

IN THE MATTER OF AN OPPOSITION
by JACQUES Britt Internationale Moden GMBH
to application No. 578,001 for the mark
BRITT filed by Pacific Rim Sportswear
Company Ltd.

On July 2, 1987, the applicant, Pacific Rim Sportswear Company Ltd., filed an application to register the mark BRITT, based on use in Canada since at least as early as June 15, 1987, in association with the following wares:

jeans, shirts, sweaters, pants, shorts,
jackets, coats and vests.

The subject application was advertised for opposition purposes on March 16, 1988. The opponent, Jacques Britt Internationale Moden GMBH, filed a statement of opposition on July 6, 1988, a copy of which was forwarded to the applicant on July 29, 1988. The opponent was granted leave on August 12, 1988 to amend its statement to correct a typographical error. The opponent was subsequently granted leave, fairly late in the proceedings (on December 16, 1992), to amend its statement to add a further ground of opposition.

The grounds of opposition initially pleaded are, firstly, that the applicant is not entitled to register the mark BRITT in view of the opponent's trade mark application for the mark JB JACQUES BRITT & Design (application No. 549,955; illustrated below), filed on September 27, 1985, covering an extensive list of wearing apparel items; secondly, that the applicant applied for mark BRITT is not distinctive of the applicant's wares in view of the opponent's use of its above mentioned mark in Canada since at least as early as July 1981.

As mentioned earlier, a third ground of opposition was added namely, that the application is not in compliance with subsection 30(b) of the Trade-marks Act because the applicant did not use the applied for mark since the date of first use (June 15, 1987) claimed in the subject application.

The applicant filed and served a counter statement in response to the first amended statement of opposition, but did not respond with an amended counter statement when the third ground was added.

The opponent's evidence of record consists of a certified copy (dated March 21, 1989) of the Trade-mark Office file relating to the opponent's trade-mark application No. 549,995 for the mark JB JACQUES BRITT & Design mentioned above. The applicant's evidence consists of the affidavit of Norman Franks, controller of the applicant company. Mr. Franks was not cross-examined on his affidavit nor did the opponent file any evidence in reply. Only the opponent filed a written argument and neither party requested an oral hearing.

While the legal burden is on the applicant to show that its applied mark BRITT should be registered, there is an evidential burden on the opponent to lead evidence to support the allegations pleaded in the statement of opposition: see John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at pp. 297-300 (F.C.T.D.). The opponent's evidential burden is a light one respecting the ground of opposition alleging non-compliance with 30(b) of the Act, since the pertinent facts are peculiarly within the knowledge of the applicant: see Molson Breweries, a Partnership v. Pernod Richard, S.A. (1991), 40 C.P.R.(3d) 102 at pp.106-7 (F.C.T.D.). In the instant case, the opponent is relying on the applicant's evidence to support the allegation that the applicant did not use the applied for mark in association with the wares shirts, coats, and vests as specified in the application. I agree with the opponent that the applicant's evidence could have been more specific about when the applicant commenced use of its mark BRITT in association with each of the items of clothing set out in the subject application. However, I do not agree that the applicant's omission to do so, by itself, satisfies the opponent's evidential burden in the circumstances of this case where the applicant's evidence has not been challenged or contradicted in any way, and where the evidence establishes use of the applied for mark in association with wares of the same general class namely, pants, shorts and sweaters. The opponent also notes that the applicant did not amend its counter statement to deny the ground of opposition alleging non-compliance with subsection 30(a). However, the opponent did not argue that the applicant's failure to do so is fatal to its application. Accordingly, I am treating the applicant's omission to amend its counter statement as a technical deficiency.

The opponent's second ground of opposition, alleging that the applied for mark is not distinctive of the applicant's wares, is based on the opponent's use of its mark JB JACQUES BRITT & Design in association with clothing. However, the opponent has not filed any evidence to show that it in fact used its mark in Canada or elsewhere. Accordingly, the second ground of opposition is rejected because the opponent has not met its evidential burden to put the question of distinctiveness in issue.

The remaining ground of opposition is based on subsection 16(1)(b) of the Act, reproduced, in part, below. The opponent is alleging that the applied for mark BRITT is

confusing with the opponent's mark JB JACQUES BRITT & Design.

16(1) An applicant . . . for registration of a trade-mark . . . is entitled . . . to secure its registration, unless at the date on which he . . . first so used it or made it known it was confusing with

. . .

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; . . .

Essentially, the opponent is asserting that it has priority rights because its filing date for the mark JB JACQUES BRITT & Design (application No. 549,955 filed on September 27, 1985) precedes the applicant's claimed date of first use namely, June 15, 1987. There is nothing explicit in the terms of the Act, or implicit in the scheme of the Act, requiring the opponent to show use of the mark that it is relying pursuant to subsection 16(1)(b). In fact, there is nothing to preclude an opponent from relying on a third party's trade-mark application. Subsection 16(4), however, does require the opponent to show that the trade-mark application that it is relying on was pending at the date that the opposed application was advertised in the Trade-marks Journal. In the instant case, the certified copy of the opponent's application file No. 549,955 shows that the application for JB JACQUES BRITT & Design was pending as of the date of advertisement (March 16, 1988) of the mark BRITT.

The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of subsection 6(2), between the applied for mark BRITT and the opponent's mark JB JACQUES BRITT & Design. The material time to consider the issue of confusion is the date of first use claimed in the applicant's application, as set out in subsection 16(1). In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in subsection 6(5). The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 at pp. 297-298 (F.C.T.D.).

With respect to subsection 6(5)(a), neither of the parties' marks are particularly distinctive having regard to the surname significance of the component BRITT. There is no evidence that either mark had any reputation in Canada at the material date. With respect to subsection 6(5)(b), the length of time that the marks have been in use is not a relevant factor. The opponent has not demonstrated use of its mark, and the applicant's use of its mark only began at the material date.

With respect to subsections 6(5)(c) and (d), the nature of the parties' wares is essentially the same, and therefore the parties' channels of trade are also potentially the same.

As for the resemblance between the marks in issue, I find that there is a fair degree of resemblance visually owing to the component BRITT common to both marks. There is also a marked similarity between the marks aurally to the extent that consumers would abbreviate the opponent's mark to JB BRITT, or JACQUES BRITT, or even to BRITT. The ideas suggested by the marks resemble each other to the extent that the component BRITT suggests a surname.

Considering the above, and keeping in mind that the test of confusion is one of first impression and imperfect recollection, I find that the applicant has not met the legal burden on it to show that the marks in issue are not confusing. In this regard, it is not unlikely that an imperfect recollection of the opponent's mark would retain the components JACQUES BRITT or BRITT.

In view of the above, the applicant's application is refused.

DATED AT HULL, QUEBEC, THIS 28th DAY OF July, 1994.

Myer Herzig,
Member,
Trade-marks Opposition Board