Federal Court  Cour fédérale

Date: 20100224

Docket: T-450-09

Citation: 2010 FC 214

Ottawa, Ontario, February 24, 2010

PRESENT: The Honourable Leonard S. Mandamin

BETWEEN:

VIBE MEDIA GROUP LLC now
INTERMEDIA VIBE HOLDINGS LLC

Applicant

and

LEWIS CRAIG TRADING AS VIBETRAIN

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] The Applicant, Vibe Media Group LLC appeals the decision of a member of the Opposition Board (Board Member) for Trade-marks dated January 18, 2009 denying opposition

to application No. 1,221,122 for trade-mark VIBETRAIN by the Respondent, Lewis Craig Trading as VIBETRAIN.

BACKGROUND

[2] On June 21, 2004 the Respondent filed an application to register the trade-mark VIBETRAN based on the proposed use in Canada for wares and services including sound recordings, printed promotional materials, magazines, clothing, souvenir items and entertainment services involving the provision of musical and entertainment performances in live, television, video and internet media. The dominant characteristic of the wares and services relate to music and culture as reflected in recordings and performances with related publications and media. The Respondent has not used the mark VIBETRAIN while waiting for trade-mark approval.

[3] On August 4, 2005 Vibe Ventures LLC filed a statement of opposition. On June 30, 2006 Vibe Ventures LLC assigned its trade-mark rights for VIBE, registration No. TMA526,485 and its pending applications Nos. 1,16727 and 1, 284,250 to the Applicant, Vibe Media Group LLC. The Applicant published VIBE, a popular culture magazine focusing on urban culture at the relevant time, January 18, 2009. On January 4, 2010, the Applicant filed notice that its interest in the proceeding is now assigned to Intermedia Vibe Holdings LLC.

DECISION UNDER APPEAL

[4] The Board Member began with a correct statement of the law in her analysis of confusion: “the test for confusion is one of first impression and imperfect recollection”. She

considered the statutory criteria for confusion set out in section 6 of the *Trade-mark Act*, R.S.C., 1985 c. T-13 (the Act) in particular to susections (2) and (5).

[5] The Board Member found the word "vibe" is not inherently distinct relying on the Court's decision in *Vibe Ventures LLC v. 3681441 Canada Inc*., 45 C.P.R. (4th) 17. She also referred to the Oxford English Dictionary (OED) defining the word as a noun.

[6] The Board Member found VIBETRAIN consists of the fusion of two ordinary disctionary words that are disconnected from their respective meanings and which, when juxtaposed, are inherently distinctive.

[7] The Board Member found the marks were "similar to some extrent"; however, she found they had different meanings "… I find the word VIBE creates an impression limited to its defined meanings, whereas VIBETRAIN, a coined word with no apparent meaning, creates a significantly different impression."

[8] She found overlap between the Applicant's and Respondent's wares and services only with respect to a "general interest magazine".

[9] The Board Member found:

> "… the issue is whether a consumer who has a general and not precise recollection of the Opponent's mark VIBE, will, upon seeing the Applicants's mark VIBETRAIN, be likely to think that the two products share a common source or that the Applicant wares and serivce have been

> licenced or otherwise approved by the Oppenent … I find the average Canadian consumer, who has imperfect recollection of VIBE, is not likely to assume that the Applicant's Mark VIBETRAIN for the applied-for wares and services, share the same source as the Opponent's mark VIBE for magazines."

LEGISLATION

[10] The relevant legislative provisions are:

Trade-marks Act, R.S.C, 1985, c. T-13

2. In this Act, "distinctive", in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;	2. Les définitions qui suivent s'appliquent à la présente loi. « distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison avec lesquels elle est employée par son propriétaire, des marchandises ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi.
…	…
6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.	6. (1) Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.
(2) The 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	(2) L'emploi d'une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l'emploi des

manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

…

(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.

…

56. (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

deux marques de commerce dans la même région serait susceptible de faire conclure que les marchandises liées à ces marques de commerce sont fabriquées, vendues, données à bail ou louées, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces marchandises ou ces services soient ou non de la même catégorie générale.

…

(5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l’espèce, y compris :

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

c) le genre de marchandises, services ou entreprises;

d) la nature du commerce;

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans la présentation ou le son, ou dans les idées qu’ils suggèrent.

…

56. (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l’avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit

(5) On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.	avant, soit après l'expiration des deux mois. (5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.

STANDARD OF REVIEW

[11] The Applicant has submitted new evidence as permitted by s. 56(5) of the Act. In *Molson Breweries v. John Labatt Ltd.*, [2003] 3 FC 145 (C.A.) at 51, Justice Rothstein wrote:

> Having regard to the Registrar's expertise, in the absence of additional evidence adduced in the Trial Division, I am of the opinion that decisions of the Registrar, whether of fact, law or discretion, within the area of his expertise, are to be reviewed on a standard of reasonableness *simplicitor*. However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division judge must come to his or her own conclusion as to the correctness of the Registrar's decision.

Accordingly, I will assess this appeal having regard to the Applicant's new evidence.

