

**IN THE MATTER OF AN OPPOSITION by
Colorific Photo& Digital Imaging Ltd. to
Application No. 1005540 for the
Trade-mark COLORIFIC and Design
filed by J.W. Crooks Company Limited**

On November February 16, 1999, J.W. Crooks Company Limited (the "Applicant"), filed an application to register the trade-mark COLORIFIC and Design as hereinafter illustrated



(the "Mark"), based on use since 1996, in association with:

Photo finishing and photo lab services; namely, receiving and processing exposed film for customers, making prints, duplicates and enlargements to order specified therein. (The "Services")

The application was subsequently advertised on January 12, 2000, for opposition purposes in the *Trade-marks Journal*.

On May 25, 2000, Colorific Photo & Digital Imaging Ltd. (the "Opponent") filed a Statement of Opposition. The Applicant served and filed on July 28, 2000, a counter statement in response to the statement of opposition, in which it denied each and every ground of opposition raised by the Opponent in its statement of opposition.

The grounds of opposition can be summarised as follows:

- a) The Applicant is not the person entitled to the registration of the Mark having regard to the provisions of section 16(1)(a), 16(1)(c) and 16(5) of the Trade-marks Act (the "Act") as it is confusing and is likely to cause confusion with the Opponent's trade-mark COLORIFIC and its trade name Colorific Photo & Digital Imaging Ltd previously used and made known in Canada by the Opponent in association with the Services since at least March 1973 by the Opponent;

- b) The Application does not comply to the requirements of Section 30(i) of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the Services since, at the date of filing of the Application, the Applicant was aware or should have been aware of the Opponent's prior use in Canada of the trade-mark COLORIFIC;
- c) The Mark is not distinctive as it does not actually distinguish the Services nor is it adapted to so distinguish them, from the wares and services of others, specifically the Applicant's Mark is not distinctive of the Applicant's Services in view of the Opponent's prior use of the trade-mark COLORIFIC.

The Opponent was granted leave to amend its statement of opposition to add the following ground of opposition:

- d) The Mark is not registrable as it is confusing with the Opponent's registered trade-mark COLORIFIC, certificate of registration TMA551680 issued on September 27, 2001.

The Opponent filed the affidavit of Mr. James R. MacDonald together with exhibits 1 to 11 inclusive as well as a certificate of authenticity of registration number TMA551680 for the trade-mark COLORIFIC. The Applicant advised the Registrar of its intention not to file evidence. Neither party filed written submissions nor was there an oral hearing.

The Opponent's evidence

Mr. James R. MacDonald is the Opponent's president. The company was incorporated in February 1973 under the name Colorific Photo Labs Ltd. On October 11, 1994, it changed its name to Colorific Photo & Digital Imaging Ltd. In the late 1980's the Opponent expanded its business into the production of large and wide format photographic murals. It was the sole supplier of such murals for the

Vancouver Expo 86. In early 1994 it acquired state of the art digital technology and equipment by which it could take the digital data of a customer from a disk and directly output the data to a print. The technology allowed the variation of colours and manipulation of the digital image in large or small format.

The Opponent's annual sales have been, since 1980, at least over one million dollars. The Opponent has been able to locate invoices going back to 1987 up to and including year 2000 (the affidavit was executed on March 26, 2001). Each of the invoices filed bore the Opponent's trade name Colorific Photo Labs Ltd (for the period prior to 1994) or Colorific Photo & Digital Imaging Ltd. (for the years 1994 to 2000) and the trade-mark COLORIFIC appears on some of them. The services described on the invoices include prints, lamination, photo panels, images transferred on CD, copy of negatives, transparency output, copy slides and other photographic laboratory services.

The Opponent's clients are located across Canada and parts of the United States of America. A business card was filed on which appeared prominently the word COLORIFIC. The Opponent advertised its services in the BC Yellow Pages since 1974 wherein the word COLORIFIC is prominently displayed and the trade-mark COLORIFIC appears on some of the ads. Articles on the Opponent's business were published in trade magazines such as Photo Marketing, Kodak Studio Light and Photo Lab Management.

The Opponent filed a certification of authenticity of registration TMA551680, for the trade-mark COLORIFIC, registered in association with:

Operation of a business providing photo finishing and photo lab services including
photographic printing, photographic enlarging and photographic mounting;
photographic reproduction, restoration and retouching; photographic computer
imaging; photographic slide and print processing and digital imaging services;
digital restoration and enhancement of photographs.

The legal issues

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial onus on the Opponent to establish the facts relied upon by it in support of its grounds of opposition. Once this initial onus is met, the burden shifts to the Applicant who must prove that the particular grounds of opposition should not prevent registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, (1985) 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

The material time for considering the issue of non-entitlement based on Subsection 16(1) of the Act is the claimed date of first use (December 31, 1996) [Section 16 of the Act]. The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (May 25, 2000) while registrability under 12(1)(d) must be assessed as of the date of my decision. [See *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) 413 at 424 (F.C.A.)]

