



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

Citation: 2013 TMOB 90
Date of Decision: 2013-05-21

**IN THE MATTER OF AN
OPPOSITION by Trader
Corporation to application
No. 1,411,492 for the trade-mark
SMART SHOPPER & Design in
the name of Austin Publishing Inc.**

FILE RECORD

[1] On September 19, 2008, Austin Publishing Inc. filed an application to register the trade-mark SMART SHOPPER & Design, illustrated below, based on use of the mark in Canada since October 13, 2007, in association with the wares and services listed below:



wares

(1) printed publications, namely periodicals offering for sale or purchase new and used items.

services

(1) providing free classified advertising (word and photo ads) to the general public; operation of a website advertising for sale or purchase new and used items of the general public, namely, automobiles, motorcycles, snowmobiles, boats, furniture and accents, computers, home entertainment, clothing, agriculture and animals, real estate, recreational vehicles, household appliances, home improvement.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 15, 2009 and was opposed by Trader Corporation on June 9, 2009. The Registrar forwarded a copy of the statement of opposition to the applicant on August 20, 2009, as required by s.38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent was subsequently granted leave, at a late stage in the proceeding, to amend its statement of opposition to correct a typographical error which cited an inappropriate section of the *Act*: see the Board ruling dated January 13, 2012.

[3] The opponent's evidence consists of the affidavits of Gloria Roknic; Michael Gritzan and Evelyn Dapito; a certified copy of trade-mark application No.1,166,805 and certified documents from the file wrapper thereof. The applicant's evidence consists of the affidavits of Paul Anthony Austin and Sandra Hood. The applicant's affiants were cross-examined on their written testimony, the transcripts thereof and replies to undertakings forming part of the evidence of record. Both parties filed written arguments. Only the applicant requested an oral hearing, but later withdrew its request. Consequently, an oral hearing was not held.

STATEMENT OF OPPOSITION

[4] The first ground of opposition alleges that the application is not in compliance with s.30(i) of the *Trade-marks Act* because, at the date of filing the application, the applicant was or should have been aware of the opponent's family of registered trade-marks consisting of the word mark SUPER SHOPPER and the combination word and design marks, shown below, covering essentially the same wares and services as specified in the subject application for the mark SMART SHOPPER & Design.



It may not be apparent that the phrase "BUY, TRADE & SELL" appears in diminutive font in the bar below the word SHOPPER in two of the above marks.

[5] The opponent's evidence shows use of each of its marks illustrated above. In my view, the opponent's use of its combination word and design marks qualifies as use of its word mark SUPER SHOPPER *per se*: in this regard see *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 CPR(3d) 535 at 538 (TMOB).

[6] The remaining grounds of opposition turn on the issue of confusion between the applied-for mark SMART SHOPPER & Design and the opponent's mark SUPER SHOPPER. The material times to consider the issue of confusion are the date of decision, with respect to the ground of opposition alleging non-registrability; the date of first use claimed by the applicant, that is, October 13, 2007, with respect to the ground of opposition alleging non-entitlement; and the date of opposition, that is, June 9, 2009, in respect of the ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD).

OPPONENT'S EVIDENCE

Michael Gritzan

[7] Mr. Gritzan identifies himself as a District Manager for the opponent company for Toronto East/Northern Ontario. On February 2, 2010, Mr. Gritzan visited various Macs Convenience Stores in Barrie, Ontario and the surrounding area. He took photographs, copies of which are attached as Exhibits 1 to 6 of his affidavit. The exhibits show magazine racks displaying the opponent's SUPER SHOPPER magazine beside magazine racks displaying the applicant's SMART SHOPPER & Design magazine. Mr. Gritzan has noticed that the SMART SHOPPER & Design magazine has been introduced into many other retail outlets in which the opponent's magazine are distributed, and that the parties' magazines have the same proximity of location as in the Macs stores, that is, beside each other.

Gloria Roknic

[8] Ms. Roknic identifies herself as a Director of Marketing for the opponent company. The opponent is a leader in print and online media. It provides a national trading and advertising platform through 160 publications and 20 websites focused on

automobiles, real estate, general merchandise and employment. The opponent's publications have a weekly national readership of about 1 million and its websites attract about 3.5 million different visitors per month. The trade-mark SUPER SHOPPER, as well as other marks incorporating these words, are used by the opponent in association with advertising services by way of the opponent's magazines and Internet websites. The magazine has been distributed over a wide area in Ontario over the last 16 years (i.e., 1994-2010) and has been used continuously distributed since 1993. The opponent's mark SUPER SHOPPER has been displayed on the front cover of each issue of the opponent's magazines since 1993.

