



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

Citation: 2012 TMOB 41
Date of Decision: 2012-03-02

**IN THE MATTER OF AN OPPOSITION
by 1772887 Ontario Limited and its
predecessor in title Toronto Life
Publishing Company Limited to
application No. 1,381,132 for the trade-
mark FASHIONISM in the name of Bell
Canada**

[1] On January 29, 2008, Bell Canada (the Applicant) filed an application to register the trade-mark FASHIONISM (the Mark) based on proposed use in Canada in association with the “operation of an entertainment website offering information in the field of lifestyle, namely, fashion and beauty featuring text articles, blogs, photos gallery, contests, newsletters and user-generated content” (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of October 15, 2008.

[3] On March 9, 2009, 1772887 Ontario Limited and its predecessor in title Toronto Life Publishing Company Limited (collectively the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Contrary to s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) the Applicant used the Mark in Canada prior to the filing date.
- At the date of filing the application for the Mark, the Applicant was well aware or ought to have been aware of the existence of the Opponent and the use and notoriety of its trade-marks referred to below in the s. 12(1)(d) and non-entitlement grounds of

opposition. As a result, the Applicant could not have been satisfied under s. 30(i) of the Act of its entitlement to use the Mark.

- The Mark is not registrable contrary to s. 12(1)(d) of the Act as the Mark is confusing with the Opponent's registered marks, as follows (hereinafter referred to as the Opponent's Registered Marks):
 - TMA633,226 – FASHION18 – registered February 21, 2005 for “printed publications, namely a magazine and newsletters; Internet services, namely electronic magazine and website services available over the worldwide web to consumers; media services, namely educational and informational services all relating to magazine; entertainment services, namely the creation and production of consumer television and radio broadcast shows and pre-recorded CD and DVD media for purchase by the consumer.”
 - TMA352,390 – TORONTO LIFE FASHION – registered February 24, 1989 for “printed publications, namely magazines”.
- The Applicant is not entitled to registration of the Mark pursuant to s. 16(3)(a) and (b) of the Act as at the date of filing the application for the Mark it was confusing with the following additional trade-marks which the Opponent had applied for and/or used in Canada since a date well prior to the date of the application for the Mark:
 - Appl. No. 1,152,493 – MONTREAL FASHION MAGAZINE – applied for based on proposed use in association with “magazines”;
 - Appl. No. 1,152,497 – VANCOUVER FASHION MAGAZINE – applied for based on proposed use in association with “magazines”;
 - Appl. No. 1,152,494 – CANADA FASHION MAGAZINE – applied for based on proposed use in association with “magazines”;
 - Appl. No. 1,152,495 – TORONTO FASHION MAGAZINE – applied for based on proposed use in association with “magazines”;
 - Appl. No. 1,310,406 – FASHION MAGAZINE – applied for based on proposed use in association with “Internet services, namely, informational services in the nature of electronic magazines and publishing services through the use of the worldwide web; Broadcast, television and entertainment services, namely, the creation and production of consumer television and radio broadcast shows and pre-recorded CD and DVD media for purchase by the consumer”; and
 - Appl. No. 1,152,496 – FASHION MAGAZINE – applied for based on proposed use in association with “magazines”.
- In view of the facts set out in the s. 12(1)(d) and s. 16 grounds of opposition, the Mark is not distinctive of nor is it capable of becoming distinctive of the Applicant within the meaning of s. 2 of the Act.

[4] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] The Opponent filed an affidavit of Elenita Anastacio, sworn October 6, 2009 with Exhibit A as its evidence pursuant to r. 41 of the *Trade-marks Regulations* SOR/96-195 (the Regulations). Ms. Anastacio was not cross-examined on her affidavit. Ms. Anastacio is a trade-mark searcher employed by the Opponent's agent. Ms. Anastacio attaches to her affidavit particulars of registration No. TMA633,226 for the trade-mark FASHION18 and application No. 1,447,752 for the trade-mark FASHION.

[6] The Applicant did not file any evidence in support of its application. In its letter advising that it would not be filing any evidence in support of its application, the Applicant made submissions and referenced materials printed from the Google search engine. The Google search results were returned to the Applicant by letter dated February 10, 2010 and do not form part of the record.

[7] Only the Applicant filed a written argument. I note that in its written argument, the Applicant improperly makes submissions relying on unsubstantiated state of the register evidence (i.e. "There are more than 300 active trade-marks filed or registered with the word FASHION") and the Google search results discussed in paragraph 6 above which are not of record.

[8] An oral hearing was held at which both parties were represented.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is 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 [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/30(b) and (i) - the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].

- s. 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 38(2)(c)/16(3)(a) and (b) - the date the application was filed [see s. 16(3) of the Act].
- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30 Grounds

Section 30(b) of the Act

[11] No evidence has been adduced in support of this ground of opposition. As a result, I am dismissing this ground of opposition on the basis that the Opponent has failed to meet its evidential burden.

Section 30(i) of the Act

[12] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the s. 30(i) ground is accordingly dismissed.

Section 12(1)(d) Ground of Opposition

[13] An opponent's initial onus is met with respect to a s. 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised that discretion and confirm that the registrations for the Opponent's Registered Marks remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[15] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C).]

