

**IN THE MATTER OF AN OPPOSITION by
Advance Magazine Publishers Inc. to application
No. 1,202,570 for the trade-mark WISE
GOURMET in the name of Wise Gourmet
Inc.**

On December 31, 2003, Jacqueline Ehlert filed an application to register the trade-mark WISE GOURMET (the “Mark”).

The application is based upon use of the Mark in Canada since at least as early as January 2002 in association with educational services, namely arranging and conducting cooking classes.

The application is also based upon proposed use of the Mark in Canada in association with:

1. carbonated and non-carbonated non-alcoholic fruit and vegetable juice beverages; prepared, packaged or frozen lunch and dinner entrees made from all natural ingredients; salad dressing made from all natural ingredients; pastas and whole grains for eating; salt; edible oils, spices, condiments, nuts, nutritional supplements, namely vitamin and mineral supplements and nutrition bars made from all-natural ingredients; printed publications, namely cookbooks, newsletters, nutrition guides, food recipes, periodicals relating to nutrition and foods; and
2. television and radio programming services; providing access to a website featuring health and gourmet foods, recipes and nutritional information; retail store services specializing in health and gourmet foods; arranging and conducting travel tours.

The right to the exclusive use of the word GOURMET has been disclaimed apart from the Mark.

On January 13, 2005, an assignment was recorded against the application in favour of Wise Gourmet Inc. (the “Applicant”).

The application was advertised for opposition purposes in the Trade-marks Journal of December 22, 2004. On August 22, 2005, Advance Magazine Publishers Inc. (the “Opponent”) filed a

statement of opposition. The Opponent has pleaded grounds of opposition under s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”). In particular there are grounds of opposition based on s. 30(i), s. 12(1)(d), s. 16(1)(a), s. 16(3)(a), and non-distinctiveness, which are premised on the Opponent’s allegation that the Mark is confusing with its trade-marks GOURMET and GOURMET Design, which the Opponent pleaded it has previously registered and used in association with magazines. The registration numbers are 392,189 and 277,151, respectively. The Opponent’s GOURMET Design mark is shown below.



The Opponent has also pleaded that the application is not in compliance with s. 30(b) in that the Applicant has not used the Mark since the date of first use alleged or at all in Canada.

The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

In support of its opposition, the Opponent filed the affidavit of Elenita Anastacio.

In support of its application, the Applicant filed the affidavit of Tom Abols. The Opponent obtained an order for the cross-examination of Mr. Abols on his affidavit but failed to conduct the cross-examination before the expiry of the assigned deadline.

Only the Applicant filed a written argument but both parties were represented at an oral hearing.

Onus and Material Dates

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].

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

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 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. 16(1) - the Applicant's date of first use [see s. 16(1)];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - 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.T.D.)].

Section 30(b) Ground of Opposition

The legal onus on an applicant under s. 30(b) is to substantiate its claimed date of first use and to prove that it has not subsequently abandoned the use of its mark. [See *Benson & Hedges v. Labatt* (1994), 53 C.P.R. (3d) 233 (T.M.O.B.)] However, before the Applicant must meet its legal burden, the Opponent must satisfy the evidential burden on it respecting the allegations of fact pleaded in support of the ground, namely that the Applicant has not used the Mark since the date of first use alleged or at all in Canada. It is to be noted that the Opponent's evidential burden is lighter respecting the issue of non-conformance with s. 30(b) of the Act, because such facts are more readily available to the Applicant than to the Opponent [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.) at 89]. Moreover, the Opponent may meet its burden by reference to the Applicant's evidence, provided that the Applicant's evidence is clearly inconsistent with the claims set forth in its application. [See *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230].

Ms. Anastacio, a trade-mark searcher employed by the Opponent's trade-mark agent, attests that she conducted an Internet search for the Mark on March 6, 2006. She says that she found no use of the Mark or any reference to any use of the Mark as of the date of first use alleged. She does not however provide the search parameters or any other details concerning the search that she conducted.

