



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

Citation: 2017 TMOB 45
Date of Decision: 2017-04-28

IN THE MATTER OF AN OPPOSITION

**United Artists Corporation and Danjaq,
LLC a joint venture and Danjaq, LLC**

Opponents

and

Fabergé Limited

Applicant

**1,341,907 for FROM RUSSIA WITH
LOVE**

Application

Background

[1] On April 2, 2007, Fabergé Limited (the Applicant) filed an application to register the trade-mark FROM RUSSIA WITH LOVE (the Mark), based on proposed use in Canada, in association with the following goods, as revised:

Precious metals and their alloys and jewellery, rings, bracelets of precious metals or coated therewith, horological and chronometric instruments, namely watches, clocks, watch chains, watch straps and watch pendants; precious stones; unwrought and semi-wrought precious stones; polished gemstones; artificial stones (precious and semi-precious); semi-finished articles of precious stone for use in the manufacture of jewellery; jewellery, imitation jewellery, costume jewellery, cufflinks; ornaments made of precious metal or precious stones; containers made of precious metals or precious stones; figurines

and objects of art made of precious stones; silverware, namely silver figurines and silver objects of art.

[2] United Artists Corporation and Danjaq, LLC a joint venture and Danjaq, LLC (the Opponents) allege that the Mark is confusing with trade-mark registration No. TMA 717,211, also for the trade-mark FROM RUSSIA WITH LOVE, but for the following goods:

Magnetically encoded computer game programs; computer software for multimedia and interactive computer games contained on cassettes, cartridges, tapes and CD ROMS; video and computer game cassettes and cartridges adapted for use with television receivers; computer hardware and software for multimedia and interactive computer games; computer game cartridges, cassettes, programs and tapes.

[3] The Opponents also allege that the Applicant is not the person entitled to registration of the Mark because at the date of filing it was confusing with the pending application for the trade-mark FROM RUSSIA WITH LOVE which was filed in Canada by United Artists Corporation and Danjaq, LLC a joint venture prior to the filing date of the Applicant's application and which had been previously used and or made known in Canada by the Opponents with the Opponents' registered goods as well as horological and chronometric instruments and timepieces. The Opponents also raise three other challenges to the application: (i) that the Applicant does not intend to use the Mark in Canada in association with the applied for goods; (ii) that the Applicant could not have been satisfied that it was entitled to use the trade-mark in view of the prior use and or making known of the trade-mark FROM RUSSIA WITH LOVE as well as with the JAMES BOND 007 trade-marks which have been used in Canada and around the world for a wide range of merchandise; and (iii) that the Mark does not actually distinguish nor is adapted to distinguish the Applicant's goods from those of the Opponents.

[4] For the reasons that follow, I find that this opposition should be rejected.

File Record

[5] The Opponents filed their statement of opposition on November 22, 2011. The Applicant filed its counter statement on January 19, 2012.

[6] The Opponents filed a certified copy of registration No. 717,211 as partial evidence, and the affidavit of David S. Pope as their evidence in chief. By way of office letter dated December 4, 2015, Mr. Pope's affidavit was returned to the Opponents pursuant to section 44(5) of the *Trade-mark Regulations* (SOR 96/195) because Mr. Pope failed to attend for cross-examination.

[7] The Applicant filed as its evidence the affidavit of Kevin Mutch, Group Legal Director of the Applicant. Mr. Mutch was cross-examined on his affidavit and his cross-examination transcript and replies to undertakings from part of the record.

[8] The Opponents did not file any evidence in reply.

[9] Only the Opponents filed a written argument but both parties were represented at an oral hearing.

Onus and Material Dates

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is, however, an initial evidential burden on the Opponents 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].

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

- sections 38(2)(a)/30(e) and (i) - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 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 CPR (3d) 413 at 422 (FCA)];
- sections 38(2)(c)/16(3)(a) and (b) – the filing date of the application [section 16(3)]; and

- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)].

Grounds of Opposition Summarily Dismissed

Non-conformity - Section 30(e)

[12] The Opponents have pleaded that the application does not comply with section 30(e) because the Applicant does not intend to use the Mark in Canada for the applied for goods. Section 30(e) of the Act requires an applicant to make a statement that it, either by itself or through a licensee, intends to use the applied for trade-mark in Canada. The application contains such a statement. It therefore formally complies with section 30(e) of the Act. In view of this, and since there is no evidence of record to suggest any lack of intention to use the Mark on the part of the Applicant, the Opponents have not met their initial burden in respect of this ground.

