



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

Citation: 2013 TMOB 79
Date of Decision: 2013-05-07

**IN THE MATTER OF AN OPPOSITION by
Runway Beauty, Inc. to application
No. 1,453,764 for the trade-mark
RUNWAYMAGAZINE.CA in the name of
Errol Hernandez**

[1] Runway Beauty, Inc. (the Opponent) opposes registration of the trade-mark RUNWAYMAGAZINE.CA (the Mark) that is the object of application No. 1,453,764 by Errol Hernandez (the Applicant).

[2] The application was filed on September 30, 2009 and is based on use of the Mark in Canada since March 26, 2009 in association with the following services:

Operation of an Internet website (service), namely, collecting and disseminating text, sound, graphics and video information, in the field of fashion. (the Services)

[3] The Opponent alleges that the Mark is not distinctive under section 2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and that the Applicant is not the person entitled to registration of the Mark under subsections 16(1)(a) and (c) of the Act because the Mark is confusing with the Opponent's trade-mark RUNWAY MAGAZINE and trade-name Runway Beauty, Inc., that the Opponent has previously used and/or made known in Canada in association with, among other things, printed and electronic publications, namely magazines. The Opponent further alleges that the application for the Mark does not comply with the requirements of section 30 of the Act for a number of reasons, one of which being that the Applicant has not used the Mark in association with the Services since the date of first use claimed in his application.

[4] I find there are two determinative issues in this proceeding, namely:

- I. whether the Applicant has used the Mark in association with the Services since the date of first use claimed in his application; and
- II. whether the Mark is confusing with the Opponent's trade-mark RUNWAY MAGAZINE.

[5] For the reasons that follow, I find that issue No. I must be answered by the negative and that issue No. II must be answered by the affirmative.

The Record

[6] The statement of opposition was filed by the Opponent on December 10, 2010. The Applicant, who was self-represented throughout this proceeding, filed its counter statement on February 28, 2011. I note that the counter statement incorrectly includes argumentation and evidence. I further note that the Applicant filed most, if not all, of his correspondence and procedural documents in several copies. For the ease of discussion, I will only refer to the pieces of procedural documents received from the Applicant that are necessary to my analysis.

[7] As its evidence, the Opponent filed the affidavit of Vincent Mazzotta, President and CEO of the Opponent, sworn July 25, 2011. As its evidence, the Applicant filed an affidavit of his own sworn November 24, 2011.

[8] No cross-examinations were conducted. Only the Applicant filed a written argument. Neither party requested an oral hearing.

The parties' respective burden or onus

[9] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Issue No. I: Has the Applicant used the Mark in association with the Services since the date of first use claimed in his application?

[10] The Opponent has pleaded that the application for the Mark does not comply with the requirements of section 30(b) of the Act in that the Applicant has not used the Mark in association with the Services since the date of first use claimed in his application.

[11] The relevant date for considering the circumstances in regard to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. In this regard, section 30(b) of the Act requires that there be continuous use of the trade-mark applied-for since the date claimed [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)]. The Opponent's evidentiary burden respecting the issue of non-conformity with section 30(b) of the Act has been characterized as a light one because the facts in regard to this ground are more readily available to the Applicant than to the Opponent [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, 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 his application [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. I find this is such a case.

[12] While the Applicant was under no obligation to positively evidence continuous use of the Mark since the date of first use of March 26, 2009 claimed in his application, the Applicant elected to file evidence. At pages 8 and 9 of his affidavit, the Applicant states that:

The date of first use mentioned in the [application for the Mark] is given as March 26, 2009. This is the date that the name Runwaymagazine.ca was first used in the "operation of an Internet website" that provided media content to the public in Canada. On March 26, 2009, text, sound, graphics and video information, related to a selected list of popular movies trailers, (some of which had brought to the Applicant's mind examples of "fashion in the movies"), were available on the website.

Additionally, on the March 26, 2009, the title of the Runwaymagazine.ca website was "RunwayMagazine.Com" and the "Welcome" message of the site was stated as follows:

Welcome to RunwayMagazine.Com...your online portal to many things
"runway"!

This message was used to place the context of the website as being related to many of the things that are associated with the word “runway”. In the modern cultural climate, (of 2009 and now) the word “runway” is highly associated with (and is indicative of) the field of fashion. [...]

