

**IN THE MATTER OF AN OPPOSITION by  
Advance Magazine Publishers Inc. to application No. 823,634  
for the trade-mark GOURMET GUYS  
filed by Dr. Robert Casciato**

**On September 18, 1996, the applicant, Dr. Robert Casciato, filed an application to register the trade-mark GOURMET GUYS. The application is based upon proposed use of the trade-mark in Canada in association with publications namely cookbooks and gambling instructional guides, together with novelty items namely t-shirts, sweatshirts and aprons. The applicant disclaimed the right to the exclusive use of the word GOURMET, apart from the trade-mark.**

**The application was advertised for opposition purposes in the Trade-marks Journal of March 18, 1998. On August 18, 1998, the opponent, Advance Magazine Publishers Inc., filed a statement of opposition. The applicant filed and served a counter statement.**

**The opponent filed evidence, namely the affidavits of Eric C. Anderson and Jennifer Nahorniak and certified copies of registrations Nos. TMA392,189 and TMA277,151.**

**The applicant filed the affidavit of Kathryn Ann Marshall as its evidence. The opponent obtained an order for the cross-examination of Ms. Marshall on her affidavit. The transcript of the cross-examination and answers provided to undertakings have been filed.**

**As reply evidence, the opponent filed certified copies of applications Nos. 802,009,**

1,071,929, 1,059,570, and 823,634 and registrations Nos. 349,314, 205,209, 404,229, 463,162 and 489,931.

Neither party filed a written argument but both participated in an oral hearing.

In its statement of opposition, the opponent claims ownership of the trade-marks GOURMET and GOURMET Design, which are the subject of Canadian trade-mark registrations Nos. 392,189 and 277,151. It relies on these trade-marks in support of grounds of opposition pleaded under paragraphs 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*. The material date with respect to the paragraph 38(2)(a) ground of opposition (non-compliance with subsection 30(i)) is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469, at p. 475]. The material date for determining the likelihood of confusion with respect to the paragraph 38(2)(b) grounds of opposition (registrability under 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.)]. The material date for determining the likelihood of confusion with respect to the paragraph 38(2)(c) grounds of opposition (entitlement under section 16) is the filing date of the application. The material date with respect to the paragraph 38(2)(d) ground of opposition (non-distinctiveness) is the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

### **Opponent's Evidence-in-Chief**

**Mr. Anderson is the opponent's Vice-President. He attests that the opponent is a magazine publisher and that it has published GOURMET magazine continuously since 1952. GOURMET magazine is said to regularly include "articles, features and advertisements relating to food, dining, travel and fine living, as well as numerous recipes and cooking instructions."**

**The opponent's GOURMET magazine is sold throughout the world by subscription and on newsstands. As of 1999, the Canadian annual circulation averaged "almost 500,000" copies. Mr. Anderson has also provided the annual Canadian circulation figures for the years 1984 through 1997. The exhibits to Mr. Anderson's affidavit include a specimen copy of GOURMET magazine, randomly selected covers and title pages, and excerpts from the opponent's web site.**

Mr. Anderson states, "My company also produces cook books which are sold in Canada in [stet] the U.S. which includes some recipes from GOURMET magazines." Copies of covers and excerpts from these books are provided, but no details as to the extent or timing of Canadian sales. Mr. Anderson also states that the opponent promotes its magazine through chef presentations and sponsoring of cooking shows, but almost no detail of such promotions has been provided.

I accept that the opponent has used GOURMET in Canada as the name of a magazine devoted to food, dining, travel and style since before the filing of the present application. However, the

evidence does not support Mr. Anderson's claim that the GOURMET magazine is famous in Canada.

The applicant's agent has challenged much of Mr. Anderson's evidence as inadmissible hearsay. In particular, he submits that although Mr. Anderson said, "[I] have access to the relevant files, books and records of my company kept in the normal course of business. I therefore have personal knowledge of the matters sworn to in this affidavit and have access to information regarding other matters sworn to herein", he did not say that he reviewed such records. The applicant's position is that Mr. Anderson's evidence cannot therefore benefit from the business records hearsay exemption. However, the applicant chose to not cross-examine Mr. Anderson and I see **no reason to question the reliability of the sales information [see *Imax Corp. v. Kukje Corp.* (2000), 8 C.P.R. (4th) 546 (T.M.O.B.) at 552]. I note too that the applicant admits there have been some sales of the opponent's GOURMET magazines in Canada.**

**The applicant's agent also objected to Mr. Anderson's opinion evidence and I agree that these are not to be given any weight. It is not uncommon for affiants to express their view on the likelihood of confusion and the like, but the Registrar disregards such self-serving statements because it is generally not the role of an affiant to make such conclusions.**

