

**IN THE MATTER OF AN
OPPOSITION by Vibe Ventures
LLC and Vibe Media Group LLC to
application No. 1,221,122 for the
trade-mark VIBETRAIN filed by
Lewis Craig Trading as Vibetrain**

On June 21, 2004 Lewis Craig trading as Vibetrain (the “Applicant”) filed an application to register the trade-mark VIBETRAIN (the “Mark”) based upon proposed use of the Mark in Canada by himself or through a licensee in association with the following wares and services as amended:

“Sound recordings, namely pre-recorded tapes, pre-recorded cassettes; promotional items, namely business cards, posters, flyers, concert programs, photographs, pamphlets, stickers, artists’ biographical materials, namely artist press kits; artistic and literary items, namely illustrations and photographs on record covers and pre-recorded covers, commercial and other art, namely graphics, lyrics in printed form; magazines, motion picture film; pre-recorded compact discs containing music, songbooks, pre-recorded digital video discs containing music, pre-recorded video cassettes containing music, pre-recorded music videos, billboards, badges; clothing namely, tour jackets, sweaters, T-shirts, tank tops, jackets, hats; adult and children’s board, electronic and video games, pre-recorded video discs containing music, pre-recorded CD ROMs containing music, computer games, note pads, memo pads, concert tour programs, fridge magnets, adhesive stickers and decals, patches, brochures, souvenir items, namely, booklets, pennants, flags, souvenir albums, bottles and flasks; balloons; printed matter, namely song book folios, paper goods, and stationary namely bulletin boards, writing paper, post cards, guest books, pencil cases, bumper stickers, stickered packets; emblems, cups, and tape covers, key chains, key tabs, paintings, clocks.”

“Entertainment services, namely the provision of live musical and entertainment performances and recording services and personal appearances of a musical artist or group, singing and playing musical instruments or otherwise performing as a musical artist or group for the purposes of entertainment in any combination thereof; operation of a website on the Internet offering pre-recorded music for sale and providing information on music; entertainment services in motion picture films as an actor; entertainment services, namely the provision of pre-recorded musical and entertainment performances in radio and television shows; entertainment services, namely the provision of live or pre-recorded musical and entertainment performances on the Internet; recording and producing aural and visual productions, namely pre-recorded magnetic tape, pre-recorded cassettes, pre-recorded compact discs, phonograph records, read-along books, songbooks, digital video discs, video cassettes, music videos.”

The application was advertised for opposition purposes in the *Trade-marks Journal* of March 9, 2005. On August 4, 2005, Vibe Ventures LLC (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a document entitled counter statement. On June 30, 2006, the Opponent assigned its trade-mark rights with respect to its trade-mark VIBE under registration number TMA526,485 and its pending applications under file number 1,163,727 and 1,284,250 to Vibe Media Group LLC. Leave to file an amended statement of opposition was granted on September 13, 2007, adding Vibe Media Group LLC as an Opponent in this matter. The word “Opponent” will therefore be used to refer to both Vibe Ventures LLC and Vibe Media Group LLC. The Opponent’s evidence consists of the affidavit of Kenard Gibbs. Mr. Gibbs was not cross-examined on his affidavit. The Applicant elected not to file evidence. Only the Opponent filed a written argument and neither party requested a hearing.

The Grounds of Opposition

Various grounds of opposition are pleaded and can be summarized as follows:

The Opponent alleges that the Applicant does not comply with the requirements of Section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended (the “Act”), that the Mark is not registrable, that the Applicant is not the person entitled to registration and finally that the Applicant’s Mark is not distinctive.

Opponent's evidence

Mr. Gibbs is the President of Vibe Ventures LLC (the "Company") since May 2000 and held the position of Sales Representative for VIBE magazine from 1993 to 1998. As president of Vibe Ventures LLC, Mr. Gibbs' duties and responsibilities relate to the operation of the Company. He explains that the Opponent is the publisher of an internationally renowned magazine titled VIBE, which he describes as a general interest magazine relating to music, fashion, urban culture and entertainment. The magazine was founded in 1992 by music icon Quincy Jones who is currently the Chairman of the Company. Mr. Gibbs attests to the use of the trade-mark VIBE in association with magazines and other wares and services such as TV Programs, a website, books, pre-recorded CD's. He further provides annual sales figures of the magazine VIBE showing over 60 000 copies of the magazine VIBE were sold in Canada in 1996 and an average of 70 000 copies have been sold each year since then. Mr. Gibbs files copies of some of the magazine covers over the years ranging from the fall of 1992 to August 2003. These front covers show the retail price of the magazines. I note that the earliest issue showing a Canadian sale price is dated November 2002. Also filed as evidence, is a complete issue of VIBE magazine, dated September 2005.

