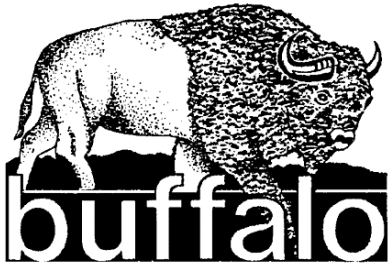


**IN THE MATTER OF AN
OPPOSITION by Sarafina Invest Ltd.
to Application No. 401300-1 for the
Trade-mark BUFFALO & Design filed
by Buffalo-Eastcantra Inc.**

On August 11, 1997, Buffalo-Eastcantra Inc. (the «Applicant»), filed an application, based on use since January 1, 1987, to extend the list of wares of existing registration number TMA226024 for the trade-mark BUFFALO & Design as illustrated herein below:



(the «Mark»)

to cover lunch bags, lunch boxes, briefcases, portfolio cases, document cases, carry-alls, knapsacks, business card holders, wallets, pencil grips, padlocks, combination padlocks, mirrors, locker organizers, and self-adhesive labels (the “Wares”). The application was published in the November 26, 1997, issue of the Trade-Marks Journal for opposition purposes.

Sarafina Invest Ltd. (the “Opponent”) filed on January 26, 1998 a statement of opposition limited to the following wares: briefcases, portfolio cases, documentary cases, carry-alls, knapsacks, wallets and business cards holders (the “Wares in issue”). The grounds of opposition can be summarized as follow:

- 1) The Opponent denies that the Applicant has used the Mark since January 1st, 1987 in association with the Wares in issue and if such use was made it was after January 3, 1995.
- 2) The Applicant is not the person entitled to the registration of the Mark as per the provisions of Section 16(1)(c) of the Act since it was confusing with the Opponent’s

trade-marks BUFFALO and BUFFALO and Design previously used in Canada since at least 1983 in association with articles of clothing and accessories;

- 3) The Applicant is not the person entitled to the registration of the Mark as per the provisions of Section 16(1)(b) of the Act since at the alleged date of first use it was confusing with the Opponent's trade-mark BUFFALO for which application bearing number 772225 had been previously filed, namely on January 3, 1995, based on proposed use, in association with luggage and packsacks;
- 4) The Mark when used in association with the Wares in issue, in view of the above, is not distinctive and is not adapted to distinguish the Wares;
- 5) The Mark is not registrable as per the provisions of Section 12(1)(d) of the Trade-Marks Act (the "Act") since it is confusing with the following registered trade-marks for BUFFALO (word or design marks) certificates of registration numbers 313138, 364692, 369788, 369789, 443164 and 443415 in association with articles of clothing and accessories. The Opponent's trade-mark BUFFALO is a famous trade-mark and as such the Wares in issue are related wares to articles of clothing and a normal extension of any corporation carrying on business in the fashion industry;

The Applicant filed on March 2, 1998 a counter statement denying each ground of opposition.

The Opponent filed the affidavit of Mr. Gilbert Bitton together with exhibits GB-1 to GB-17. Pursuant to an order made by the Board, Mr. Bitton was cross-examined on his affidavit and the transcript of such examination was filed in the record. The Applicant filed the affidavit of Mr. Danny Fonfeder together with exhibits A-1 to A-15 as well as exhibit A-1 filed during the cross-examination of Mr. Bitton. Mr. Fonfeder was also cross-examined and the transcript of such cross-examination was filed in the record.

Both parties submitted written arguments and were represented at an oral hearing.

The Evidence

Mr. Bitton is the president of Slide Sportswear Inc. , the Opponent's licensee for the trade-mark BUFFALO. On January 3 1995, the Opponent filed an application to register the trade-mark BUFFALO, application number 772225, in association with luggage and packsacks. The Applicant opposed such application only in so far as the packsacks were concerned. A copy of the statement of opposition filed by the Applicant was produced as exhibit GB-1. A copy of the affidavit filed by Mr. Fonfeder in support of such opposition was also produced as an exhibit in this file. Pictures of the respective parties products were also filed in the record. Mr. Bitton introduced as evidence extracts of French and English dictionaries for the words "fourre-tout", "havresac", "carry-all" and "knapsacks".

