

IN THE MATTER OF AN OPPOSITION by Robinson's Camera  
Centre Ltd. to application No. 564,461 for the trade-mark BLACK'S  
IS PHOTOGRAPHY filed by Black Photo Corporation

On June 13, 1986, the applicant, Black Photo Corporation, filed an application to register the trade-mark BLACK'S IS PHOTOGRAPHY based upon use of the trade-mark in Canada since 1979 in association with "the operation of retail establishments selling photographic equipment, accessories and supplies; photofinishing services and servicing of photographic and optical equipment". The applicant disclaimed the right to the exclusive use of the word PHOTOGRAPHY apart from its trade-mark. The applicant's trade-mark was advertised for opposition purposes in the Trade-marks Journal on July 1, 1987.

The opponent, Robinson's Camera Centre Ltd., filed a statement of opposition on February 26, 1988 in which it alleged the following grounds of opposition:

- (a) that the applicant's application does not comply with s. 29 (now s. 30) of the Trade-marks Act "in that the trade-mark has not been continuously used as a trade mark in Canada since the date claimed in the application, or in the alternative, for the reasons set out hereafter";
- (b) that the applicant's trade-mark is not registrable pursuant to s. 12(1)(a) of the Trade-marks Act "in that the word "Black's" is primarily merely the surname of an individual who is living or has died within the preceding thirty years";
- (c) that the applicant's trade-mark is not registrable in view of s. 12(1)(b) of the Trade-marks Act in that the applicant's trade-mark "is clearly descriptive in the English language of the character of the services in association with which it is used, namely Black's operation of retail establishments selling photographic equipment, accessories and supplies; photofinishing services and servicing of photographic and optical equipment";
- (d) that the applicant's trade-mark is not registrable pursuant to s. 12(1)(c) of the Trade-marks Act in that "it is the name in English of the Services in connection with which it is used, namely Black's operation of retail establishments selling photographic equipment, accessories and supplies; photofinishing services and servicing of photographic and optical equipment"; and
- (e) that the applicant's trade-mark is not distinctive of the applicant and cannot be in that it does not actually distinguish the services of the applicant and it is not adapted to distinguish, nor is it capable of distinguishing them from services provided by others.

In support of its grounds of opposition, the opponent alleged that it has used its trading name in conjunction with the words "is photography" since as early as 1982 and that it is aware of at least one other photographic equipment and services company which has used the phrase "is photography" in conjunction with its trade-name since at least as early as 1979. Further, the opponent denied that the applicant has used the trade-mark in Canada since 1979 and that the phrase "is photography" is a descriptive one, covering a broad field of photographic services and supplies. Finally, the opponent alleged that Black is a personal surname and the word Black's together with the words "is photography" which are descriptive of the applicant's services do not constitute a distinctive trade-

mark, such that the trade-mark BLACK'S IS PHOTOGRAPHY as a whole is not adapted to distinguish the services of the applicant from the like services of others bearing the same surname.

The applicant served and filed a counter statement in which it asserted that its trade-mark is registrable and distinctive and that its application complies with s. 30 of the Trade-marks Act.

The opponent filed as its evidence the affidavits of Andrew Stein, Tony Peters, Leslie Pearl and two affidavits of Mary D'Amato. The applicant submitted as its evidence the affidavits of Bryan F. Black, Fred Auchterlonie, Luke Sklar, Douglas Matthew, Bruce C. Jones and Lorraine King.

Both parties submitted written arguments and the applicant alone was represented at an oral hearing.

With respect to the first ground of opposition, the applicant's evidence establishes use of the trade-mark BLACK'S IS PHOTOGRAPHY in Canada in association with the services covered in its application since 1979. Accordingly, I have rejected the opponent's first ground of opposition.

The opponent's next three grounds of opposition are that the applicant's trade-mark is not registrable in that it is primarily merely a surname, that it is clearly descriptive of the character of the applicant's services and, further, that it is the name in English of the applicant's services. Similar objections to registration of the trade-mark LABATT EXTRA were considered by Mr. Justice Cattanach of the Federal Court, Trial Division in Molson Companies Ltd. v. John Labatt Ltd. et al, 58 C.P.R. (2d) 157, at page 162 as follows:

Likewise, in the present case, the applicant's trade-mark BLACK'S IS PHOTOGRAPHY, when considered in its entirety, is neither a surname nor the name of the applicant's services as covered in its application. As well, the applicant's mark as a whole is not clearly descriptive of the character of the applicant's services. As a result, the trade-mark BLACK'S IS PHOTOGRAPHY as applied to the services covered in the applicant's application does not offend the provisions of ss. 12(1)(a), (b) or (c) of the Trade-marks Act.

The opponent's final ground of opposition is that the applicant's trade-mark is not distinctive of its services in view of the use by the opponent of its trading name in association with the words "is photography" since 1982, as well as the use since at least as early as 1979 of the phrase "is photography" by an unidentified third party in association with photographic equipment and services.