Therefore, although the word fashion was not explicitly mentioned on the main page of the website, it was implied, by the website name, the domain address, and the “Welcome” message – by association.

[...]

In summary, the website (Runwaymagazine.ca) was up and running on the Internet on March 26, 2009 and its condition at that time may be described as follows:

The “Operation of a website” (service), that provided Mutli-Media content; and carried a title, a domain name, and a Welcome message that implied a connection to fashion, to the Canadian public.

[...]

Please see INFORMATIONAL EXHIBITS [sic] 109.

[13] Upon review of Exhibit 109, I note that it consists of a two-page printout dated 3/26/2009 of the portal *runwaymagazine.com*, which was accessed to via the link *http://www.runwaymagazine.ca*. Below the welcome message described above, the website includes a “Menu” with the following message:

Coming Soon – “There are many ‘runway magazines’ published around the World”... In the meantime enjoy the movie trailers...

[14] Eight movie trailers for movies such as “Twilight”, “Titanic”, “Spiderman”, and “Indiana Jones” follow. The movie trailers are followed by the message: “RunwayMagazine.Com...more to come...” The website ends with the following legal notice:

All brands, products, services, trademarks, service-marks and registered trademarks mentioned on this site are the property of their respective owners.

Runway Magazine ® is a Registered Trademark in the USA but not in Canada, it is the property of [the Opponent] of the USA.

RunwayMagazine.Com and RunwayMagazine.Com, Inc. are not related to [the Opponent] or its publication called Runway Magazine ®.

The Domain Name “RunwayMagazine.Com” was legally registered on March 04, 1999, many years before the trademark mentioned above was issued.

RunwayMagazine.Com, Inc. is a Federally Registered entity in Canada and it was created before the trademark mentioned above was registered.

[15] The above evidence is clearly inconsistent with the Applicant’s claimed date of first use of the Mark for the following reasons:

1. The domain name *runwaymagazine.ca* only serves as a means of accessing the *runwaymagazine.com* portal. It does not support a finding of use of the Mark in association with the Services as provided for in section 4 of the Act. The domain name *runwaymagazine.ca* is not used as a trade-mark to distinguish the Services of the Applicant from those of others. As stated in Fox (Kelly Gill, *Fox on Canadian Law of Trade-marks and Unfair Competition*, Fourth Edition, loose-leaf supplements (Toronto: Carswell, 2013) at 17-3):

While domain names are similar to trade-marks in that they might be distinctive and may identify source, there are several important distinctions between the two. [...] These differences and similarities lead to a number of conclusions. First, ownership of a domain name does not necessarily confer any trade-mark rights in that domain name. Ownership and mere use as a domain name does not give rise to trade-mark rights; the domain name itself must be used as a trade-mark before those rights arise. [...] [my underlining]

2. The printout filed as Exhibit 109 merely establishes that the Applicant operates a rudimentary portal entitled “RunwayMagazine.com”, which displays a few movie trailers. Such service offering by no means amounts to the Services, which have been described as the operation of a website for collecting and disseminating text, sound, graphics and video information *in the field of fashion*, not to mention that there is no evidence that Canadians did access the Applicant’s website at that time.

[16] Before concluding on this ground of opposition, I note that the Applicant itself acknowledges at page 5 of its counter statement and at page 10 of his affidavit that:

The name (RunwayMagazine.Com) shown at the top-left corner of the printout [Exhibit 109] is not the same as the URL (*http://www.runwaymagazine.ca/*) for the website because the name RunwayMagazine.Com was the name chosen to be

the title of the main page of the website (at that time).

which pleading and statement far from contradicting my findings made above, reinforce them.

[17] Having regard to the foregoing, I find that the Opponent has satisfied the light burden upon it. The section 30(b) ground of opposition succeeds on the basis that the Applicant has not met its burden.

Issue No. II: Is the Mark confusing with the Opponent's trade-mark RUNWAY MAGAZINE?

[18] As indicated above, the Opponent has pleaded various ground of opposition revolving around the issue of confusion between the Mark and either the Opponent's trade-mark RUNWAY MAGAZINE or trade-name Runway Beauty, Inc., that the Opponent has previously used and/or made known in Canada in association with, among other things, printed and electronic publications, namely magazines. I will focus my analysis on the Opponent's trade-mark RUNWAY MAGAZINE, which presents the Opponent's strongest case. If the Opponent is not successful with respect to this mark, it would not achieve a more favourable result with its trade-name. In so doing, I will start my analysis with the Opponent's non-entitlement ground of opposition based on section 16(1)(a) of the Act.

