



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

Citation: 2016 TMOB 180
Date of Decision: 2016-11-21

IN THE MATTER OF AN OPPOSITION

Les Espaces Memoria Inc.	Opponent
and	
Star-Jet Jewellers Ltd.	Applicant
1,655,159 for the trade-mark Memoria Imprints	Application

Introduction

[1] Les Espaces Memoria Inc. (the Opponent) opposes registration of the trade-mark Memoria Imprints (the Mark).

[2] The application covers jewellery (the Goods) and the following services:

Lasers engraving of fingerprints, handprints, and pawprints on jewellery. Wholesale sale of jewellery to jewellers, jewellery manufacturers, jewellery designers, goldsmiths and to other retail outlets, retail jewellery sales, marketing of jewellery of third parties by means of magazine advertisements, brochures and promotional videos. (the Services).

[3] The application was filed by Star-Jet Jewellers Ltd. (the Applicant) on December 9, 2013 on the basis of proposed use in Canada.

[4] For the reasons explained below, I refuse the application.

The Record

[5] The application was advertised in the *Trade-marks Journal* on October 29, 2014.

[6] The Opponent filed a statement of opposition on December 23, 2014 under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded are based on sections: 30 (requirements), 12(1)(d) (registrability), 16(3) (non-entitlement), and 2 (distinctiveness).

[7] The Applicant filed and served a counter statement on March 9, 2015 in which it denied each ground of opposition pleaded by the Opponent.

[8] The Opponent filed as evidence the affidavit of Jocelyne Dallaire Légaré dated July 30, 2015 while the Applicant chose not to file evidence.

[9] Only the Opponent filed written arguments and was represented at the hearing.

The parties' respective burden or onus

[10] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Preliminary remarks

[11] I wish to point out that in reaching my decision I have considered all the evidence in the file but I will only refer in my reasons for this decision to the relevant portions of the evidence.

[12] This file was heard subsequent to oppositions filed by the Opponent to applications Nos. 1,615,907 for the trade-mark ‘MEMORIA loved remembered & design’ and 1,615,508 for the trade-mark ‘MEMORIA for all those memories & design’ covering similar goods and services to those covered by the present application. Not surprisingly, the Opponent cited the Registrar’s decisions rendered in those two files maintaining its oppositions [see *Espaces Memoria Inc v Star-Jet Jewellers Ltd*, 2015 TMOB 167 (CanLII) and *Espaces Memoria Inc v Star-Jet Jewellers Ltd*, 2015 TMOB 168 (CanLII) (Registrar’s prior two decisions)].

[13] I will point out the differences between the present file and those previous ones, but as it will appear, those differences will not have an impact on this decision. In any event, in the absence of evidence, written and oral arguments from the Applicant, it is difficult to justify a different result from the Registrar’s prior two decisions given the similarities in all those files.

Grounds of opposition summarily dismissed

Section 30 grounds of opposition

[14] In its statement of opposition, the Opponent raised as grounds of opposition sections 30(e), (h), and (i) of the Act. These grounds of opposition have not been addressed by the Opponent in its written argument and at the hearing.

[15] There is no evidence in the record that supports any of these grounds of opposition.

[16] Consequently, they are all dismissed, as the Opponent failed to meet its initial burden of proof.

[17] Therefore, the only grounds of opposition to be discussed hereinafter are those based on sections 12(1)(d), 16(3) and 2 (distinctiveness) of the Act. They all turn on the issue of likelihood of confusion with the Opponent’s trade-marks MEMORIA and COLLECTION MEMORIA.

Registrability of the Mark under section 12(1)(d) of the Act

[18] The relevant date for the analysis of this ground of opposition is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[19] Ms. Dallaire Légaré has been the Opponent's President since May 3, 2002. She filed a certificate of authenticity for the trade-mark MEMORIA (registration No. TMA647,454) registered in association with:

Urns, reliquaries, caskets, bookmarks, guest books, thank-you cards, picture frames and votive candles; (MEMORIA products) and

Funeral home services; prepaid funeral services; cremation services; mausoleum, burial plots and columbariums; funeral arrangement services, reception room rental, photographic and videographic tribute services, mourning follow-up services, inheritance assistance services, repatriation services, art therapy services, psychological and legal assistance services, sale of funerary products (MEMORIA services).