Analysis of the Various Grounds of Opposition

Section 30(e) of the Act

In its first ground of opposition the Opponent alleges that, pursuant to s. 38(2)(a) of the Act, the Applicant does not comply with the requirements of s. 30(e) of the Act, in that the statement of intent to use is invalid, and that the Applicant did not have the necessary

intention as of the filing date.

The material date that applies to this ground of opposition is the filing date of the application (June 21, 2004) [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475].

Although the legal onus is on the Applicant to demonstrate that he has complied with the requirements of s. 30(e), there exists an initial burden on the Opponent to prove the allegations of fact supporting this ground. The Opponent can meet its burden either by relying on facts that are self evident or admitted, otherwise, in accordance with the general rules of evidence, there is an evidential burden upon the Opponent to prove those allegations [*Joseph E. Seagram & Sons Ltd. Et al. v. Seagram Real Estate Ltd.* (1984) 3 C.P.R. (3d) 325].

To meet its initial evidential burden, the Opponent relies on the Gibbs affidavit, the Applicant's counter statement and the Applicant's request for a retroactive extension of time dated May 29, 2006.

The Opponent refers to paragraphs 16 and 17 of the Gibbs affidavit wherein the affiant is of the belief that the Applicant did not truly intend to use the Mark in association with all the goods and services as some of the services relate to the musical performance by a group, but the Applicant is an individual. The affiant further submits that it is highly unusual that a mark would truly be used as the name of a particular musical artist while at the same time being used as a brand name for the recording and producing for other artists.

Moreover, in its written argument the Opponent recalls that the Applicant's counter statement refers to the Applicant as "we", and further recalls the Applicant's request for

an extension of time within these proceedings dated May 29, 2008 contains the sentence “*On behalf of the music group, we have every intention to adhere to the procedures and dates*”. I note that the Opponent does not further elaborate its contention in this regard.

While I recognize that the initial evidentiary burden on the Opponent is lighter than usual when facing a s. 30(e) ground since the facts regarding the Applicant’s intentions are particularly within the knowledge of the Applicant [*Molson Canada v. Anhauser-Busch Inc.* (2003), 29 C.P.R.(4th) 315 (F.C.T.D.)], I find the Opponent has not met its initial burden, for the following reason:

I do not consider that paragraphs 16 and 17 of the Gibbs affidavit evidence the fact that the Applicant does not truly intend to use the Mark in association with all the wares and services as listed in the application. I find the Opponent’s argument in this regard without merit, because even though the Applicant is an individual, there is nothing incompatible, nor is there anything to prevent the Applicant or his potential licensees from using the Mark in association with the wares and services as listed in the application.

Furthermore, while I may have the authority to consider an admission made by an Applicant in its counter statement in deciding a s. 30 ground [*Société nationale Elf Aquitaine v. Spex Design Inc.*(1988), 22 C.P.R. (3d) 189 (TMOB)], I do not consider that use of the pronoun “we” in the body of the Applicant’s counter statement to be clear admissions that it is not the Applicant himself who intends to use the Mark. As for the request for a retroactive extension of time date May 29, 2006, it was not properly introduced into evidence by way of affidavit or statutory declaration pursuant to s. 38(7)

of the Act and Rule 41(1) of the *Trade-marks Regulations*, as such it does not form part of the evidence of record.

In view of the above, I find that there is no evidence of record that would suggest that Lewis Craig trading as Vibetrain does not intend to use its Mark in Canada, nor is there any evidence to suggest that his intent to use the Mark is invalid.

The Opponent has therefore not met its burden under s. 30(e) of the Act, thus the first ground of opposition is unsuccessful.

Section 30(i) of the Act

The second ground of opposition alleges that “*Under Section 30(i), the Applicant could not have been satisfied that it was entitled to use the trade-mark in Canada in association with the wares described in the application including, for among other reasons, the facts stated therein*”.

Where an Applicant has provided the statement required by s. 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the Applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 T.M.O.B.]. As this is not such a case, I am dismissing this ground of opposition.

Section 12(1)(d) of the Act

The Opponent pleads under s. 12(1)(d) of the Act, that the Applicant’s Mark is confusing with the Opponent’s trade-mark VIBE registered under number TMA 526,485 in association with the wares: “*General interest magazine*”.

The material date that applies to this ground is 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.)].

The Opponent has met its initial burden by filing the certified copy of registration number TMA526, 485 which is in good standing as of this date. The Opponent having met its burden, the onus shifts to the Applicant who must establish, on a balance of probabilities, that its mark is registrable. The presence of an onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant [*John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.)].