**Ms. Nahorniak, a legal clerk, purchased copies of GOURMET magazine and GOURMET'S SWEETS cookbook in Toronto in 1999. She also noted that three other GOURMET cookbooks were offered for sale: GOURMET'S PARTIES, GOURMET'S QUICK KITCHEN and GOURMET'S WEEKENDS. She states that she is aware of a**

television show called COOKING LIVE... broadcast in Canada on the Food Network. She states that such show is hosted by GOURMET magazine's executive chef and provides a TV GUIDE that lists the broadcast time for this cooking program as well as pages from the Food Network's web site that refer to the show and its host. She also provides partial results of a search that she conducted of the Internet for the words GOURMET MAGAZINE. It appears that not all of the web sites located are referring to the opponent's magazine; for example, the second hit is for Diabetic Gourmet Magazine while the sixth is for Gourmet Connection Magazine.

Registration No. TMA277,151 is for the trade-mark GOURMET Design. It issued to registration on March 4, 1983 based on use of the mark in Canada in association with magazines since August 1957. The opponent's predecessor-in-title obtained the registration after demonstrating registrability under section 14 of the Act. Registration No. TMA392,189 is associated with TMA277,151. It issued on December 20, 1991 for GOURMET based on use of the mark in Canada in association with magazines since at least as early as August 1957.

#### Applicant's Evidence

Ms. Marshall, a law clerk, conducted searches in 2000 to locate use of the word "gourmet" as a trade-mark in connection with publications of any kind and for food and beverage services. She searched Canadian telephone directories, the Canadian Trade-mark Register, the Internet and book titles.

During cross-examination, the opponent's agent focussed on whether Ms. Marshall knew whether businesses listed in the telephone directories were active and how frequently the publisher purged inactive listings from the directories, whether Ms. Marshall knew how many of each of the printed materials that she referred to were distributed in Canada, whether the web sites she located originated in Canada and whether she knew how frequently they were viewed, whether the various Gourmet names/marks she located appear on recipes, cookbooks, magazines and the like, and whether she knew how many of each of the books that she identified as referring to "gourmet" are sold in Canada.

#### Opponent's Reply Evidence

**The certified copies filed show changes in the state of the register subsequent to Ms. Marshall's searches.**

#### Entitlement

**The material date with respect to the opponent's section 16 grounds of opposition is September 18, 1996. I will begin by focusing on the likelihood of confusion between the trade-mark GOURMET GUYS in association with cookbooks and the opponent's GOURMET trade-mark as previously used for magazines.**

**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. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-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; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

In *Dion Neckwear Ltd. v. Christian Dior, S.A. and the Registrar of Trade Marks* (2002), 20 C.P.R. (4<sup>th</sup>) 155 (F.C.A.) at 160-163, Décary J. A. said the following about the issue of confusion:

Some practical guidelines have been set out by Malone J.A. in para. 18 of his reasons in *Polo Ralph Lauren* [(2000), 9 C.P.R. (4<sup>th</sup>) 51 (F.C.A.)]:

A review of some of the leading cases also establishes some practical guidelines. For example, the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier. With respect to the degree of resemblance in appearance, sound or ideas under subparagraph 6(5)(e), the trade-marks at issue must be considered in their totality. As well, since it is the combination of elements that constitutes a trade-mark and gives distinctiveness to it, it is not correct to lay the trade-marks side by side and compare and observe similarities or differences among the elements or components of the marks when applying the test for confusion. In addition, trade-marks must not be considered in isolation but in association with the wares or services with which they are used. When dealing with famous or well-known marks, it may be more difficult to demonstrate that there is no likelihood of confusion, especially if the nature of the wares are similar. Lastly, the enumerated factors in subsection 6(5) need not be attributed equal weight. Each particular case of confusion might justify greater emphasis being given to one criterion than to others.

...

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the "beyond doubt" standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is

**to be resolved in favour of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a Registrar should avoid resorting to it.**

GOURMET is an inherently weak mark with respect to magazines, given that it suggests the subject matter of the magazine. GOURMET GUYS is similarly inherently weak with respect to cookbooks.

GOURMET magazine has become known in Canada through many years' use. There is no evidence that GOURMET GUYS has become known at all.

The applicant has not evidenced any use of GOURMET GUYS in Canada whereas the opponent's GOURMET mark has been used since 1957.

The registration for GOURMET covers magazines and the evidence shows that these magazines include recipes. Thus there is a great similarity between the opponent's magazines and the applicant's cookbooks.

Mr. Anderson states that the opponent's magazine is sold by subscription and on newsstands but there is also evidence of its presence in bookstores and on the Internet. While there is no evidence concerning the applicant's channels of trade, it is reasonable to assume that they might at least overlap with those of the opponent.

