

**IN THE MATTER OF AN OPPOSITION by
Gemstar Development Corporation to
application No. 1,034,325
for the trade-mark DVD PLUS
in the name of Dieter Dierks**

On October 29, 1999, the applicant, Dieter Dierks, filed an application to register the trade-mark DVD PLUS based upon use and registration of the trade-mark in France. The statement of wares currently reads as follows:

blank optical discs for recording and reproducing of digital information such as data, sound, image, computer games, computer programs and map information; prerecorded optical discs featuring motion pictures, musical performances, variety shows; optical disc players, optical disc recorders and personal computers, color television sets, radio cassette tape recorders, computer game players, optical discs for electronically sorting and filing documents, digital video cameras, digital still video cameras and computerized memory storage devices containing optical disc players or recorders for installation in automobile assisting the driver in land navigation.

The application claims a convention priority filing date of April 30, 1999. The applicant has disclaimed the exclusive use of the word DVD apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of January 9, 2002. The opponent, Gemstar Development Corporation, filed a statement of opposition on March 8, 2002. The applicant filed and served a counter statement in which it denied the opponent's allegations. On August 22, 2002, the opponent requested leave to file an amended statement of opposition. Leave was granted by letter dated November 1, 2002.

As rule 41 evidence, the opponent filed the affidavit of Jonathan B. Orlick, a certified copy of the file wrapper for the present application, and certified copies of trade-mark registrations Nos. TMA418,092, TMA429,352, TMA433,567, TMA562,382 and TMA562,483.

The applicant obtained an order for the cross-examination of Mr. Orlick on his affidavit but did not proceed with such cross-examination. Furthermore, the applicant elected to not file any evidence pursuant to Rule 42.

Only the opponent filed a written argument. An oral hearing was not held.

In respect of each of the grounds of opposition, there is an initial evidential burden on the opponent. The opponent is required to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support its grounds of opposition exist. [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298] However, the legal onus is on the applicant to establish that its application complies with the requirements of the *Trade-marks Act*.

The first two grounds of opposition are based on subsection 30(d) of the *Trade-marks Act*. Section 30 of the Act sets out the required contents of a trade-mark application and subsection 30(d) makes the following requirement:

in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in

which the trade-mark has been used by the applicant or the applicant's named predecessor in title, if any, in association with each of the general classes of wares or services described in the application.

The opponent pleaded that the application does not comply with the provisions of subsection 30(d) because the applicant has not named his predecessor-in-title in respect of the application filed in France. It is clear from the certified copy of the French registration in the prosecution file that the foreign application was not filed by the applicant, as alleged in this application, but by the applicant's predecessor, Godefroy Giudicelli. The applicant's failure to name this predecessor renders its application contrary to section 30 and the application is refused on this basis. [see *Hardee's Food Systems Inc. v. Hardee Farms International Ltd.* (1984), 1 C.P.R. (3d) 417 (T.M.O.B.) and *Sanna, Inc. v. Chocosuisse Union des Fabricants Suisses de Chocolat* (1986), 14 C.P.R. (3d) 139 (T.M.O.B.)]

The opponent has also pleaded that the applicant's trade-mark is not registrable pursuant to paragraph 12(1)(d) of the Act and is not distinctive because it is confusing with the trade-mark VCR PLUS+ & Design, which has been registered and used by the opponent.

Mr. Orlick, the opponent's Senior Vice President, informs us that the opponent "is a technology development corporation which develops and licenses proprietary technology which simplifies the operation of VCR's, DVD recorders, television sets, cable television boxes, satellite receivers and other consumer electronic devices." The opponent owns the trade-mark VCR PLUS+ & Design registered under TMA418,092 for, *inter alia*, controllers for programming of video cassette recorders and cable boxes, and video cassette recorders. That mark is shown below:



The opponent also uses the trade-marks VCR PLUS+, PLUSCODE, VCR PLUSCODE and VCR PLUS + GOLD. Since 1996, over 2.5 million consumer electronic products have been sold in Canada under the opponent's VCR PLUS + marks. Mr. Orlick has shown how his company's VCR PLUS+ & Design trade-mark is displayed on the packaging of electronic products and has provided copies of advertisements circulated in Canada that display such mark.

The material date with respect to paragraph 12(1)(d) is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)], whereas the material date with respect to distinctiveness is the filing date of the statement of opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.*, 2004 FC 1185 at 10-11]. The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the *Act*. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Neither of the parties' marks is inherently distinctive. Only the opponent's mark has become known sufficiently to acquire some distinctiveness.

The opponent's mark has been used in Canada since 1991 whereas there has been no use in Canada of the applicant's mark.

The parties' wares are related and they would both be sold through similar channels of trade, e.g. stores featuring electronic products.

There is a high degree of resemblance between the trade-marks in the ideas suggested by them. There is also a fair degree of resemblance between them with respect to appearance and sound.

The issue is whether a consumer who has a general and not precise recollection of the opponent's mark, will, upon seeing the applicant's mark, be likely to think that the related wares/services share a common source. I find that a consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between the marks as of either today's date or the date of filing of the statement of opposition. I reach this conclusion based on the strong resemblance between the marks with respect to the ideas suggested, the similarity between the parties' wares and channels of trade, the distinctiveness acquired by the opponent's mark through use and advertisement, and the failure of the applicant to file any evidence.

As the opposition has already succeeded on more than one ground, I will not discuss the remaining grounds of opposition.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 20th DAY OF OCTOBER 2004.

**Jill W. Bradbury
Member
Trade-marks Opposition Board**