

IN THE MATTER OF AN OPPOSITION
by Tele-Direct (Publications) Inc.
to application No. 702,937
for the trade-mark **HAND DESIGN**
filed by Televerket, now standing in the name Telia AB

On April 13, 1992, Televerket filed an application to register the trade-mark **HAND DESIGN**, for the following wares:

Prerecorded computer programmes, computer programmes for catalogue and directory information recorded on magnetic carriers, diskettes, cassettes and discs; catalogues and directories.

And the following services:

Advertising for others in business catalogues and directories; business management; business administration; all the aforesaid services related to catalogue and directory activities; radio broadcasting and telecommunication services.

The application was filed based on proposed use in Canada, with a priority date of October 17, 1991 based on the filing of a corresponding Swedish trade-mark application, and was advertised in the Trade-marks Journal for the purposes of opposition on March 16, 1994. I have reproduced the mark below:



The opponent, Tele-Direct (Publications) Inc., filed a statement of opposition on August 16, 1994, which was forwarded to the applicant on September 12, 1994. The first ground of opposition is that the trade-mark is not registrable pursuant to Section 12(1)(d) of the Act, as the advertised trade-mark is and was at all material times confusing with the opponent's registered trade-marks **FINGERS & DESIGN** TMA 238,688 and **FINGERS & DESIGN** TMA 231,876. The second ground of opposition is that the applicant is not entitled to register the mark pursuant to Section 16(3)(a) of the Act because, as of the applicant's filing date, and at all material times, the advertised design trade-mark was and is confusing with the above-mentioned design trade-marks of the opponent previously used in Canada. The third ground of opposition is that the advertised mark is not distinctive, in that it does not distinguish the wares and services of the applicant from the wares and services of the opponent.

The applicant filed and served a counter statement on January 11, 1995 in which it denied the opponent's allegations. On February 17, 1995 the Trade-marks Office

acknowledged that the applicant, Televerket, had been transformed from a government agency into a limited company, Telia AB. The only evidence filed by either party was the opponent's affidavit of Patrick F. Crawford. There was no cross-examination of this affidavit. Both parties filed written arguments and were represented at an oral hearing.

At the oral hearing, an issue was raised with respect to the proper identification of the opponent's trade-marks. Although the opponent has described their marks as **HAND AND FINGERS DESIGN**, their registration TMA231,876 has been described by the Federal Court as **WALKING FINGERS DESIGN** and is identified on the trade-marks register as **FINGERS & DESIGN**. In my opinion, the "official" description of these design marks is not relevant to my final decision. In any event, I have chosen to refer to the opponent's marks as they are identified on the register.

The first ground of opposition to be considered is under Section 12(1)(d) of the Act, namely that the applicant's mark is confusing with the opponent's registered trade-mark **FINGERS & DESIGN** TMA231,876 for use in association with the wares "printed publications, namely business and telephone directories", and the services "advertising businesses in directories and compiling and publishing business and telephone directories", in addition to the opponent's registered trade-mark **FINGERS & DESIGN** TMA238,688 for use in association with "(1) printed publications, namely business and telephone directories". (2) mailing lists" and the services "(1) advertising businesses in directories and compiling and publishing business and telephone directories. (2) compiling and publishing mailing lists". The opponent's marks are set out below:



TMA 231,876



TMA 238,688

The legal burden is on the applicant to prove that there would be no reasonable likelihood of confusion between the trade-marks. The material date for considering the issue of confusion with a registered trade-mark is the date of my decision (see **Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.** (1991), 37 C.P.R. (3d) 413 (FCA)). Furthermore, in assessing whether there would be any reasonable likelihood

of confusion between the trade-marks, the Registrar shall have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Act. I have reproduced this subsection below:

- 6.(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including
- (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
 - (b) the length of time the trade-marks or trade-names have 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 or trade-names in appearance or sound or in the ideas suggested by them.
- R.S., c. T-10, s. 6.

The applicant's design mark possesses some measure of inherent distinctiveness. However, it is suggestive of reading material as it would appear to be the image of a hand perusing lines of text. As the applicant has filed no evidence, I must conclude that the applicant's mark has not become known in Canada.

The opponent's marks also possess some measure of inherent distinctiveness, although TMA 238,688 has as a feature a design element which appears to be a fanciful "open book". Thus, this mark is somewhat suggestive with respect to printed publications. Considering the extent that these marks have become known, it is clear that the opponent's mark TMA238,688 has become well known across the country in association with telephone directories. The opponent's mark TMA231,876 would also appear to have become known in association with telephone directories, although to a lesser extent. Both of the opponent's marks appear to have become known for use in association with "advertising businesses in directories and compiling and publishing business and telephone directories". On the other hand, there was little clear evidence as to how well the opponent's marks had become known in association with mailing lists or the services of compiling and publishing mailing lists. As a result, with the exception of these most recently mentioned wares and services, it could be said that these marks have acquired a significant amount of distinctiveness through their widespread use across Canada. With respect to the actual length of time the marks have been in use, the evidence filed showed use of the opponent's marks since the mid-seventies and extensive use across Canada by the early nineteen-eighties.