When considered in their totalities, there is a fair degree of resemblance between GOURMET and GOURMET GUYS in appearance, sound and idea suggested. The applicant's mark not only



includes the opponent's mark in its entirety but the opponent's mark appears as the first portion of the applicant's mark. The first component of a mark is of course often considered more important for the purpose of distinction, although, when such word is a common, descriptive or suggestive word, the significance of the first component may decrease [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4<sup>th</sup>) 109 (T.M.O.B.)]. The *Gage Canadian Dictionary* defines "gourmet" as "a person who is expert in judging and choosing fine foods, wines, etc.; epicure" [Exhibit "S-3", Marshall affidavit]. The idea suggested by the applicant's mark is that the associated cookbooks contain "gourmet" recipes for/by men.

As of the material date of September 18, 1996, there is no evidence of the state of the register or marketplace.

**Having considered all of the surrounding circumstances, I am not satisfied that, on a balance of probabilities, there was not a reasonable likelihood of confusion between GOURMET magazine and GOURMET GUYS cookbook as of September 18, 1996.**

**Turning to the remaining wares in the application, I reach a different conclusion. I am satisfied that, on a balance of probabilities, there was not a reasonable likelihood of confusion between the opponent's GOURMET magazine and GOURMET GUYS gambling instructional guides, together with novelty items namely t-shirts, sweatshirts and aprons as of September 18, 1996. The main reasons for the different conclusion are that**

**GOURMET GUYS is not inherently weak with respect to gambling instructional guides and there is not much similarity between the opponent's magazines and the applicant's gambling instructional guides.**

**My conclusions with respect to the likelihood of confusion with the opponent's GOURMET Design mark are identical to those set out above with respect to the opponent's GOURMET mark.**

**I note that at the oral hearing, the applicant relied on *Conde Nast Publications, Inc. v. Canadian Federation of Independent Grocers* (1991), 37 C.P.R. (3d) 538 (T.M.O.B.), in which Board Member Martin rejected an opposition by the present opponent's predecessor to a use-based application to register GOURMET WORLD for "operation of a trade exhibition of food industry products, equipment and services". However, I distinguish that decision on the basis that the opponent did not there file any evidence and the divergence between the applicant's services and the opponent's wares was more significant than that between two types of food-related publications.**

#### **Distinctiveness**

**August 18, 1998 is the material date with respect to the distinctiveness ground of opposition. The evidence as of that date is not materially different from the evidence as of September 18, 1996. Accordingly, I reach the same decision concerning the likelihood of confusion under this ground as I did under the entitlement grounds of opposition.**

## Registrability

I turn now to the paragraph 12(1)(d) ground of opposition based on registration No. 392,189 for the word mark GOURMET. Most of what was said above concerning the surrounding circumstances set out in subsection 6(5) of the Act applies equally, or even more so, as of today's date. The major difference between the surrounding circumstances as of today's date and September 18, 1996 is the evidence of the state of the register and marketplace.

Ms. Marshall located well over one hundred telephone listings for Canadian businesses whose names start with GOURMET. There is however no indication that any of these are in the business of selling publications, as opposed to food.

The following marks are, in my view, the most relevant of those located in Ms. Marshall's trademark register search and not shown to have been subsequently expunged:

- **ELECTRONIC GOURMET & Design for computer software systems that inputs, stores and retrieves recipes, menus...;**
- **GARLIC GOURMET registered for, *inter alia*, garlic cookbooks and recipes;**
- **WHOLE HOME GOURMET & Design registered for, *inter alia*, cookbooks.**

**These are insufficient in number to draw a meaningful conclusion about the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].**

**Ms. Marshall has however provided some evidence of the use of these registered trademarks in the marketplace. She provides a copy of two pages from the Internet concerning**

**ELECTRONIC GOURMET & Design, which provides a searchable database of more than 1000 recipes. The Internet address is a Canadian one and the owner of the mark listed on the trade-mark registration is located in Canada. She has also provided pages from the Internet concerning THE GARLIC GOURMET, which is a business located in Ottawa at the address listed in the trade-mark registration for GARLIC GOURMET. Ms. Marshall also provides pages from a Sears catalogue advertising WHOLE HOME GOURMET cookware for sale.**

**As Exhibits “I-1” through “I-39”, Ms. Marshall provides pages from the Internet concerning publications marketed under a “gourmet” name. These include GOURMET CONNECTION magazine, THE DIABETIC GOURMET magazine, GOURMET FARE magazine, THE GOURMET RETAILER magazine, LE FIN GOURMET magazine, GOURMET BUSINESS magazine, GOURMET GUIDE, THE BODY GOURMET magazine, ASIAN HOME GOURMET magazine, GOURMET TRAVELLER magazine, THE GRUMPY GOURMET dining guide, THE GOURMET GAZETTE’s GOURMET TRADE for cookbooks, THE HEALTHY GOURMET cookbook, GUILT FREE GOURMET cookbook, THE RAW GOURMET cookbook, TOO EASY GOURMET cookbook, GOURMET GUIDES for cookbooks, GOURMET WORLD recipes, GUILTLESS GOURMET newsletter, THE INTERNATIONAL GOURMET for cookbooks, THE NATURAL GOURMET cookbook, *etc.* Although these web sites are clearly accessible from Canada, there is no evidence that any of these publications have ever been sold in Canada or that any Canadians other than Ms. Marshall have ever**

