

**IN THE MATTER OF AN OPPOSITION  
by Arden Holdings Inc. to application No. 761,887  
for the trade-mark SOPHIST-O-TWIST filed by  
DCNL, Inc., a California corporation and now  
standing in the name of DCNL, Inc., a Texas corporation**

**On August 17, 1994, DCNL, Inc., a California corporation, filed an application to register the trade-mark SOPHIST-O-TWIST for “hair ornaments” based on (1) proposed use in Canada and (2) use and registration (No. 1,973,369) in the United States. The applicant claimed priority based on its corresponding American application and thus the effective filing date of the present application is June 8, 1994. The application was advertised for opposition purposes on August 7, 1996. As a consequence of a corporate merger, the application now stands in the name of DCNL, Inc., a Texas corporation.**

**The opponent, Arden Holdings Inc., filed a statement of opposition on January 7, 1997, a copy of which was forwarded to the applicant on February 13, 1997. In its statement of opposition, the opponent states that it is the owner of the trade-mark FRENCH-O-TWIST used in association with hair ornaments. However, no grounds of opposition were apparently based on the opponent’s use of that mark.**

**The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(c) of the Trade-marks Act because it is the name of the applied for wares in that it “.....is the generic name of a device used to hold hair in place.” The second ground is that the applied for trade-mark is not registrable pursuant to Sections 10 and 12(1)(e) of the Act because it consists of a term that by ordinary and *bona fide* commercial**

usage in Canada has become recognized as designating the kind of wares applied for. The third ground is that the applicant's trade-mark is not distinctive "by reason of the foregoing." The fourth ground is that the applicant's application does not conform to the requirements of Section 30(i) of the Act because the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in Canada.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Stephen Solursh. The applicant did not submit evidence. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

In his affidavit, Mr. Solursh identifies himself as a student at law and states that, on December 18, 1997, he purchased a product bearing the trade-mark SOPHIST-O-TWIST PETITE at a Wal-Mart store in Toronto. Exhibit A to his affidavit is that product which also bears the trade-mark QUALITY & Design (shown below), a notice that SOPHIST-O-TWIST PETITE is a trade-mark and a notice that the product is distributed by Quality Special Products followed by a Scarborough, Ontario address and a Minneapolis, Minnesota address.



Also appended to Mr. Solursh's affidavit are certified copies of a trade-mark registration and two pending applications owned by Quality Dino Entertainment Ltd. The registration is No. 157,596 for the trade-mark QUALITY & Design (shown above) for phonograph records, compact discs and videotapes. One of the applications (S.N. 842,822) is for the trade-mark QUALITY SPECIAL PRODUCTS & Design for the services of operating a business dealing in the distribution of a wide variety of products either by way of direct response marketing or through normal retail channels. Exhibit D to the Solursh affidavit is a copy of an Ontario business name registration for the name Quality Special Products registered by Quality Dino Entertainment Ltd.

The fourth ground does not raise a proper ground of opposition. Merely asserting that the applicant could not have been satisfied that it was entitled to use the applied for trade-mark is insufficient to raise a ground of non-conformance with the provisions of Section 30(i) of the Act. The opponent was required to include supporting allegations of fact in accordance with Section 38(3)(a) of the Act but failed to do so. Thus, the fourth ground of opposition is unsuccessful.

As for the first ground of opposition, the material time for considering the circumstances respecting a ground of non-registrability is the date of decision. Furthermore, while the onus or legal burden is on the applicant to show that its applied for trade-mark is registrable, there is an initial burden on the opponent to support its allegations of fact with evidence. Since the opponent failed to file any evidence directed to establishing that the mark

**SOPHIST-O-TWIST is the name of the applied for wares, the first ground of opposition is unsuccessful.**

**The second ground of opposition is also a ground of non-registrability and thus the material time is the date of decision. As before, although the onus or legal burden is on the applicant to show that its trade-mark is registrable, there is an initial burden on the opponent to evidence its supporting allegations of fact. Since the opponent failed to file any evidence to show that the mark SOPHIST-O-TWIST has become recognized as a generic term designating a kind of hair ornament, the second ground of opposition is also unsuccessful.**

**As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - January 7, 1997): see Re 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 v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.).**

**The only allegations of fact relied on by the opponent in support of its third ground were those set out in its first and second grounds. As discussed, the opponent failed to support those allegations with any evidence. Thus, the opponent has failed to meet its evidential**

burden respecting the third ground of opposition and it, too, is unsuccessful.

