

IN THE MATTER OF AN OPPOSITION by Rogers Broadcasting Limited to application No. 564,004 for the trade-mark FAVOURITES OF YESTERDAY AND TODAY filed by Chum Limited

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On June 5, 1986, the applicant, Chum Limited, filed an application to register the trade-mark FAVOURITES OF YESTERDAY AND TODAY based upon proposed use of the trade-mark in Canada in association with "cigarette lighters, pens, pencils, pen holders, note pads, note stickers, calendars, memo cubes, shirts, golf shirts, pants, jackets, buttons, cassettes, t-shirts, blouses, sweat shirts, sweat suits, shorts, hats and caps" and in association with "entertainment services provided by pre-recorded music, live musical performances, related commentary and news broadcast on radio; television production and broadcasting; and radio programming".

The opponent, Rogers Broadcasting Limited, filed a statement of opposition on December 8, 1986 in which it alleged that the applicant's trade-mark is not registrable and not distinctive as applied to the services covered in the application in that the applied-for mark, whether depicted, written or sounded, is either clearly descriptive or deceptively misdescriptive in the English language of the character or quality of the services.

The applicant served and filed a counterstatement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Anthony P. Viner and the declaration of Fred Jacobs while the applicant submitted the affidavit of Duff Roman. Further, both parties submitted written argument and an oral hearing was not conducted in respect of this opposition.

The opponent's second ground of opposition based on the alleged non-distinctiveness of the applicant's trade-mark is founded on the allegation that the applicant's trade-mark is either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's services. Accordingly, the determination as to whether the applicant's trade-mark is registrable in view of Section 12(1)(b) of the Trade-marks Act will effectively decide both grounds of opposition.

The issue as to whether the applicant's trade-mark FAVOURITES OF YESTERDAY AND TODAY is clearly descriptive of the applicant's services must be considered from the point of view of the average user of those services. Further, in determining whether a trade-mark is clearly descriptive of the character or quality of the services associated with it, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its

entirety as a matter of immediate impression (see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks, 40 C.P.R. (2d) 25, at pgs. 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks, 2 C.P.R. (3d) 183, at pg. 186).

The relevant date for considering the ground of opposition based on Section 12(1)(b) is as of the filing date of the applicant's application (June 5, 1986). In this regard, reference may be made to the decisions in Oshawa Group Ltd. v. Registrar of Trade Marks, 46 C.P.R. (2d) 145, at pg. 147 and Carling Breweries Limited v. Molson Companies Limited et al, 1 C.P.R. (3d) 191, at pg. 195. Also, the material date with respect to the issue of distinctiveness is as of the date of opposition (December 8, 1986). Further, while the legal burden is on the applicant to establish the registrability and distinctiveness of its trade-mark, there is an evidential burden on the opponent in respect of both of these grounds to adduce sufficient evidence which, if believed, would support the truth of the allegations set forth in the statement of opposition relating to the alleged non-registrability and non-distinctiveness of the trade-mark FAVOURITES OF YESTERDAY AND TODAY. It is therefore necessary in the present case to consider the opponent's evidence in order to determine whether the opponent has met the evidential burden upon it.

Rule 43 of the Trade-marks Regulations specifically provides that the opponent shall file with the Registrar such evidence by way of affidavit or statutory declaration as he desires to adduce in support of his opposition. In this regard, the declaration of Fred Jacobs has not been sworn to or declared before a notary public, commissioner of oaths or other appropriate official and therefore has not been completed in compliance with s. 38 of the Canada Evidence Act. Accordingly, the Jacobs declaration is inadmissible as evidence in this opposition.

In his affidavit, Mr. Viner, Executive Vice-President and General Manager of the opponent, expresses the opinion that the word FAVOURITES when used in relation to musical compositions has a recognized meaning or connotation to radio audiences and the radio industry, namely, a song which was popular when it was originally released and has remained popular with radio audiences and/or segments thereof, and further that the phrase FAVOURITES OF YESTERDAY AND TODAY'S "describes musical compositions recorded prior to the early 1980's which are popular with radio listening audiences".

With respect to the admissibility of opinion evidence on the ultimate issue to be decided in a trade-mark case, Mr. Justice Collier in his reasons for judgment [Jordan & Ste-Michelle Cellars Ltd. et al v. T. G. Bright & Co. Ltd., 71 C.P.R. (2d) 138] dismissing an appeal from the decision of

the Registrar of Trade-marks [71 C.P.R. (2d) 132] in respect of the registrability of the trade-mark BRIGHTS CHILLABLE RED, commented as follows [pp. 138-9]:

In William H. Rorer (Canada) Ltd. v. Johnson & Johnson, 48 C.P.R. (2d) 58, at pg. 62, Mahoney, J. made the following comments regarding the admissibility of opinion evidence in that case:

Having regard to the above, I would note that Mr. Viner has not set forth the facts and/or assumptions upon which his opinions are based. Further, and even if the subject-matter of the opinions expressed by Mr. Viner were to be considered as being expert opinion evidence, I do not consider that the affiant has established that he is an expert in the radio broadcast industry which would qualify him to give expert opinion evidence.

Mr. Viner also states that he is unable to provide specific instances where the applicant's mark has been used by radio announcers other than by the applicant although he believes that the mark has been used frequently by radio announcers of numerous radio stations in introducing recordings. Again, the affiant has not set forth any facts upon which I could assess the validity of the affiant's opinion or the process by which it was reached. Further, Mr. Viner has annexed to his affidavit a recorded cassette and transcript thereof of specific references by the applicant's employees wherein the applicant's mark is allegedly used in a descriptive manner. However, the recordings were made subsequent to either the filing date of the applicant's application or the date of opposition and

in only three references does the applicant's mark appear. Accordingly, little weight can be attributed to this evidence.

Having regard to the above, I have concluded that the opponent has failed to meet the evidential burden upon it in respect of its grounds of opposition and I therefore reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 28<sup>th</sup> DAY OF FEBRUARY 1991.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.