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 determining whether there is a likelihood of confusion between the Applicant's mark VIBETRAIN and the Opponent's mark VIBE, the Registrar must have regard to all the surrounding circumstances including those enumerated in s. 6(5) of the Act.

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

In an appeal from the Registrar's decision in a similar opposition, wherein the Opponent in these proceedings was opposing an application for the registration of the trade-mark VIBE in association with clothing, the Federal Court made the determination that "*There is nothing inherently distinctive in the word "VIBE"* [*Vibe Ventures LLC v. 3681441 Canada Inc.* 45 C.P.R. (4th) 17]. Equally applicable in this opposition, there is nothing inherently distinctive in the word VIBE as it consists of an ordinary dictionary word defined in the *Oxford English Dictionary* to mean: "*vibe: noun (informal) the atmosphere or aura of a person or place as communicated to and felt by others*". Not only is the word VIBE an ordinary dictionary word, it is also somewhat suggestive of the Opponent's magazine since it can be said that the content of magazine holds a certain aura, a certain vibe, characterizing the flavour of the magazine. For these reasons the Opponent's mark is not inherently distinctive.

Although the first portion of the Applicant's mark is the word VIBE, it is the trade-mark in its entirety that must be considered. VIBETRAIN consists of the fusion of two ordinary dictionary words that are disconnected in terms of their respective meanings and when juxtaposed render the Mark inherently distinctive.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. From the evidence adduced, I find that the Opponent's trade-mark has become known to a limited extent in Canada. It is recalled that the Applicant did not file any evidence.

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

The Applicant filed an application based on proposed use and has not filed any evidence. In contrast, the Opponent's evidence establishes use of its mark in Canada in association with magazines since 1996.

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

When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

The Opponent's registration covers "*General interest magazine*". Only one of the Applicant's wares clearly overlaps with the Opponent's namely, magazines. As for the remaining wares and services in the application, there is nothing to suggest that they are related with the Opponent's wares.

Very little information has been provided concerning the parties' channels of trade however, it seems reasonable to assume that their channels of trade would overlap with respect to magazines.

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

The marks are similar to some extent in appearance and sound insofar as the Opponent's mark is the first component of the Applicant's Mark. However, with respect to the ideas suggested, I find the word VIBE creates an impression limited to its defined meaning, whereas VIBETRAIN, a coined word with no apparent meaning, creates a significantly different impression.

Conclusion re likelihood of confusion

In applying the test for confusion, it is a matter of first impression and imperfect recollection. The following excerpt from the Supreme Court of Canada in *Mattel U.S.A. Inc. v 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 is insightful on the issue of the perspective from which the likelihood of a "mistaken inference" is to be measured:

The statutory test of confusion

[51] Trade-mark confusion is a term defined in s. 6(2) and arises if it is likely in *all* the surrounding circumstances (6(5)) that the prospective purchaser will be led to the mistaken 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.(...)

[56] 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 Cooperative Society Ltd. v. Express Newspapers Ltd.* (1978), [1979] F.S.R. 113 (Eng. Ch. Div.), 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 (Ont. H.C.), at p. 13. See also *Barsalou v. Darling* (1882), 9 S.C.R. 677 (S.C.C.), at p. 693. In *Aliments*

Delisle Ltée/Delisle Foods Ltd. v. Anna Beth Holdings Ltd. (1992), 45 C.P.R. (3d) 535 (T.M. Opp. Bd.), 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.

And see *American Cyanamid Co. Record Chemical Co.*, [1972] F.C. 1271 (Fed. T.D.), at p. 1276, aff'd (1973), 14 C.P.R. (2d) 127 (Fed. C.A.) . As Cattnach J. explained in *Canadian Schenley Distilleries*, at p. 5.

That does not mean a rash, careless or unobservant purchaser on the one hand, nor on the other does it mean a person of higher education, one possessed of expert qualifications. It is the probability of the average person endowed with average intelligence acting with ordinary caution being deceived that is the criterion and to measure that probability of confusion. The Registrar of Trade Marks or the Judge must assess the normal attitudes and reactions of such persons.

[57] Having repeated that, I fully agree with Linden J.A. in *Pink Panther* that in assessing the likelihood of confusion in the marketplace "we owe the average consumer a certain amount of credit" (para. 54). A similar idea was expressed in *Michelin & Cie v. Astro Tire & Rubber Co. of Canada* (1982), 69 C.P.R. (2d) 260 (Fed. T.D.), at p. 263:

...one must not proceed on the assumption that the prospective customers or members of the public generally are completely devoid of intelligence or of normal powers of recollection or are totally unaware or uninformed as to what goes on around them.