The opponent submitted that the product purchased by Mr. Solursh shows that the applied for trade-mark was not distinctive of the applicant's wares because the product packaging points to use of the trade-mark SOPHIST-O-TWIST by someone other than the applicant with no indication that such use was licensed by the applicant. However, the opponent failed to plead such a ground in its statement of opposition and I am therefore precluded from considering it: see Imperial Developments Ltd. v. Imperial Oil Ltd. (1984), 79 C.P.R.(2d) 12 at 21 (F.C.T.D.).

The opponent submitted that the ground of non-distinctiveness as argued in its written argument did not have to be pleaded in detail in its statement of opposition in order to be considered in this proceeding. In this regard, the opponent relied on the decision of O'Keefe, J. in Canadian Council of Professional Engineers v. APA - The Engineered Wood Association (2000), 7 C.P.R.(4th) 239 at 256-257 (F.C.T.D.). However, the APA decision dealt with the breadth of a ground of non-registrability whereas the Imperial Developments decision dealt with an unpleaded ground of non-distinctiveness based on third party uses of the applicant's trade-mark by unapproved proposed registered users. Since the latter situation is very similar to that in the present case, I consider that it is preferable to follow the position taken by the Court in Imperial Developments.

Furthermore, Mr. Justice O'Keefe recognized in the APA case that his broadened

approach to the opponent's ground of non-registrability was subject to the potential prejudice it might cause to an applicant who did not receive adequate notice of the expanded ground. In the present case, a review of the applicant's written argument reveals that the applicant was not aware of the specific ground of non-distinctiveness the opponent intended to rely on. Rather, the applicant was apparently misled by the reference in the statement of opposition to the opponent's trade-mark FRENCH-O-TWIST and assumed that the opponent's non-distinctiveness ground was based on an allegation of confusion with the opponent's mark. The first indication that the opponent was relying on an allegation of third party, unlicensed use of the applied for trade-mark in support of a general ground of non-distinctiveness was when that allegation appeared in its written argument. Thus, even if the APA decision is applicable in this case, I could not consider the opponent's characterization of its ground of non-distinctiveness since it would significantly prejudice the applicant who only became aware of that characterization after the evidence stage of the present proceeding had closed.

Even if such a ground had been properly raised, I doubt that it would have been successful. The opponent contended that the packaging of the product purchased by Mr. Solursh gives the message that the source of the wares is an entity called Quality Special Products. However, that entity is identified on the packaging as a distributor which is not inconsistent with the applicant being the owner of the mark SOPHIST-O-TWIST PETITE shown thereon and the anonymous source of the wares. On the other hand, if the opponent is contending that the purchase by Mr. Solursh establishes third party use tending to negate the distinctiveness of the applicant's trade-mark, a single sale would have been insufficient to

**meet the opponent's initial evidential burden in this regard.**

**At the oral hearing, the opponent's agent requested that, if the opponent's characterization of its non-distinctiveness ground was not accepted, the opponent be allowed to amend its statement of opposition to include that specific pleading. However, I cannot act in such a fashion unless the opponent submits a proper request and the applicant is given an opportunity to make its objections. No such request was received. Even if such a request had been made, given its lateness and the potential prejudice to the applicant, it seems unlikely that it would have been granted.**

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

**DATED AT GATINEAU, QUEBEC, THIS 6<sup>th</sup> DAY OF JUNE, 2002.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**