[20] However, because of a section 45 proceeding, caskets have been removed from the list of goods and funeral home services; prepaid funeral services; cremation services; mausoleum, burial plots and columbariums from the list of services [see *Sim & McBurney v Les Espaces Memoria Inc.* 2016 TMOB 24 (CanLII)]. Taking into consideration the Registrar's prior two decisions, those modifications will not have an impact on this decision.

[21] Ms. Dallaire Légaré also filed a certificate of authenticity for the trade-mark COLLECTION MEMORIA (registration No. TMA786,566). However, since I consider that the Opponent has its best chances of success with its registered trade-mark MEMORIA, I will therefore limit my analysis of the relevant criteria to that mark. If the Opponent were not successful with this trade-mark, it would not achieve a better result with its registered trade-mark COLLECTION MEMORIA.

[22] Therefore, the Opponent has met its initial burden with respect to this ground of opposition.

[23] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between

two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[24] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's trade-marks, who sees the Applicant's Goods and Services in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[25] Even though MEMORIA is a coined word, it is suggestive of 'memorial' when used in association with the MEMORIA products and the MEMORIA services. As for the Mark, the addition of 'Imprints' to 'Memoria' does not add to the distinctiveness of the Mark. In fact, 'Imprints' is certainly at least highly suggestive of the following services: 'laser engraving of fingerprints, handprints and pawprints on jewellery'.

[26] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. The application is based on proposed use. As for the evidence of use of the Opponent's registered trade-mark MEMORIA, it is contained in Ms. Dallaire Légaré's affidavit.

Evidence of use of the Opponent's registered mark

[27] Ms. Dallaire Légaré states that the Opponent is a family business going back four generations, created by Alfred Dallaire and carrying on business in the field of funerals. The

Opponent is now presently located in most areas of Montreal Metropolitan, Laval and Repentigny, with a dozen of branches, complexes and mausoleums.

[28] Ms. Dallaire Légaré affirms that, in 2003, the Opponent's predecessor in title Alfred Dallaire Inc (ADI) went through a corporate restructure such that half of its assets were transferred to the Opponent, incorporated on May 3, 2002, which was then known as 9116-2644 Quebec Inc. and now known under the Opponent's name. It was soon thereafter that the Opponent adopted the trade-mark MEMORIA.

[29] Ms. Dallaire Légaré alleges that the MEMORIA products and MEMORIA services are displayed on the Opponent's website located at *www.memoria.ca*. She states that the website has been in operation since December 2003.

[30] Ms. Dallaire Légaré filed as exhibit JDL-2 extracts of the website illustrating MEMORIA products sold since 2003 in Canada such as cinerary urns, reliquaries, caskets, bookmarks, guest books, thank-you cards, picture frames and votive candles. She also filed as exhibit JDL-3 extracts of the website describing the MEMORIA services offered in Canada since at least 2003 such as funeral arrangement services, reception room rental, mausoleum, columbarium, inheritance assistance services, repatriation services and art therapy services.

[31] At this stage I wish to illustrate what appears on the extracts of the webpages and I will determine later if this representation constitutes use of the trade-mark MEMORIA:

Alfred Dallaire | MEMORIA

Also, on most of the exhibits filed, the trade-mark MEMORIA appears in the same format as illustrated above, except where stated otherwise in my decision.

[32] Ms. Dallaire Légaré filed as exhibit JDL-5 extracts of the website showing keepsake jewellery (in French 'bijoux reliquaires') sold in association with the trade-mark MEMORIA since at least as early as 2003 in Canada. The trade-mark appearing on each of the pages filed is in the form illustrated above. She filed as exhibit JDL-6 a photograph taken in 2003 showing different keepsake jewellery in the form of necklaces sold in Canada since as early as 2003.

