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MEDIA COMPANY'S *SER PADRES* TRADE-MARK FOUND CONFUSING IN PART WITH SAN DIEGO BASEBALL CLUB'S MARKS, RULES OPPOSITION BOARD

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A recent decision by Canada's Trade-marks Opposition Board has allowed in part the opposition by Padres L.P., the owner of the trade-mark rights in the San Diego baseball club's PADRES marks, against an application filed by Meredith Corporation for the trade-mark SER PADRES in association with calendars and various articles of clothing for children (*Padres L.P. v. Meredith Corporation*, 2013 TMOB 142 (T.M.O.B.), A. Flewelling, August 29, 2013).

On October 14, 2005, Meredith Corporation (hereafter the "applicant" or "Meredith"), a U.S. media company, filed an application to register the trade-mark SER PADRES in association with various wares and services, namely: Magazine directed to parents. Computer software and multimedia software recorded on CD-ROM, namely, educational software featuring information in the field of pregnancy, childbirth, child rearing, child development, child-proofing, child safety and parenting; series of non-fiction books in the field of pregnancy, childbirth, child rearing, child development and parenting; calendars; home safety products, namely non-metal locks and latches for doors, cabinets, drawers, furniture corner cushions, finger pinch guards, cord wind-ups, door knob covers, and safety kits comprised of corner cushions for tables and chairs, small object tester, outlet plugs and home safety guide, all sold as a unit; home safety products, namely, covers and plugs for electric outlets, motion sensitive security lights and safety harness other than for vehicles or sports purposes; musical sound recordings, namely, audio compact discs and cassette tapes for children; infant development toys; children's multiple activity toys; footwear for children, namely, shoes, boots, sandals; layettes, namely sets of clothing and bedding for a newborn child; headwear, namely, hats, toques, caps; clothing for infants and children, namely, infantwear, shirts, t-shirts, sweatshirts, sweatpants, overalls, dresses, play suits, rompers, singlets, shorts, pants, jumpers, jackets, coats, gloves, scarves, underwear, pajamas, robes, sleepwear, rainwear, socks, tights, bathing suits, baby bunting, cloth bibs and cloth diapers; bedding, namely, bed linen, bed sheets, quilts, bed blankets, comforters, duvet covers, mattress covers, mattress pads, pillow shams, pillow cases, bed skirts and crib bumpers. Computer services, namely, providing on-line magazines in the fields of child development and parenting.

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This application for the trade-mark SER PADRES was published for opposition purposes on May 30, 2007. On January 25, 2008, Padres L.P. (hereafter the “opponent” or “Padres L.P.”) filed a statement of opposition against Meredith Corporation’s application.

In its statement of opposition, Padres L.P. alleged that the applied for trade-mark was not registrable as it was confusing with the opponent’s four registered trade-marks. Each registration protected a variant of the PADRES mark in association with various wares and services.

For example, one trade-mark was registered with the performance, presentation and promotion of baseball games rendered live and through the media of radio and television and for the following wares: “Boys’ and men’s tank tops, sweatshirts, hats, caps; helmets; girls’ shirts, nightshirts; infants’ shirts; jewelry, namely pins; photo trading cards, collector albums; buttons, felt pennants.” .

Another one was registered in association with a long list of wares, including: “clothing, namely jackets, coats, ponchos, raincoats, pants, overalls, jeans, coveralls, shorts, sweatpants, t-shirts, shirts, tops, jerseys, turtlenecks, pullovers, sweaters, vests, tank tops, sweatshirts, jogging suits, warm-up suits, skirts, short sets, diaper sets, dress and pant sets, pant sets, sweater sets, sunsuits, swimsuits, sleepers, snowsuits, underwear, housecoats, bath robes, bath wraps, undershirts, bibs, pyjamas, nightgowns, nightshirts, boxer shorts, layette sets, socks, hosiery, hats, caps, visors, headbands, wristbands, mitts, gloves, scarves, handkerchiefs, belts, suspenders, ties, buckles, footwear and accessories, namely shoelaces, shoe bags, shoes, boots, slippers, sneakers, running shoes, baby booties, ... games, toys and play things, namely inflatable toys, balls, bats, gloves, ... calendars, ... bed, bath, kitchen and table linen, namely sheets, pillow cases, pillows, blankets, quilts, comforters, duvets, bedspreads, curtains, bumper pads, sleeping bags and sacks, cushions, shower curtains, towels, tablecloths, placemats, napkins, oven mitts, potholders, aprons, chef hats, carpets, rugs, mats, ...”.