[13] Accordingly, this ground of opposition is summarily dismissed.

Non-conformity--Section 30(i)

[14] The Opponents also plead that the application does not comply with section 30(i) because the Applicant cannot be satisfied that it is entitled to use the trade-mark FROM RUSSIA WITH LOVE in view of the prior use and or making known of the trade-mark FROM RUSSIA WITH LOVE by the Opponents for a variety of goods, as well as with the JAMES BOND 007 trade-marks which have been used in Canada and around the world for a wide range of merchandise.

[15] Where an applicant has provided the statement required by section 30(i), a ground of opposition based upon this section should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152, (Reg TM) at 155]. Mere knowledge of the existence of an opponent's trade-mark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the Mark [*Woot Inc v Woot Restaurants Inc / Les Restaurants Woot Inc* 2012 TMOB 197]. The application for the Mark contains the requisite statement and there is no evidence that this is an exceptional case.

[16] Accordingly, this ground of opposition is also summarily dismissed.

Non-entitlement – Section 16(3)(b)

[17] Under this ground the Opponents plead that the Applicant is not the person entitled to registration of the Mark because at the date of filing such application it was confusing with the trade-mark FROM RUSSIA WITH LOVE which was then the subject of a pending application under No. 1,249,949, filed in Canada by the Opponents.

[18] An opponent may not rely on a previously filed application if the application was not pending as of the date of advertisement of the opposed mark: see section 16(4) of the Act. In this case, the application relied on by the Opponents for the mark FROM RUSSIA WITH LOVE matured to registration on June 23, 2008. As the application was not pending as of the date of advertisement of the Applicant's Mark (i.e. June 22, 2011), this ground is also summarily dismissed.

Remaining Grounds of Opposition

Non-entitlement - Section 16(3)(a)

[19] The Opponents plead under this ground that the Applicant is not the person entitled to registration of the Mark because, at the date of filing of the application, it was confusing with the trade-mark FROM RUSSIA WITH LOVE which had been previously used or made known in Canada by the Opponents and/or the Opponents' predecessor(s) in association with the registered goods as well as in association with horological and chronometric instruments, timepieces.

[20] This ground of opposition is based upon an assertion of prior rights, and to succeed under this ground, the Opponents must establish the existence of those rights. Specifically, the Opponents' initial onus is to evidence "use" or making known of its trade-mark with the pleaded goods prior to the filing date of the application for the Mark. Whether there has been "use" within the meaning of section 4 of the Act is a legal determination which must be based upon an assessment of the evidence. The Opponents must also show that they had not abandoned their mark when the Applicant's Mark was advertised (section 16(5)).

[21] Section 4 of the Act sets out what qualifies as “use” of a trade-mark. The portion relevant to the case at hand is section 4(1) which reads:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[22] As noted above, the only evidence of record from the Opponents is a certified copy of registration No. TMA717,211 for the trade-mark FROM RUSSIA WITH LOVE. When an opponent files only a certified copy of its registration, the Registrar will assume only *de minimus* use of the opponent's trade-mark [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. Therefore the mere filing of a certified copy of the registration for the mark FROM RUSSIA WITH LOVE is not sufficient to support the Opponents' evidential burden under this ground.

[23] At the oral hearing, the Opponents' agent submitted that the Opponents' initial burden can be met through the Applicant's evidence, namely the affidavit of Mr. Mutch. As noted above, Mr. Mutch is Group Legal Director of the Applicant. The most pertinent excerpts from the affidavit of Mr. Mutch are as follows:

Reply to Affidavit of David S. Pope

3. I turn first to address the Affidavit of Mr. David S. Pope dated 29 June 2012 (the Affidavit). Any allegations contained in the Affidavit that I do not specifically address here, should be regarded as having been denied.

...

23. In his affidavit at paragraph 34, Mr Pope refers to a line of watches produced by Swatch which identified different James Bond film titles including FROM RUSSIA WITH LOVE, 1,700 of which were sold in Canada. Based on my knowledge of sale of jewellery and watches, in my mind this is not a considerable level of sales and I believe this would be insufficient to cause the FROM RUSSIA WITH LOVE trade-mark to be understood by consumers as indicating the trade origin of a watch feature the mark to be the Opponent.

...