Although the Opponent's evidential burden is light, the above-mentioned evidence of the Opponent does not satisfy it. Moreover, I find that the Applicant's own evidence is not clearly inconsistent with its use claim.

The s. 30(b) ground is accordingly dismissed on the basis that the Opponent has not met its evidential burden.

At the oral hearing the Opponent took the position that the application does not comply with s. 30(b) because it does not name the predecessor-in-title to the Applicant. Apart from the issue as to whether such a ground has been pleaded, such an argument is without merit. The material date under s. 30(b) is the filing date of the application and at that date there is no evidence that there was an unnamed predecessor-in-title. The facts are that Ms. Ehlert filed the present application on December 31, 2003 and assigned it on January 13, 2005 to Wise Gourmet Inc., a company incorporated in 2004 [see Exhibit "B", Anastacio affidavit]. Contrary to the Opponent's submission, there is no requirement that an assignee of a "use-based" application file an amended application to identify the original applicant as its predecessor-in-title.

Section 30(i) Ground of Opposition

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. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] As this is not such a case, I am dismissing this ground of opposition.

Section 16 Grounds of Opposition

In order to meet its initial burden under s. 16, the Opponent must establish use of its marks in Canada prior to the filing date of the application and the Applicant's claimed date of first use. As there is no evidence that the Opponent was using either of its marks prior to either December 31, 2003 or January 2002, the s. 16 grounds are dismissed.

Remaining Grounds of Opposition

Each of the remaining grounds of opposition turns on the issue of the likelihood of confusion between the Mark and the Opponent's marks. As the resemblance between the Mark and GOURMET is slightly higher than between the Mark and GOURMET Design, I will focus my discussion on the likelihood of confusion with GOURMET.

I will begin by mentioning that the parties raised several prior decisions rendered by this Board concerning GOURMET marks. I do not intend to address those submissions since each case is to be decided on its own facts and the present case is thereby distinguishable from each of the prior decisions.

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 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.).]

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

The Opponent's GOURMET mark is not inherently distinctive with respect to magazines as it indicates that the subject matter would be of interest to lovers of food. As the Opponent has not provided any evidence concerning its use or promotion of GOURMET, I am unable to conclude that the mark has become known to any meaningful extent. It is true that the Applicant did provide some evidence of the use/promotion of the Opponent's mark [see for example, Exhibits "G", "H" "I" and "K", Abols affidavit], but there is no evidence of the extent to which Canadians may have been exposed to the Opponent's mark.

The Applicant's Mark is also not inherently distinctive since it suggests that its wares and services would be of interest to knowledgeable or prudent food lovers. There is also insufficient evidence of the use or promotion of the Applicant's Mark for me to conclude that it has become known to any significant extent.

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

This factor would favour the Opponent, if we accept the statement in its registration that its mark has been used in Canada since at least as early as August 1957 (although such use is assumed to be only *de minimus*).

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

Based on the evidence filed, it is fair to say that both parties' wares and services concern food. Moreover, the Opponent's sole ware is a magazine and the Applicant includes periodical printed publications in its list of proposed wares. Thus the parties' wares/services are related and overlap in some respects.

Very little information has been provided concerning the parties' channels of trade, but they do both have some presence on the Internet. Overall, it seems reasonable to assume that their

channels of trade could overlap, particularly with respect to their publications.

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

The Applicant has incorporated the Opponent's mark in its entirety into its Mark. However, it has placed another word before the common word GOURMET, and it is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. Thus, although there is a fair degree of resemblance between the marks, the word WISE does serve to distinguish the Applicant's Mark somewhat from the Opponent's mark in appearance, sound and idea suggested.

other surrounding circumstances - state of the register or marketplace

The Applicant has evidenced the existence of one other GOURMET mark on the Register, which is insufficient to enable me to make any meaningful inference about the state of the marketplace. [See *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.).]

