



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

**Citation: 2014 TMOB 291**  
**Date of Decision: 2014-11-19**

**IN THE MATTER OF AN OPPOSITION  
by 0764468 B.C. Ltd. to application  
No. 1,524,936 for the trade-mark  
PHOTOSTAR in the name of Photostar  
Inc.**

[1] 0764468 B.C. Ltd. (the Opponent) opposes registration of the trade-mark PHOTOSTAR (the Mark) that is the subject of application No. 1,524,936 by Photostar Inc. (the Applicant).

[2] Filed on April 26, 2011, the application is based on use of the Mark in Canada since June 18, 2010 in association with the following wares and services:

Wares:

(1) Portable photography booth-like structure having a digital camera and a display screen in front of which individuals appear and have their image photographed. (2) Software to enable transmission of digital images via the Internet.

Services:

(1) Sales and rental of photography equipment. (2) On-line services, accessible via a global computer network or personal computers connected to the Internet, in the field of photography namely: operation of a web site and offering web services which allow customers to receive, view, manipulate, transmit, store and purchase digitized photographs.

[3] The Opponent alleges that: (i) the application does not comply with the requirements of sections 30(b) and 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Applicant is not the person entitled to registration of the Mark under sections 16(1)(a) of the Act; and (iii) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I refuse the application.

#### The Record

[5] The Opponent filed its statement of opposition on May 14, 2012. The Applicant then filed and served its counter statement on July 23, 2012 denying all of the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Kimberley Shaak, President of the Opponent, as well as the affidavits of Lynda Francouer, Malcolm Bellinger, Heather Fowler, and Simon Edwards. The Applicant did not file any evidence in support of its application. None of the affiants was cross-examined.

[7] Both parties filed written arguments; neither party requested a hearing.

#### The Parties' Respective Burden or Onus

[8] 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 Ltd v Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (FCTD) at 298].

#### Grounds of Opposition Summarily Dismissed

[9] The grounds of opposition raised under sections 30(b) and 30(i) of the Act are summarily dismissed for the reasons that follow.

[10] In its statement of opposition, the Opponent alleges that the application does not conform to section 30(b) of the Act because the Applicant could not have used the Mark on the alleged date of first use considering that it was not incorporated until April 21, 2011. The Opponent also pointed out that no predecessor in title was alleged in the application. Since the Opponent has not provided or referred to any evidence in support of the section 30(b) ground of opposition, it is dismissed for the Opponent's failure to meet its initial evidential burden.

[11] Section 30(i) of the Act requires an applicant to declare in the application that it is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence here.

Was the Applicant the person entitled to registration of the Mark?

[12] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act, on the ground that it is confusing with the Opponent's trade-marks OKANAGAN PHOTOSTAR and OKANAGAN PHOTOSTAR Design, which have been previously used in Canada by the Opponent since at least as early as May 21, 2010 in association with entertainment services including the provision of photobooth services, and have not been abandoned.

[13] The material date for considering these grounds of opposition is the alleged date of first use of the subject application, namely June 18, 2010.

[14] The Opponent has the initial burden of proving that one or more of the alleged trade-marks were used or made known in Canada prior to the material date and had not been abandoned at the date of advertisement of the application for the Mark [section 16(5) of the Act].

*The Opponent's Evidence*

[15] At the outset of the analysis, I note that in its written argument, the Applicant submits that "the Opponent has not produced evidence of its use of [the word mark] OKANAGAN PHOTOSTAR alone as a mark". I disagree. I consider that any evidence of use of the design mark OKANAGAN PHOTOSTAR Design qualifies as use of the word mark OKANAGAN PHOTOSTAR as the Opponent is not under any restriction to use the word mark in any particular format.

[16] According to the Staak affidavit, the Opponent has been using the trade-marks OKANAGAN PHOTOSTAR and OKANAGAN PHOTOSTAR Design (the OKANAGAN PHOTOSTAR Marks), in association with entertainment services including the provision of photobooth services since as least as early as December 1, 2009, and continues to do so.

[17] Ms. Staak states that the Opponent operates a portable photobooth that takes digital photos of people sitting in the booth in sequences of four shots. Once completed, copies of the photo strips are given to guests. Ms. Staak explains that the photobooth services are typically provided at events. Specifically, the Opponent provides the physical, on-site photobooth together with an operator and supervisor, namely Ms. Staak, who operates the camera from the back of the booth. Once the photos are taken, they are printed onto a photo strip using a computer and a printer, all of which are contained within the booth. Depending on the events, the Opponent can also provide props such as costumes for the guests.

