

**IN THE MATTER OF AN OPPOSITION by
Vibe Ventures LLC, Vibe Media Group LLC
and InterMedia Vibe Holdings, LLC to
Application No. 1,220,040 for the trade-mark
VIBE filed by 3681441 Canada
Inc.**

I The Pleadings

[1] On June 7, 2004, 3681441 Canada Inc. (the “Applicant”) filed an application to register the trade-mark VIBE (the “Mark”), application number 1,220,040, in association with:

Men's, women's and children's clothing namely, coats, suits, jackets, pants, jeans, sweaters, playsuits, bodysuits, shorts, skirts, sweatshirts, T-shirts, tank-tops, blouses, underwear and sleepwear (the “Wares”).

[2] The application is based on use in Canada since December 26, 1997 and was advertised on December 8, 2004 in the Trade-marks Journal for opposition purposes. The application was amended on August 12, 2005 to claim use by the predecessors-in-title Request Jeans Ltd. and Buffalo Inc.

[3] Vibe Ventures LLC (“Ventures”) filed on May 6, 2005 a statement of opposition that was forwarded by the Registrar to the Applicant on May 31, 2005. The Applicant denied essentially all grounds of opposition in a counter statement filed on June 29, 2005.

[4] The statement of opposition was amended twice including a request dated September 24, 2009 filed shortly before the oral hearing. At the hearing I asked the Applicant if it had any objection to the filing of the amended statement of opposition dated September 24, 2009. The Applicant did not oppose and in view of the fact that the amendment was to add opponents following successive assignments in the rights of Ventures’ trade-marks alleged in support of the original statement of opposition, I granted leave. Therefore Vibe Media Group LLC and InterMedia Vibe Holdings, LLC have been added as opponents. I shall refer to them together with Ventures or individually as the case may be as the “Opponents”.

[5] The Opponents' evidence consists of the affidavit of Kenard Gibbs while the Applicant filed the affidavit of Charles Bitton, which contains a copy of the affidavit of Jean-François Croteau.

[6] Both parties filed written arguments and were represented at an oral hearing.

II The grounds of opposition

[7] The grounds of opposition pleaded are:

1) The application does not conform to the requirements of s. 30(b) of the Trade-marks Act, R.C.S. 1985, c. T-13, (the "Act") in that the date of first use is incorrect as the Applicant was incorporated on December 7, 1999 and that the principal of the Applicant admitted in another affidavit that it first used the Mark in 1998 and not December 26, 1997;

2) The application does not conform to the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Wares given the facts set out herein and that the Applicant was personally aware of the Opponents' VIBE magazine having been an advertiser in the magazine under an earlier brand name;

3) The Applicant is not entitled to registration of the Mark in view of s. 16(1) (a) of the Act because at the alleged date of first use of the Mark it was confusing with the Opponents' trade-mark VIBE that had been previously used or made known in Canada;

4) The Applicant is not entitled to registration of the Mark in view of s. 16(1) (c) of the Act because at the alleged date of first use of the Mark it was confusing with the Opponents' trade-names VIBE and VIBE VENTURES that had previously been used or made known in Canada;

5) The Applicant's Mark is not distinctive and does not actually distinguish nor is adapted to distinguish the Wares from the wares, services or business of the Opponents;

6) The Mark is not registrable in view of s. 12(1)(d) of the Act because it is confusing with the Opponents' registered trade-mark VIBE, TMA526485.

III Burden of Proof in Trade-marks Opposition Proceedings

[8] The legal onus is upon the Applicant to show that its application complies with the provisions of the Act, but there is however 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

IV Section 30(b) ground of opposition

[9] The relevant date for the analysis of this ground of opposition is the filing date of the application (June 7, 2004) [See *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469].

[10] The Opponents have an evidential burden when alleging non-compliance to the provisions of s. 30(b) of the Act but it has been characterized as a light one. Moreover the Opponents can rely on the evidence filed by the Applicant itself [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156]. However such evidence must raise serious doubts on the accuracy of the statements made by the Applicant in its application. [See *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) *et Williams Telecommunications Corp. v. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107 (T.M.O.B)].

[11] Kenard Gibbs has been Ventures' President since May 2000 and was a Sales Representative for that company between 1993 and 1998. On the issue that the Applicant had not used the Mark as of the alleged date of first use, he filed a copy of an Industry Canada webpage regarding Canadian federal corporations and in particular the Applicant to show that it was incorporated only on December 7, 1999 and that one of its directors has been Mr. Charles Bitton.

[12] He alleges that in a Federal Court proceeding involving the same parties Mr. Bitton filed an affidavit indicating that a company called Request Jeans Ltd., the Applicant's predecessor in title, started marketing a line of clothing in association with the trade-mark VIBE in 1998.