[33] Ms. Dallaire Légaré alleges that some of the necklaces, part of the new line created in 2013 sold in association with the trade-mark MEMORIA, are shown on the website as well, and she filed as exhibit JDL-7 extracts illustrating them. However, the trade-mark appearing beside the photograph of the necklace is MEMORIA HARRICANA. I noticed that on each webpage filed appears the trade-mark Alfred Dallaire | MEMORIA as illustrated above.

[34] Ms. Dallaire Légaré affirms that, in the normal course of business, the trade-mark MEMORIA appears on the MEMORIA products or on the bags or pouches in which those products are sold in Canada since as early as 2003. She filed as exhibit JDL-8 a sampling of pictures showing the trade-mark MEMORIA on some of the MEMORIA products such as cards, bookmarks and votive candles. Again, on most of these pictures, the trade-mark appearing is Alfred Dallaire | MEMORIA. However, on some of the pictures the words Alfred Dallaire and MEMORIA are separated by a horizontal line instead of a vertical line as illustrated above.

[35] As for the use of the trade-mark MEMORIA in association with keepsake jewellery, Ms. Dallaire Légaré states that the mark appears on boxes, bags and pouches in which they are sold and she referred to the pictures of those packaging filed as exhibit JDL-8, all bearing the trade-mark Alfred Dallaire | MEMORIA as illustrated above.

[36] Ms. Dallaire Légaré filed as exhibit JDL-9 a box in which the necklaces created in collaboration with a third party identified as Harricana are sold, since as early as 2013, in association with the trade-mark MEMORIA. However, the trade-mark appearing on the box is MEMORIA HARRICANA.

[37] As an illustration of the use of the trade-mark MEMORIA in association with the MEMORIA Services since 2003, Ms. Dallaire Légaré filed as exhibit JDL-10 a pamphlet distributed by the Opponent in its branches, complexes and mausoleums, through kiosks operated in shopping centers, during special events held outside its branches, complexes and mausoleums, or during conferences given by Opponent's employees.

[38] Ms. Dallaire Légaré further alleges that all of the Opponent's MEMORIA products and services are offered for sale and sold in Canada in association with its trade-marks in its various

complexes and branches located in the Montreal Metropolitan area as well as through its website as it appears from the various extracts filed.

[39] Ms. Dallaire Légaré asserts that the trade-mark MEMORIA appears on the façade of the complexes and branches wherein the MEMORIA products and MEMORIA services are sold since 2003 and she filed as exhibit JDL-12 a picture of the façade of its head office located on Laurier Street in Montreal.

[40] As for the sales figures, Ms. Dallaire Légaré simply states that the annual sales figures of the products and services sold in association with the trade-marks MEMORIA and COLLECTION MEMORIA are in the millions of dollars. However, there is no breakdown, per year, per trade-mark, per product and service. She filed samples of invoices as exhibit JDL-13 issued between 2010 and 2013 to Canadian customers for the sale of MEMORIA products and MEMORIA services. The invoices filed do refer to some of the MEMORIA products and there is a reference number beside the goods described therein that corresponds to the reference number identified on the webpages filed and described above.

[41] In addition, she filed as exhibit JDL-14 samples of invoices issued between 2004 and 2015 for the sale of keepsake jewellery in association with the trade-mark MEMORIA. I notice that trade-mark MEMORIA is overprinted on most of these invoices. The poor quality of the copies prevents me to conclude that it appears on each invoice.

[42] Moreover, Ms. Dallaire Légaré affirms that the Opponent invested in Canada annually, on average, between 500,000\$ and 700,000\$ in publicity and for the promotion of the trade-mark MEMORIA in the form of ads in printed publications (newspapers and magazines), on radio and television. She filed as exhibit JDL-15 an advertisement for funeral services published in the December 5, 2012 issue of the newspaper *La Presse* and as exhibit JDL-16 a sampling of printed advertisements for the trade-mark MEMORIA published in 2009 and 2012 in local Italian newspapers which circulated in the Italian community. However no French or English translation of these advertisements have been provided. Moreover, there is no information furnished on the extent of the distribution of those Italian local newspapers.

