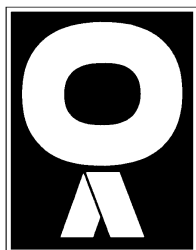


**IN THE MATTER OF AN OPPOSITION by Barreau du Québec
to application No. 742,249 for the trade-mark I & Design filed by
The Amicus Legal Publishing Company Limited**

On November 25, 1993, the applicant, The Amicus Legal Publishing Company Limited, filed an application to register the design trade-mark, a representation of which appears below, based upon use of the trade-mark in Canada since at least as early as April 24, 1992 in association with “*Periodical legal journal and law reporter*” and in association with services identified as the “*publication of articles, commentary and reports prepared by third parties and specifically addressed to the legal profession*”. The applicant in its correspondence has described its mark as AMICUS Design but for the purposes of this opposition I have identified the applicant’s trade-mark as I & Design.



The present application was advertised for opposition purposes in the *Trade-marks Journal* of March 1, 1995 and the opponent, Barreau du Québec, filed a statement of opposition on March 31, 1995, a copy of which was forwarded to the applicant on May 24, 1995. The opponent alleged that the applicant’s trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the applicant’s trade-mark is confusing with the opponent’s registered trade-marks Q & Design and BARREAU DU QUÉBEC & Design, registration Nos. 184,595 and 401,263, set out below, which marks had previously been used in Canada.



Registration No. 184,595

“Publications, nommément, brochures; recueils officiels des arrêts des tribunaux; périodiques d'intérêt professionnel et d'information publique et mémoires. Boutonnieres, boutons de manchettes, épinglettes, plaques souvenirs, porte-documents, stylos, cartons d'allumettes, chandails.”

“L'administration dans la province de Québec d'une corporation des membres de la profession juridique, qui, comme auxiliaire de la justice et dans le but d'assurer la protection et l'intérêt du public, a des pouvoirs de réglementation, de contrôle et de surveillance de la profession, dont les membres bénéficient du monopole du titre d'avocat, et qui a juridiction entre autres pour assurer le maintien de l'honneur et de la dignité du Barreau et administrer la discipline de ses membres; établir et administrer un organisme d'assistance judiciaire dans toute la province et conclure à cette fin toutes ententes utiles avec les Sections et les autorités gouvernementales; assurer la formation professionnelle des candidats [sic] à l'exercice de la profession et le perfectionnement de ses membres; promouvoir les relations entre les membres afin de stimuler la profession juridique; établir les politiques et le rôle social du Barreau; former des comités chargés de certaines des affaires du Barreau, de la recherche, de la surveillance de la législation et de l'administration de la justice, et faire les représentations jugées opportunes à qui de droit; publier des recueils officiels des arrêts des tribunaux ou tous autres périodiques ou publications d'intérêt professionnel ou d'information publique; informer le public d'une manière appropriée de ses droits et des objets de Barreau.”

Registration No. 401,263

“Publications imprimées, nommément, brochures, recueils officiels des arrêts des tribunaux, périodiques d'intérêt professionnel et d'information publique, mémoires; boutonniers, boutons de manchettes, épinglettes, plaques souvenirs, porte-documents, chandails, articles promotionnels, nommément, stylos, cartons d'allumettes, bannières.”

“Administration dans la province de Québec d'une corporation des membres de la profession juridique, qui, comme auxiliaire de la justice et dans le but d'assurer la protection et l'intérêt du public, a des pouvoirs de réglementation, de contrôle et de surveillance de la profession, dont les membres bénéficient du monopole du titre d'avocat, et qui a juridiction entre autres pour assurer le maintien de l'honneur et de la dignité du Barreau et administrer la discipline de ses membres; établir et administrer un organisme d'assistance judiciaire dans toute la province et conclure à cette fin toutes ententes utiles avec les Sections et les autorités gouvernementales; assurer la formation professionnelle des candidats à l'exercice de la profession et le perfectionnement de ses membres; promouvoir les relations entre les membres afin de stimuler la profession juridique; établir les politiques et le rôle social du Barreau; former des comités chargés de certaines des affaires du Barreau, de la recherche, de la surveillance de la législation et de l'administration de la justice, et faire les représentations jugées opportunes à qui de droit; publier des recueils officiels des arrêts des tribunaux ou tous autres périodiques ou publications d'intérêt professionnel ou d'information publique; informer le public d'une manière appropriée de ses droits et des objets du Barreau.”

The applicant filed and served a counter statement in which it generally denied the allegations set forth in the statement of opposition. The opponent filed as its evidence the affidavit of Pierre

Gauthier dated January 22, 1996 while the applicant submitted as its evidence the affidavit of Dwight Richardson, dated August 7, 1996. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

The first ground of opposition is based on Paragraph 12(1)(d) of the *Trade-marks Act*, the opponent asserting that the trade-mark I & Design is not registrable in that there would be a reasonable likelihood of confusion between the applicant's trade-mark and its registered trade-marks noted above. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those which are specifically enumerated in Subsection 6(5) of the *Act*. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date in relation to the Paragraph 12(1)(d) ground [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

The applicant's trade-mark I & Design would, as a matter of immediate impression, be perceived by the average consumer of the applicant's wares or services as being a depiction of a barrister in a robe and collar and is therefore suggestive of the nature of the applicant's wares and services which are directed to the legal profession. Further, while the design element of the opponent's trade-mark BARREAU DU QUÉBEC & Design adds some measure of inherent distinctiveness to the trade-mark when considered in its entirety, the mark is dominated by the words BARREAU DU QUÉBEC which identify the source of the wares and services associated with the opponent's mark. Thus, the opponent's trade-mark BARREAU DU QUÉBEC & Design possesses a limited degree of inherent distinctiveness. The opponent's Q & Design is inherently distinctive although some consumers of the opponent's wares and services might perceive the design as being a depiction of a barrister's collar and is therefore somewhat suggestive of the fact that the opponent's wares and services are intended for members of the legal profession.