**accessed these sites. Similarly, there is no evidence that any of the 34 “gourmet” cookbooks listed at [www.gourmets-choice.com](http://www.gourmets-choice.com) have been sold in Canada.**

Ms. Marshall did determine that the Australian food magazine GOURMET TRAVELLER is listed for sale at a bookstore in Toronto, although it was not in stock when she attended. At that same store she located a book entitled “GOURMET GETAWAY – A Taste of North America’s Top Resorts” published in Canada in 1998. A search of that store’s database located listings for 673 books with the word GOURMET in the title but there is no evidence that any of these books have been sold in Canada.

At another bookstore in Toronto, Ms. Marshall determined that its listing of magazines included the aforementioned GOURMET TRAVELLER and ASIAN HOME GOURMET, as well as the opponent’s GOURMET magazine. At that store, she also picked up a promotional flyer for a cookbook entitled “Nice Timing: Gourmet Meals in Minutes”. This store’s database listed 315 books with the word GOURMET in the title, but again there is no evidence that any of these have been sold in Canada.

Despite the fact that much of Ms. Marshall’s evidence does not relate to Canada, I am prepared to accept from the remainder of her evidence (as well as some of the evidence of the opponent’s affiant Ms. Nahorniak) **that Canadians are used to seeing the word GOURMET as part of various business names, as well as part of titles of various publications. Given the meaning of the word “gourmet”, these businesses and publications tend to relate to food in one form or another.**

**As a further surrounding circumstance, I have considered the evidence of cookbooks sold in Canada in association with the opponent's GOURMET mark. These include titles such as GOURMET'S QUICK KITCHEN, GOURMET'S WEEKENDS and GOURMET'S PARTIES.**

**Having considered all of the surrounding circumstances, I am satisfied that, on a balance of probabilities, there is not a reasonable likelihood of confusion between GOURMET magazine and GOURMET GUYS cookbook or the other applied-for wares as of today's date. Comparatively small differences may suffice to make confusion unlikely between GOURMET and GOURMET GUYS when there is evidence of the adoption of the descriptive word GOURMET by other publications. [see *Molson Companies Ltd. v. John Labatt Ltd.* (1994), 58 C.P.R. (3d) 527 (F.C.A.) at 529-530]**

**The above discussion applies equally to the opponent's GOURMET Design mark.**

**In summary, the applicant has satisfied the burden on it with respect to each of the paragraph 12(1)(d) grounds of opposition and these grounds are accordingly rejected.**

**At the oral hearing, the opponent relied on the unreported June 27, 2001 decision in *Advance Magazine Publishers Inc. v. Quarto Publishing Plc* re application No. 802,009 for the trade-mark MAGNET GOURMET. That application was based upon proposed use in association with "series of small format books, booklets, cards, decalcomanias, stickers, posters, calendars, with magnetic mounts for fixing to refrigerator doors and other**

refrigerator surfaces, or similar metallic surfaces”. Board Member Martin refused the application, saying, “...in view of the resemblance between the wares, trades and marks of the parties and the acquired reputation associated with the opponent’s two marks, I find that I am left in a state of doubt respecting the issue of confusion. Since the onus is on the applicant to show no reasonable likelihood of confusion, I must resolve my doubt against it. ... Had the applicant been able to evidence widespread use of third party marks including the word GOURMET for similar wares, my conclusion might have been different.”

The opponent’s evidence in that proceeding was similar to its evidence in the present proceeding. However, the only evidence from the applicant concerning the state of the marketplace was a single trade-mark registration and I distinguish that case on that basis.

#### Subsection 30(i)

The opponent pleads that “at the date of application a search of the Trade-Mark Register would have located the marks of the Opponent relied on herein, and therefore the Applicant could not have been satisfied under Section 30(i) of its entitlement to use the said mark. The Applicant knew or ought to have known of the Opponent’s use, registration and notoriety prior to its date of application.” However, there is no indication in any of the evidence that the applicant was aware of the opponent’s rights with respect to GOURMET when it filed its application. This ground is therefore dismissed because the opponent has failed to meet its initial burden.

#### Disposition

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, pursuant to the provisions of subsection 38(8) of the Act, I refuse the application with respect to the wares “cookbooks” and reject the opposition with respect to the remainder of the wares. Authority for a split decision is set out in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH*, 10 C.P.R. (3d) 492 (F.C.T.D.).

DATED AT TORONTO, ONTARIO THIS 14<sup>th</sup> DAY OF APRIL, 2004.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board