The non-entitlement ground of opposition based on section 16(1)(a) of the Act

[19] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the provisions of section 16(1)(a) of the Act because at the Applicant's claimed date of first use of the Mark, that is March 26, 2009, the Mark was confusing with the Opponent's trade-mark RUNWAY MAGAZINE that the Opponent had previously used and/or made known in Canada in association with various wares and services, including printed and electronic publications, namely magazines.

[20] In order to meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the alleged date of first use of the Mark in Canada, the Opponent's trade-mark RUNWAY MAGAZINE had been previously used or made known in Canada and had not been abandoned as of the date of advertisement of the Applicant's application in the *Trade-marks Journal*, that is October 20, 2010 [section 16(5) of the Act]. As per my review below of the

relevant parts of the Mazzotta affidavit, the Opponent has met this burden with respect to the wares described as printed and electronic publications, namely magazines.

[21] Indeed, Mr. Mazzotta states in his affidavit that since March 2006, the Opponent has designed, manufactured, distributed, marketed and sold magazines in association with its RUNWAY MAGAZINE trade-mark. The Opponent also markets and provides services under its RUNWAY MAGAZINE trade-mark, namely it operates a website providing information relating to fashion, beauty, entertainment, shopping and romance and it provides advertising and promotional services to others through its magazine and website [para 3 of the Mazzotta affidavit].

[22] In support of his statement that the Opponent has continuously used the trade-mark RUNWAY MAGAZINE in association with the goods set out above, Mr. Mazzotta attaches as Exhibit “B” images of the Opponent’s magazine covers prominently displaying it. Upon review of these magazine covers, I note that the Fall 2008 and Winter 2009 issues show use of the Opponent’s trade-mark RUNWAY MAGAZINE prior to the Applicant’s claimed date of first use of the Mark, while others show use of the Opponent’s mark in the following seasons [see the Spring/Summer 2009 and the Swim Edition 2009 issues] or years [see the 2010 Winter, Spring, Summer, and Fall issues, as well as the 2011 Spring and Summer issues]. Mr. Mazzotta states that these magazines were sold and are currently sold and distributed by the Opponent across Canada on a quarterly basis and available on newsstands and online. This statement is further corroborated by the fact that the issues filed under Exhibit “B” display prices in both Canadian and American dollars. Further, Exhibit “C” consists of images of the Opponent’s website obtained from <http://web.archive.org>, some of which date back to the year 2008, which is prior to the Applicant’s claimed date of first use of the Mark [paras 4 and 5 of the Mazzotta affidavit].

[23] The Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent’s trade-mark RUNWAY MAGAZINE.

The test for confusion

[24] Section 6(2) of the Act provides that:

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

[25] The test for confusion is one of first impression and imperfect recollection. As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[26] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 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 the trade-marks have 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[27] All of these factors favour the Opponent in this case.

a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[28] I assess the inherent distinctiveness of each of the trade-marks in issue as relatively low and about the same. The word “magazine” is descriptive in the context of the parties’ wares and/or services and as such, is not inherently distinctive. The same comment applies to the country code extension “.ca”. As for the word “runway”, it is suggestive in the context of the parties’ wares and/or services, of publications relating to the field of fashion. Indeed, the word

“runway” may be understood as referring to the platform along which models walk in a fashion show.

[29] Concerning the extent to which the trade-marks in issue have become known, there is no evidence that the Mark has been used in Canada by the Applicant so as to enhance its distinctiveness. Again, the ownership and mere use of the domain name *runwaymagazine.ca* as evidenced by the Applicant does not amount to trade-mark use.

[30] By contrast, the Opponent’s evidence introduced through the Mazzotta affidavit establishes that the Opponent’s trade-mark RUNWAY MAGAZINE has been used in Canada to some extent so as to benefit from acquired distinctiveness. Indeed, in addition to the specimens of use filed under Exhibits “B” and “C” discussed above, Mr. Mazzotta has provided the number of issues sold for the years 2008 to 2011, which vary between 993 and 11,554 [para 6 of the Mazzotta affidavit].