With respect to the nature of the wares and services, the applicant's wares of "catalogues and directories" and services of "Advertising for others in business catalogues and directories" would appear to be identical to the opponent's wares and services. The applicant's wares of "Prerecorded computer programmes, computer programmes for catalogue and directory information recorded on magnetic carriers, diskettes, cassettes and discs" and services of "business management; business administration; all the aforesaid services related to catalogue and directory activities" would relate somewhat to the opponent's wares "business and telephone directories". The applicant's "radio broadcasting and telecommunication services" would not appear to be related to the opponent's services,

except to the extent that one might expect a telecommunications company to provide a telephone directory. There would presumably be some overlap in the channels of trade associated with the respective wares and services of the parties.

The last consideration under Section 6(5) is the degree of resemblance between the marks in appearance, sound and ideas suggested. There is no phonetic resemblance between the marks. However, the elements comprising the designs are similar. The applicant's mark is the top view of a hand with an outstretched index finger, and what would appear to be lines of text. The opponent's mark TMA238,688 contains a side view of a hand with outstretched fingers "walking" across the pages of an open book. The opponent's mark 231,876 is comprised simply of the "walking fingers" design. As a result, it could be said that although there is a minor degree of visual resemblance between the marks, there is a large degree of resemblance in the ideas suggested by the marks. Although I agree with the applicant that the opponent's mark is in effect a "visual pun" showing fingers "walking", I believe that this recognition may be in part from the occasional use of the opponent's word mark **LET YOUR FINGERS DO THE WALKING** with this mark, and is not inherent in these marks themselves. Furthermore, I do not believe that this "visual pun" minimizes the common idea shared by the parties' marks, namely that of a hand or fingers moving across a printed page.

As a surrounding circumstance, the opponent filed evidence of an alleged fraud being perpetrated by a third party against customers of the opponent involving the use of a look-alike trade-mark. However, as the third party mark did not resemble the applicant's mark, and as there were several issues involved in this alleged fraud beyond mere trade-mark confusion, I do not believe that this event is relevant to the issue of confusion between the parties' marks.

The legal burden is on the applicant to show that there is no reasonable likelihood of confusion between the marks at issue. Any doubts are to be resolved against the applicant. In my opinion, the applicant has appropriated the same basic idea used by the opponent in its well known marks, namely the movement of a hand across a printed page. The marks are for use in association with identical wares and services. Although the differences between the opponent's and applicant's marks are apparent when viewed side-by-side, this is not the legal test. In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. I find that the applicant has failed to satisfy the burden on it to show that its mark is not confusing with the opponent's registered marks in respect of the wares "catalogues and directories" and the services of "Advertising for others in business catalogues and directories".

I am less certain of the likelihood of confusion with respect to the applicant's wares "Prerecorded computer programmes, computer programmes for catalogue and directory information recorded on magnetic carriers, diskettes, cassettes and discs" and services of "business management; business administration; all the aforesaid services related to catalogue and directory activities". These wares and services are to some extent ancillary to those of the opponent, but are not identical. I have already found that the opponent's marks have developed a significant reputation in respect of directories, publishing directories and advertising services in directories, and consider that this reputation serves to extend its ambit of protection beyond those wares. The marks are not similar in appearance, and yet share similar imagery. As I am left in a state of doubt, and the onus is on the applicant to prove that its mark is not confusing, I find that the trade-marks are confusing in respect of these wares and services as well.

I do not perceive the applicant's mark to be confusing with respect to "radio broadcasting and telecommunication services". The third ground of opposition is therefore successful with respect to all wares and services except "radio broadcasting and telecommunication services".

The material date with respect to the second ground of opposition under Subsection 16(3) would be the date of the applicant's priority filing date, namely, October 17, 1991. With respect to the ground of opposition based on Section 16(3)(a), there is a burden on the opponent in view of the provisions of Subsections 16(5) and 17(1) of the Act to establish prior use of its trade-marks in Canada as of the priority filing date of the applicant's mark, as well as to show that it had not abandoned its trade-mark as of the advertisement of the applicant's application in the Trade-marks Journal. The opponent has shown use and non-abandonment of the marks, at least in association with telephone directories and the sale of advertising in directories, and compiling and publishing directories. Notwithstanding its allegations, the opponent did not clearly show use of either trade-mark in association with the distribution of directory information by computer tapes, diskettes or cartridges.

In my view, the circumstances existing at this date are not materially different from those I reviewed in assessing the first ground, except that the opponent may not have established as strong a reputation in these marks by this new date. However this is merely a question of degree, and as the issue of entitlement also turns on the question of confusion, I find this second ground would be decided the same as the first ground.

The third ground, the issue of distinctiveness, must be considered as of the date the statement of opposition was filed namely August 16, 1994 (see **Cellular One Group, a partnership v. Brown, now standing in the name of Bell Mobility Cellular Inc.** (1996),

69 C.P.R. (3d) 236 (TMOB)). As the issue of distinctiveness can be seen as encompassing the issue of confusion discussed above, I do not believe that my findings with respect to the distinctiveness of the mark would differ materially from the result of my analysis for the first ground of opposition above.

I refuse the applicant's application in respect of "Prerecorded computer programmes, computer programmes for catalogue and directory information recorded on magnetic carriers, diskettes, cassettes and discs; catalogues and directories", and the following services: "Advertising for others in business catalogues and directories; business management; business administration; all the aforesaid services related to catalogue and directory activities", and I otherwise reject the opponent's opposition. Authority for such a divided result may be found in **Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH** (1986), 10 C.P.R.(3d) 482 at p. 492 (FCTD).

DATED AT HULL, QUEBEC, THIS 27th DAY OF FEBRUARY 1998.

Peter C. Cooke
Member
Trade-marks Opposition Board