[9] As of 2010, the opponent's magazines are sold through over 1000 retail outlets including chains such as Zehr/Loblaws, Shoppers Drug Mart and Canadian Tire. Paid circulation for the magazine was about 580,000 in 1998. Between 300,000 and 500,000 copies of the magazines have been sold each year since then. The opponent's website began in 1999. The website was viewed by over 2.3 million different visitors in the period April 2007 to February 2010.

[10] The opponent's magazines and websites have generated revenue between about \$2 million and \$3.4 million annually for each of the years 2005 to 2009. In 1993 the magazines retailed for \$1.52 per issue, increasing to \$2.50 in 2002 and increasing again to \$3.25 in 2010. Voluminous exhibit materials attached to Ms. Roknic's affidavit further detail and illustrate her written testimony.

Evelyn Dapito

[11] Ms. Dapito identifies herself as a trade-mark agent with the firm representing the opponent. She conducted Internet searches to locate use of the trade-mark or trade-name SMART SHOPPER by third parties in association with a magazine or website with content similar to general classified advertising. Her search located one such use, by Sun Media Corporation.

APPLICANT'S EVIDENCE

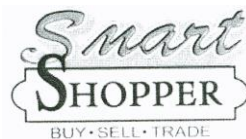
Paul Austin – Affidavit Evidence

[12] Mr. Austin identifies himself as the CEO of the applicant company. Since 1999 the applicant has been in the business of providing classified advertising of various consumer goods and services to the general public through printed publications. Average consumers may place ads free of charge. In 2003 the applicant commenced operating a website providing similar classified advertising services. The ads generally consist of a photograph and a short written description of the wares or services. Ads are free for individuals but not for businesses.

[13] From 1999 to 2003 the applicant used the mark shown below in association with its business:



From 2003 to 2007 the applicant used the mark shown below:



[14] In 2007 the applicant began to use the mark which is the subject of the present proceeding. The mark is displayed on the front cover of each issue of the applicant's periodicals, on promotional materials and on the applicant's website. The applicant's periodical is distributed primarily in Ontario and is published every second Friday. The periodical is available through grocery stores, convenience stores, variety stores, gas stores and hardware stores. As of October 2007, the periodical was available at about 2000 retail outlets. The electronic version of the periodical is updated bi-weekly as well. The website has received in excess of 6,100 visits per month since October 2007. The website includes a form to enable private individuals to electronically renew their photo and word ad for the next issue of the periodical. In the period October 2007 to May 2010, the applicant spent in excess of \$35,000 on advertising its wares and services in various

media including newspapers, store displays, direct mailing, on billboards and on the radio.

Paul Austin - Transcript of Cross-examination

[15] Mr. Austin's further evidence at cross-examination was that the applicant goes directly to stores to show them its magazine. If the store decides to take it, then the applicant delivers copies to the store. The store charges \$2.99 for the magazine if a customer wants to buy it. The magazine is sold on consignment, that is, the retailer keeps 25% of sales and non-sold items are picked up by the applicant. The age range for purchasers of the magazine is 18 to 60. Particular industries that advertise in the magazine are home improvement and car dealerships, for used cars, as well as plumbers and electricians.

[16] Mr. Austin was aware of the opponent's mark SUPER SHOPPER when he chose the term SMART SHOPPER for his magazine; a graphic designer created the design feature for the first logo used by the applicant. Subsequent logos were created "To be new, to be current. Give it a little more flash:" see Q 98 of the transcript. Stores which carry the applicant's magazine include 7-Eleven, Macs, Canadian Tire, Woolco, Esso, Petro Canada, and Home Hardware.

Sandra Hood

[17] Ms. Hood identifies herself as a trade-mark agent working with a trade-mark search firm in Ottawa. On May 25, 2010, she conducted an online search for the word combination "super shopper." The results of her search are attached as Exhibit A to her affidavit. Exhibit A includes a feature in the *Toronto Life* magazine entitled "Super Shopper" which discusses various consumer goods and services; a reference in *Winnipeg Women Magazine* to a certain individual described as a "super shopper;" The Kingston Super Shopper on-line site which offers discount coupons for various consumer goods; a website for a Super Shopper Club offering wholesale prices; and several other similar references to the term "supper shopper." Her testimony on cross-examination does not add any salient facts.