[18] In terms of use of the trade-marks, Ms. Staak states that the OKANAGAN PHOTOSTAR Marks are prominently displayed on the photobooth as well as on the back of each photo strip given to the guests. In this regard, Ms. Staak attaches the following exhibits:

- Exhibit D – the front and back of a photo strip produced at the KGH 20<sup>th</sup> Eldorado Inn Keepers Event held in Kelowna, British Columbia on December 1, 2009. According to Ms. Staak, 636 photographs were taken using the photobooth at this particular event [report attached as Exhibit E]. The affiant states that the Opponent was not paid for its services at this event; the services were provided as a form of advertisement. The following label can be seen in the back shot of the photo strip:



- Exhibit B – a photo of the Opponent’s photobooth said to be used by the Opponent at all the events since at least as early as December 1, 2009. The same OKANAGAN

PHOTOSTAR Design trade-mark can be seen prominently displayed at the exterior of the photobooth.

[19] Replicas of the front of printed photo strips said to be produced at events held at various locations of British Columbia between December 2009 and June 2010 are attached as Exhibits F, G, H, J, K, L, M, N, O, P and Q. A total of over 4300 photos were taken by the Opponent in these events, using the photobooth [see report attached as Exhibit E]. Ms. Staak states that the Opponent was paid for its services at some events while others were provided free of charge as a form of advertisement for the Opponent's services [see copy of invoices bearing the OKANAGAN PHOTOSTAR Design trade-mark issued between May and June 2010 attached as Exhibits K, L, N, P]. A list of other events at which the Opponent provided photobooth services from 2010 and November 2012 is attached as Exhibit S, I note that most of the events are identified as "paid events".

[20] The rest of the Opponent's evidence (i.e. the Francouer affidavit, the Bellinger affidavit, the Fowler affidavit and the Edwards affidavit) consists of testimonies from guests who have used the Opponent's photobooth services at various events held between December 1, 2009 and June 17, 2010. Copies of photo strips said to be taken at these events are attached to the affidavits. I note that the OKANAGAN PHOTOSTAR Design trade-mark can be seen at the back of these photo strips.

[21] When the Opponent's evidence is viewed in its entirety, I am satisfied that the OKANAGAN PHOTOSTAR Marks have been used in association with photobooth services in Canada within the meaning of section 4(2) of the Act as early as December 1, 2009, and that such use has not been abandoned as of December 14, 2011.

[22] Since the Opponent has satisfied its initial evidential burden, the issue becomes whether the Applicant has met its legal burden to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's OKANAGAN PHOTOSTAR Marks at the date of alleged first use of the Mark.

[23] In my opinion, comparing the Mark and the word mark OKANAGAN PHOTOSTAR will effectively decide the section 16(1)(a) ground of opposition. In other words, if confusion is

not likely between the Mark and the word mark OKANAGAN PHOTOSTAR, then it would not be likely between the Mark and the Opponent's design mark OKANAGAN PHOTOSTAR Design.

[24] For the reasons that follow, I accept this ground of opposition and decide this issue in favour of the Opponent.

#### The test for confusion

[25] 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.

[26] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

[27] I will now turn to the assessment of the section 6(5) factors.

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

[28] The overall consideration of the section 6(5)(a) factor involves a combination of inherent and acquired distinctiveness of the parties' trade-marks. I assess the degree of inherent distinctiveness of both parties' word marks to be equal. Both parties' trade-marks share the word

PHOTOSTAR, which has some degree of inherent distinctiveness in the context of the parties' wares and services. In the case of the Opponent's word mark OKANAGAN PHOTOSTAR, the word OKANAGAN does not contribute to the inherent distinctiveness of the trade-mark given its geographical significance [see *London Drugs Limited v International Clothiers Inc* 2014 FC 223 par 49]. In this regard, the Canadian Oxford Dictionary defines "Okanagan" as "a region of south central BC, lying between the Cascade and Columbia mountain systems and extending southward into N Washington state".

[29] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. As per my review of the Opponent's evidence above, I am satisfied that the Opponent's word mark OKANAGAN PHOTOSTAR has acquired some measure of distinctiveness through promotion and use in association with photobooth services in Canada since December 1, 2009. Conversely, the Applicant did not provide any evidence of promotion or use of the Mark in the present proceeding.