35. I note the watches produced by Swatch featuring the FROM RUSSIA WITH LOVE film name and included at Exhibit I of Mr. Pope's affidavit have a retail price of £40.00 whereas a FABERGE branded watch retails for between £10,000 to around £30,000. An example of watches produced by the Applicant which include the retail price are attached as Exhibit 9.

[24] The Opponents' agent argues that Mr. Mutch's statements above should be viewed as an admission or recognition that watches bearing the mark FROM RUSSIA WITH LOVE have been sold by the Opponents in Canada.

[25] The Applicant, on the other hand, submits that the Opponents cannot rely on the Applicant's evidence to meet its burden under the section 16(3)(a) ground of opposition for the following reasons:

- since Mr. Mutch does not have personal knowledge of the Opponents' watch sales this evidence is hearsay;
- this evidence is unreliable as the statements upon which Mr. Mutch's statements are based are not before the Board and Mr. Mutch could not have been cross-examined about them; and
- the only reason the Opponent is relying on this evidence is because Mr. Pope did not appear for cross-examination – it was therefore not necessary for the Opponent to rely on this evidence in support of its case.

[26] I agree with the Applicant that the Opponents cannot rely on Mr. Mutch's evidence to meet the burden under the section 16(3)(a) ground for each of the reasons provided by the Applicant. Even if I could have relied on this evidence, I would not have been satisfied that it was sufficient to meet the Opponents' burden under this ground as there is no evidence of how the mark FROM RUSSIA WITH LOVE was made known or used in association with watches by the Opponents pursuant to section 4(1) of the Act.

[27] In considering this issue, I also had regard to the following comments made by former Board Member Jill Bradbury in the decision *Ronald and Nancy Mallette v Maritime Imports Inc*, 2010 TMOB 204, at para 23:

I am not aware of any case law that says that an Opponent can meet its initial burden under s. 16(3)(a) by means of the Applicant's evidence. It is true that under certain grounds of opposition, namely grounds pleaded pursuant to s. 30(b) or 30(e), an opponent may rely on the applicant's evidence to meet its initial burden. However, this exception applies in such cases because the facts regarding the applicant's use of the applicant's mark or the applicant's intent to use the applicant's mark are particularly within the knowledge of the applicant (see *Labatt Brewing Company v. Molson Breweries, Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.); *Molson Canada v. Anheuser-Busch Inc.* (2003), 29 C.P.R. (4th) 315 (F.C.T.D.); *Canadian National Railway Co. v. Schwauss* (1991), 35 C.P.R. (3d) 90 at 94 (T.M.O.B.); and *Green Spot Co. v. J.B. Food Industries* (1986), 13 C.P.R. (3d) 206 at 210-211 (T.M.O.B.)). Clearly, such a rationale does not apply when one is concerned with evidence of the opponent's use. I see no reason why an opponent's initial burden should be as light under s. 16(3)(a) as it is under s. 30(b) and 30(e).

[28] I therefore am dismissing the section 16(3)(a) ground of opposition on the basis that the Opponents have not met their evidential burden.

[29] I would add that if I had evidence of record from the Opponents which had shown that the Opponents had used or made known the FROM RUSSIA WITH LOVE trade-mark in Canada prior to the material date for this ground in association with horological and chronometric instruments and timepieces, my conclusion under this ground may have been different. In this regard, my analysis of the likelihood of confusion, and in particular the nature of the goods and the nature of the parties' trades, would not have been limited to the statement of the goods covered by the Opponent's registration TMA717,211 (as in the case of the ground of opposition based on the non-registrability of the Mark which will be discussed below), but would have also taken into account the potential overlap between the other goods of the Opponents and the applied for goods.

Non-distinctiveness – section 38(2)(d)

[30] Under this ground the Opponents plead that the Mark does not actually distinguish nor is adapted to distinguish the goods in association with which it is proposed to be used from the goods of the Opponents.

[31] In order to satisfy its initial burden with respect to a distinctiveness ground of opposition, an opponent's evidence must show that its trade-mark had become known sufficiently as of the commencement of the opposition to negate the distinctiveness of the applied-for trade-mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC) and *Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44, (FCTD), at 58].

[32] As noted above, the only evidence of record of the Opponents is the certified copy of the trade-mark registration for the mark FROM RUSSIA WITH LOVE. The mere filing of a certificate of registration is not sufficient for the Opponents to meet their initial evidential burden under a non-distinctiveness ground [see *Roxxs Inc v Edit-SRL* (2002), 23 CPR (4th) 265, (TMOB)]. Accordingly, this ground of opposition is also dismissed.