Mr. Bitton takes the position that exhibits A-1 to A-7 to the affidavit of Mr. Fonfeder, filed in support of the Applicant's opposition to the Opponent's application number 772225, clearly establish that the Applicant has not sold any carry-alls and knapsacks since January 1, 1987 but instead sold pencil pouches or cases. Some of these exhibits are physical exhibits filed in the record of application 772225 and therefore only pictures of these items were filed in this record. Mr. Bitton filed, as exhibit GB-7, a picture of the largest carry-all or knapsack sold by the Applicant and identified as exhibit A-14 during the cross-examination of Mr. Fonfeder held on June 30, 1998 with respect to the Applicant's opposition to application 772225. Annexed to Mr. Bitton's affidavit were a bundle of invoices dated between 1993 and 1997 evidencing the sale of backpacks by the Opponent's licensee. Samples of Opponent's various bags were produced as exhibits GB-9 to GB-17 inclusive.

I will comment hereinafter on the outcome of the opposition in application 772225 but suffice to say for the moment that I was able to locate those physical exhibits referred to in these proceedings but filed in the record of application 772225 and with the permission of the parties' agents I will hereafter refer to the physical exhibits instead of the pictures. I noticed and informed the agents of the parties that Exhibit I-1 and A-1 to the cross-examination of Mr. Bitton were not produced in the record with the transcript and I shall therefore disregard those exhibits or any reference to them. A

copy of the license agreement was made available by the Opponent's agent for the eyes of the Applicant's agent only.

Mr. Fonfeder has been the Applicant's president. He alleges that the Applicant has been selling pouches and cases of all kinds for the last twenty (20) years. He filed a copy of the Applicant's 1980 catalogue in which are illustrated briefcases, credit card and license holders, and various pouches identified as pencil pouches. He also filed a copy of the Applicant's 1986 catalogue in which are illustrated similar products. Exhibits A-3 to A-7 to his affidavit were samples of pouches. The same exhibits with the same identification number were filed in the record of application 772225. As mentioned above, I also located those physical exhibits.

He filed a bundle of invoices, the oldest one dated June 2, 1991, to evidence the sale of pouches and bags bearing the Mark. He alleges that the bags and pouches are sold in chain stores such as Wal Mart, Zellers and Giant Tiger. He filed samples of Pharmasave and Pharmaprix advertising flyers.

He produced photocopies of certificates of registration 226024, 169588, 169558, 135476, and 517113 all in the name of the Applicant for the word mark or various design marks BUFFALO.

He alleges that a Value Drug Mart advertising flyer published in August 1997 illustrates a BUFFALO carry-all pouch. He filed a product status report dated August 12, 1998 that shows that the Applicant would have sold approximately \$4 million worth of pouches and bags.

During his cross-examination he acknowledged that there was no date on the catalogue, exhibit A-1, to confirm that it was published in 1980. He stated however as a reply to undertaking that the item numbers used in such catalogue lead him to believe that it was published in 1980. He also mentioned that a lot of people are now using what is identified as a "pencil pouch" as a carry-all. He admitted that exhibits A-3 to A-7 are not knapsacks.

The legal issues

In its written submissions and during the oral hearing, the Opponent did focus mainly on the issue that the Applicant did not show use of the Mark in association with knapsacks and carry-alls bags as of the claimed date of first use and the Opponent did not argue strongly this point with respect to the other Wares in issue. At the oral hearing the Opponent did not address the second, third and fourth grounds of opposition and skimmed through the fifth ground of opposition. There was no submission on the last ground in the written arguments.

The legal burden is upon the Applicant to show that its application complies with the provisions of Section 30 of the Act, but there is however an initial evidential burden on the Opponent to establish the facts relied upon by it in support of its grounds of opposition. Once this initial burden is met, it shifts to the Applicant who then must prove that the particular grounds of opposition should not prevent registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, (1984) 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, (1990) 30 C.P.R. (3d) 293].

The material time for considering the issues of non-compliance with Section 30 of the Act is the filing date of the application (August 11, 1997). [See *Georgia-Pacific Corp. v. Scott Paper Ltd.*, (1984) 3 C.P.R. (3d) 469, at p. 475]

It must be remembered that an opponent who claims that the applicant has not complied with section 30(b) of the Act has a light evidential burden. [See *John Labatt Ltd v. Molson Companies Ltd* (1990) 30 C.P.R. (3d) 293 at 298]. Moreover the opponent can rely on the evidence filed by the applicant to discharge this initial burden. [*Tune Masters c. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84 (T.M.O.B.), *Hearst Communications Inc. c. Nesbitt Burns Corp.*, (2000) 7 C.P.R. (4th) 161 (T.M.O.B.), *Labatt Brewing Co. c. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.) et *Williams Telecommunications Corp. c. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107 (T.M.O.B)]

The Opponent is relying on the following facts to support this ground of opposition:

- a) The Applicant's catalogues filed in the record do not show any carry-alls and knapsacks;
- b) During his cross-examination with respect to his affidavit filed in application 772225 (exhibit GB-6), Mr. Fonfeder produced a sample of the largest bag (exhibit GB-7 to Mr. Bitton's affidavit) being offered for sale or sold by the Applicant and such bag cannot be considered as either a carry-all or a knapsack;
- c) In order to be considered as a knapsack, a bag must have shoulder straps as per the dictionaries' definition. There have been no bags filed in the record by the Applicant that have such feature;
- d) There is no evidence of sales of carry-alls or knapsacks in association with the Mark as of the date of first use, namely January 1st, 1987 as the invoices filed in the record are dated from June 1991 onwards.

The Opponent failed to discharge its initial burden and raise enough doubts that the Applicant never used the Mark, as of the claimed date of first use, in association with briefcases, portfolio cases, documentary cases, wallets and business cards holders. In fact these items are illustrated in the two catalogues exhibits A-1 and A-2. [See *Hearst Communications, supra*]

As for the other Wares in issue, the Applicant takes the position that:

- a) Its pouches identified in its catalogues as pencil pouches can also be considered as carry-alls;
- b) The name "pencil pouch" was used in the context of a particular catalogue;
- c) The pouches illustrated in such catalogues are not limited to the storage of pencils.

The pouch filed as exhibit A-14 was considered large enough to contain small objects other than pencils. As stated by the former Chair of the Board Mr. G.W. Partington in *Buffalo-Eastcantra Incv. Sarafina Invest Ltd. re application No.772225, November 27, 2000,:*

"While the opponent [the Applicant in our case] in its evidence generally characterized its pouches as being pencil pouches, I believe that the average consumer would view at least some of the opponent's pouches, specimens of which have been adduced by Mr. Fonfeder, as being of a size that they could be used for carrying a variety of items including school supplies, transistor radios, cellular telephones, calculators, address books, diaries and the like."

There is however no evidence that such pouch was sold or even offered for sale in Canada in 1987. It does not appear in the Applicant's catalogues, exhibits A-1 and A-2. Reference was made during Mr. Fonfeder's cross-examination to a pouch bearing identification number U521. According to Mr. Fonfeder, such pouch was identified in advertisements as a carry-all. He did refer to exhibit A-14 to his affidavit, which is an advertisement of Value Drug Mart of August 30, 1997. There is however no evidence of use of the Mark in association with such product as of January 1st, 1987.

In so far as knapsacks are concerned, the Applicant is relying heavily on the Registrar's decision in *Buffalo-Eastcantra Inc, supra*, in which the Applicant successfully opposed the Opponent's application to register the trade-mark BUFFALO in association with packsacks. It argues that the evidence filed by the Applicant in the present record, which is substantially the same as that filed in application 772225, establishes use of the Mark in association with knapsacks.

There exists a fundamental difference between the burden of proof of an opponent who is opposing the registration of a mark on the basis of likelihood of confusion with its registered trade-mark and the situation where an opponent is alleging non-use of the mark in association with some of the wares described in an application. In the former situation the applicant must convince the Registrar, on the balance of probabilities that its trade-mark is not likely to cause confusion with the opponent's registered mark. Some of the circumstances to take into consideration are described in Section 6(5) of the Act. Those include the nature of the wares, services or business and the nature of the trade of the respective parties'. It was in that context that Mr. Partington concluded in *Buffalo-Eastcantra Inc, :*

“Considering next the nature of the wares of the parties [Para.6(5)(c)] and the nature of the trade associated with the trade-marks at issue, the applicant's “packsacks” are, in my view, similar to the “school bags” covered in the opponent's registration and also bear some minor degree of similarity to the pencil pouches which are also covered in the opponent's registration. I would note that the advertisement comprising Exhibit A-9 to the Fonfeder affidavit shows a school bag described as a “High School Book Bag” which is similar to the “Children's Backpack” appearing in the same advertisement. Further, backpacks and packsacks would, in my view, be quite similar in nature. Moreover, I would expect that there could be a potential overlap in the channels of trade associated with the applicant's “packsacks” and the opponent's school bags and pencil pouches.”

He therefore concluded that there was a likelihood of confusion between the packsacks described in Application 772225 and the school bags covered by the existing Applicant's registration TMA226024. Nowhere in *Buffalo-Eastcantra Inc.*, did the Registrar conclude that there was evidence of use of the Mark by the Applicant in association with knapsacks.