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[16] The parties' marks share the dictionary word "fashion". I can take judicial notice of the dictionary definition for the word "fashion" [see *Envirodrive Inc. v. 836442 Canada Inc.*, 2005 ABQB 446; *Aladdin Industries, Inc. v. Canadian Thermos Products Ltd.* (1969), 57 C.P.R. 230 (Ex. Ct.), aff'd (1974), 6 C.P.R. (2d) 1 (S.C.C.)]. The word "fashion" is defined in *The Canadian Oxford Dictionary* as "the current popular custom or style, esp. in dress or social conduct".

[17] As drafted, the Services specifically relate to fashion. The Opponent's wares and services relate to various forms of media publications. The word "fashion" is thus suggestive of the subject matter of the parties' wares and services such that it lacks inherent distinctiveness.

[18] I note that in coming to this conclusion regarding the lack of inherent distinctiveness for the word "fashion", I am not placing any weight on the Applicant's unsubstantiated submission that the word "fashion" is common to the trade. The state of the register evidence referred to by the Applicant in its written argument has not been filed as evidence. I note that state of the register evidence cannot be considered where it is adduced through the written argument and without filing certified copies of the registrations or at least an affidavit affixing particulars of

the relevant registrations [see *Unitron Industries Ltd. v. Miller Electronics Ltd.* (1983), 78 C.P.R. (2d) 244 at 253 (T.M.O.B.)]. Furthermore, the law is clear that, when adjudicating in an opposition proceeding, the Registrar does not exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications are extant [see *Quaker Oats* at 411 and *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.)]. The parties to opposition proceedings are expected to prove each aspect of their case following fairly strict rules of evidence [see *Loblaw's Inc. v. Telecombo Inc.* 2004 CarswellNat 5135 at para 13 (T.M.O.B.)].

[19] The Mark features the addition of the suffix “ism” to the word “fashion” which creates a coined word. The Applicant submits that this results in a mark with no particular meaning aside from the fact that it is suggestive of fashion. By contrast, at the oral hearing the Opponent submitted that “ism” means a common belief in a principle. The Opponent made the analogy that “communism” suggests a common belief in communist ideas and as such “fashionism” would suggest a common belief in fashion. The Opponent has not provided any evidentiary support for its interpretation of the suffix “ism”. I note that *The Canadian Oxford Dictionary* defines the suffix “ism” as “forming nouns, esp. denoting”.

[20] While I have taken the Opponent’s submissions and the dictionary definition into consideration, I remain of the view that the Mark, being a coined word, possesses a higher degree of inherent distinctiveness than the Opponent’s Registered Marks which merely consist of the addition of the number “18” or descriptive words to the word “fashion”.

[21] A trade-mark may acquire distinctiveness through use or promotion. However, in the present case neither party has filed evidence to show use or promotion of its marks. While it is true that the Opponent’s registrations claim use in Canada, at most this entitles me to assume *de minimis* use of the Opponent’s Registered Marks [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.) at 430]. *De minimis* use does not support a conclusion that the Opponent’s Registered Marks had become known to any significant extent.

Section 6(5)(b) – the length of time each has been in use

[22] I do not agree with the Opponent that this factor favours the Opponent. While it may be true that *de minimis* use is more than no use, in the absence of evidence of use of either party's marks, this factor does not significantly favour either party.

Section 6(5)(c) and (d) – the nature of the wares, trade and business

[23] It is the Applicant's statement of services as defined in its application versus the Opponent's registered wares and/or services that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[24] I agree with the Opponent that the Opponent's "Internet services, namely electronic magazine and website services available over the worldwide web to consumers" registered under registration No. TMA633,226 for the trade-mark FASHION18 create an overlap in the nature of the parties' services.

[25] Given that the Services overlap with the Opponent's "Internet services, namely electronic magazine and website services available over the worldwide web to consumers", and in the absence of any evidence regarding the parties' trades, I am satisfied that the parties' channels of trade could also overlap.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[26] Recently, in *Masterpiece*, the Supreme Court of Canada discussed the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with s. 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[27] As submitted by the Applicant, the Federal Court of Appeal noted in *United Artists Corp. v. Pink Panther Beauty Corp.* (1998), 80 C.P.R. (3d) 247 at 263 (F.C.A.),

While the marks [in issue] must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.

[28] At the oral hearing, the Applicant submitted that while the first portion of the mark is usually the most important for the purpose of distinguishing (see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188) the importance will be diminished where the first portion is a common descriptive word. The Applicant submits that it would be inappropriate to give the Opponent broad protection over the suggestive word "fashion" in the absence of evidence supporting a finding that the Opponent's Registered Marks have acquired any distinctiveness. In support of this submission, the Applicant relied upon *Johnson & Johnson v. Mahrukh Panthakey* at para 24 (April 12, 2011 T.M.O.B. (unreported) application No. 1,141,824) where the marks ACUVUE and ACCUWAVE, both covering contact lenses, were found not confusing despite sharing the same first portion.