[43] When the Opponent launched its line of MEMORIA necklaces, it issued flyers and she filed as exhibit JDL-17 a sample of such flyer. There is no information on the circulation figures of this flyer. I also note that the trade-marks appearing on it are: Alfred Dallaire | MEMORIA, Alfred Dallaire MEMORIA, and MEMORIA HARRICANA.

[44] Ms. Dallaire Légaré explains that the Opponent promotes cultural and artistic events and she filed as exhibit JDL-18 a sampling of books, films, music records and cultural events to which the trade-mark MEMORIA is associated with. However, various versions of the trade-mark Alfred Dallaire MEMORIA appear on the documentation filed.

[45] The trade-mark MEMORIA is also promoted since 2003 through the distribution of promotional items such as calendars, note pads, promotional bookmarks, greeting cards and umbrellas and she filed as exhibit JDL-19 pictures of such promotional material. There is no information on the extent of its distribution and the period of time during which it was distributed. Finally the trade-mark appearing on most of the pictures is Alfred Dallaire | MEMORIA as illustrated previously.

[46] Ms. Dallaire Légaré then filed a sample of an article published in the newspaper *La Presse* on November 10, 2007 concerning a prize won by the Opponent with respect to the interior decoration of one of its places of business located in Montreal. Again, the trade-mark or trade name referred to is Alfred Dallaire MEMORIA. Finally, she filed as exhibit JDL-21 extracts of articles published in 2013 in the newspapers *La Presse* and *Journal de Montréal* on the necklaces MEMORIA. However, the trade-mark referred to is HARRICANA X MÉMORIA.

[47] As it appears from the above detailed summary of the Opponent's evidence, there is very little use of the trade-mark MEMORIA alone. I have to determine if the use of the different variations of Alfred Dallaire MEMORIA, as described above, can be considered evidence of use of the trade-mark MEMORIA. It has been ruled in the Registrar's prior two decisions that the use of Alfred Dallaire | MEMORIA as illustrated above or with a horizontal line separating Alfred Dallaire and MEMORIA combined with the use of different fonts give a clear indication to the consumers that Alfred Dallaire and MEMORIA constitute two separate trade-marks. Therefore, those variations of Alfred Dallaire MEMORIA constitutes use of the trade-mark MEMORIA. I have no reason to depart from such finding.

[48] In view of these conclusions, I also conclude that the trade-mark MEMORIA is known to some extent in the Montreal area. As for the Mark, it cannot be considered to be known as there is no evidence of use of the Mark in the record.

Length of time the marks have been in use

[49] From the evidence described above, this factor favours the Opponent in so far as its registered trade-mark MEMORIA is concerned.

The nature of the goods and services and their channels of trade

[50] Under section 12(1)(d) ground of opposition, I must compare the goods as described in the application with the goods and services covered by the Opponent's registrations [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[51] A thorough analysis was done in the Registrar's prior two decisions on the issue whether or not the parties' respective goods overlap. The conclusion was that there exists an overlap and I have no reasons before me to reach an opposite conclusion.

[52] Dealing with the parties' services, the Services slightly differ from the list of services covered by the two applications that lead to the Registrar's prior two decisions in that the Services include the additional service defined as 'laser engraving of fingerprints, handprints, and pawprints on jewellery'.

[53] As pointed out by the Opponent in its written argument and at the hearing, registration TMA647,454 for the trade-mark MEMORIA still covers funeral arrangement services. The

Opponent has proven that it offers the services of engraving marble urns [see exhibit JDL-10, 10 pages from the end of the last document under that tab].

[54] It appears, from the evidence described above, that the Opponent is selling, through its funeral homes and website, necklaces and pendants in association with the trade-mark MEMORIA which can contain ashes of a beloved one. On the other hand, I have no evidence of the Applicant's business and channels of trade. However, the description of the Services leads me to conclude that the Applicant is in the business of selling jewellery. Therefore, I conclude that there is some overlap in the parties' businesses.