In the present opposition, the Opponent is relying on the Applicant's own evidence as well as the evidence filed by the Applicant in the opposition re application 772225 to at least raise some doubts as to the use of the Mark in association with carry-alls and knapsacks. I agree with the Opponent's position and as such the burden of proof has shifted to the Applicant who must show use, as of the claimed date of first use, of the Mark in association with carry-alls and knapsacks. The Applicant has failed to discharge such burden. [See *Immuno AG v. Immuno Concepts, Inc.*, (1996) 69 C.P.R. 374] Therefore I maintain the first ground of opposition described above, in so far as carry-alls and knapsacks are concerned [See *Lowenbrau Aktiengesellschaft v. Comm. Telesforo Fini Societa Per Azioni* (1991) 36 C.P.R. (3d) 54].

The relevant date with respect to grounds of opposition described in paragraph 2 and 3 above is the claimed date of first use, namely January 1st, 1987 as per the wording of Section 16(1) of the Act. The Opponent failed to file any evidence of use prior to the material date of the trade-mark BUFFALO in association with articles of clothing or accessories. Because I maintain the first ground of opposition in so far as carry-alls and knapsacks are concerned, only for those wares the relevant date for those grounds of opposition would be the date of filing of the present application, namely August 11, 1997. [See *American Cyanamid Co. v. Record Chemical Co. Inc.* (1972), 6 C.P.R. (2d) 278 (T.M.O.B.); *Everything for a Dollar Store (Canada) Inc. v. Dollar Plus Bargain Centre Ltd.* (1998), 86 C.P.R. (3d) 269 (T.M.O.B.)] Exhibit GB-9 to GB-17 inclusive are sample bags of the Opponent bearing the trade-mark BUFFALO. The Opponent filed invoices, Exhibit GB-8, predating the relevant date of August 11, 1997. There is however no evidence;

- a) That these invoices are for bags bearing the trade-mark BUFFALO
- b) Of a correlation between the style numbers appearing on the invoices and the bags GB-9 to GB-17.

As the Opponent failed to discharge its initial burden, I dismiss the second and third grounds of opposition.

There remain the fourth and fifth grounds of opposition. The relevant date with respect to Section 12(1)(d) ground of opposition is the date of my decision. [*See Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)*] The material date for assessing the issue of distinctiveness is generally accepted to be the date of filing of the opposition (January 26, 1998) [see *Andres Wines Ltd. and E&J Gallo Winery (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.)* and *Park Avenue Furniture Corporation, op.cit.*]

The difference in the relevant dates of the remaining grounds of opposition will not have an impact on the outcome of my analysis of the surrounding circumstances to determine if there exists, on a balance of probabilities, any likelihood of confusion between the Mark and the Opponent's trade-marks

The Opponent did not file any evidence to establish the existence of the certificate of registrations listed under its fifth ground of opposition. The Registrar is entitled to consult the Register to confirm the existence of the registrations cited in support of such ground of opposition. [See *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée. v. Manu Foods Ltd., 11C.P.R. (3d) 410*] I did such verification and confirm that registration numbers 313138, 364692, 369788, 369789, 443164, and 443415 are still in good standing on the Register and cover articles of clothing and headwear.

The outcome of the remaining two grounds of opposition will turn on the issue of likelihood of confusion between the Mark and the Opponent's registered trade-marks listed above.

The burden of proof lies on the Applicant who must convince the Registrar, on the balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's trade-marks at the abovementioned relevant dates [see *Sunshine Biscuits Inc. c. Corporate Foods Ltd. (1982), 61 C.P.R. (2d) 53*].

Mr Justice Décary of the Federal Court of Appeal stated in the case of *Christian Dior, S.A. et Dion Neckwear Ltd* [2002] 3 C.F.405:

«...the Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it; the question is whether the ordinary consumer will, on seeing the later mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares of the earlier...”

In order to determine whether the parties’ trade-marks are confusing, Subsection 6(5) of the Act directs that the Registrar is to have regard to all of the surrounding circumstances, including: i) the inherent distinctiveness of the trade-marks or trade names and the extent to which they have become known; ii) the length of time the trade-marks or trade names have been in use; iii) the nature of the wares, services, or business; iv) the nature of the trade; and v) the degree of resemblance between the trade-marks or trade names in appearance or sound or in the ideas suggested by them.