The applicant's I & Design trade-mark had only become known to a limited extent as of the

date of my decision as applied to the applicant's wares and services. While the applicant has argued that its use of its trade-mark AMICUS & Design, a representation of which appears below, constitutes use of its I & Design trade-mark, I do not consider that the average consumer of the applicant's wares and services would perceive the use of the AMICUS & Design mark as being use of the I & Design trade-mark which the applicant is seeking to register. Further, the appearance of the applicant's mark at the end of various publications would not, in my view, be perceived as use of the I & Design mark as a trade-mark in association with wares as contemplated by Subsection 4(1) of the *Trade-marks Act*. Thus, it is only exhibits F1 and F2 to the Richardson affidavit which could arguably be said to show use of the trade-mark I & Design in association with the applicant's services.

The applicant has submitted that the opponent does not use its trade-mark Q & Design separate and apart from the words BARREAU DU QUÉBEC. I disagree with the applicant's submission. In my view, the Gauthier affidavit establishes that the opponent had used both its Q & Design and BARREAU DU QUÉBEC & Design trade-marks in Canada. However, the opponent's Q & Design mark often appears in conjunction with the words BARREAU DU QUÉBEC, thus limiting the extent to which the opponent's Q & Design mark can be considered as having become known in Canada [see, in this regard, *Le Barreau du Québec/ The Bar of the Province of Quebec v. Nash*, 70 C.P.R. (3d) 233, at p. 239]. However, having regard to the Gauthier affidavit, I have concluded that both of the opponent's marks have become known primarily in the province of Quebec in association with legal publications and in association with the opponent's services relating to the administration of the legal profession in Quebec. Thus, the extent to which the trade-marks at issue have become known favours the opponent.

The opponent has used its trade-mark Q & Design since 1971 in relation to the services and certain of the wares covered in registration No. 184,595 and has used its BARREAU DU QUÉBEC & Design mark since December of 1984 in association with the wares and services covered in

registration No. 401,263. On the other hand, the applicant claims that it commenced use of its I & Design trade-mark in April of 1992 although, as noted above, it is doubtful whether the applicant has used its trade-mark I & Design in association with the wares covered in the present application. Accordingly, the length of time that the trade-marks at issue have been in use also weighs in the opponent's favour.

The present application covers periodical legal journals and law reporters and services relating to the publication of articles, commentary and reports prepared by third parties and specifically addressed to the legal profession. These wares and services overlap the opponent's wares covered in its registrations which include "Publications, nommément, brochures; recueils officiels des arrêts des tribunaux; périodiques d'intérêt professionnel et d'information publique et mémoires" and the opponent's services which include "publier des recueils officiels des arrêts des tribunaux ou tous autres périodiques ou publications d'intérêt professionnel ou d'information publique". Further, as there is no restriction in the channels of trade associated with the wares and services covered in the present application and the opponent's registrations, there could be a potential overlap in the respective channels of trade of the parties.

As for the degree of resemblance between the trade-marks at issue, there is relatively little similarity in appearance and in the ideas suggested and no similarity in the sounding between the applicant's I & Design trade-mark and the opponent's registered trade-mark BARREAU DU QUÉBEC & Design. Further, there is relatively little similarity between the trade-marks I & Design and Q & Design in appearance and, to the extent that the marks would be sounded by reference to the letters I and Q, there would be no similarity in sounding of these marks. As the applicant's trade-mark I & Design would be perceived as a depiction of a barrister in a robe and collar while the opponent's Q & Design might suggest to some consumers of its wares and services a depiction of a barrister's collar or tabs, there is at least some degree of similarity in the ideas suggested by these trade-marks.

The applicant has submitted that no evidence of actual confusion between the trade-marks at issue has been adduced by the opponent despite the concurrent use of the trade-marks at issue.

However, the Richardson affidavit points to the applicant's use of its trade-mark AMICUS & Design and little, if any, use of its I & Design as a trade-mark. Thus, the absence of evidence of instances of actual confusion between the trade-marks at issue is not a relevant surrounding circumstance in this case.

Having regard to the above and, in particular, to the absence of any resemblance between the trade-marks I & Design and BARREAU DU QUÉBEC & Design, I have concluded that there would be no reasonable likelihood of confusion between these trade-marks. On the other hand, I am left in doubt concerning the likelihood of confusion between the applicant's I & Design mark and the registered trade-mark Q & Design, bearing in mind that there is some resemblance in the ideas suggested by these marks and the wares and services and channels of trade associated with them overlap. Furthermore, I am mindful of the fact that the opponent's Q & Design trade-mark has acquired some measure of a reputation in Canada in association with the opponent's wares and services. As a result, the applicant's trade-mark is not registrable in view of Paragraph 12(1)(d) of the *Trade-marks Act*.

Having been delegated by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 12th DAY OF NOVEMBER, 1997.

G.W. Partington
Chairperson
Trade Marks Opposition Board