IN THE MATTER OF AN OPPOSITION by ArtScroll Printing Corp., Mesorah Publications Ltd., and Rabbi Martin Zlotowitz to application No. 855,740 for the trade-mark ART SCROLL filed by National Office & Classroom Supply N.O.C.S. Inc./Fourniture de Bureau et Scolaire N.O.C.S. Inc.

On Sept. 12, 1997, the applicant, National Office & Classroom Supply N.O.C.S. Inc./Fourniture de Bureau et Scolaire N.O.C.S. Inc., filed an application to register the trade-mark ART SCROLL based on proposed use in Canada. The application covers the following wares: Art supplies namely: paint, paint brushes, pastels, chalk, crayons. The applicant disclaimed the right to the exclusive use of the word ART apart from the trade-mark as a whole. The application was advertised for opposition purposes on June 10, 1998.

The opponents, ArtScroll Printing Corp., Mesorah Publications Ltd., and Rabbi Martin Zlotowitz, filed a statement of opposition on Nov. 9, 1998 and an amended statement of opposition on December 18, 1998. The applicant served and filed a counter statement on January 15, 1999.

The grounds of opposition, as pleaded, are as follows:

a) Section 38(2)(a)

The opponents base their opposition on the grounds set out in Section 38(2)(a) of the Trade-Marks Act, [R.S.C. 1985, c. T-13 ("the Act")], namely that the applicant does not comply with the requirements of Section 30(e) of the Act in that the applicant does not intend to use the mark in Canada.

b) Section 38(2)(b) and Section 38(3)(a)

The opponents further base their opposition on the grounds set out in Section 38(2)(b) of the Act, namely that the application is not registrable having regard to the provisions of Section 6 of the Act. The applicant's mark is confusing with the opponent's trade-mark and trade-name ARTSCROLL. Opponents have used the trade-name ARTSCROLL since at least 1963 in association with the commercial operation of an art studio offering caligraphy, fine art, painting and other art services and since at least 1973 in association with card colouring and crayon sets, children's books, colouring books, educational books, school books used for religious education, graphic art services offering the production of religious and secular documents, greeting cards, and illuminated scrolls and a cd rom software paint program.

The opponents allege that the applicant's ART SCROLL trade-mark is not registrable for use in

association with the "opposed wares" because the use thereof by the applicant and the use by the opponents of their aforesaid trade-mark in the same area would likely lead to the inference that the wares and services associated with such trade-marks were sold by the same person. Therefore, the applicant's said trade-mark in respect of the "opposed wares" will be considered confusing with the aforesaid trade-marks of the opponents.

c) Section 38(2)(c)

The opponents base their opposition on the grounds set out in Section 38(2)(c) of the Act, namely that the applicant is not the person entitled to registration of the alleged mark claimed in the application, in view of the provisions of Section 16 and in view of the fact that ART SCROLL was and is likely to cause confusion with ARTSCROLL, the opponent's trade-mark and trade-name. At the date of filing the application, namely September 12, 1997, such alleged mark was confusing with:

> (i) The trade-mark ARTSCROLL of the opponents set out in paragraph 4 hereof, which had been previously used in Canada by the opponents;
> (ii) The trade-name ARTSCROLL which has been previously used in Canada by the opponents;
> (iii) Opponents' trade-mark ARTSCROLL in that opponents' trade-mark ARTSCROLL had previously been used in Canada or made known in Canada by another person and Applicant could not have been satisfied that it was entitled to use ART SCROLL in Canada in association with the "opposed wares".

(d) Section 38(2)(d)

The opponents further base their opposition on the grounds set out at Section 38(2)(d) of the Act, namely that ART SCROLL is not distinctive and therefore does not conform to Section 2, as it does not actually distinguish the wares of the applicant from those of the opponents, nor is it adapted to so distinguish them.

The opponents state that ART SCROLL is not distinctive of the "opposed wares". In respect of this ground of opposition, the opponents allege and the fact is that ART SCROLL neither distinguishes the "opposed wares" with which it is alleged to be used by the applicant from the wares and services of the opponents furnished under its aforesaid trade-mark, nor is ART SCROLL adapted so as to distinguish such wares of the applicant.

As its Rule 41 evidence, the opponents submitted the affidavit of Rabbi Martin (Meir) Zlotowitz. However, since Mr. Zlotowitz was not made available for cross-examination, his affidavit was returned to the opponents (see office letter dated January 11, 2001). As its Rule 42 evidence, the applicant filed the affidavit of Michel Bouchard. Only the applicant filed a written argument and an oral hearing was not held.

With respect to the first ground of opposition, the material time for assessing the applicant's compliance with Section 30(e) is the filing date of its application. The onus or legal

burden is on the applicant to show its compliance with that subsection: see the opposition decisions in **Joseph Seagram & Sons** v. **Seagram Real Estate** (1984), 3 C.P.R.(3d) 325 at 329-330 and **Canadian National Railway Co.** v. **Schwauss** (1991), 35 C.P.R.(3d) 90 at 94 and the decision in **John Labatt Ltd.** v. **Molson Companies Ltd.** (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponents respecting their allegations of fact in support of a s.30 ground. That burden is lighter respecting the issue of non-compliance with Section 30(e) of the Act: see page 95 of the **Schwauss** decision and the opposition decision in **Green Spot Co.** v. **J.B. Food Industries** (1986), 13 C.P.R.(3d) 206 at 210-211.

In the present case, the opponents have not provided any evidence that would raise a doubt that the applicant lacked an intention to use its trade-mark in association with the wares listed in its application at the date of filing. No evidence was filed that would indicate that the applicant's mark was already in use in association with the proposed use wares, or had been abandoned by the applicant's filing date. In fact, the applicant's evidence shows that its mark was in use with its wares subsequent to its filing date. This ground of opposition is therefore unsuccessful.

With respect to the Section 16(3)(a) and (c) grounds, there is a burden on the opponents, in view of the provisions of Sections 16(5) and 17(1) of the Act, to establish their prior use or making known of the trade-mark ARTSCROLL and previous use of the trade-name ARTSCROLL as of the applicant's filing date (*i.e.* Sept. 12, 1997) and non-abandonment of the trade-mark as of the date of advertisement for opposition purposes of the present application in the *Trade-marks Journal* (*i.e.* June 10, 1998). As the opponents have not filed any evidence in this regard, they have failed to meet their burden under these two grounds of opposition. Both these grounds of opposition are therefore unsuccessful.

As its final ground, the opponents have alleged that the applicant's trade-mark ART SCROLL is not distinctive in that the applicant's mark does not actually distinguish the applicant's wares. However, no evidence has been furnished by the opponents to show that they have used the trade-mark ARTSCROLL in Canada at any time. The opponents have therefore failed to meet their evidential burden in relation to this ground and it too is therefore unsuccessful.

In view of the above, and pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opponents' opposition.

DATED AT HULL, QUEBEC, THIS 19th DAY OF November, 2002.

C. Folz
Member,
Trade-Marks Opposition Board