Mr. Justice Décary of the Federal Court of Appeal in *Miss Universe Inc. v. Bohna* [1995] 1 C.F. 614 stated:

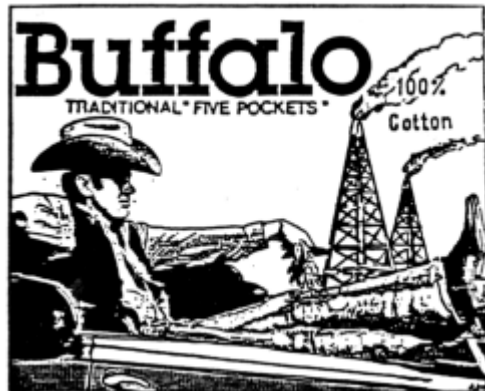
To decide whether the use of a trade-mark or of a trade-name causes confusion with another trade-mark or another trade-name, the Court must ask itself whether, as a matter of first impression on the minds of an ordinary person having a vague recollection of that other mark or name⁵*ftnote⁵ See *Coca-Cola Co. v. Pepsi-Cola Co. (1942)*, 2 D.L.R. 657 (P.C.), at p. 661, Lord Russell of Killowen, the use of both marks or names in the same area in the same manner is likely to lead to the inference that the services associated with those marks or names are performed by the same person, whether or not the services are of the same general class.⁶*ftnote⁶ See s. 6(2),(3) and (4) of the Act; *Rowntree Company Limited v. Paulin Chambers Company Limited et al.*, [1968] S.C.R. 134; *Oshawa Holdings Ltd. v. Fjord Pacific Marine Industries Ltd.* (1981), 55 C.P.R. (2d) 39 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, [1988] 3 F.C. 91 (C.A.), at p. 99, Thurlow C.J.; and *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1 (F.C.T.D.), at p. 12, Cattanach J.

(...)

The onus is always upon an applicant for the registration of a trade-mark to establish that, on the balance of probabilities, there is no likelihood of confusion

with a previously used and registered trade-mark.⁷ See *Sunshine Biscuits, Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53 (F.C.T.D.), at p. 57, Cattnach J. and *Molnlycke Aktiebolag v. Kimberly-Clark of Canada Ltd.* (1982), 61 C.P.R. (2d) 42 (F.C.T.D.), at p. 46, Cattnach J.”

For ease of reference I reproduce the designs of registrations TMA313138 and TMA364692 respectively:



It becomes apparent from these designs that the best-case scenario for the Opponent is with its word trade-mark BUFFALO as the designs elements are totally different. The Mark and the Opponent’s registered trade-mark BUFFALO, certificate of registration TMA369788, possess the same degree of inherent distinctiveness when used in association with the parties’ respective wares.

The Wares in issue are different from the wares covered by the various registrations owned by the Opponent listed under the fifth ground of opposition. The Opponent has filed no evidence to support its contention mentioned in its statement of opposition that the Wares in issue are related wares to articles of clothing and a normal extension of any corporation carrying on business in the fashion industry.

The channels of trade would be different in view of the difference in the type of wares covered by the present application and the wares listed in the Opponent’s certificates of registration.

The Applicant has filed evidence of use since at least 1980 (Exhibits A-1 to Mr. Fonfeder's affidavit) of the Mark in association with the Wares in issue save and except for knapsacks. The Opponent's certificate of registration 313138 issued on the basis of alleged use of the mark by the Opponent since 1983. On the assumption that one can rely on the date of alleged use referred to in a certificate of registration, which issue does not need to be decided for the purpose of this decision, this factor would also favour the Applicant.

As an additional relevant circumstance, even though it is only necessary to conclude there exists, on a balance of probabilities, a likelihood of confusion in order to maintain such grounds of opposition, I notice that there has been no case of confusion alleged by the Opponent despite the coexistence of the marks in issue over a period of twenty-one years. [See *Cornell Trading Ltd. v. Saan Stores Ltd* 8C.P.R.(4th) 233 and *Compulife Software inc v. CompuOffice Software inc* (2001) 13 C.P.R.(4th) 117]

I'm satisfied in taking into consideration the circumstances described above that, on a balance of probabilities, the Applicant's Mark is not likely to cause confusion with the Opponent's marks when used in association with the Wares in issue. As such I dismiss the fourth and fifth grounds of opposition described above.

Conclusion

Having been delegated authority by the Registrar of Trade-marks by virtue of Section 63(3) of the Act, and applying the principles enunciated in the case of *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH 10 C.P.R. (3d) 482*, I refuse, pursuant to Subsection 38(8) of the Act, the Applicant's application for the registration of the Mark, only with respect to carry-alls and knapsacks.

DATED, IN MONTREAL, QUEBEC, THIS 27 DAY OF JULY 2004.

Jean Carrière,
Member,
Trade-marks Opposition Board