[31] To sum up, the overall consideration of this first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Opponent.

b) the length of time the trade-marks have been in use

[32] For the reasons given above, this factor also favours the Opponent.

c) the nature of the wares, services or business; and d) the nature of the trade

[33] The Applicant’s Services are clearly overlapping with the Opponent’s printed and electronic publications. So does the nature of the trade. The fact that the Opponent’s electronic publications are accessed via the Opponent’s website at *www.runwaybeauty.com* has no bearing on the outcome of the present proceeding. The trade-mark RUNWAY MAGAZINE is clearly displayed on the Opponent’s website and electronic publications.

[34] These third and fourth factors thus favour the Opponent.

e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[35] The trade-marks in issue are, practically speaking, identical. As indicated above, the country code extension “.ca” by no means enhances the distinctiveness of the Mark. As such, it does not serve to distinguish the Mark from that of the Opponent. This fifth factor favours the Opponent.

Additional surrounding circumstances

[36] In his affidavit, the Applicant discusses at length the fact that it legally owns the domain name *runwaymagazine.ca*, which was registered by the Applicant before the Opponent started using the trade-mark RUNWAY MAGAZINE in Canada. The Applicant also stresses the fact that the parties were involved in a dispute under the World Intellectual Property Organization / ICANN Uniform Domain-Name Dispute Resolution Policy, concerning the domain names *www.runwaymagazine.com*, *www.runwaymagazine.net*, and *www.runwaymagazine.org*, which ended up in the Applicant’s favour. However, the fact that the Applicant may have registered in good faith these domain names is not pertinent to the present proceeding. Again, the issue in this case is the Applicant’s right to the registration of the Mark.

[37] Before concluding, I also wish to comment on a few passages of the Applicant’s affidavit. At pages 6 and 9 the Applicant states that:

The Applicant does not doubt that the Opponent has sold magazines in Canada. However, the Applicant believes that the Opponent has not had and currently does not have exclusive rights to the use of the name “Runway Magazine”, as a trade-mark or trade-name, in Canada.

[...]

Over the past 20 years, the word “runway” has become a very common term in the field of fashion, In particular, in the context of modern media, the Internet, and popular culture, the last 10 years has seen the term “runway” become extremely symbolic (and symbiotic) with the field of art, lifestyle, and fashion.

For example:

[1] The fictitious high-end fashion magazine called “Runway Magazine” in the best-selling novel and (its related) block-buster movie “The Devil Wears Prada”; by Lauren Weisberger[;]

[2] The very popular Television show called “Project Runway” (www.projectrunwaycanada.ca);

[3] “Rip the Runway” (www.bet.com/specials/ripherunway10); and

[4] “Runway”, a magazine, published in Australia, since 2002 (www.runway.org.au).

[38] I am not prepared to afford weight to these contentions of the Applicant which amount to argumentation based on allegations of facts that are not supported by evidence. Furthermore, I am not prepared to take judicial notice that the name “Runway Magazine” would have become very popular in Canada by reason of the novel and corresponding movie called “The Devil Wears Prada”. The same comment applies to the other alleged third parties’ use of the word “runway”.

Conclusion regarding the likelihood of confusion

[39] As indicated above, section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of wares and services from one source as being from another source. In the present case, the question posed is whether an individual, who has an imperfect recollection of the Opponent’s trade-mark as applied to the Opponent’s printed and electronic publications, would, as a matter of first impression and imperfect recollection, be likely to conclude that the Applicant’s Services are manufactured, sold, leased, hired or performed by the Opponent.

[40] I find this is such a case. As per my comments above, all of the section 6(5) factors favour the Opponent. Besides, I note that the Applicant itself apparently felt necessary to indicate on the legal notice of its “RunwayMagazine.com” portal reproduced above that: “RunwayMagazine.Com and RunwayMagazine.Com, Inc. are not related to [the Opponent] or its publication called Runway Magazine ®”. The Applicant further states at page 8 of his affidavit that: “The choice of not explicitly using the word “fashion” on the main page of the website

(Runwaymagazine.ca), was made on March 26, 2009, in order to minimize issues with the Opponent, at that time”.

[41] The non-entitlement ground of opposition based on section 16(1)(a) of the Act therefore succeeds on the basis that the Applicant has not met its burden.

Remaining grounds of opposition

[42] As I have already found in favour of the Opponent under two grounds of opposition, I do not consider it necessary to address the remaining grounds of opposition.

Disposition

[43] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office