as of August 31, 2008. I am not willing to make such an inference merely on the basis that the links on an archived version of a website from a number of years ago did not function. I have no evidence regarding the functionality of archived websites found on Wayback Machine.

[17] Based on a review of the Anastacio affidavit as a whole, I am not satisfied that the Opponent has met its burden under s. 30(b) of the Act. Specifically, the WHOIS search results show that the Applicant created the *fashionism.ca* domain in January 2008 and the Wayback Machine results show that the *www.fashionism.ca* website was active and displaying content and the Mark on August 31, 2008. Neither of these facts is inconsistent with the claimed date of first use of August 31, 2008.

[18] Based on the foregoing, the ground of opposition based on non-compliance with s. 30(b) of the Act is dismissed.

Section 12(1)(d) Ground of Opposition

[19] An opponent's initial onus is met with respect to a s. 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised that discretion and confirm that the registration for the trade-mark FASHION18 remains valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[20] 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.

[21] 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 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [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.).]

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

[22] The parties' marks share the dictionary word "fashion". I can take judicial notice of the dictionary definition for the word "fashion" [see *Envirodrive Inc. v. 836442 Canada Inc.*, 2005

ABQB 446; *Aladdin Industries, Inc. v. Canadian Thermos Products Ltd.* (1969), 57 C.P.R. 230 (Ex. Ct.), aff'd (1974), 6 C.P.R. (2d) 1 (S.C.C.)). The word "fashion" is defined in *The Canadian Oxford Dictionary* as "the current popular custom or style, esp. in dress or social conduct".

[23] As drafted, some of the Services specifically relate to fashion. The Opponent's wares and services relate to various forms of media publications. The word "fashion" is thus suggestive of the subject matter of the parties' wares and services such that it lacks inherent distinctiveness.

[24] I note that in coming to this conclusion regarding the lack of inherent distinctiveness for the word "fashion", I am not placing any weight on the Applicant's unsubstantiated submission that the word "fashion" is common to the trade. The state of the register evidence referred to by the Applicant in its counter statement has not been filed as evidence. I note that state of the register evidence cannot be considered where it is adduced through pleadings and without filing certified copies of the registrations or at least an affidavit affixing particulars of the relevant registrations [see *Unitron Industries Ltd. v. Miller Electronics Ltd.* (1983), 78 C.P.R. (2d) 244 at 253 (T.M.O.B.)]. Furthermore, the law is clear that, when adjudicating in an opposition proceeding, the Registrar does not exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications are extant [see *Quaker Oats* at 411 and *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.)]. The parties to opposition proceedings are expected to prove each aspect of their case following fairly strict rules of evidence [see *Loblaws Inc. v. Telecombo Inc.* 2004 CarswellNat 5135 at para 13 (T.M.O.B.)].

[25] The Mark features the addition of the suffix "ism" to the word "fashion" which creates a coined word. The Applicant submits that this results in a mark with no particular meaning aside from the fact that it is suggestive of fashion. By contrast, at the oral hearing the Opponent submitted that "ism" means a common belief in a principle. The Opponent made the analogy that "communism" suggests a common belief in communist ideas and as such "fashionism" would suggest a common belief in fashion. The Opponent has not provided any evidentiary support for its interpretation of the suffix "ism". I note that *The Canadian Oxford Dictionary* defines the suffix "ism" as "forming nouns, esp. denoting".

[26] I note that the Mark also features design elements, in the form of stylized text and the letter “A” being replaced with the depiction of a woman holding shopping bags.

[27] While I have taken the Opponent’s submissions and the dictionary definition into consideration, I remain of the view that the Mark, being a coined word with design features, possesses a higher degree of inherent distinctiveness than the Opponent’s trade-mark FASHION18 which merely consists of the addition of the number “18” to the word “fashion”.

[28] A trade-mark may acquire distinctiveness through use or promotion. However, in the present case neither party has filed evidence to show use or promotion of its marks. While it is true that the Opponent’s registration claims use in Canada, at most this entitles me to assume *de minimis* use of the trade-mark FASHION18 [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.) at 430]. *De minimis* use does not support a conclusion that the trade-mark FASHION18 had become known to any significant extent.

Section 6(5)(b) – the length of time each has been in use

[29] I do not agree with the Opponent that this factor favours the Opponent. While it may be true that *de minimis* use is more than no use, in the absence of evidence of use of either party’s marks, this factor does not significantly favour either party.

Section 6(5)(c) and (d) – the nature of the wares, trade and business

[30] It is the Applicant’s statement of services as defined in its application versus the Opponent’s registered wares and/or services that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[31] I agree with the Opponent that the Opponent’s “Internet services, namely electronic magazine and website services available over the worldwide web to consumers” create an overlap in the nature of the parties’ services.

[32] Given that some of the Services overlap with the Opponent’s “Internet services, namely electronic magazine and website services available over the worldwide web to consumers”, and

in the absence of any evidence regarding the parties' trades, I am satisfied that the parties' channels of trade could also overlap.

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

[33] Recently, in *Masterpiece*, the Supreme Court of Canada discussed the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with s. 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[34] As submitted by the Applicant, the Federal Court of Appeal noted in *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 at 263 (F.C.A.),

While the marks [in issue] must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.