With respect to this issue, Mr. Peters in his affidavit states the he is "personally aware that Nikon Canada used the phrase "Nikon is Photography" extensively in print advertising since at least as early as 1979 and for a period of approximately four years". However, it would appear that whatever use was made by Nikon of the phrase "Nikon is photography" ceased approximately five years prior to the date of the opposition and no direct evidence from a representative of Nikon was adduced in this opposition in support of its alleged use of the mark. As a consequence, I do not consider that such evidence is of any consequence insofar as the distinctiveness of the applicant's trade-mark as of the date of opposition.

The opponent also adduced evidence of its use since 1982 of the phrase "Robinson's is Photography" in association with the sale of photographic equipment and supplies and the providing of photofinishing services through twelve locations located in Calgary, Edmonton and Lethbridge, Alberta, as well as one store operated in Kelowna, B.C. from 1982 to 1987. According to Mr. Peters, president of the opponent, the opponent has expended in excess of \$150,000 per year in each of the years from 1982 to 1987 in respect of its newspaper advertisements in which the phrase "Robinson's is Photography" appears.

Both in its written argument and at the oral hearing, the applicant argued that its trade-mark need not distinguish its wares or services throughout Canada or from those of all other persons in Canada. Accordingly, the applicant submitted that, in view of the decision in Great Lakes Hotels Ltd. v. Noshery Ltd., 56 C.P.R. 165, use of the phrase ROBINSON'S IS PHOTOGRAPHY in a limited

area in Canada is not sufficient to establish that the applicant's trade-mark is not distinctive. I disagree with the applicant's submission which, in my opinion, is contrary to the over-all basic policy of the Trade-marks Act to grant registrations to registrants which are national in scope, whereby the owner has the right to the exclusive use of the registered trade-mark throughout Canada in association with the wares and services covered in the registration. In general, a trade-mark must either distinguish or be adapted to distinguish the wares or services of the owner thereof in all parts of the country in order to be distinctive within the scope of the definition of "distinctive" as set forth in Section 2 of the Act. In this regard, I would refer to my comments in Morris et al trading as Happy Cooker Catering v. Lisko, 70 C.P.R. (2d) 254, at pages 261-262:

In DeCaria Hair Studio Ltd. v. Massimo De Berardinis et al trading as De Berardinis, 2 C.P.R. (3d) 309, the hearing officer commented on the Great Lakes decision at pages 317-318 as follows:

As the present case is not a s. 12(2) situation, I have concluded that the Great Lakes case is not applicable in this opposition and, if I am incorrect in this regard, I would adopt the position of the hearing officer in the De Berardinis case, and take the position that the Great Lakes case can be distinguished from the present opposition in that it involved an expungement proceeding under s. 18(1)(b) of the Trade-marks Act whereas the opponent's non-distinctiveness ground of opposition arises under s. 38(2)(d) of the Act.

At the oral hearing, the applicant elected not to take a position as to whether the applicant's trade-mark BLACK'S IS PHOTOGRAPHY as applied to the applicant's services is confusing with the opponent's mark ROBINSON'S IS PHOTOGRAPHY as applied to services which are essentially identical to those of the applicant. The word "photography" is defined in Webster's Third New International Dictionary as the "process of producing a negative or positive image directly or indirectly on a sensitized surface by the action of light or other form of radiant energy". As such, photography would appear to include the photofinishing services of both the applicant and opponent and the word PHOTOGRAPHY must be considered as either clearly descriptive or possibly the name of those services. In any event, I consider the word PHOTOGRAPHY to be non-distinctive in association with photofinishing services and this is confirmed by the disclaimer by the applicant of the word PHOTOGRAPHY apart from its trade-mark.

Having regard to the above, I have concluded that the applicant's trade-mark BLACK'S IS PHOTOGRAPHY as applied to its services is not confusing with the opponent's mark ROBINSON'S IS PHOTOGRAPHY, such that the activities of the opponent in respect of its mark in the provinces of Alberta and British Columbia would not have had an impact on the distinctiveness of the applicant's trade-mark.

With respect to the non-distinctiveness ground of opposition, the opponent relied upon the LABATT EXTRA decision in support of its position that the applicant's trade-mark is not distinctive in that BLACK is a surname and the words BLACK'S together with the words IS PHOTOGRAPHY which are descriptive of the applicant's services do not constitute a trade-mark which, as a whole, is adapted to distinguish the applicant's services from the like services of others bearing the same surname. With respect to the issue of the non-distinctiveness of the trade-mark LABATT EXTRA, Cattnach, J. commented as follows at pages 163-165:

Unlike the situation in the LABATT EXTRA case, I do not consider that the words IS PHOTOGRAPHY are clearly descriptive when considered separate and apart from the word BLACK'S although the word PHOTOGRAPHY per se is either the name of the applicant's photofinishing services or is clearly descriptive thereof. In any event, in the present case, the applicant's evidence establishes that its trade-mark was distinctive of its services as of the date of opposition in at least Ontario, Quebec and parts of British Columbia, with sales in excess of \$530,000,000 in these areas of Canada from 1979 to 1987.

In view of the above, I have rejected the opponent's final ground of opposition and therefore reject the opponent's opposition pursuant to s. 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31<sup>ST</sup> DAY OF DECEMBER 1990.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.