Non-Registrability - Section 12(1)(d)

[33] Under this ground the Opponents plead that the Mark is not registrable because it is confusing with its registered trade-mark FROM RUSSIA WITH LOVE (registration No.TMA717,211).

[34] As noted above, the Opponents filed a certified copy of the registration for the mark FROM RUSSIA WITH LOVE. I have exercised my discretion and checked the register to confirm that the registration is extant [*Quaker Oats Co of Canada Ltd/Cie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410, (TMOB)]. Therefore, the Opponents have met their initial burden with respect to this ground.

[35] As the Opponents' evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the registered mark FROM RUSSIA WITH LOVE.

[36] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[37] 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 goods, 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 USA Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321, (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(e) - degree of resemblance between the trade-marks

[38] In most cases, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145, (FCTD), conf. (1982), 60 CPR (2d) 70, (FCA)].

[39] In *Masterpiece, supra*, the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion as follows at 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.

[40] Bearing this in mind, I have elected to begin my analysis by considering section 6(5)(e).

[41] The parties' trade-marks are identical. This factor therefore favors the Opponents.

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

[42] As noted above, the parties' trade-marks are identical. Neither of the trade-marks have any particular meaning in the context of the parties' goods. Accordingly, I find it reasonable to

conclude that the parties' trade-marks are equally inherently distinctive and that they possess a fair degree of inherent distinctiveness.

[43] The acquired distinctiveness of a trade-mark refers to the distinctiveness a trade-mark has acquired through promotion or use.

[44] The Opponents' agent submitted that I could take judicial notice of the reputation of James Bond movies, including the movie From Russia With Love. I agree. However, even if I took judicial notice that the average Canadian is familiar with James Bond movies, there is no admissible evidence showing the use or reputation of the registered trade-mark FROM RUSSIA WITH LOVE in association with the registered goods, including computer games software and related items. I am therefore unable to assess the extent to which the Opponents' trade-mark has become known in Canada in association with its registered goods.

[45] The only evidence filed by the Applicant is the Mutch affidavit. Although Mr. Mutch provides evidence of the Applicant's applications for and registrations of the FROM RUSSIA WITH LOVE trade-mark around the world, and the Applicant's plans for its proposed use Mark in Canada, Mr. Mutch does not provide any evidence of use or making known of the Mark in association with the applied for goods in Canada.

[46] In view of the foregoing, I must conclude that this factor does not favour either party.

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

[47] The Applicant has not filed any evidence of use of the Mark and, as noted above, the existence of the registration only enables me to infer *de minimus* use of the registered trade-mark [see *Entre Computer Centers Inc, supra*]. At best, this factor therefore only very slightly favours the Opponents.

Sections 6(5)(c) and (d) - the nature of goods, services or business and trade

[48] With respect to section 6(5)(c) of the Act, the Registrar must consider the goods set forth in the Applicant's application and in the registration filed by the Opponents since it is these goods which determine the respective monopolies being claimed by the parties in relation to their

trade-marks [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (Fed CA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (Fed CA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (Fed CA)].

[49] For ease of reference, I will set out again the goods as applied for by the Applicant and the goods in the registration filed by the Opponents.

[50] The statement of goods in the Applicant's application reads as follows:

Precious metals and their alloys and jewellery, rings, bracelets of precious metals or coated therewith, horological and chronometric instruments, namely watches, clocks, watch chains, watch straps and watch pendants; precious stones; unwrought and semi-wrought precious stones; polished gemstones; artificial stones (precious and semi-precious); semi-finished articles of precious stone for use in the manufacture of jewellery; jewellery, imitation jewellery, costume jewellery, cufflinks; ornaments made of precious metal or precious stones; containers made of precious metals or precious stones; figurines and objects of art made of precious stones; silverware, namely silver figurines and silver objects of art.

[51] The goods in the registration filed by the Opponents, on the other hand, are as follows:

Magnetically encoded computer game programs; computer software for multimedia and interactive computer games contained on cassettes, cartridges, tapes and CD ROMS; video and computer game cassettes and cartridges adapted for use with television receivers; computer hardware and software for multimedia and interactive computer games; computer game cartridges, cassettes, programs and tapes.

[52] The parties' goods differ substantially from one another.