However, the Applicant has also provided evidence of 740 books being offered for sale from the Canadian online bookseller www.indigo-chapters.ca, which contain the word GOURMET in their titles [Exhibit "J", Abols affidavit]. These include a cookbook that displays the Opponent's GOURMET Design mark on its cover plus numerous third party books, such as the following select few:

- Grain-free Gourmet: Delicious Recipes for Healthy Living
- Gourmet Low GI
- Gourmet Garnishes: Creative Ways to Dress Up Your Food
- Gourmet Baby: Fresh, Fun & Healthy Recipes
- Gourmet Slow Cooker: One-Pot Meals from Around the World
- The Gluten-Free Gourmet: Living Well Without Wheat

- The Raw Gourmet
- The Game Gourmet
- The Vegetarian Gourmet: Delicious Dining Without Meat
- The Organic Gourmet: Feast of Fields
- The Country Gourmet
- Tofu Gourmet Cuisine
- Natural Gourmet
- The Bubba Gourmet
- Tray Gourmet
- Microwave Gourmet
- Gourmet Cooks
- Gourmet Traveller
- Kosher Gourmet
- The Clueless Gourmet

Even if I accord reduced weight to the evidence of these third party publications (on the basis that it might have been better if the Applicant had evidenced the existence of these third party publications in physical bookstores in Canada, as opposed to via online offering for sale), I find that it plays a supporting role with respect to the conclusion that I can independently reach, namely that, without evidence of acquired reputation, the mark GOURMET should only be entitled to a very narrow scope of protection due to its descriptive nature.

conclusion regarding likelihood of confusion

I find that the Applicant has met the legal onus on it to show that, on a balance of probabilities, confusion between the marks is not likely. In particular, I find that the average Canadian would not as a matter of first impression conclude that GOURMET magazines and WISE GOURMET cookbooks, newsletters, nutrition guides, food recipes, or periodicals relating to nutrition and food share a common source. I have reached this overall conclusion because the common word GOURMET is just that, a very common word, with a well-known descriptive meaning. The Opponent has not evidenced that it has acquired a significant reputation in its mark, and it is trite

law that where a party adopts an inherently weak mark, relatively small differences will suffice to distinguish another's mark.

The s. 12(1)(d) ground of opposition that is based on the Opponent's registration for GOURMET is therefore dismissed. Moreover, as the Opponent's case is no stronger under s. 12(1)(d) when it is based on its GOURMET Design registration, that registrability ground is also dismissed.

Before proceeding to the next ground, I ought to mention that the Opponent evidenced that it owns a third registration for a GOURMET mark, namely registration No. 576,562 for GOURMET for "online magazines and publications distributed in electronic format via the internet; operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet". That registration claims a date of first use of at least as early as July 1997. [See Exhibit "A", Anastacio affidavit.] At the oral hearing, the Opponent took the position that the existence of this evidence meant that it had effectively also pleaded a s. 12(1)(d) ground of opposition based on this registration. I have reviewed the statement of opposition and find that it is precise in relying on only two registrations in support of its s. 12(1)(d) ground. The scope of that ground of opposition has accordingly been clearly defined. It is therefore my view that it is inappropriate to consider the pleading to have been expanded by the evidence; if the Opponent wished to expand its pleadings, it should have requested leave to file an amended statement of opposition. In the event that I am wrong in this regard, I will add that I would have concluded that, on a balance of probabilities, there is not a likelihood of confusion between the Mark and the mark registered under No. 576,562. The Opponent did not establish that it has acquired any substantial reputation in association with GOURMET with respect to these registered services. Moreover, these registered services are no more similar to the Applicant's wares and services than are the Opponent's magazines given that the registered services appear to relate primarily to an online version of the Opponent's magazine.

Non-distinctiveness Grounds of Opposition

In order to meet its initial burden with respect to these grounds, the Opponent need only show

that its marks were “known to some extent at least” as of August 22, 2005. [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58] I find that the Opponent has not met its initial burden and I therefore dismiss these grounds.

Disposition

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

DATED AT TORONTO, ONTARIO, THIS 20th DAY OF MAY 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board