The Registrar therefore had to evaluate this ground of opposition and decide whether the use of the applied for trade-mark and the use of the opponent’s trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks were manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services were of the same general class.

In support of its application, the applicant argued that its trade-mark SER PADRES translates into English as “to be parents”. For its part, the opponent indicated in its written submissions that the word means “father” in Spanish. However, since there was no evidence as to the average Canadian consumer’s understanding of Spanish, the Registrar concluded that the average Canadian would be more likely to infer that the parties’ respective marks are coined words.

No evidence of significant use of either party's trade-marks in Canada was filed into evidence.

As for the nature of the wares, services or business of each party, the Registrar concluded that there was some degree of similarity between the applicant's wares and the opponent's wares protected in its registrations. For example, the applicant's application included the following wares that the Registrar described as overlapping with those of the opponent: calendars; ... musical sound recordings, namely, audio compact discs and cassette tapes for children; infant development toys; children's multiple activity toys; footwear for children, namely, shoes, boots, sandals; layettes, namely sets of clothing and bedding for a newborn child; headwear, namely, hats, toques, caps; clothing for infants and children, namely, infantwear, shirts, t-shirts, sweatshirts, sweatpants, overalls, dresses, play suits, rompers, singlets, shorts, pants, jumpers, jackets, coats, gloves, scarves, underwear, pajamas, robes, sleepwear, rainwear, socks, tights, bathing suits, baby bunting, cloth bibs and cloth diapers; bedding, namely, bed linen, bed sheets, quilts, bed blankets, comforters, duvet covers, mattress covers, mattress pads, pillow shams, pillow cases, bed skirts and crib bumpers. (hereafter the "overlapping wares"). However, the other wares and services mentioned in the application did not resemble the opponent's wares and services.

The Registrar also noted that the marks shared some degree of similarity since they both included the identical word PADRES. The parties' respective marks also suggested the same idea, even if it was not clear what that idea was.

The Registrar reminded the parties that the Supreme Court of Canada in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, [2011] 2 S.C.R. 387, at paragraph 49, highlighted the importance of the issue of resemblance between trade-marks in the analysis concerning the likelihood of confusion. In the present case, there was certainly some similarity between the parties' respective trade-marks. Moreover, the overlapping wares in the applicant's application did not help the applicant in overcoming or minimizing in any way the similarity between the marks. Consequently, the Registrar was not satisfied that the applicant had discharged its onus of establishing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the parties' respective marks with respect to the overlapping wares. On the other hand, the other wares and services mentioned in the applicant's application were not sufficiently similar to those of the opponent and this was enough to enable the applicant to satisfy its onus in support of its claim to registration of its mark for those wares and services. The opponent's opposition was allowed against the applicant's trade-mark, but only for the overlapping wares.

While both parties were apparently involved in different businesses, some of the wares associated with their respective trade-marks were found to overlap. Canadian case law allows the Registrar to carve out from an application those wares that create confusion with an opponent's trade-marks, allowing those that do not to survive the opposition process (*Produits Menagers Coronet Inc v. Coronet-Werke Heinrich*

Schlerf GmbH (1986), 10 C.P.R. (3d) 492 (F.C.T.D.). It is also worth mentioning that the opponent was partially successful because of its registrations, even if no evidence of use of its marks in Canada was presented to the Registrar. This is important since it allows an opponent to successfully challenge (at least in part in this case) any application on the basis of a registration in good standing, even if no evidence of use is available. To resolve an opposition in such a case, the Registrar will compare the parties' respective statements of wares and services to determine whether confusion is likely or not. Registration alone can therefore allow an opponent to successfully oppose an application, in cases where no evidence of use is readily available.



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