MAIN ISSUES

Non-compliance with s.30(i)

[18] A ground of opposition pursuant to s.30(i) requires an opponent to plead fraud on the part of the applicant or that specific federal statutory provisions prevent the registration of the applied-mark: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 CPR (3d) 221. In the instant case no such allegations have been made and therefore the pleadings do not support a ground of opposition pursuant to s.30(i). The ground of opposition pursuant to s.30(i) is therefore rejected.

Confusion

[19] As noted earlier, the determinative issue in this proceeding is whether the applied-for mark SMART SHOPPER & Design is confusing with the opponent's mark SUPER SHOPPER. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Trade-marks Act*, shown below, between the applied-for mark SMART SHOPPER & Design and the opponent's mark:

The 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 . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[20] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of the applicant's wares and services, provided under the mark SMART SHOPPER & Design, as wares or services emanating from or sponsored by or approved by the opponent.

LEGAL ONUS AND EVIDENTIAL BURDEN

[21] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal 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. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

TEST FOR CONFUSION

[22] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R.(4th) 361 (S.C.C.), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

CONSIDERATION OF S.6(5) FACTORS

First Factor

[23] The opponent’s mark SUPER SHOPPER possesses a relatively low degree of inherent distinctiveness as the mark is composed of common dictionary words. Further, the first component SUPER is a laudatory term and the second component SHOPPER is descriptive of the clientele that use the opponent’s wares and services. The

opponent's mark is therefore an inherently "weak" mark. Similarly, the applied-for mark SMART SHOPPER is an inherently "weak" mark as the design feature of the mark is not particularly distinctive. Further, the design feature is descriptive of the wares tires that would be offered for sale in the applicant's magazine and on its website. Having regard to the evidence of record, I find that the opponent's mark SUPER SHOPPER had acquired a fairly significant reputation in Canada at all material times while the applied-for mark had acquired only a fair reputation at all material times. In this regard, the applicant is entitled to rely on use of its former marks, shown in paragraph 13 above, as variations of the applied-for mark: see the decision in *Promafil Canada Ltée v. Munsinger Inc.* (1992), 44 CPR(3d) 59 at pp. 70-71 (FCA) which permits a trade-mark owner to make slight changes to the form of a mark but to retain the benefit of its use of the earlier form (although *Promafil* concerned a Section 45 proceeding rather than an opposition proceeding). The first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, favours the opponent owing to the greater acquired distinctiveness of the opponent's mark.

Second to Fourth Factors

[24] The second factor in s.6(5) favours the opponent as it is the senior user of the marks in issue. The third and fourth factors also favour the opponent as the nature of the parties' wares, services, businesses and trades is essentially the same.

Last Factor

[25] There is necessarily a fair degree of resemblance between the marks in issue as both parties' marks consist of a laudatory adjective prefixing the word SHOPPER. However, when the marks are considered in their entirety, I find that they are somewhat more different than alike owing to their first components. In this regard, the sound of the word SUPER is distinct from the sound of the word SMART. Further, the idea suggested by the opponent's mark is a "superior shopper" while the idea suggested by the applicant's mark is an "intelligent shopper." Also, the marks in issue are different visually owing mostly to the design component featured in the applied-for mark. The last

and most important factor in s.6(5) therefore favours the applicant, but only to a limited extent.

JURISPRUDENCE

[26] There are also two principles of trade-mark law that, in the circumstances of the instant case, give greater favour to the applicant under the last factor in s.6(5). The first principle is that comparatively small differences will suffice to distinguish between “weak” marks, that is, between marks of low inherent distinctiveness: see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 CPR(2d) 154 (FCTD). Further, the opponent's evidence falls short of demonstrating that its mark SUPER SHOPPER had, at any material time, become so well known as to entitle the opponent to a broad scope of protection for its mark. The second principle is that the first portion of a mark is usually considered the more important for the purposes of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 CPR(2d) 183 at 188 (FCTD). In the instant case, it is the first portion of the parties' marks that contributes to differentiating them.

DISPOSITION

[27] Considering the factors in s.6(5) as discussed above, and taking into account in particular that the opponent's mark is a weak mark, that differences in the parties' marks are sufficient to distinguish them, and that the opponent's mark is not entitled to a broad scope of protection, I find that at all material times the applicant has met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied-for mark SMART SHOPPER & Design and the opponent's mark SUPER SHOPPER.

[28] Accordingly, the opposition is rejected. This decision has been made pursuant to a

delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office