[30] Thus, the overall considerations of the section 6(5)(a) factor favour the Opponent.

*Section 6(5)(b) – the length of time the trade-marks have been in use*

[31] This factor also favours the Opponent.

[32] As discussed above, the Opponent has shown use and promotion of the word mark OKANAGAN PHOTOSTAR in association photobooth services in Canada since December 1, 2009. In comparison, the application for the Mark is based on use in Canada since June 18, 2010. However, the Applicant has not provided any evidence of use of the Mark in the present proceeding.

*Sections 6(5)(c) and (d) – the nature of the wares, services, trade and business*

[33] Sections 6(5)(c) and (d) factors, which involve the nature of the wares and services, trade and business, also favour the Opponent.

[34] There is clear overlap between the parties' wares and services as both offer photo related wares and services, including that of a photobooth. The Mark is applied for use in association

with photography booth-like structures, and software for the transmission of digital photos via the Internet, as well as the sale and rental of photography equipment, and the operation of a website for digital photos. As part of the Opponent's photobooth services, in addition to the photo strips given to guests at the events, Ms. Staak states that copies of the digital photos are also available to guests via email upon request.

[35] In the absence of evidence from the Applicant and given that the parties' wares and services clearly overlap, for the purpose of assessing confusion, I conclude that there is potential for overlap between the parties' channels of trade.

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

[36] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. It is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks. It is nevertheless possible to focus on particular features of a mark that may have a determinative influence on the public's perception of it [see *United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)].

[37] There is necessarily a fair degree of resemblance between the Opponent's word mark and the Mark in appearance, sound and in ideas suggested as they all share the word PHOTOSTAR, a term that suggests a person who is preeminent in photos.

[38] In its written argument, the Applicant submits that the Mark is not confusing with OKANAGAN PHOTOSTAR considering that OKANAGAN is the first and primary component of the Opponent's word mark and does not sound or appear similar to the Applicant's Mark. I disagree with the Applicant's confusion analysis. While the first component of a trade-mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)], the preferable approach 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].



[39] In the present case, I am of the view that the term PHOTOSTAR is the dominant feature of the Opponent's word mark as it is the unique and inherently distinctive component of the trade-mark. As discussed under the section 6(5)(a) analysis, the word OKANAGAN is not distinctive as it is a geographic reference.

[40] Thus, the section 6(5)(e) factor favours the Opponent.

*Conclusion in the likelihood of confusion*

[41] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances and given that each of the section 6(5) factors favours the Opponent, I am not satisfied that the Applicant has discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's word mark OKANAGAN PHOTOSTAR.

[42] Since I accept the section 16(1)(a) ground of opposition based the word mark OKANAGAN PHOTOSTAR, I am not considering the ground of opposition based on the Opponent's design mark OKANAGAN PHOTOSTAR Design. Accordingly, I accept the ground of opposition based on section 16(1)(a) of the Act to the extent that it is based on the word mark OKANAGAN PHOTOSTAR.

Was the Mark distinctive of the Applicant's wares and services at the filing date of the statement of opposition?

[43] This ground of opposition as pleaded is based upon the likelihood of confusion between the Mark and the Opponent's OKANAGAN PHOTOSTAR Marks. The material date to assess this ground of opposition is the filing date of the statement of opposition, namely May 14, 2012 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[44] Once again, I find that comparing the Mark with the word mark OKANAGAN PHOTOSTAR will effectively decide the outcome of this ground of opposition. Based on my review of the Opponent's evidence, I am satisfied that the Opponent has met its evidentiary burden to establish that its word mark OKANAGAN PHOTOSTAR had become known

sufficiently in Canada, as of May 14, 2012, to negate the distinctiveness of Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd* 2006 FC 657 (CanLII), (2006), 48 CPR (4th) 427 (FC)].

[45] Assessing each of the section 6(5) factors as of May 14, 2012 does not significantly impact my previous analysis of the surrounding circumstances of this case. For reasons similar to those expressed previously, I conclude that the Applicant has not discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and the Opponent's word mark OKANAGAN PHOTOSTAR as of May 14, 2012.

[46] Accordingly, I accept the non-distinctiveness ground of opposition.

#### Disposition

[47] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

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Pik-Ki Fung  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office