[55] I have no evidence of the Applicant's channels of trade. However, from the description of the Services, I can infer that the Applicant will be offering for sale its Goods through jewellery stores while the Opponent's reliquaries are sold through its funeral homes. Therefore, the parties' channels of trade are different.

Degree of resemblance

[56] As stated by the Supreme Court of Canada in *Masterpiece*, in the majority of cases, the degree of resemblance between the marks in issue is the most important factor.

[57] The Opponent submits that the parties' marks have a common denominator, namely the word 'memoria'. It is the distinctive and dominant portion of each of these marks. Also it is the entire mark of the Opponent while it is the first portion of the Mark. It has been ruled in the past that the first portion of a trade-mark is often the most important one [see *Conde Nast Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[58] The test for confusion has been set out in the following terms by Mr. Justice Binnie in *Veuve Clicquot, supra*, at para 20:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark], at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[59] The combination of the common dominant feature in the parties' trade-marks namely the word 'memoria', with the nature of the parties' respective goods and services, leads me to conclude that the idea suggested by the parties' marks is the same, namely 'in memory'. Consequently, the marks do resemble one another visually with the presence of the dominant first word 'memoria', in sound and in the idea suggested by them. I do not consider the addition of the word 'imprints' to be sufficient to distinguish the present case from the Registrar's prior two decisions on this issue.

[60] This factor also favours the Opponent.

Conclusion

[61] From this analysis of the relevant criteria, I conclude that the Applicant has failed to meet its legal onus to prove, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent's MEMORIA trade-mark. I base my decision on the fact that the Opponent's trade-mark is known to some extent in association with keepsake jewellery, reliquaries and funeral arrangement services; there is an overlap in the parties' goods and services in so far as jewellery is concerned; and there is a fair degree of resemblance between the marks in sound, appearance and the ideas suggested by them. As for the difference between the Mark and the Opponent's trade-mark MEMORIA described in paragraph 59 above, I do not consider it to be sufficient to enable a consumer, who is vaguely aware of the Opponent's trade-mark MEMORIA, on a first impression basis, to infer that the Applicant is the source of the Goods and Services.

[62] Consequently I maintain the ground of opposition based on section 12(1)(d) of the Act.

Lack of distinctiveness of the Mark

[63] This ground of opposition must be assessed as of the filing date of the statement of opposition (December 23, 2014) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317 (FC)].

[64] To meet its initial burden under this ground of opposition the Opponent had to prove that its trade-mark MEMORIA had become sufficiently known in Canada on December 23, 2014, to

negate any distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[65] The evidence described under the ground of opposition of registrability is sufficient to conclude that the Opponent's trade-mark MEMORIA was known in Canada, or at least in Montreal Metropolitan area at the relevant date. Therefore the burden shifts on the Applicant to show that, on a balance of probabilities, the Mark was not likely to create confusion with the Opponent's aforesaid trade-mark such that it was adapted, at the relevant date, to distinguish or actually distinguished throughout Canada the Goods and Services from the Opponent's MEMORIA products and MEMORIA services [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[66] The earlier material date under this ground of opposition would not materially affect my analysis of the relevant criteria to assess the likelihood of confusion between the marks in issue. My analysis of the relevant criteria to determine if the Mark is likely to cause confusion with the Opponent's trade-mark MEMORIA would therefore generate similar results.

[67] Under these circumstances, I conclude that the Applicant has failed to prove that the Mark was distinctive or was adapted to distinguish the Goods and Services from the Opponent's MEMORIA products and the MEMORIA services. Consequently I maintain this ground of opposition.

Other Grounds of opposition

[68] The Opponent having been successful under two separate grounds of opposition, it is not necessary to assess the remaining grounds of opposition.

Disposition

[69] 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.

Jean Carrière
Member
Trade-marks Opposition Board

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: Date: 2016-11-09

APPEARANCES

Mr. Barry Gamache	For the Opponent
No one	For the Applicant

AGENTS OF RECORD

Robic	For the Opponent
Sim & McBurney	For the Applicant