[53] With respect to the parties' channels of trade, Mr. Mutch states that the normal channels of trade for the applied for goods are, in his experience, jewellery and watch shops, specifically the Fabergé boutiques as well as through jewellery and watch sections of high end department stores such as Harrods [Mutch, para 32 and Exhibit 8]. He further states that because most of the applied for goods are luxury goods, they are targeted toward the high end consumer and would

be made available to the public through different channels of trade than the Opponents' computer game software and related goods.

[54] On cross-examination, Mr. Mutch confirmed that not all of the applied for goods are luxury goods, as the applied for goods also include imitation jewellery and costume jewellery which would have a much lower retail price than the Applicant's high end jewellery items [Mutch cross-ex., q. 168-169]. Further, as pointed out by the Opponents' agent, the Applicant's application is not restricted to any particular channel of trade. Absent any restriction in the statements of goods, the Registrar cannot take into consideration the fact that the Applicant plans to provide most of its goods through Fabergé boutiques and high end department stores [see *Henkel Kommanditgesellschaft, supra*, at p. 112; and *Miss Universe, supra*, at pp. 390-392]. In any case, in the absence of evidence to the contrary, in view of the differences between the nature of the parties' goods, it is unlikely that the parties' channels of trade would overlap.

Further surrounding circumstances

[55] The Opponents' agent submits that a further surrounding circumstance that should be considered is its reputation in association with a series of James Bond Hollywood films and trade-marks in Canada and around the world. The Opponents' agent maintains that this reputation of this series of films in association with such a wide range of merchandise shows without any doubt that it is within the Opponents' natural zone of expansion to cover the kind of goods in association with which the Applicant proposes to use its Mark. In particular, the Opponents' agent submits that movie merchandising relating to the James Bond movie *From Russia With Love* could extend to high end jewellery, such as some of the Applicant's applied for goods.

[56] As noted above, there is no admissible evidence from the Opponents which shows that the Opponents' FROM RUSSIA WITH LOVE trade-mark has been used or made known in Canada association with any goods. At best, the Opponents' registration only enables me to infer *de minimus* use of its trade-mark with computer game software and related goods, goods which I note are not diverse in nature.

[57] With no admissible evidence of use or making known of the mark FROM RUSSIA WITH LOVE from the Opponents other than the registration for the registered mark, all that I am left with are those facts that I am prepared to take judicial notice of. As I stated above, I am prepared to take judicial notice of the fame of the James Bond series of Hollywood films, including the James Bond movie From Russia With Love. I am also prepared to take judicial notice that the average consumer would generally be aware about movie merchandising, i.e. that a wide variety of products are often sold in the marketplace in association with the name of a well-known movie. However, even by taking judicial notice of these particular facts, there would still not be enough evidence in this case to show that the natural zone of expansion for the Opponents' computer software and related goods are the kind of goods in association with which the Applicant proposes to use its Mark.

Conclusion on the Likelihood of Confusion

[58] Having considered all of the surrounding circumstances, I have concluded that there is not a reasonable probability of confusion between the trade-marks at issue. In coming to this conclusion, I acknowledge that the parties' marks are identical and that in most instances the degree of resemblance between the trade-marks is the most crucial factor in determining the issue of confusion [see *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145, (Fed TD), at 149, affirmed (1982), 60 CPR (2d) 70, (Fed CA) and *Masterpiece* 416 NR 307 *supra*]. I also acknowledge the reputation associated with the Opponents' From Russia With Love movie, and that there is no evidence to establish that the Mark has been used or acquired any reputation in Canada in the hands of the Applicant. However, the argument that the Opponents' series of James Bond films are world renowned is not a factor so important as to make the differences in the goods irrelevant. I am therefore unable to conclude that the reputation of the Opponents' mark and the average consumer's general knowledge about movie merchandising is sufficient such that upon seeing the Mark in the context of the Applicant's goods, he or she would be likely to conclude that those goods originate with or are somehow associated with the Opponents.

[59] The Opponents' agent has correctly pointed out that it is possible for confusion to be likely even when parties' goods are not of the same general class [section 6(2)]. However, as

stated in *Mattel, supra*, at paragraph 71, "given the role and function of trade-marks, [a difference in goods and services] will generally be an important consideration." In my view, the disparity between the parties' goods suffices to meet the Applicant's legal burden. Prospective consumers will likely *not* infer that the Applicant's precious metals, jewellery, watches and related goods associated with the Mark originate from the same source or are somehow associated with the same source as the computer game programs and related goods of the Opponents.

[60] For the foregoing reasons, the section 12(1)(d) ground of opposition is unsuccessful.

Disposition

[61] Having regard to the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2017-04-24

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