There has been no evidence filed by the Opponent to substantiate the ground of opposition b) described above, and as such it is dismissed.

The Opponent has discharged its initial onus with respect to the first ground of opposition mentioned above, namely that it has used the trade-mark COLORIFIC and the trade name Colorific Photo Digital Imaging Ltd. prior to the claimed date of first use alleged in the application for the registration of the Mark. Moreover the evidence described above established that the Opponent has not abandoned the use of the trade-mark COLORIFIC and the trade name Colorific Photo & Digital Imaging Ltd at the date of advertisement (January 12, 2000) of the application [Section 16(5) of the Act].

The Opponent has also discharged its initial burden of proof by filing the certificate of registration TMA551680 for the trade-mark COLORIFIC. The burden of proof therefore lies on the Applicant who must convince the Registrar, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trade-mark COLORIFIC and its trade

name Colorific Photo & Digital Imaging Ltd at the above mentioned relevant dates [*see Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982), 61 C.P.R. (2d) 53* and *Christian Dior, S.A. v. Dion Neckwear Ltd [2002] 3 C.F.405*].

Confusion is a key issue to the remaining grounds of opposition, namely registrability of the Mark (Section 12(1)(d)), entitlement to the registration (Section 16(1)) and distinctiveness of the Mark. In order to determine whether the Mark is confusing with the Opponent's registered trade-mark COLORIFIC and the trade name Colorific Photo & Digital Imaging Ltd, Section 6(5) of the Act directs the Registrar to have regards to all of the surrounding circumstances, including:

- i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- ii) The length of time the trade-marks or trade-names have been in use;
- iii) The nature of the wares, services, or business;
- iv) The nature of the trade; and
- v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

It has been established that the criteria listed in section 6(5) of the Act are not exhaustive and it is not necessary to give each one of them equal weight [See *Clorox Co. v. Sears Canada Inc. (1992), 41 C.P.R. (3d) 483 (F.C.T.D.)* and *Gainers Inc. v. Marchildon (1996), 66 C.P.R.(3d) 308 (F.C.T.D.)*].

As the Opponent's strongest case is the likelihood of confusion with the trade-mark COLORIFIC, if the Applicant's Mark is not confusing with the Opponent's trade-mark COLORIFIC, then it will not be confusing with the Opponent's trade name Colorific Photo & Digital Imaging Ltd. I shall therefore focus my analysis of the surrounding circumstances by comparing the Mark with the Opponent's trade-mark COLORIFIC. The difference in the various relevant dates to the remaining grounds of opposition will not have an effect on the outcome of my decision.

i) The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

The Mark is a coined word and does possess some degree of inherent distinctiveness even though the Mark is composed of the word “color” which could be considered somewhat suggestive when used in association with photo finishing and photo lab services. The Opponent’s trade-mark COLORIFIC possesses some measure of inherent distinctiveness which is enhanced by the evidence of use detailed above which establishes that the Opponent’s trade-mark COLORIFIC is known to some extent in the province of British Columbia while there has been no evidence of use of the Mark in Canada by the Applicant. Thus, I am able to conclude that this factor favours the Opponent.

ii) The length of time the trade-marks or trade-names have been in use;

The evidence filed in the record establishes “use” by the Opponent of the trade-mark COLORIFIC since at least 1979 while the Applicant hasn’t filed any evidence of use of the Mark. This criterion also favours the Opponent.

iii) & iv) The nature of the wares, services, or business and the nature of the trade;

By comparing the Services with the Opponent’s services described on the invoices filed and the services covered by certificate of registration TMA551680 issued to the Opponent, there is clearly an overlap between them. The Applicant failed to adduce any evidence to try to differentiate the channels of trade of its Services from the channels of trade used by the Opponent to sell or offer for sale its services. Therefore the third and fourth factors described above also favour the Opponent.

v) The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

The word portion of the Mark is identical to the Opponent's Registered trade-mark COLORIFIC. In this case, the addition of a design portion to the word COLORIFIC is not sufficient to enable an average consumer to distinguish the origin of the Services from those offered by the Opponent.

I conclude that the Applicant hasn't discharged its burden to prove, on the balance of probabilities, that the Mark would not likely cause confusion with the Opponent's registered trade-mark COLORIFIC, when used in association with the Services. I reach this conclusion on the basis of the analysis of all of the surrounding circumstances which favour the Opponent and the Applicant's apparent lack of interest in this proceeding. Therefore I maintain grounds of opposition a), c) and d) described above.

Having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, I refuse the Applicant's application to register the Mark in association with the Services, the whole pursuant to Section 38(8) of the Act.

DATED, IN MONTREAL, QUEBEC, THIS 19th DAY OF MARCH 2004.

Jean Carrière,
Member,
Trade-mark Opposition Board