[29] I agree with the Applicant's submission. Furthermore, I note that the Supreme Court of Canada in *Masterpiece* recently advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64]. In the present case, the focus would be placed on the "ism" element of the Mark, as it adds distinctiveness to the inherently non-distinctive "fashion" and would therefore be considered "striking" or "unique".

[30] There is no similarity between the striking "ism" element of the Mark and any portion of the Opponent's Registered Marks in appearance, sound or ideas suggested.

[31] Confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd. v. Chalet Bar B Q (Canada) Inc.* (1982), 66 C.P.R. (2d) 56 at 73 (F.C.A.)].

[32] Ultimately, when considering the marks as a whole, I am not convinced that the mere fact that the Mark contains the suggestive word “fashion” is sufficient to find that the parties’ marks share any significant degree of similarity in appearance, sound or ideas suggested.

Conclusion

[33] As discussed above, in *Masterpiece* the Supreme Court of Canada highlighted the importance of the s. 6(5)(e) factor in the analysis of the likelihood of confusion. In the present case, I have found significant differences between the parties’ marks. I am of the view that none of the other factors assist the Opponent in overcoming these differences between the marks. The Opponent has not evidenced that its trade-marks have acquired any distinctiveness through use or promotion. As discussed above in the analysis of the s. 6(5)(a) factor, while the Opponent’s registrations claim use in Canada, the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer*]. The ambit of protection of the Opponent’s Registered Marks is very narrow, due in part to the low inherent distinctiveness. Therefore while the parties’ services share some degree of overlap, this is insufficient to result in a likelihood of confusion given the differences between the marks and the inherent distinctiveness of the Mark.

[34] Having considered all of the surrounding circumstances, in particular the inherent distinctiveness of the Mark and the differences between the parties’ marks in terms of appearance, sound and idea suggested, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s Registered Marks.

[35] Based on the foregoing, the s. 12(1)(d) ground of opposition is dismissed.

Non-entitlement Grounds

Section 16(3)(a) of the Act

[36] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s previously used marks, the Opponent has the initial onus of proving that one or more of the trade-marks

alleged in support of its ground of opposition based on s. 16(3) of the Act had been used in Canada prior to the date of filing the application for the Mark (January 29, 2008) and had not been abandoned at the date of advertisement of the application for the Mark (October 15, 2008) [s. 16(5) of the Act].

[37] The Opponent has not filed any evidence of use of the claimed marks. As discussed, the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer*]. Ms. Anastacio does not provide any particulars for the applications claimed under the s. 16(3)(a) ground of opposition. Ms. Anastacio does however attach to her affidavit particulars of a pending application No. 1,447,752 for the trade-mark FASHION which claims use since as early as 1977. I note that this application was not included in the statement of opposition and as a result it does not form a basis for the s. 16(3)(a) ground of opposition. Even if I were to consider this application, I note that the Opponent has not provided evidence of use of this mark in support of the date claimed in the application. The particulars attached to Ms. Anastacio's affidavit would not be sufficient to enable the Opponent to meet its evidential burden for this ground in any event.

[38] Based on the foregoing, the ground of opposition based on s. 16(3)(a) of the Act is dismissed.

Section 16(3)(b) of the Act

[39] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's Marks, the Opponent has the initial onus of proving that one or more of the trade-mark applications alleged in support of its ground of opposition based on s. 16(3)(b) of the Act were pending at the date of filing the application for the Mark, and remained pending at the date of advertisement of the application for the Mark, October 15, 2008 [s. 16(5) of the Act]. The Registrar has the discretion, in view of the public interest, to check the register for applications relied upon by an opponent [see *Royal Appliance*]. I have exercised my discretion to check the status of the applications cited by the Opponent.

[40] All of the pending applications cited in the statement of opposition in support of the s. 16(3)(b) ground of opposition have been either refused or abandoned. That said, all of the pleaded applications were filed before the date of filing the application for the Mark and remained pending as of the date of advertisement for the Mark. As a result, the Opponent has met its burden under this ground.

[41] None of the trade-marks claimed under the s. 16(3)(b) ground of opposition shares any more similarity in terms of appearance, sound or idea suggested with the Mark than the Opponent's Registered Marks. Furthermore, the wares and services for these applications are no more similar to the Services than those associated with the Opponent's Registered Marks. Finally, the difference in material dates is not significant. As a result my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here.

[42] Having considered all of the surrounding circumstances, in particular the inherent distinctiveness of the Mark and the differences between the parties' marks in terms of appearance, sound and idea suggested, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the trade-marks that are the subject of the Opponent's claimed applications as pleaded in the s. 16(3)(b) ground of opposition.

[43] Based on the foregoing, the ground of opposition based on s. 16(3)(b) of the Act is dismissed.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[44] In order to meet its initial burden with respect to this ground, the Opponent must establish that one or more of its claimed trade-marks was known at least to some extent in Canada as of March 9, 2009 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)].

[45] The Opponent has not filed any evidence of use of the claimed marks. I note that the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer*]. The

particulars attached to Ms. Anastacio's affidavit are therefore not sufficient to enable the Opponent to meet its evidential burden for this ground.

Disposition

[46] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office