In keeping with this approach, the issue is whether a consumer who has a general and not precise recollection of the Opponent's mark VIBE, will, upon seeing the Applicant's mark VIBETRAIN, be likely to think that the two products share a common source or that the Applicant's wares and services have been licensed or otherwise approved by the Opponent. Given my analysis above, and having had regard to all the surrounding circumstances including those enumerated in s. 6(5) of the Act, I conclude that this would not be the case. I find that the average Canadian consumer, who has an imperfect

recollection of VIBE, is not likely to assume that the Applicant's Mark VIBETRAIN for the applied-for wares and services, share the same source as the Opponent's mark VIBE for magazines.

As I find that there is no reasonable likelihood of confusion, the s. 12(1)(d) ground is accordingly dismissed.

Sections 38(2)(c) and 16(3)(a)

The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) on the basis that the Mark is confusing with the trade-mark VIBE previously used or made known in Canada by the Opponent.

The Opponent has met its initial onus of proving that the trade-mark VIBE alleged in support of its grounds was being used at the material date namely at the filing date of the application (June 21, 2004) and had not been abandoned at the date of advertisement of the application (March 9, 2005) (s. 16(5) of the Act). My findings above with respect to confusion are, for the most part, applicable to this ground of opposition. This ground of opposition is therefore unsuccessful.

Sections 38(2)(c) and 16(3)(b)

Moreover, the Opponent alleges that the Mark is confusing with the trade-mark in respect of which application No.1, 163,727 for the trade-mark VIBE was previously filed in Canada (January 3, 2003). The relevant date for this ground is the filing date of the application (June 21, 2004). The Opponent has the initial onus of showing that its application had been previously filed in Canada and was pending at the date of advertisement of the application (s. 16(4) of the Act).

I find the Opponent has met its burden with respect to this ground.

In addition to the wares “*General interest magazine relating to music, fashion, urban culture and entertainment*” Opponent’s application 1 163 727 also includes the following services: “*Entertainment services in the nature of TV programs*” and “*Operation of an Internet website providing an on-line magazine and information relating to music, fashion, urban culture and entertainment*”. Although these services can be considered to overlap with Applicants services such as “*Operation of a website (...) providing information on music*” and “*Entertainment services, namely the provision of pre-recorded musical and entertainment performances in radio and television shows*”, my conclusions respecting to test for confusion above are applicable regarding this ground of opposition. Notwithstanding these additional overlapping services, I find that there is no likelihood of confusion between the Applicant’s mark VIBETRAIN and the Opponent’s mark VIBE. This ground is dismissed.

Sections 38(2)(c) and 16(3)(c)

The Opponent's allegation regarding the following ground of opposition is reproduced as follows: "*the subject mark was, under Section 16(3)(c), as of the date of first use, confusing with one or more trade-names that had been previously used in Canada by the Opponents, namely: VIBE and VIBE VENTURES*" (emphasis added). I find that this ground is not properly pleaded as the subject application is based on intent to use [s. 16(3)]. Thus, this ground of opposition should have alleged "*as of the date of filing*" rather than "*as of the date of first use*". In any event, even if I were to consider this a clerical error, this ground would not be successful for the following reasons.

The relevant date in assessing the risk of confusion between the Mark and the trade-names relied upon by the Opponent namely VIBE and VIBE VENTURES is the filing date of the application (June 21, 2004). The Opponent has the initial onus of proving that the alleged trade-names were being used at the relevant date and had not been abandoned at the date of advertisement of the application [s. 16(5)]. I find that the Opponent has not discharged its burden of evidencing prior use of the alleged trade-names. Therefore, the ground of opposition based upon s. 16(3)(c) is dismissed. In any event, even had the Opponent evidenced use of its trade-names, given my findings regarding the mark VIBE, I consider even less likely any confusion regarding the trade-name VIBE VENTURES and the Mark VIBETRAN.

Sections 38(2)(d) and 2 of the Act

The Opponent's last ground of opposition alleges that *"The Applicant's trade-mark is not distinctive within the meaning of Section 2 in that the Applicant's trade-mark does not actually distinguish, nor is it adapted to distinguish, the wares or services of the Applicant from the ware, services or business of the Opponents as mentioned above"*.

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

As I find that there is no likelihood of confusion between the Applicant's Mark and the Opponent's, this ground is unsuccessful.

Disposition

All of the pleaded grounds of opposition have been dismissed. Therefore, having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the Opponent's opposition pursuant to s. 38(8) of the Act.

DATED AT GATINEAU, QUÉBEC, THIS 18th DAY OF JANUARY 2009.

Lynne Pelletier
Member
Trade-marks Opposition Board