[35] At the oral hearing, the Applicant submitted that while the first portion of the mark is usually the most important for the purpose of distinguishing (see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188) the importance will be diminished where the first portion is a common descriptive word. The Applicant submits that it would be inappropriate to give the Opponent broad protection over the suggestive word "fashion" in the absence of evidence supporting a finding that the trade-mark FASHION18 has acquired any distinctiveness. In support of this submission, the Applicant relied upon *Johnson & Johnson v. Mahrukh Panthakey* 2011 TMOB 60 at para 24 (April 12, 2011 T.M.O.B. (unreported) application No. 1,141,824) where the marks ACUVUE and ACCUWAVE, both covering contact lenses, were found not confusing despite sharing the same first portion.

[36] I agree with the Applicant's submission. Furthermore, I note that the Supreme Court of Canada in *Masterpiece* recently advised that the preferable approach when comparing marks is

to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64]. In the present case, the focus would be placed on the “ism” element of the Mark, as it adds distinctiveness to the inherently non-distinctive “fashion” and would therefore be considered “striking” or “unique”.

[37] There is no similarity between the striking “ism” element of the Mark and any portion of the trade-mark FASHION18 in appearance, sound or ideas suggested. The design element serves to further distinguish the Mark from the trade-mark FASHION18.

[38] Confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd. v. Chalet Bar B Q (Canada) Inc.* (1982), 66 C.P.R. (2d) 56 at 73 (F.C.A.)].

[39] Ultimately, when considering the marks as a whole, I am not convinced that the mere fact that the Mark contains the suggestive word “fashion” is sufficient to find that the parties’ marks share any significant degree of similarity in appearance, sound or ideas suggested.

Additional Surrounding Circumstance

[40] At the oral hearing, the Applicant referred to the existence of the Applicant’s FASHIONISM registrations: FASHIONISM.CA (TMA780,887); FASHIONISM.CA & Design (TMA780,886) and FASHIONISM.CA LOVE YOUR LOOK & Design (TMA780,885).

[41] I note that the fact that the Applicant owns these registrations does not give it the automatic right to the registration of the Mark [see *Mister Coffee & Services Inc. v. Mr. Coffee, Inc.* (1999), 3 C.P.R. (4th) 405 (T.M.O.B.) at 416 and *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 572 (T.M.O.B.) at 576].

[42] Based on the foregoing, I am not satisfied that this forms an additional surrounding circumstance supporting the Applicant’s position.

Conclusion

[43] As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the s. 6(5)(e) factor in the analysis of the likelihood of confusion. In the present

case, I have found significant differences between the parties' marks. I am of the view that none of the other factors assist the Opponent in overcoming the differences between the marks. The Opponent has not evidenced that its trade-mark has acquired any distinctiveness through use or promotion. As discussed above in the analysis of the s. 6(5)(a) factor, while the Opponent's registration claims use in Canada, the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer*]. The ambit of protection of the Opponent's trade-mark FASHION18 is very narrow, due in part to the low inherent distinctiveness. Therefore while the parties' services share some degree of overlap, this is insufficient to result in a likelihood of confusion given the differences between the marks and the inherent distinctiveness of the Mark.

[44] Having considered all of the surrounding circumstances, in particular the inherent distinctiveness of the Mark and the differences between the parties' marks in terms of appearance, sound and idea suggested, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the trade-mark FASHION18.

[45] Based on the foregoing, the s. 12(1)(d) ground of opposition is dismissed.

Non-entitlement Grounds

Section 16(1)(a) of the Act

[46] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's previously used marks, the Opponent has the initial onus of proving that one or more of the trade-marks alleged in support of its ground of opposition based on s. 16(1) of the Act had been used in Canada prior to the claimed date of first use (August 31, 2008) and had not been abandoned at the date of advertisement of the application for the Mark (March 24, 2010) [s. 16(5) of the Act].

[47] The Opponent has not filed any evidence of use of the claimed marks. As discussed, the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer*].

[48] Based on the foregoing, the ground of opposition based on s. 16(1)(a) of the Act is dismissed.

Section 16(1)(b) of the Act

[49] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's Marks, the Opponent has the initial onus of proving that one or more of the trade-mark applications alleged in support of its ground of opposition based on s. 16(1)(b) of the Act were pending at the claimed date of first use for the Mark, and remained pending at the date of advertisement of the application for the Mark [s. 16(5) of the Act]. The Registrar has the discretion, in view of the public interest, to check the register for applications relied upon by an opponent [see *Royal Appliance*]. I have exercised my discretion to check the status of the applications cited by the Opponent.

[50] As discussed in the s. 12(1)(d) ground of opposition, the trade-mark FASHION18 was registered on February 21, 2005 and therefore was no longer pending as of the date of advertisement for the Mark. Furthermore, application No. 1,447,752 for the trade-mark FASHION was applied for on July 31, 2009 which is subsequent to the claimed date of first use for the Mark.

[51] Based on the foregoing, the ground of opposition based on s. 16(1)(b) is dismissed for having been improperly pleaded.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[52] In order to meet its initial burden with respect to this ground, the Opponent must establish that one or more of its claimed trade-marks was known at least to some extent in Canada as of August 24, 2010 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)].

[53] The Opponent has not filed any evidence of use of the claimed marks. I note that the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer*]. The

particulars attached to Ms. Anastacio's affidavit are therefore not sufficient to enable the Opponent to meet its evidential burden for this ground.

Disposition

[54] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office