[13] He further alleges that on January 28, 1998 Request Jeans Ltd. filed an application to register the trade-mark VIBE and design, application 867457, based on proposed use in association with clothing.

[14] The Opponent argues that those facts tend to prove that the Applicant could not have used the Mark as of December 26, 1997, since the Applicant was not yet incorporated at that time, the Applicant's representative made an allegation in an affidavit filed before the Federal court that "The line of clothing known under the name VIBE was put on the market in 1998...." (my translation) and the application filed on January 28, 1998 by the Applicant's predecessor in title for the trade-mark VIBE and design was based on proposed use.

[15] Those facts may not be sufficient in themselves to shift the burden to the Applicant. Application 867457 was covering a different trade-mark and the present application refers to the use of the Mark by a predecessor in title. There is no evidence that Request Jeans Ltd. was not incorporated at the claimed date of first use of the Mark. However the Opponent may rely on the Applicant's evidence.

[16] Mr. Bitton filed an affidavit. He confirms that Request Jeans Ltd. is the Applicant's predecessor in title and filed a first application to register VIBE and Design, which matured to registration under TMA541721. It wanted to develop a line of clothing for a young clientele. He states that a line of clothing under the trade-mark VIBE (as opposed to VIBE and Design) was introduced on the market in 1998 and he filed catalogues to substantiate such allegation. This statement confirms the Opponents' position that the Applicant did not first use the Mark on December 26, 1997 as claimed but sometime in 1998. It also corroborate the allegation made by Mr. Gibbs that Mr. Bitton did state in another court proceeding that the Mark was first used in 1998. There is no evidence filed by the Applicant to substantiate its claimed date of first use.

[17] Under these circumstances I have no alternative but to maintain the first ground of opposition.

[18] I will however address the two arguments raised by the Applicant on this issue. Firstly it argues that Mr. Bitton's statement that the line of clothing was put on the market in 1998 does not contradict the statement made in the application that the Mark was first used on December 26, 1997. Use is a defined term in the Act. Section 4(1) clearly states that in order to have "use" of a trade-mark in association with wares, the trade-mark must be on the wares themselves; or on their packaging ;or in any other manner is associated with the wares at the time of transfer of the property. If, as stated by Mr. Bitton, the line of clothing bearing the trade-mark VIBE was "put on the market" in 1998, I fail to see how the Applicant can substantiate a date of first use of December 26, 1997.

[19] The Applicant is relying on the case of *Miranda Aluminum Inc. v. Miranda Windows & Doors Inc.* (2009) FC 669 to support its contention that the application should not be declared invalid on the sole basis of an incorrect date of first use. Our situation is different than in the case cited. In *Miranda*, the Court was ceased with an application to expunge a registered trade-mark pursuant to s. 57 of the Act on the basis that the declaration of use filed, which lead to the issuance of the certificate of registration, was false. This is not our situation. The Opponent is attacking the content of the application not the circumstances surrounding the issuance of a certificate of registration of the trade-mark. On the issue that an application is invalid when based on a claimed date of first use earlier than the actual date of first use I refer to *Canadian Occidental Petroleum Ltd. v. Oxychem Canada Inc.* (1990), 33 C.P.R. (3d) 345.

[20] The Applicant is also referring to *Parfums de Coeur, Ltd. v. Christopher Asta* (2009) CF 21. Again this was an application for the expungement of a registered trade-mark on the basis that the declaration of use filed, which lead to the registration of the trade-mark, was false.

[21] There is no doubt that non-compliance to the provisions of s. 30(b) of the Act is a valid ground of opposition [see *Structureco Inc. v. Jean* (1997), 79 C.P.R. (3d) 331 and *Lise Watier Cosmétiques Inc. v. Villoresi* (2009), 76 C.P.R. (4th) 196]. By filing an application based on a date of first use earlier than the actual date of first use an applicant is preventing the filing of statement of opposition by opponents who may have prior rights that arose in between the applicant's claimed date of first use and its actual date of first use.

V Other grounds of opposition

[22] All the other grounds of opposition are based on the alleged confusion between the Mark and the Opponents' trade-mark VIBE. I do not intend to adjudicate on these grounds of opposition simply because the evidence is clear that the Applicant claimed an earlier date of first use than the actual date of first use. Rule 32 of the *Trade-marks Regulations* states that no application may be amended after it has been advertised to change the date of first use claimed in the original application. Therefore the Applicant is not in a position, at this stage or even if it decides to appeal this decision, to cure such defect. The application being invalid, there is no need to dispose of the other grounds of opposition.

VI Conclusion

[23] Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, and pursuant to s. 38(8) of the Act I refuse the Applicant's application as I maintain the first ground of opposition.

DATED, IN BOUCHERVILLE, QUEBEC, THIS 27th DAY OF NOVEMBER 2009.

Jean Carrière,
Member, Trade-marks Opposition Board