ANALYSIS

[12] The Board Member concluded there was nothing distinctive in the word 'vibe', referring to the finding in *Vibe Ventures LLC v. 3681441 Canada Inc.*, 45 C.P.R. (4th) 17 (*Vibe Ventures LLC*) and the OED definition: "vibe: noun (informal) the atmosphere or aura of a person or place as communicated to and felt by others". The Board Member interpreted "vibe" as an adjective referring to its use by the Applicant as "… the content of the magazine holds a certain aura, a certain vibe, characterizing the flavour of the magazine".

[13] The Respondent supports the Board Member's finding by giving as examples the myriad uses of the the word 'home' in marks such as Home Depot, Home Hardware, and the like.

[14] The Applicant argues the Board Member's use of the OED was extrinsic evidence the parties should have had an opportunity to respond to. It refers to other dictionaries which do not define "vibe"; concluding it is not an ordinary dictionary word.

[15] In my view, the distinctive nature of the word 'vibe' is more nuanced. In *Vibe Ventures LLC,* Justice Harrington stated there was nothing distinctive in the word. He acknowledged its use in different contexts such as music and youth lifestyle but argued at paragraph 35, "the genius of the English language is such that a word may mean different things to different people at different times and in different places." On this point, he concluded at paragraph 37:

> "Vibe", however the English language may be developing, is not so unique as to lend itself exclusively to a particular culture, a particular age group, particular wares such as magazines, clothing, or automobiles, or services."

[16] The crux is "developing". At the time Quincy Jones called his magazine Vibe, the word may have been slang and his use of the word for his magazine unique. However, the use of the word increased. It is now sufficiently widespread as to lead one to conclude "vibe" is no longer inherently distinctive. Nevertheless, through continuous by Mr. Jones' successors including the Applicant corporation (of which Mr. Jones is Chairman), the word 'VIBE' has acquired a reputation. This reputation was acknowledged by the Board Member who stated:

> Not only is the word VIBE an ordinary word, it is also suggestive of the Opponent's magazine since it can be said the content of the magazine holds a certain aura, a certain vibe, characterizing the flavour of the magazine.

[17] The Applicant submitted new evidence to establish the term 'train' can suggest 'a succession of musical performances' and reiterates its magazine is popular in the field of music. It appears to me the dominant word in VIBETRAIN is 'vibe' which characterises a musical and cultural millieau rather than "train" used to denote a succession of things.

[18] The Applicant also submitted new evidence to show no other magazine title begins with "VIBE". The Applicant's evidence establishes in addition to magazine sales in Canada, the mark "VIBE" has been used in Canada in connection with:

- TV programs as early as 1998;
- An annual two-hour TV production called the VIBE AWARDS show since 2003;
- A website providing an on-line magazine with information relating to music and entertainment since 1996;
- A website providing music and music videos;
- A mobile phone based service called MVIBE or MOBILE VIBE through which subscribers receive entertainment updates, album reviews, and other information;
- Books relating to music, entertianment and culture; and
- Musical recordings (CD's).

[19] I find there is a broad overlap in the music, culture and clothing wares and services which both the Applicant's and Respondent's marks seek to identify. Both rely on similar channels of trade. They both target people who have an interest in music, entertainment and culture. For these reasons I find there is a likelihood of confusion in the mind of a "casual consumer somewhat in a hurry": *Advance Magazine Publishers, Inc. v. Wise Gourmet Inc.*, 2009 FC 1208 at 48.

CONCLUSION

[20] I find the Applicant's additional evidence gives rise to reconsideration of the question of confusion between the marks VIBE and VIBETRAIN.

[21] Use of the mark VIBE going back to its originator, Quincy Jones, has given the Applicant a reputation related to its magazine and associated wares and services in the field of culture, music and entertainment. That reputation was well known in Canada at the material time of the filing of the Repondent's mark on June 21, 2004. I find considerable overlap exists in the areas of marketing to which the marks are directed both with respect to subject matter and audience. In these circumstances, I conclude confusion would arise such that the Respondent's mark VIBETRAIN would be seen to be associated with the Applicant's mark VIBE.

[22] Accordingly, the appeal is granted.

[23] The Respondent is self-represented. He refrained from use of the mark VIBETRAIN pending success of his application. Individuals are entitled to apply for legislative rights such as trade-mark. The Respondent has conducted himself responsibly and was initially successful, therefore I make no order for costs.

JUDGMENT

THIS COURT ORDERS AND ADJUDGES that:

1. The appeal is granted.

2. The application No. 1,221,122 under the *Trade-marks* Act for the Trade-mark VIBETRAIN is refused.

3. I make no order for costs.

"Leonard S. Mandamin"

Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-450-09
STYLE OF CAUSE:	VIBE MEDIA GROUP LLC now INTERMEDIA VIBE HOLDINGS LLC v. LEWIS CRAIG TRADING AS VIBETRAIN
PLACE OF HEARING:	TORONTO, ONTARIO
DATE OF HEARING:	JANUARY 12, 2010
REASONS FOR JUDGMENT AND JUDGMENT:	MANDAMIN J.
DATED:	FEBRUARY 24, 2010

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